

1902
 Mar. 4.

DAVID FINDLAY AND WILLIAM } PLAINTIFFS;
 FINDLAY..... }

AND

THE OTTAWA FURNACE AND } DEFENDANTS.
 FOUNDRY COMPANY (LIMITED)

*Industrial Design—Cook stove—Imitation—Infringement—Injunction—
 Cancellation of conflicting design.*

The plaintiffs were registered owners of an industrial design for a cook stove, called the "Royal Favorite, 9-25," which, as a special article of their manufacture, had become well known to the trade. The defendants procured one of the said stoves, caused a model to be made of it, and with some minor alterations, chiefly in the ornamentation, manufactured a stove called the "Royal National, 9-25," and subsequently registered it as an industrial design. In an action by the plaintiffs for infringement and for an order to expunge defendants' design from the register, the weight of evidence established that the defendants' design was an obvious imitation of that of the plaintiffs.

Held, that the defendants should be enjoined from infringing the plaintiffs' design, and that the registration of that of the defendants should be expunged from the register.

THIS was an action to restrain the infringement of the plaintiffs' industrial design for a cooking stove, and to expunge from the register a design registered by the defendants.

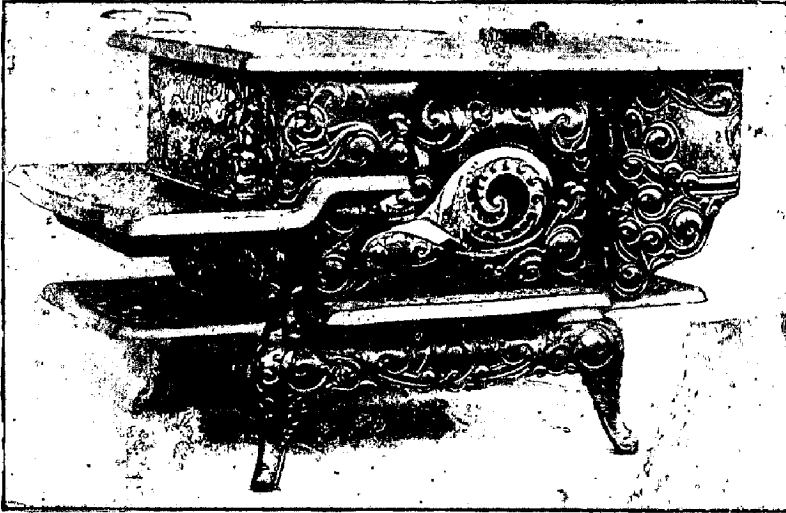
March 1, 1902

The case was tried at Ottawa, argument being postponed until March 4th, 1902.

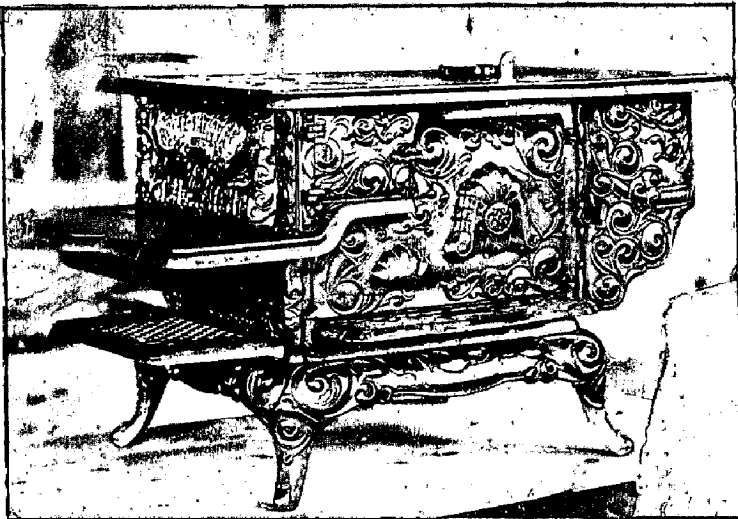
The facts of the case were as follows:—

The plaintiffs were doing business as manufacturers of stoves at Carleton Place, Ont., and had registered an industrial design in the Department of Agriculture, at Ottawa, for a cooking stove which is now known to the trade as the "Royal Favourite, 9-25." The diagram marked "A" on the following page is a representation of the plaintiffs' stove.

"A"



"B"



The defendants were an incorporated joint-stock company carrying on the trade and business of iron-founders and manufacturers of stoves in the City of Ottawa, Ont. A short time after they had commenced business, they procured a stove made by plaintiffs according to their registered design, took it apart and made a set of patterns of the parts. From these patterns the defendants made a stove known as the "Royal National, 9-25". They, however, made alterations in the ornamental scroll-work of the stove, and adopted a different medallion; they also made some minor alterations in the interior construction of the stove. The exterior top was, with the exception of the name, practically the same as that of the plaintiffs' stove. The diagram marked "B" on page 339 is a representation of the defendants' stove

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The defendants' manager, being examined on discovery, described as follows the method his company pursued in preparing the model for their stove:

Q. Where did you get the stove?—A. We bought it from Burton Harum.

Q. Who is he and what does he do?—A. He is a stove dealer.

Q. In Ottawa?—Yes.

Q. Did he procure it at the request of the company, or did you happen just to buy it from him?—A. We asked him to buy a stove of that description.

Q. Did you ask him to buy the Findlay "Royal Favorite, 9-25"?—A. Yes.

Q. And he got the stove and supplied your company with it?—A. Yes.

Q. When was that?—A. I could not give you the date of it at the present moment.

Q. You say you do not remember?—A. I could not tell you the date, some time in the fall of 1901.

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Q. I am looking at a letter here from Findlay Brothers to the defendants of the 18th October last in which they draw attention to the fact that they learn that you had got one of the "Royal Favorite" stoves from B. Haram?—A. Yes.

Q. It would be about that time?—A. Yes, it would be about that time.

Q. Then, having got that stove what did you do with it?—A. We redressed it.

Q. Did you take it apart?—A. Yes.

Q. And what else did you do with it?—A. We made a set of patterns of it.

Q. Made a set of patterns of the parts?—A. Of a similar size.

Q. Made a set of patterns of the parts of the stove that you took apart?—A. Yes.

Q. Did you do anything in the way of altering the work upon the stove?—A. Yes.

Q. You did something?—A. Yes, considerable.

Q. That is, you made alterations in the scroll-work?
 A. Yes, and the interior.

Q. You made alterations in the scroll-work?—A. Yes.

Q. And you put a medallion of a different pattern from that which was on the "Royal Favorite"?
 A. Yes.

Q. How did you make the alterations in the scroll-work?—A. We used parts of the scroll-work of our furnaces.

Q. I am not asking what scrolls you used, but how did you make the alterations on the iron, on the metal of the stove that you bought in order to make patterns of it?—A. Well, we simply took off and added in different places.

Q. I want to know how it was done? Did you file it off or saw it off?—A. Yes, we ground part of it off with an emery wheel.

Q. You ground part of the scrolls that were on Findlay's stove?—A. Yes.

Q. And how did you put on the additions that you made?—A. Well, we took patterns from our furnaces: we run those in lead or block tin, and cut out the lettering, and added in that way, running it in brass afterwards.

Q. And you attached that to the parts of the stove which you used as patterns in the same way?—A. Yes.

Q. And then that made the completed pattern?—A. Yes.

Q. With what was on before?—A. Yes, brass parts were added.

Q. For instance, just to illustrate that, here are two stoves, exhibits attached to an affidavit filed on the 16th January last. Just one instance we will take, not to multiply evidence. On the fuel door you ground off this small scroll at the top of the door?—A. I think we took this all off.

Q. You took off part of the scroll on the top of the fuel door, and then you added a piece like that, like what is on the "Royal National" stove exhibited on the same affidavit?—A. Yes.

Q. That is an instance of the way you made the alterations?—A. Yes.

Q. Then did you make any alterations on the inside of the stove?—A. Yes, sir.

Q. That is, the mechanical construction of the stove inside you altered: is that what you mean, or was it merely in the shape of things that were inside?—A. The construction of all stoves is similar.

Q. Give me an instance of any alteration you made on the inside in the shape or pattern of what was there?—A. The firebox linings. We altered them altogether in the back.

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Q. That is, you altered the pattern?—A. Yes; of course a fire-brick is a fire-brick in any stove.

Q. You made some differences in the pattern of the inside of the firebox?—A. And in the front of the firebox also.

Q. Inside?—A. Yes.

Q. On the top of the stove you did not make any alteration either in the figures or their position, of 9-25?—A. No.

Q. You left that exactly the same?—A. 9-25 is 9-25.

Q. You did not make any difference: you just used the top of the stove as a pattern, just as it was?—A. Yes.

Q. And on the inside parts of the stove you did not make any difference in the figures and letters that were there, "Roy." for instance, 9-25?—A. We have got "Royal".

Q. You left that there?—A. Yes.

Q. Just as it was?—A. Yes, sir.

Q. And these figures or letters—that is "Roy. 9-25"—you left them just exactly as they were upon the parts of the stove inside of the "Royal Favorite"?—A. Yes.

Q. You left it the same in your "Royal National"?—A. Yes.

Q. Who designed these changes that were made?—A. Mr. Baird, foreman of the shop, and myself.

Q. The general size and shape of the stove was the same?—A. Very much similar in size; there might be a fraction of an inch difference.

Q. It was intended to be: if you used one of them as a pattern, you would naturally make it exactly the same size as the one you used?—A. Yes, or pretty near it.

Upon the question of obvious imitation, and as to the liability of the public being deceived into buying the defendants' stove for that of the plaintiffs', the following evidence for and against that theory was submitted at the trial:—

William Strahan, a stove dealer in Ottawa of twenty years experience, stated that, in his opinion, there was so much similarity between the stoves that an ordinary customer might easily purchase the defendants' stove in mistake for that of the plaintiffs.

Joseph Boyden, whose experience in the business of buying and selling stoves in Ottawa covered a period of some twenty-five years, was asked:

Is the similarity such as from your experience a purchaser would be likely to take the one for the other, the "Royal National" for the "Royal Favorite".

"A. Well, I would decidedly say that if the two stoves were not present it would be a very difficult matter. For instance if the customer looked at one stove in my place, and we will say went to another dealer and looked at the other stove, it would be a very difficult matter for them to define, or tell, which was which".

Frank Esmond, a dealer in stoves of eighteen years experience, said, on direct examination, that the two stoves were practically the same. On cross-examination he expressed the opinion that even an ordinary customer who wanted to buy the "Royal Favorite" stove, and knew the design, might buy the "Royal National" for it.

John C. Enright, who had thirty-five years experience in the stove trade, said he thought that an ordinary purchaser, coming into a store and not observing the name, might mistake the "Royal National" for the "Royal Favorite." Leaving out the difference in the name and a difference in the ornamentation he did

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not think that there would be any difficulty in selling one stove for the other.

“Q. If you take off the name of the manufacturer, and the name of the stove, and have the two stoves standing together, it would be a difficult matter for anyone to tell?”

“A. You take the hearth-plate off the “Royal Favorite,” and the nickel medallion off the oven door, and change them around, it would be very hard to say which was which.”

Thomas H. Percival, a manufacturer of stoves, thought that there was a very strong resemblance between the stoves in respect of design, dressing and construction. There was also, in his opinion, some similarity in the names. Some purchasers would be deceived by the similarity, others would not, in his opinion.

Robert McAllen, having a dozen years' experience in the stove trade, said that, assuming a dealer would act fairly and honestly in conducting a sale, the average customer would not be deceived into buying the “Royal National” for the “Royal Favorite.”

John Kerr, who had from ten to fifteen years experience in buying and selling stoves, expressed the view founded upon his experience, that there were no incautious buyers of stoves. He thought that an average purchaser would not be deceived by any outward similarity in appearance of the two stoves in question into purchasing the defendants' stove for that of the plaintiffs.

Upon the question of originality of design in the plaintiffs' stove,—

John Baird, one of the defendants' employees, and having twenty-five years experience in stove-making, said that there was nothing new in the design of the plaintiffs' stove. “I cannot place anything in that stove that Mr. Findlay has registered that we cannot

in some other stoves find something very similar, if not the very same."

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The argument of the case now took place at Ottawa.

W. D. Hogg, K. C., for the plaintiffs, contended that there was a clear case of intentional imitation apparent upon the evidence. The plaintiffs' stove was deliberately taken to pieces and models prepared from it by the defendants. The two stoves are practically made from the same design.

[BY THE COURT.—You would contend that there is an obvious imitation by the defendants of the plaintiffs' stove.]

Yes.—The public is likely to be deceived into buying the defendants' stove for that of the plaintiffs', and even in the absence of fraud the defendants ought to be restrained under the authorities. (Cites *Harper v. Wright* (1); *Hecla Foundry Company v. Walker* (2); *Grafton v. Watson* (3); *Sen-Sen v. Brittens* (4).)

On the question of jurisdiction, I think this court has a clear right to grant the remedy sought by the plaintiffs. While there may be some doubt upon the Trade-Marks and Industrial Designs Amendment Act, 54-55 Vict. ch. 35, there is certainly none under the Exchequer Court Amendment Act, 54-55 Vict. c. 26 sec. 4, which expressly gives the court jurisdiction in respect of actions for infringement of industrial designs as well as of those seeking to expunge registration, or to vary or rectify the register. That jurisdiction has never been taken away expressly or by implication.

G. F. Henderson, for the defendants, claimed that under the guise of an industrial design the plaintiffs were seeking the protection of a patent. There is the greatest difference between the two. The plaintiffs

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(1) [1896] 1 Ch. 142.

(2) 14 App. Cas. 550.

(3) 51 L. T. 141.

(4) 68 L. J. Ch. 250.

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cannot prevent us from manufacturing a cook stove when all they have registered is an ornamental design for a cook stove. If we differentiate the ornamentation, we have a clear right to manufacture a stove of the shape and dimensions of that of the plaintiffs. All the witnesses say there is nothing new in the plaintiffs' stove, nor anything original for that matter in the ornamentation. These facts distinguish the case from *Harper v. Wright* (1); where the cathedral design of the stove was new. (*Re Clarke's Design* (2); *Payton v. Snelling* (3); *DeKuyper v. Van Dulken* (4); *Rollason's Design* (5).

So long as we do not imitate the ornamentation, the configuration of the stove in the opinion of the witnesses here is not an element of deception. (Cites *Le May v. Welch* (6); *Morton's Design* (7); *Holdsworth v. McRae* (8),

W. D. Hogg, K.C., replied, citing *Saxlehner v. Apollinaris Co.* (9).

At the conclusion of the argument, the following judgment was delivered by the JUDGE OF THE EXCHEQUER COURT :

I do not think anything would be gained by reserving this case. It is largely a question of fact that is to be determined, and the question has been very fully discussed. I have no doubt that I have jurisdiction in the matter, and I think it clear that the plaintiffs have a registered design in respect of which they are entitled to protection.

As to the law bearing on the case, it is, I think, to be found in the cases mentioned during the argument,

(1) [1896] 1 Ch. 142.

(2) 13 *Cutl. P. C.* 358.

(3) 17 *Cutl. P. C.* 57.

(4) 4 *Ex. C. R.* 71.

(5) 15 *Cutl. P. C.* 447.

(6) 28 *Ch. D.* 24.

(7) 17 *Cutl. P. C.* 171.

(8) *L. R.* 2 *H. L.* 380.

(9) 66 *L. J. Ch.* 533 ; [1897] 1 *Ch.* 893.

those referred to *In re Melchers* (1), that is *Harper v. Wright, Holdsworth v. McCrea, The Hecla Foundry Coy's* case; and the case of *Oliver v. Thornley* (2), and other cases that have been referred to on the argument.

Then as to the question of imitation, it seems to me, that the stove the defendants are making, the "Royal National", is, as it is now manufactured, an obvious imitation of the plaintiffs' "Royal Favorite" for which the latter have a registered design. I do not think I am called upon to express any opinion as to whether or not the defendants might make a stove similar in dimensions and shape to the "Royal Favorite" that would not be an imitation of the "Royal Favorite". The only question here is whether the "Royal National" is an imitation or infringement of the plaintiffs' registered design, and I think it is. I confine myself to that issue, and I hold myself free to deal, upon its merits, with any other case that may arise.

Now as to the remedy,—I think the plaintiffs are entitled to an injunction against the manufacture and sale of the "Royal National" stove in the form in which it has been manufactured, and with the design adopted by the defendants. I do not say that the defendants are not entitled to manufacture a stove to be called the "Royal National", only that they are not to manufacture it in the form and with the design shown in evidence in this case. I agree with Mr. Henderson that if an injunction should be granted there should also be an order to expunge from the Register of Industrial Designs the defendants' registration of the "Royal National". There will be such an order.

On the question of the disposition to be made of the "Royal National" stoves already manufactured by

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(1) 6 Ex. C. R. at p. 101.

(2) 13 Cutl. P. C. 490.

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the defendants, I understand the parties to say that it is possible that they can come to an agreement as to that; but if they are not able to do so there will be a reference to the Registrar to ascertain how many there are of such stoves, and the question of the disposition to be made of them will be reserved until after his report is made.

I think the plaintiffs are entitled to their costs, to be taxed.

Judgment accordingly.

Solicitors for plaintiffs: *O'Connor, Hogg & Magee.*

Solicitors for defendants: *McCracken, Henderson & McDougal.*
