

IN THE MATTER OF the Petition of JONKOPINGS OCH
VULCANS TANDSTICKSFABRIKSAKTIEBOLAG of Westra
Storgatan, Jonkoping, Sweden, Manufacturers.

1914
May 12.

AND IN THE MATTER of the Specific Trade Marks
"VULCAN SUPERIOR," "VULCAN UNIVERSAL" and
"VULCAN GLOBE PARAFFIN" used by the Petitioners
in connection with the sale of matches which the
Petitioners make and sell in their trade.

AND IN THE MATTER of the General Trade-Mark
"VULCAN" registered by the firm of N. Quintal
& Fils and assigned to the Firm of Bergeron, Whissell
& Cie, of the City of Montreal, in the Province of
Quebec.

*Trade-Mark—Effect of Registration—Assignment in gross—Ownership in
Claimant—Differences between English and Canadian Trade-Mark Statutes
considered—Registration of General Trade-Mark "Vulcan" in, No. 21, Fol.
4846 Canadian Register varied.*

1. Registration under the Canadian Trade-Marks Act confers no title in the mark registered; it is merely a pre-requisite to the right to bring an action.
2. A trade-mark cannot be assigned in gross. Dictum of Proudfoot, V.C., in *Smith v. Fair*, 14 O. R. 736, disapproved. *Gegg v. Bassett*, 3 O. L. R. 263 adopted.
- The applicant for registration of a trade-mark in Canada must be the proprietor of the mark. *Partlo v. Todd*, 17 S. C. R. 196, and *Standard Ideal Co. v. Standard Sanitary Mfg. Co.* 27 T. L. R. 63, referred to.

Difference between English and Canadian statutes relating to trade-marks discussed.

The general trade-mark consisting of the word "Vulcan," registered in Canadian Trade-Mark Register No. 21, Fol. 4846, limited by excluding therefrom the use of the word "Vulcan" as applied to matches.

PETITION to have certain trade-marks registered.
The facts upon which the application was based are
stated in the reasons for judgment.

January 13th, 1914.

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The case came on for hearing before the Honourable Mr. Justice Cassels, at Ottawa.

J. F. Edgar for petitioners

J. A. Ritchie for objecting parties;

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

CASSELS, J. now (May 12th, 1914) delivered judgment.

The present petitioners, styled in English the Vulcan Match Manufacturing Company, presented a petition to have it declared that they are entitled to have placed on the Register of Trade-Marks, three specific trade-marks set out in the petition. The prominent feature of the alleged trade-marks is the word "Vulcan" as applied to matches. The application was made on the 21st November, 1910, and rejected by the Minister. The ground of rejection, as stated, is that by an application dated on the 23rd January, 1894, one Joseph E. Quintal on behalf of the firm of N. Quintal et Fils, applied for and registered as a general trade-mark the word "Vulcan". The certificate of the Registrar of Trade-Marks, which bears date the 24th January, 1894, certified that "this trade-mark (general) which consists of the word "Vulcan", as per the annexed application, has been registered in the Trade-Mark Register as Number 21, Folio 4846, in accordance with the *Trade-Mark and Design Act*, by N. Quintal et Fils of the City of Montreal, province of Quebec."

It is important to refer to the application which is as follows

"I, Joseph E. Quintal, of the City of Montreal, in the district of Montreal, and province of Quebec, one and on behalf of the firm of N. Quintal et Fils, carrying on business in the said City as wholesale

“importers of wines, liquors cigars, groceries, etc.
 “do hereby furnish a duplicate copy of a general
 “trade-mark in accordance with sections 4 and 9 of
 “the *Trade-Mark and Design Act*, which I verily
 “believe to be the property of the said firm, on account
 “of its having been the first to make use of the same.
 “The said general trade-mark consists of the word
 “Vulcan” which can be printed in any form of type
 “on labels, wrappers or packages, or be stamped,
 “branded, or stencilled in any way on goods manufac-
 “tured and sold by the said firm.”

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It appears from the evidence that it is usual for those engaged in the wholesale grocery business to sell as part of their stock in trade matches. It is important, however, to bear in mind that no reference to matches is made in the application—and later on I will point out that, as far as the evidence shows, no matches labelled with the word “Vulcan” were in reality sold by the respondents with the label “Vulcan” until about the time of the trouble between the respondents Bergeron, Whissell & Cie., the assignees of N. Quintal et Fils, and the petitioners.

It would appear that about the 16th December, 1910, the petitioners asked the firm of Bergeron, Whissell & Cie., for a consent for the registration by the petitioners of their specific trade-marks.

The petitioners pray:—“(a) That the entry in the Register of Trade-Marks, of the said general trade-mark “Vulcan” by N. Quintal et Fils, be expunged, or (b) That the said entry be varied by limiting the said general trade-mark “Vulcan” to a specific trade-mark applicable to the manufacture and sale of a class or classes of merchandise of a particular description other than matches.”

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Evidence was taken on Commission in Sweden on behalf of the petitioners. At the trial before me, on behalf of the respondents, Mr. Ritchie objected to a portion of the evidence taken on Commission, as being hearsay evidence. I admitted the evidence subject to the objection. No other objection was made to the reception of this evidence.

It is clear from the evidence, that these petitioners The Vulcan Match Manufacturing Company, have been carrying on a most extensive business in matches, at all events as far back as the year 1870. Their business has been a continuous one. Their trade-mark, a prominent part of which is the word "Vulcan" was registered in England as far back as the year 1880, and in the United States as far back as the year 1883. A list of the places, and the dates of registration, are annexed to the evidence taken under the commission

As early as 1882 shipments of matches by the petitioners having the trade-mark "Vulcan" on the boxes were sent to Canada. There were further shipments in June of 1885. Subsequent shipments were made in August, 1895, in September of 1895, in October, 1895, in November, 1895, and in February, 1896.

The contention put forward on the part of the respondents is that the petitioners abandoned their right to the trade-marks by reasons of the length of time which elapsed between the various shipments; but it is to be borne in mind that no intention to abandon can reasonably be inferred in this case as the petitioners were continuously engaged in the manufacture and the sale of these matches practically the world over. Sales, according to the evidence, have amounted in value to about one million pounds sterling, and

according to the evidence of Palmgren at the time of giving his evidence the sale of goods was at the rate of over one hundred thousands pounds sterling per annum.

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In the case of *Mouson & Co. v. Boehm*, (1) the judgment of Chitty J. is very pertinent—the facts in this case being much stronger against any idea of abandonment than in that case.

At the trial before me, Mr. Dandurand, a member of the firm of Bergeron, Whissell & Co. gave evidence. He sets out a great number of articles in which the firm have dealt in and to which the trade mark “Vulcan” was applied. He is asked in regard to matches, and he states:

“Q. And for some years you have used the word “Vulcan in connection with matches, as I understand?”

“A. Yes.

“Q. For the last three or four years? A. Yes.”

This testimony was given on the 13th January, 1914. The last three or four years, if taken back would mean to the years 1910 or 1911, later on in cross-examination the question is put to him:

“Q. The first time you recollect the word “Vulcan” being applied to matches was since 1907? A. Yes.

“Q. There is no doubt about that? A. No doubt.”
“They were selling matches apparently continuously.

“Q. Then you remember getting labels made since 1907? A. Yes by our own firm.

“Q. For your own firm? A. Yes.

“Q. These labels, such as the ones you produced here, they were made since 1907? A. Yes.

“Q. And those were the first Vulcan labels that you recollect seeing for matches? A. Yes.

“Q. You never saw any Vulcan labels for matches before that? A. Never.

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“Q. Never? A. No.

“Q. And you had those made since 1907. When would it be—1911? A. About three years ago.

“Q. About 1911? A. Three or four years ago.”

The importance of this evidence in my opinion is its bearing on the question of alleged abandonment. I have called attention to the fact that in the application for registration of the trade-mark in 1894, matches are not stated as part of the business; and as the word “Vulcan” was applied to matches by the respondents only within three or four years, it is not reasonable to impute to the applicants any intentional assent to the rights of the respondents to use this word as a trade-mark as against the rights of the petitioners.

It always has to be borne in mind that the registration under the statute confers no title. It is merely a pre-requisite to the right to bring an action.

I am of opinion that these petitioners are entitled to have their three trade-marks registered, and I so adjudge.

The question that remains to be determined, namely, how the registered trade-mark of the respondents is to be dealt with is one of difficulty. The trade-mark of the respondents, as I have mentioned, is a general trade-mark.

In the case of *Re Auto Sales Gum and Chocolate Company*, (1) I considered the question of the jurisdiction of this court to vary or rectify a trade-mark. In a later case of *Re Gebr Noelle's Application*, (2) I have given my views as to the difference between a general trade-mark and a specific trade-mark.

On the trial before me Mr. Edgar read a portion of the depositions of Mr. Joseph Dandurand on his examination for discovery. Mr. Dandurand stated:

(1) 14 Ex. C. R. 302.

(2) 14 Ex. C. R. 499.

"Q. You have consented to the registration of "Vulcan" as a trade mark by others, have you not? ¹⁹¹⁴ *In re VULCAN TRADE MARK.*

"A. Yes Sir.

"Q. On payment of a consideration? A. Yes, on "a certain consideration."

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The attention of the respondents had not been called to the effect a sale to others of the right to use the trade-mark might have on the validity of the trade-mark. See *The Bowden Wire Co. v. The Bowden Brake Co.* (1)

Nice questions would arise as to whether the law as applied in England, apply under our Canadian statute to a general trade-mark. I thought it fair to the respondents that they should have liberty to file an affidavit setting out dates of any assignments and consideration received for such assignment. It now appears that any sales made by the respondent firm of the right to use the word "Vulcan" were in regard to articles of manufacture not covered by their trade-mark,—according to the views I have expressed in the case referred to of Gebr Noelle's application. I have received a communication from the counsel of the petitioners to the effect that they do not desire to have the trade-mark of the respondents expunged except so far as applicable to matches. I would be very loth to declare that the trade-mark of the respondent should be expunged from the register in toto. The consent of the petitioners assists in relieving me from having to so decide.

The Canadian statute differs materially from the English Act.

In *Smith v. Fair*—a decision of the late Vice-Chancellor Proudfoot, (2) there is a dictum which would rather indicate that the Vice-Chancellor's view was

(1) 30 R. P. C. 581.

(2) 14 O. R. 736.

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that there must have been evidence of prior user in Canada. He also apparently is taken to have held that under our statute a trade-mark might be assigned in gross. This is merely a dictum and it was held the other way in the case of *Gegg v. Bassett*, (1) by Lount, J. I have no hesitation in adopting the view of Mr. Justice Lount. It is thoroughly in accord with the opinions of the English judges. It is quite true that the Canadian statute permits an assignment of a trade-mark, but it would be contrary to all rule applicable to trade-marks if a mark could be assigned to somebody who would use it upon goods neither manufactured nor sold by the owner of the trade-mark. It would have the effect of leading to misrepresentation. I may say in passing that the Berliner case, referred to in *Smith v. Fair*, is a case of passing-off. If the judgment on appeal cited by Proudfoot, V.C., is looked at it will appear that it was not decided on the ground of infringement of trade-mark.

In *Spilling v. Ryall*, (2) the late Mr. Justice Burbridge guards himself against expressing any opinion as to what might be the result were the goods of the owner of the prior trade-mark in the United States placed upon the Canadian market.

The late Mr. Low, Deputy Minister of Agriculture, as far back as 1888, in two cases, namely, *Bush Manufacturing Co. v. Hanson*, (3) and *Groff v. The Snow Drift Baking Powder Co.* (4) expressed his views on the question. His opinion apparently being that the applicant must be the proprietor of the trade-mark the world over in order to entitle him to ownership of the trade-mark.

In tracing the Canadian statute here does not appear to be any substantial difference between the

(1) 3 O. L. R. 263.

(2) 8 Ex. C. R. 195.

(3) 2 Ex. C. R. 557.

(4) 2 Ex. C. R. 568.

Trade-Marks Act at present in force and the earlier Acts. The present statute provides that the Minister may from time to time, subject to the approval of the Governor-in-Council, make rules and regulations and adopt forms for the purposes of this Act respecting trade-marks and industrial designs, and such rules, regulations and forms circulated in print for the use of the public shall be deemed to be correct for the purpose of this Act.

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The earlier statute of 1872 practically is the same. The form approved pursuant to the terms of the statute is that, "I hereby request you to register in the name of..... a general trade-mark, which I verily believe is mine on account of having been the first to make use of the same, etc. I hereby declare that the said general trade-mark was not in use to my knowledge by any other person than myself at the time of my adoption thereof.

I do not find in any of the forms given under any of the preceding statutes any limitations confining such use to Canada. I mention this because in one case a reference was made to the fact that the Commissioner had accepted the application which on its face stated that there was no knowledge of user in Canada.

Under Section 11 of *The Trade-Marks Act*, it is provided that the Minister may refuse to register any trade-mark, if he is not satisfied that the applicant is undoubtedly entitled to the exclusive use of such trade-mark.

The applicant for registration of the trade-mark must be the proprietor. The case of *Partlo v. Todd*, (1) deals with the question in an exhaustive manner. Reference may also be made to the case of the *Stan-*

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

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dard Ideal Co. v. The Standard Sanitary Manufacturing Co. (1) where the Judicial Committee of the Privy Council dealt with the same question.

I have pointed out that the English statute differs from the Canadian statute. Prior to the statute in England of 1875, the courts there adopted what is usually styled the "three trade-marks" rule. This seems to have been based upon an order of the Comptroller, or the other official who had charge of the matter.

In two cases, *Re Walkden Aerated Waters Application*, (2) and *Re Hyde & Co.'s Trade-Mark* (3) the late Master of the Rolls, Jessel, has explained the reason of this rule. (4)

Under the English Act an applicant can apply for a trade-mark for the particular articles under each class. There are a long series of decisions in the English reports in which applications were made for registration of trade-marks, which would embrace all the articles mentioned in the particular class,—and where the applicant for the registration although obtaining the registration failed to use the trade-mark in respect to one or other of the particular articles. The courts in England have in such cases rectified the register by expunging from the trade-mark register the particular article not so used. For instance, in *Re Hart's Trade Mark* (5) "Condensed Milk" was covered by the registration but not used. The register was amended by striking out "Condensed Milk" from the register.

In *Hargreaves v. Freeman*, (6) *Anglo-Swift Condensed Milk Co. v. Pearks*, (7) and *Edwards v. Dennis*, (8)

(1) 27 T. L. R. 63.

(2) 54 L. J. Ch. 394.

(3) 54 L. J. Ch. 395.

(4) Sebastian, 5th ed. at page 71,

also deals with the question.

(5) 19 R. P. C. 569.

(6) 3 Ch. D. 39.

(7) 20 R. P. C. 509.

(8) 30 Ch. D. 454.

and in numerous other cases, a limitation has been imposed upon the trade-mark excluding from its scope articles which might have been covered.

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On the whole, having regard to the facts of the case, I will direct that the general trade-mark be limited by excluding therefrom the use of the word "Vulcan" as applied to matches. The respondents will not be injured to any great extent, as the correspondence shows they were willing to sell the right to the present petitioners for a comparatively small sum.

I think the respondents are liable to pay the costs of the petitioners, and I so order. I give no costs for or against the Minister of Agriculture.

Judgment accordingly.

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

Solicitors for objecting parties: *St. Germain, Guerin & Raymond.*