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Dec. 12.

KOPS BROTHERS of the Borough of Manhattan, in the City of New York, County of New York and State of New York, one of the United States of America.....PETITIONERS.

AND

THE DOMINION CORSET COMPANY.....RESPONDENT.

AND

In the Matter of the specific Trade-Mark "Self-Reducing" used by the petitioners in Connection with the sale of Corsets, Corset Waists and Corset Covers.

Trade-mark—Word "Self-reducing" as applied to corsets—Descriptive name.

Held, upon the facts, that, the word "self-reducing" as applied to the manufacture and sale of women's corsets is descriptive and does not constitute a good trade-mark.

THIS was a petition for the registration of a trade-mark, a previous application to the Minister of Agriculture to register the same having been refused.

The facts relied on by the petitioners for registration were set out in the petition as follows:—

1. That your petitioners are a firm composed of Daniel Kops and Max Kops, both residing in the said Borough of Manhattan and doing business at Fourth Avenue and Twelfth Street in the said Borough.

2. Your petitioners carry on an extensive business in the manufacture and sale of Corsets, Corset Waists and Corset Covers.

3. The business of the said firm was founded in the year 1894, and the said firm used the said Trade-Mark

as applied to the sale of Corsets, Corset Waists and Corset Covers continuously since that time, and have used the said Trade-Mark as applied to such goods in Canada continuously since the year 1900.

4. Throughout the whole of the aforesaid period the distinctive name and trade-mark "self-reducing," under which such goods have been and are being sold, was adopted and used by the petitioners for the purpose of distinguishing such goods from goods of a similar kind manufactured and sold by other persons.

5. The said distinctive name and trade-mark has been and is habitually and continuously used in connection with the said goods by placing the same on the goods themselves and also on the receptacles containing the goods, and also by displaying the same in your petitioners' catalogues, price lists, advertisements, and, in fact, in every way in which it would be likely to attract the notice of purchasers of such goods.

6. Your petitioners have spent hundreds of thousand of dollars in advertising their said goods and bringing their said goods to the attention of the public under their said trade-mark " self-reducing."

7. Throughout the whole of the period aforesaid the said distinctive name and trade-mark "self-reducing" has been and the same is universally recognized by the trade and public as indicating exclusively that the goods of the aforesaid description to which the same is applied, or in respect of which it is used, are goods manufactured or supplied by your petitioners, and no one has ever disputed your petitioners' right to the exclusive use of the said distinctive name and trade-mark "self-reducing" as applied to the goods in respect of which your petitioners are seeking to register the same.

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8. The words "self-reducing" are not descriptive of the said goods and anyone desiring to describe similar goods for the purpose for which they are sold and used would not describe them as " self-reducing."

9. As far as your petitioners are aware no goods of the aforesaid description of other makers have ever been called or described by the said name and trade-mark, the use of which has been exclusively confined to the goods of the aforesaid description manufactured and supplied by your petitioners as aforesaid except lately when The Robert Simpson Company, of Toronto, have applied the said words to an imitation of your petitioners' goods, and your petitioners immediately notified the said Robert Simpson Company to discontinue such practice.

10. Your petitioners are desirous that, for the protection of their own business and also of the trade and public purchasing their goods, their said trade-mark should be registered in their name and protected under the provisions of the Trade Mark and Design Act.

11. That on the fifteenth day of September, 1911, your petitioners duly filed an application for the registration of the said Specific Trade-Mark "self-reducing" in the Department of Agriculture, Trade-Mark and Copyright Branch, at Ottawa, to be used in connection with the sale of Corsets, Corset Waists and Corset Covers which your petitioners make and deal in their trade.

12. That registration of the said Specific Trade-Mark was duly refused on the 18th day of June, 1912, in the form as presented.

The petition came on for hearing before the Honourable Mr. Justice Cassels on the twelfth day of December, 1913.

J. F. Edgar for the petitioners;

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H. P. Hill for the respondents;

R. V. Sinclair, K.C., for the Minister of Agriculture.

CASSELS, J., now (December 12th, 1913) delivered judgment.

There is no doubt, as far as my judgment goes, that the decision of the Commissioner is correct, and that this trade-mark ought not to be registered.

This does not take away in any shape or form from the petitioner, the right to bring an action if anybody else is passing off his goods. That action remains open to him.

The question before me is one purely and simply of whether he is entitled to register the trade-mark "Self-Reducing."

In nearly all the exhibits put in, this particular corset is noted as the "Nemo" corset. The word "self-reducing" underneath is simply used to describe the character of the corsets. That appears on the covers of the boxes, produced as exhibits herein.

The law is laid down in the *Standard Ideal Co.* v. *Standard Mfg. Co.*, (1) and in *Registrar of Trade-Marks* v. *W. & G. Du Cros, Ltd.*, (2)

In the *Standard* case it was held, looking at Canadian legislation as it is now embodied in the *Trade-Mark and Design Act*, R.S.C., ch. 71, section 11, that the necessary ingredients of a trade-mark have to appear in order to entitle the party to registration.

Now the word "self-reducing" is absolutely nothing but descriptive of the kind of corset which is being sold by these petitioners. It is admitted beyond question that "reducing" corsets have been on the market for years, and that the reducing took place by the same mechanical means in these other corsets as in the

(1) (1911) A.C. 73. (2) (1913) A.C. 624.

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corsets sold by the petitioners. Every one was entitled in selling these corsets to their customers, to describe them as "reducing" corsets and also to point out that they were "self-reducing" corsets in the sense that the wearer of the corset could, by pulling a band a little tighter, contract the corset so as to reduce her figure down to the fashionable shape and fashionable size.

Taking the word "self" and putting it before the word "reducing" cannot, to my mind, confer any right whatever to a trade-mark. I do not see how it is possible to ask any Court to declare that such a trade-mark is valid.

I think the decision of the Minister is right, and that this petition must be dismissed with costs.

Judgment accordingly.

Solicitor for petitioners: *J. F. Edgar.*

Solicitors for objecting party: *Christie, Greene & Hill.*