

CONGOLEUM COMPANY OF CANADA . . PETITIONER;

AND

THE CANADIAN LINOLEUMS & }  
OILCLOTHS, LTD. . . . . } OBJECTING PARTY.

1923  
March 20.

*Trade-mark—Registration without sufficient cause—Similarity of marks—  
Deception on the public—Expunging—Public interest—Trade-Mark  
and Design Act, section 11, subsection B and section 42.*

Petitioner's trade-mark "Congoelum" was registered in Canada in 1913, having been adopted in 1909 by petitioner's predecessors, in connection with their business of felt base floor coverings which were extensively sold in the United States and in Canada between 1913 and 1920. The objecting party registered the word "Kingoleum" in Canada, as a trade-mark in 1920, to be applied to the same class of merchandise. The two marks resembling each other, being alike in sound, and applied to the same class of merchandise, it was held, that as the public was liable to be deceived, the trade-mark "Kingoleum" was registered "without sufficient cause" and should be expunged from the Register.

2. That in such a case the interests of the public must be considered before those of the parties.

ACTION by petitioner to have the trade-mark consisting of the word "Kingoleum," expunged.

February 16, 1923.

Case now heard before the Honourable Mr. Justice Audette at Ottawa.

*W. L. Scott, K.C.* for petitioner.

*G. A. Stiles, K.C.* for objecting party.

The facts are stated in the reasons for judgment.

AUDETTE, J. this (March 20, 1923) delivered judgment.

This is an application to expunge from the Canadian Register a specific trade-mark

to be applied to the sale of floor coverings, particularly those generally known as felt base floor coverings of all kinds, and similar articles used for the same or like purposes, and which consists of the word "Kingoleum."

At the opening of the trial the parties filed (exhibit No. 1) an admission reading as follows:—

The Canadian Linoleums and Oil Cloths, Limited, admits that Barrett Manufacturing Company, Inc., the predecessors in title of Congoelum Company, Inc., of the United States, referred to in the petition herein was one of the pioneer companies engaged in the felt base floor covering business in the United States and also in Canada and that it began carrying on business in Canada in 1913 and continued to do so until such business was handed over to the Congoelum Company of Canada, Limited, the petitioner herein on the 1st day of May, A.D. 1920.

It was further admitted

that R. E. Kingley was in the business since 1904, but that he was not carrying on business under his own name, and was an officer of the company.

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The petitioner's predecessors adopted the trade-mark "Congoleum," in the year 1909, in respect of their business of felt base floor coverings, which they extensively sold both in the United States and in Canada between the years 1913 and 1920, and on the 31st March, 1913, they registered the same in Canada, in register No. 74, folio 18164, as a specific trade-mark to be applied to the sale of prepared floor coverings.

The objecting party's trade-mark "Kingoleum" was registered in Canada on the 13th day of October, 1920, as a specific trade-mark for the class of business above set forth.

Section 4 of the Trade-Mark and Design Act defines as a "general" trade-mark one which is used in connection with the sale of various articles in which a proprietor deals in his trade and business generally; while a "specific" trade-mark is one used in connection with the sale of a class of merchandise of a particular description. *Re Gebr. Noelle* (1).

Now it cannot be denied that "Congoleum" and "Kingoleum" seen side by side show a certain resemblance to one another; but that is not the test. One has to bear in mind that the danger to be guarded against is that the person seeing one mark by itself will think it to be the same as another which he has seen before, and that the purchaser will not see the two marks side by side so as to note the small differences.

These two specific marks are used in connection with the sale of the same class of merchandise, and that fact alone will greatly add to the possibility of taking the goods of one trader for those of another, creating confusion and, therefore, the use thereof will become liable to deceive the public.

Moreover, the general principle to be adopted in deciding such cases is to consider the impression produced by the mark as a whole. It is the appeal to the eye which is to be considered. It is by the eye the buyer judges. And in this case one must not overlook the similarity in the phonetics of the two words, which, while not exactly *idem sonans* maintain a certain analogy in sound which

(1) [1913] 14 Ex. C.R. 499.

may easily lead to mistake in the identity of the goods, particularly where both words relate to the same class of goods. Re application of *Egg Products, Ltd.* (1).

The two marks resemble one another; they sound alike; they are applied to the same class of merchandise. To allow such similarity in trade-marks is baneful to trade in that it is liable to deceive the public whose interest must be considered before the relative rights of the parties. 27 Hals.; 698 to 700. In re *Gebr Noelle's Trade-Mark "Albaloid"* (2); *Barsalou v. Darling* (3); *Melchers, J. J. v. John de Kuyper* (4); *Eno v. Dunn* (5); *Aunt Jemima Mills Co. v. Blair Milling Co.* (6); *William Waltke Co. v. Schafer* (7); *Northwestern Consol Milling Co. v. Mauser* (8).

Having found that the two marks resemble one another and reading subsection (b) of section 11 of the Trade-Mark and Design Act which enacts that the Minister may refuse to register any trade-mark which resembles any trade-mark already registered. I have come to the conclusion that the trade-mark "Kingoium" was registered without sufficient cause (see section 42). *Billings & Spencer v. Canadian Billings* (9).

The essence of a trade-mark is distinctiveness and this cardinal requirement is wanting as between the two marks in question.

Is not the very name of this trade-mark as having reference to the character of the goods descriptive or suggestive of the origin of the class of goods in connection with which it is used?

I have therefore come to the conclusion, for the reasons above mentioned, to order and adjudge to expunge from the Canadian Register of Trade-Marks, vol. 117, folio 27,350 the specific trade-mark "Kingoium" as applied to the sale of floor coverings, etc., the whole with costs in favour of the petitioner.

*Judgment accordingly.*

(1) [1922] 39 R.P.C. 155.

(2) [1913] 14 Ex. C.R. 499.

(3) [1881] 9 S.C.R. 677.

(4) [1898] 6 Ex. C.R. 82.

(5) [1890] 15 A.C. 252.

(6) [1921] 270 Fed. R. 1021.

(7) [1920] 263 Fed. R. 650.

(8) [1908] 162 Fed. R. 1004.

(9) [1921] 20 Ex. C.R. 405.