

BETWEEN :

HYMAN RUBENSTEIN *et al* APPELLANTS;

AND

THE REGISTRAR OF TRADE MARKS. RESPONDENT,

AND

BULOVA WATCH COMPANY } OBJECTING PARTY.
INC. }

1952
Feb. 28
Mar. 18

Trade Mark—"Bulla"—"Bulova"—The Unfair Competition Act, 1932, S. of C. 1932, c. 38, ss. 2(k) (m) (o), 26(1) (f), 51—Whether "Bulla" similar to "Bulova"—Whether two trade marks are similar within meaning of s. 2(k) of the Act a question of fact to be determined upon facts and particulars of each case—Test to be applied that of sound—Sound of words "Bulova" and "Bulla" likely to confuse users of wares—Evidence of actual confusion not necessary—Appeal dismissed.

The Registrar refused the appellant's application to register the word mark "Bulla" for use in association with watches on the ground that the proposed word mark is confusingly similar to the objecting party's registered trade mark "Bulova" for use in association with watches,

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watch movements, watch cases and watch parts. The appeal is from the Registrar's refusal and the objecting party was added as a party to the proceedings in appeal.

Held: That whether two trade marks are similar within the meaning of s. 2(k) of the Unfair Competition Act, S. of C. 1932, c. 38, is a question of fact to be determined upon the particular facts and circumstances of each case.

2. That the only test that need be applied herein is that of sound. In each case, the word mark is comprised of one word only; in each case, when spoken in English, the accent is on the first syllable, which is identical for both words; and in each case the first and last syllables are exactly alike both in spelling and pronunciation.
3. That the sound of the two words "Bulova" and "Bulla" is such that users of the wares would likely confuse them and be led "to infer that the same person assumed responsibility for their character or quality".
4. That when there has been no substantial contemporaneous use of the two marks, the fact that there is no evidence of actual confusion through such use as there has been, is not of much importance. *Freed and Freed Ltd. v. Registrar of Trade Marks et al* (1950) Ex. C.R. 431 followed.

APPEAL from the Registrar's refusal to register the appellant's proposed word mark "BULLA".

The appeal was heard before the Honourable Mr. Justice Cameron at Ottawa.

Henri Gerin-Lajoie, Q.C. for appellant.

W. P. J. O'Meara, Q.C. for Registrar.

J. C. Osborne for objecting party.

The facts and questions of law raised are stated in the reasons for judgment.

CAMERON J. now (March 18, 1952) delivered the following judgment:

This is an appeal under section 51 of the Unfair Competition Act, 1932, from the refusal of the Registrar of Trade Marks to register the word mark "BULLA." On November 21, 1949, the appellants filed an application to register that mark, alleging that they had used it on wares described as "watches" to indicate that such wares were *sold* by them.

At that time, Bulova Watch Company, Inc., was the registered owner of two specific trade marks as follows: (1) Registration No. 235/50875, consisting of the word mark "BULOVA" for use with watches and watch movements,

which was registered on November 5, 1930; (2) Registration No. 194/42775, consisting of the word mark "BULOVA," together with certain design matter for use with watches, watch-cases and watch parts, which was registered on November 2, 1927.

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Bulova Watch Company opposed the appellants' application and after some correspondence the Registrar, on December 22, 1950, refused the application, his grounds being stated as follows:

It is my opinion that the word "BULLA" and the registered Trade Marks "BULOVA" are confusingly similar within the meaning of Section 2(k) of the Unfair Competition Act, 1932, and that in the mind of the public, the marks so resemble each other or so clearly suggest the idea conveyed by each other that the contemporaneous use of both in the same area in association with wares of the same kind would be likely to cause dealers in and/or users of such wares to infer that the same person assumed responsibility for their character or quality.

Accordingly, the application of your client is refused. This is a final action.

Upon the application of Bulova Watch Company, it was added as an objecting party in the appeal and in its Statement of Objections it relied substantially on the reasons assigned by the Registrar for refusing the application.

The Registrar's decision was based on the provisions of section 26(1) (f) of the Unfair Competition Act, as follows:

26. (1) Subject as otherwise provided in this Act, a word mark shall be registrable if it

(f) is not similar to, or to a possible translation into English or French of, some other word mark already registered for use in connection with similar wares;

It is admitted that the wares sold by the appellants and the wares manufactured and sold by the objecting party are "similar" as that term is defined in the Unfair Competition Act, s. 2(1). The sole question for determination, therefore, is whether "BULLA," the proposed word mark of the appellants, is similar to "BULOVA," the word mark of the objecting party, already registered.

Section 2 of the Act defines "similar" in relation to trade marks, "trade mark" and "word mark," as follows:

2. In this Act, unless the context otherwise requires:

(k) "Similar," in relation to trade marks, trade names or distinguishing guises, describes marks, names or guises so resembling each other or so clearly suggesting the idea conveyed by each other that the contemporaneous use of both in the same area in association with wares of the same kind would be likely to cause

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dealers in and/or users of such wares to infer that the same person assumed responsibility for their character or quality, for the conditions under which or the class of persons by whom they were produced, or for their place of origin;

- (m) "Trade mark" means a symbol which has become adapted to distinguish particular wares falling within a general category from other wares falling within the same category, and is used by any person in association with wares entering into trade or commerce for the purpose of indicating to dealers in, and/or users of such wares that they have been manufactured, sold, leased or hired by him, or that they are of a defined standard or have been produced under defined working conditions, by a defined class of persons, or in a defined territorial area, and includes any distinguishing guise capable of constituting a trade mark;
- (o) "Word mark" means a trade mark consisting only of a series of letters and/or numerals and depending for its distinctiveness upon the idea or sound suggested by the sequence of the letters and/or numerals and their separation into groups, independently of the form of the letters or numerals severally or as a series.

The appellants have been carrying on business as wholesale jewellers and importers in Montreal since August, 1949, selling watches wholesale in Canada, but mostly in the province of Quebec. Since October, 1949, they have been selling watches exclusively under the trade mark "BULLA," as imported from Switzerland from the firm "Manufacture de Montres Bulla, Emile Juillard, S.A." It is shown that the latter firm has been in existence since 1872 and has continuously carried on the business of the manufacture, sale and export of watches, using the trade mark "BULLA" in connection therewith. There is no evidence that any of its watches were sold at any time in the United States or that any of such wares with the word mark "BULLA" were ever sold in Canada until October, 1949, when the appellants first commenced to import and sell them. The appellants are not shown to have acquired any rights in the word mark from the Swiss manufacturer of the watches. Their good faith in attempting to register as their word mark the actual mark appearing on watches imported by them is not challenged.

The objecting party is a New York corporation. Its business was originally founded about 1875 by Joseph Bulova and was incorporated in 1911 as "J. Bulova Company," but its present name was adopted in 1923. As early at least as 1907, the word "BULOVA" was adopted as its trade mark and has been used continuously since that time in association with watches, watch movements, parts

thereof and watch cases. It was first used in Canada as a trade mark with respect to watches and watch movements at least as early as 1927, and such use has been continuous since that date. It is the principal trade mark of the objecting party and that it is a very valuable asset is established beyond question. From 1941 to 1951, it sold wares bearing that mark throughout every state in the United States and every province in Canada, sales in the United States aggregating over 389 million dollars and in Canada over 21 million dollars. For the same period, its direct advertising costs in connection therewith totalled over 39 million dollars in the United States and over 3 million dollars in Canada. In the United States and Canada there are respectively over twelve thousand and two thousand active outlets for its sales. Its advertising has been conducted in all media, including magazines, trade papers, newspapers, radio, television, window displays, etc., the details of which are supplied in the affidavits of H. E. Henshal and R. F. Warren, two of its vice-presidents.

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Whether two trade marks are similar within the meaning of section 2(*k*) is a question of fact to be determined upon the particular facts and circumstances of each case. The matter has been frequently before the courts, but it is well established that except where some general principle is laid down, cases on the similarity of other marks under other circumstances are of little assistance (vide *Coca-Cola Company of Canada, Ltd. v. Pepsi-Cola Company of Canada, Ltd.* (1)).

The general approach to this problem was stated by Parker, J. in the *Pianotist Co. Ltd's. Application* (2), as follows:

You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion—that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods—then you may refuse the registration, or rather you must refuse the registration in that case.

(1) (1942) 2 D.L.R. 657 at 661.

(2) (1906) 23 R.P.C. 774 at 777.

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This statement was quoted with approval by Davis J. in the *Pepsi-Cola v. Coca-Cola case* (1).

In the case of *British Drug Houses Limited v. Battle Pharmaceuticals Limited* (2), certain general principles were laid down both in this Court and on the appeal. In the Supreme Court of Canada, Kerwin, J. followed the judgment of the House of Lords in *Aristoc Ltd. v. Rysta Ltd.* (3), which adopted a passage in the dissenting judgment of Luxmoore, L.J., in the Court of Appeal as a fair statement of how the Court should approach the question of the similarity of trade marks. The passage appears in the speech of Viscount Maugham at p. 86:

The answer to the question whether the sound of one word resembles too nearly the sound of another so as to bring the former within the limits of s. 12 of the Trade Marks Act, 1938, must nearly always depend on first impression, for obviously a person who is familiar with both words will neither be deceived nor confused. It is the person who only knows the one word, and has perhaps an imperfect recollection of it, who is likely to be deceived or confused. Little assistance, therefore, is to be obtained from a meticulous comparison of the two words, letter by letter and syllable by syllable, pronounced with the clarity to be expected from a teacher of elocution. The court must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description, but also of the shop assistant ministering to that person's wants.

In this connection, reference may also be made to *S. Cohen v. Registrar of Trade Marks* (4) and to *Union Oil Co. of California v. The Registrar of Trade Marks* (5).

The evidence given on the appeal (with one exception to be later noted) was entirely by affidavit and it related almost entirely to the manner in which "BULLA" and "BULOVA" were pronounced. There is no disagreement as to the manner in which the proposed mark "BULLA" is pronounced. The affidavits filed by the appellants state that when used by an English-speaking person, it is pronounced with the accent on the first syllable, thus, "Bull'-a," and when used by a French-speaking person, it is pronounced without accent, thus: "Bul-a." The objecting party's affidavits do not deal with the matter at all and I therefore accept the applicant's evidence on that point.

(1) (1940) S.C.R. 17 at 32.
 (2) (1944) Ex. C.R. 239,
 (1946) S.C.R. 50.

(3) (1945) A.C. 68.
 (4) (1948) Ex. C.R. 513.
 (5) (1949) Ex. C.R. 397.

The evidence as to the manner in which "BULOVA" is pronounced is contradictory. For the appellants there are sixteen affidavits from jewellers carrying on business in the cities of Montreal and Quebec and other cities in the province of Quebec. In each case, after stating the experience which the deponent had in the sale of watches and the length of time which he had known the marks "BULOVA" and "BULLA," he stated:

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When I first learned of the existence of the trade mark "BULLA" in connection with the sale of watches, I already knew the trade mark "BULOVA" and no confusion arose in my mind between the two trade marks which I have always distinguished without difficulty.

As to the word "BULOVA", I have always pronounced and have heard it pronounced in trade and by the general public, in *English* with the letter "o" pronounced as in "low" and with the accent on the second syllable, as follows: "Boo-low'-va."

In French I pronounce the word "BULOVA" without accent on any syllable, and with the first syllable pronounced "Bu," following its French pronunciation, in place of "Bou."

In each case, also, there is a statement that the deponent knows of no instance of confusion ever having arisen in the trade or among the purchasing public, or otherwise, between the two marks "BULLA" and "BULOVA."

In addition, there is an affidavit of Sol Mayoff, a jewellery salesman from Montreal, in English, in which he states that no confusion arose in his mind between the two marks which he has always distinguished without difficulty; and that he has always pronounced "BULOVA" and heard it pronounced as above set forth, namely, "Boo-low'-va." The affidavit of S. Bigner, Quebec City, in English, is to the same effect. In addition, there are four further affidavits in English, three by jewellers carrying on business in Vancouver and one by a bookkeeper-accountant of the city of Toronto, in which the same statements are made. There are also four affidavits taken by residents of Montreal, a teacher, two engravers, and a furrier, all in English, and all to the same effect.

The remaining evidence of the appellants consists of the affidavit of Hyman Rubenstein, one of the appellants, and C. E. Demers, a representative and sales agent of Elite Jewellery Company, each stating that no confusion has arisen in his mind between the marks "BULLA" and "BULOVA," and each stating that when "BULOVA" is pronounced in English, it is pronounced with the accent

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on the second syllable, as "Boo-low'-va." In addition, Mr. Demers states that when pronounced in French "BULOVA" is pronounced without accent on any syllable and that the first syllable is pronounced "Bu" instead of "Bou."

The evidence for the objecting party as to the pronunciation of its mark "BULOVA" is most cogent and convincing, so much so that I accept it without question as establishing affirmatively that throughout the greater part, if not all, of Canada, and throughout all of the United States, it is pronounced as stated in their affidavits, namely, with the accent on the first syllable as in "Bull," and with the "o" pronounced as in "love," thus, "Bull'-love-a." As is well known, much of the objecting party's advertising is done by spot advertising over radio and television networks, a large part of it being in connection with time signals—given many times daily—and on each occasion the word "BULOVA" is repeated several times and usually spelled. It is shown that instructions are given to announcers of the radio and television programs advertising "BULOVA" watches that the word should be pronounced as above. Their broadcasts, whether originating in Canada or originating in the United States and heard in Canada, are heard almost daily throughout the whole of Canada. The affidavits of H. D. Henshel, a vice-president, and of R. F. Warren, a vice-president in charge of advertising and sales promotion of the objecting party, state that they have never heard the word pronounced at any time other than as above, and have never heard it pronounced as stated in the affidavits filed on behalf of the appellants. Because of their positions, both these witnesses would have a special interest in noting the manner in which the word was pronounced and I accept their statements without question.

There are also seven affidavits filed by radio announcers employed in radio stations located in St. John's (Newfoundland), Vancouver, Montreal, Winnipeg, Hamilton and Toronto, all of whom have been broadcasting from eleven to seventeen years. In each case, they state:

2. In the course of my duties as a radio announcer, I have frequently broadcast the BULOVA time announcements which are issued over stations located throughout the Dominion of Canada and in each case, I have pronounced the word BULOVA with the accent on the first syllable and with the letter "o" pronounced as in "love," thus "Bull'-love-a".

Hugh Horler, who is in charge of the radio advertising division of the MacLaren Advertising Co. Ltd. of Toronto, and is familiar with the advertising of watches (including Bulova watches) throughout Canada, gave instructions to the various broadcasting stations for the diffusion of Bulova watch advertising throughout Canada, and he states as follows:

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4. I have never heard the name "Bulova" pronounced in the manner set forth in the affidavit filed on behalf of the appellants herein, but have always heard it pronounced with the accent definitely upon the first syllable. If I had heard any radio announcer making an announcement of "Bulla" watches, I would have been certain that he had made a slip and was in fact broadcasting in connection with Bulova watches.

5. I am the person who gave instructions to the various radio broadcasting stations for the diffusion of Bulova watches throughout Canada. I have not at any time authorized the use of any other pronunciation of the name of the said company or of its registered trade mark, except with the accent very clearly upon the first syllable.

6. If at any time I had been in the province of Quebec and had heard any announcer on the French network pronouncing the word "Bulova" accentuated as referred to in the affidavits filed on behalf of the appellants, I would have communicated at once with the said station and have directed that the announcer should thereafter pronounce the word "Bulova" in the accepted manner and in the only way known to me, namely, with the accent on the first syllable.

The affidavit of Mr. E. V. Rechnitzer, a vice-president of the said MacLaren Advertising Company, is to the same effect.

The objecting party also put in evidence twenty affidavits by retail jewellers resident in every province of Canada, and each of whom has been familiar with Bulova watches for many years. Each states as follows:

2. In the course of such business, I have sold a very large number of time pieces including watches of many varieties and I have become thoroughly familiar with the trade and the majority of the well-known trade marks used in it.

3. In particular, I have been familiar with the internationally known trade mark BULOVA for—years and I recognize it as a symbol identifying watches of high quality which are in constant and extensive demand by Canadian purchasers not only in my own establishment but in many other outlets of which I have personal knowledge.

4. I have never seen the word BULLA used in Canada as a trade mark or otherwise in association with watches or other time pieces nor have I seen it used in advertising in connection with such wares.

5. I have always pronounced the word BULOVA, and heard it pronounced, with the accent on the first syllable and with the letter "o" pronounced as in "love", thus "Bull-love-a".

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6. The words BULLA and BULOVA so resemble each other that the contemporaneous use of both in the same area in association with watches would cause me to infer that the same person assumes responsibility for their character or quality.

There are also five affidavits from the general public, namely, an appliance salesman from Toronto, a stenographer from St. John's, Newfoundland, a clerk from Montreal, a bank clerk from Vancouver, and an assistant manager from Winnipeg, each of whom has had occasion to interest himself in the sale of watches and has been familiar with a number of different trade marks used in association with the watches. Each has been familiar with the trade mark "BULOVA" for many years and each gives evidence to the same effect as in paragraphs 4, 5 and 6 of the affidavits of the retail jewellers just quoted.

As I have said, the evidence as to the manner in which "BULOVA" is pronounced in Canada is somewhat conflicting. However, I prefer that of the objecting party, supported as it is by the evidence of those having a particular interest in and knowledge of the manner in which it is pronounced, namely, the officials of the company, the advertising agents, broadcasters throughout all of Canada, and jewellers from every province of Canada who have sold Bulova watches for many years, and also from the general public. I am satisfied that its normal and generally used pronunciation is with the accent on the first syllable and with the "o" pronounced as in "love," thus, "Bul'-love-a"; and that it is only in a comparatively few and exceptional cases, if at all, that it is pronounced with the accent on the second syllable as in "low."

At the hearing, counsel for the objecting party asked leave to submit to the court the phonograph recordings of certain radio broadcasts advertising Bulova watches and in which the announcer repeatedly used the word "BULOVA". Rubenstein, one of the appellants, had stated in his affidavit that to his personal knowledge the word when used by radio broadcasters was pronounced as "Boo-low-va." To meet this allegation, the objecting party secured the affidavits of the seven radio announcers above referred to, and each, after stating that he had always

pronounced the word as contended for by the objecting party, added:

3. Submitted herewith and marked as Exhibit A is a recording of such a time announcement broadcast by me in the ordinary course of my duties over station on the day of December, 1951, which said recording was taken on my instructions, and having listened to the same, I verify that it is a reproduction of my voice.

In each case the date of the recording was in December, 1951, after this appeal was taken. The application also extended to two other records referred to as Exhibits A and B in the affidavit of R. F. Warren, and while the details of these recordings are not specifically stated, it is probable that they also were taken after the present appeal was launched.

Counsel for the appellants objected to the use of these recordings both on principle and because they were taken after the commencement of the appeal, and might, therefore, have been especially prepared so as to assist the objecting party's contention. Had they been taken prior to the dispute between the parties hereto, I would have admitted them without question, as perhaps the best evidence of the manner in which broadcasters actually pronounce the word, and as that matter had been brought in issue by the affidavit of one of the appellants. I have given consideration to the objections and have decided that the playing of these records is admissible evidence. The affidavits show that the recordings as submitted were of broadcasts "in the ordinary course of my duties" and are in confirmation of a statement in the previous paragraph that the deponent had always pronounced the word "BULOVA" as "Bull-love-a." At the hearing, I admitted the recordings subject to counsel's objections, which I now over-rule. When actually played, these records confirmed the other evidence contained in the affidavits filed for the objecting party, the announcer in each case pronouncing the word as I have just stated, with the accent on the first syllable, and the "o" as in "love."

In view of these conclusions, considering all the surrounding circumstances, and applying the principles laid down in the cases which I have cited, I have no hesitation in reaching the conclusion that the first impression of users of or dealers in watches in association with which the words "BULOVA" and "BULLA" are used, would likely be that

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they are confusingly similar. In this case, the only test that need be applied is that of sound. In each case, the word mark is comprised of one word only; in each case, when spoken in English, the accent is on the first syllable, which is identical for both words; and in each case the first and last syllables are exactly alike both in spelling and pronunciation. The importance of the first syllable of a word mark was referred to in the case of *In the Matter of London Lubricants, (1920) Limited's Application to Register a Trade Mark* (1), where in the Court of Appeal Sargant, L.J. said at p. 279:

The termination of the new word is different. Though I agree that, if it were the only difference, having regard to the way in which the English language is often slurred at the termination of words, that might not alone be sufficient distinction. But the tendency of persons using the English language to slur the termination of words also has the effect necessarily that the beginning of words is accentuated in comparison, and, in my judgment, the first syllable of a word is, as a rule, far the most important for the purpose of distinction.

It seems to me that a person who had some knowledge of the mark "BULOVA," but remembered the name somewhat imperfectly (and possibly only the first syllable thereof) would be easily confused when buying a watch which was described by the seller as one made by "BULLA," or as a "BULLA" watch, and thus there would be confusion in the goods themselves. It is to be kept in mind, also, that when the watches of the appellants and the objecting party are sold by the same dealer, it is highly probable that they would be displayed and sold over the same watch counter. The sound of the two words is such that in my opinion users of the wares would likely confuse them and be led "to infer that the same person assumed responsibility for their character or quality."

As I have said, there has been no proof that confusion has arisen because of the actual use of the two marks in question. That would be an element to be taken into consideration if there had been a long contemporaneous user of the two marks in the same area, but that is not the case here. The appellant first used their mark in October, 1949, but they have not seen fit to state the extent of its sales or

of any advertising used in connection therewith. None of the persons who supplied affidavits for the objecting party had ever heard of the word "BULLA" in connection with watches until these proceedings were commenced. I think I can infer that such use as the appellants have made of their mark has been extremely limited. When there has been no substantial contemporaneous use of the two marks, the fact that there is no evidence of actual confusion through such use as there has been, is not of much importance, and in this case I attach no great weight to it. (*Freed and Freed Ltd. v. Registrar of Trade Marks et al* (1)).

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It is admitted that the onus is on the appellants to show that the decision of the Registrar was wrong. In my opinion, the appellants have failed to establish that the proposed mark is not calculated to deceive and to cause confusion. I think that the decision of the Registrar was right and should be affirmed.

The appeal will therefore be dismissed. The objecting party will be entitled to its costs after taxation. While the Registrar of Trade Marks was represented by counsel at the hearing, the latter took no part in the proceedings and in accordance with the usual practice, no order will be made as to his costs.

Judgment accordingly.

(1) (1950) Ex. C.R. 431.