

BETWEEN

1904
Mar. 7.

SPILLING BROTHERS..... PLAINTIFFS;

AND

JAMES O'KELLY.....DEFENDANT.

Trade-mark—Infringement—Prior use—“King” cigars—Application to rectify register—Counter-claim—Title in trade-mark—Defence.

A manufacturer or dealer in cigars cannot acquire the right to the exclusive use, and be entitled to the registration, of a specific trade-mark, of which the term “King” forms the leading feature, and is used in combination with the representation of some particular king, while other manufacturers or dealers use the same term in combination with the likeness of other kings. *Spilling Bros. v. Ryall* (8 Ex. C. R. 195) explained.

2. An application to rectify the register of trade-marks cannot be made by counter-claim. (*Secus* now, under general order of 7th March, 1904.)
3. In an action for the infringement of a trade-mark the defendant may attack the legal title of the plaintiffs to the exclusive use of the trade-mark which they have registered. *Partlo v. Todd* (17 S. C. R. 196) referred to. *Provident Chemical Works v. Canadian Chemical Manufacturing Co.* (4 O. L. R. 545) approved.

ACTION for infringement of a trade-mark for cigars. Defendant filed a counter-claim asking for a rectification of the register of trade-marks by expunging therefrom the plaintiffs' mark (1).

The facts of the case are stated in the reasons for judgment.

(1) REPORTER'S NOTE.—The practice under which this counter-claim was dismissed is changed, being regulated by the following order:

IN THE EXCHEQUER COURT
OF CANADA.

GENERAL ORDER.

In pursuance of the provisions contained in the 55th section of

“*The Exchequer Court Act,*” as amended by 52 Vict. ch. 38, sec. 2, it is hereby ordered that the following rule in respect of the matters hereinafter mentioned shall be in force in the Exchequer Court of Canada:—

1. An application to have any entry in any register of copyrights, trade-marks or industrial designs

February 16th, 1904.

The case was heard at Ottawa.

R. G. Code (*E. F. Burritt* with him) for the plaintiffs, contended that the trade-mark relied on by the plaintiffs in this case was a valid one, and the evidence showed that the plaintiffs have an exclusive right to it. *Apollinaris Company v. Snook* (1); *Lever v. Goodwin* (2). As soon as we obtain our certificate of registration we have an exclusive right to use the trade-mark.

W. R. White K.C., for the defendant, contended that upon the additional evidence touching the use of the term "King" as a label for cigars, which was produced in this case, *Spilling Bros. v. Ryall* (3) is of no avail to support the plaintiffs' contention. *Partlo v. Todd* (4); *Watson v. Westlake* (5); *Provident Chemical Works v. Canadian Chemical Manufacturing Co.* (6).

But if it were conceded that the plaintiffs' trade-mark is good, the defendant has not infringed it. A person who desires to buy Spillings' cigars will not be misled into buying those of the defendant.

A. W. Fraser, K.C., followed for the defendant, contending that the defendant acted in good faith and did not know of the plaintiffs' trade-mark until this action was threatened. The term "King" is a material part

expunged, varied or rectified, may be joined with or made in an action for infringement—

(1) By the plaintiff in his statement of claim, where such entry has been made at the instance of the defendant, or some one through whom he claims, and the plaintiff is aggrieved thereby; or

(2) By the defendant by counter-claim, where such entry has been made at the instance of the plaintiff, or some one through

whom he claims, and the defendant is aggrieved by such entry.

Dated at Ottawa, this 7th day of March, A.D. 1904.

(Sgd.) GEO. W. BURBIDGE,
J. E. C.

- (1) 7 Cutl. R. P. C. 474.
(2) 4 Cutl. R. P. C. 492.
(3) 8 Ex. C. R. 195.
(4) 17 S. C. R. 196.
(5) 12 Ont. R. 449.
(6) 4 O. L. R. 545.

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Argument
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of the plaintiffs' trade-mark, and after being so long in prior use could not subsequently be made a subject of trade-mark by them. *Bass v. Dawber* (1); *Sebastian on Trade-marks* (2); *Rodgers v. Rodgers* (3); *Fulwood v. Fulwood* (4).

R. G. Code, in reply, contended that the defendant's counter-claim was bad, because he asks therein to have the Register of Trade-marks rectified by expunging therefrom the plaintiffs' trade-mark. This cannot be done in England by counter-claim, nor can it be done here. *Pinto v. Badman* (5). Nor can the defendant set up by way of defence that we have not the exclusive right to use our trade-mark. That can only be done by bringing in the Minister of Agriculture.

On the question of infringement he cited *Partlett v. Guggenheimer* (6).

THE JUDGE OF THE EXCHEQUER COURT now (March 7th, 1904) delivered judgment.

The action is brought for relief against an alleged infringement by the defendant of the plaintiffs' registered trade-mark hereinafter described. The same trade-mark was in question in the case of *Spilling Brothers v. Ryall* (7), and by agreement of the parties a portion of the evidence taken in that case was read on the hearing hereof.

From the year 1890 to the year 1901 the plaintiffs, who are manufacturers of cigars, put up cigars in boxes, on the covers of which were impressed the words "Our King Cigar." On the under side of the cover were the words in large letters "Royal Crown" surmounting a crown and other representations, below which appeared the words "The King of 10c. Cigars."

(1) 19 L. T. N. S. 626.

(4) 9 Ch. D. 176.

(2) 4th ed. p. 172.

(5) 8 Cutl. R. P. C. 181.

(3) 31 L. T. N. S. 285.

(6) 67 Md. 542.

(7) 8 Ex. C. R. 195.

On the 5th of February, 1901, they registered as a specific trade-mark to be used in connection with the sale of cigars a label bearing in an "oval form a vignette of King Edward VII., with a coat of arms on one side and a marine view on the other surmounted by the word 'Our King,' and with the words Edward VII., underneath." This, as a whole, was, of course, a different mark from that which they had been using; but it appeared from the evidence, and it seemed reasonable, that where cigars were sold from boxes bearing either of such marks, the tendency was for the cigars to become known as "King Cigars." And so far as appeared in evidence in that case the plaintiffs were the first to use the word "King" as a leading feature or characteristic of a mark to designate cigars manufactured by them. On that ground the registered trade-mark was upheld. While the plaintiffs had added to, and changed the mark they had been using, they had retained that important feature. In the present case, however, it has been shown that the plaintiffs were not the first to use the word "King" with other words and designs as a mark to be applied to boxes in which cigars were put up and from which they were sold, and the ground upon which their registered trade-mark was in the case mentioned upheld fails.

The question, however, remains whether the manufacturer or dealer of cigars may acquire the right to an exclusive use, and be entitled to registration of, a specific trade-mark of which the term "King" forms the leading feature, if it is used in combination with the representation of some particular king; while other manufacturers and dealers use the same term with the likeness of other kings. May one manufacturer use a "King of the West", another a "King Special", a third a "King Oscar", a fourth a "King

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Bruce", and a fifth a "King Edward"? (to use illustrations afforded by the evidence) and each be entitled to registration of his particular label? If so, the list might be extended indefinitely, as there is no reason why it should be confined to the names of living kings. It is suggested that it would be proper to register any number of such marks. But with that view I cannot agree. Such a course of procedure would, I think, tend to confusion and deception in the particular trade or business. Where one maker had acquired a right to an exclusive use as a specific trade-mark, of which a prominent characteristic was for example a "star" or a "maple leaf", it would not be proper to allow some other maker to register for use with the same class of goods a mark having the same leading feature simply because he called his "star" by some other name, or used a "maple leaf" having a different form or shape. And if these things were in common or general use as marks applied to a particular class of goods, then no one could acquire a right to the exclusive use thereof in connection with the manufacture and sale of such goods. And the same rule should, I think, be applied in the present case, and I find against the plaintiffs' title to an exclusive use of the trade-mark on which they rely.

The defendant by a counter-claim asks that the plaintiffs' registered trade-mark be expunged from the register; but as to that the practice of this court is, I think, at present the same as that of the High Court of Justice in England, where it has been held by the Court of Appeal that an application to rectify the register of trade-marks cannot be made by counter-claim. *Pinto v. Badman* (1).

The defendant in the fourth paragraph of the statement of defence, among other things, alleges that the

(1) 8 Cult. R. P. C. 181.

plaintiffs have no legal title to the exclusive use of the trade-mark that they have registered. For the plaintiffs, however, it is contended that this ground cannot be set up as a defence to the action of infringement, and that an application to rectify the register should first be made. The case of *Partlo v Todd* (1) is to the contrary of that contention, as *The Trade-Marks Act* stood when that case was decided; and I agree fully with the views of the learned Chief Justice of Ontario expressed in the case of *The Provident Chemical Works v. The Canada Chemical Manufacturing Co.* (2) that the amendments made to the statute since *Partlo v. Todd* was decided have not in that respect altered the law.

The action and the counter-claim will both be dismissed, and the costs as usual will follow the event.

Judgment accordingly.

Solicitors for the plaintiffs: *Code & Burritt.*

Solicitors for the defendant: *White & Williams.*

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(1) 17 S. C. R. 196.

(2) 4 O. L. R. 546.