

BETWEEN:

KELLOGG COMPANY OF CANADA }
LIMITED

APPELLANT;

AND

THE REGISTRAR OF TRADE }
MARKS

RESPONDENT.

1939
Mar. 17.
Apr. 13.
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*Trade Mark—Appeal from the Registrar of Trade Marks allowed—
Unfair Competition Act, 22-23 Geo. V, c. 38, s. 26 (1) (c)—Trade
Mark "Gro-Pup" as applied to dog food neither descriptive nor
misdescriptive.*

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Held: That the word "Gro-Pup" is not descriptive or misdescriptive of the article to which it is to be applied, namely, dog food, within the meaning of s. 26 (1) (c) of the Unfair Competition Act, 22-23 Geo. V, c. 38, and is registrable as a trade mark.

APPEAL by Kellogg Company of Canada Limited from the refusal of the Registrar of Trade Marks to register the word mark "Gro-Pup" in connection with the sale of dog food.

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

R. S. Smart, K.C. for appellant.

W. P. J. O'Meara, K.C. for respondent.

The facts are stated in the reasons for judgment.

ANGERS J., now (April 13, 1939) delivered the following judgment:

This is an appeal from the refusal of the Registrar of Trade Marks dated February 4, 1939, to register a trade mark consisting of the word "Gro-Pup" as applied to dog food.

The application for this trade mark, bearing Serial No. 173,938, was filed on August 18, 1938.

The application contains, among others, the following statements:

2. The mark of which registration is desired is a word mark consisting of the following letters in the following grouping, namely:—

GRO-PUP

3. The applicant has used the said mark since the 6th day of August, 1938, on wares ordinarily and commercially described by the applicant as dog food, for the purpose of indicating that such wares were sold by the applicant. Such use has been principally in the Dominion of Canada.

4. In addition to wares of the kind described the applicant is commercially concerned with wares ordinarily and commercially described as all kinds of food products.

On January 11, 1939, the Registrar wrote to the applicant's solicitors as follows:

This application is considered confusingly similar to the following registration:

192-42202 Specific Trade Mark applied to Poultry Feed. Consists of the word "GROWENA" Registered by Ralston Purina Company, of St. Louis, Missouri, U.S.A., on 27th August, 1927.

The word "GRO-PUP" is considered clearly descriptive or mis-descriptive of the character or quality of the wares in association with which it is used.

In view of the provisions of Sections 26 (1) (c) and 26 (1) (f) of the Unfair Competition Act, your client's application, copy enclosed, does not appear to be registrable.

On January 17, 1939, applicant's solicitors wrote to the Registrar requesting reconsideration of the application; their letter reads in part as follows:

The word "GRO-PUP" is neither descriptive nor misdescriptive of the character or quality of the wares, namely, dog food. The mark is a fanciful mark which suggests, perhaps, that if a dog eats the particular dog food of the trade mark user it will grow * * *

With respect to the citation it is submitted that there is no similarity between the words "GRO-PUP" and "GROWENA." The first syllable, it is true, is the same in each but the mark must be considered as a whole and we do not think that anyone would confuse "GRO-PUP" with "GROWENA." Furthermore the wares are different, one being for poultry feed, which is gram, and the other being for dog food, which is usually made of some kind of meat, perhaps ground up with ground up bone and flour.

On February 4, 1939, the Registrar replied to applicant's solicitors stating (*inter alia*):

The trade mark disclosed in this application is a mis-spelling or phonetic equivalent of the words "GROW PUP" and is, therefore, not registrable in view of the provisions of Section 26 (1) (c) of the Unfair Competition Act. Your client's application, copy enclosed, is refused.

The Registrar evidently abandoned the objection raised in his letter of the 11th of January regarding the alleged similarity between the words "Growena" and "Gro-Pup."

I think he was right in acting thus: there is no similarity between the two words, save for the first syllable, and the mark must be considered as a whole; moreover they apply to different wares. Had not the Registrar waived this objection, a notice of the appeal would have had to be given to the owner of the mark "Growena" in compliance with subsection (2) of section 51 of the Unfair Competition Act, 1932 (22-23 Geo. V, Chap. 38).

The initial clause of subsection (1) of section 26 of the Unfair Competition Act, 1932, and paragraph (c) thereof, upon which the Registrar relied to refuse to register the trade mark in question, read thus:

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

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(c) is not, to an English or French-speaking person, clearly descriptive or misdescriptive of the character or quality of the wares in connection with which it is proposed to be used, or of the conditions of, or the persons employed in, their production, or of their place of origin.

Is the word "Gro-Pup" descriptive or misdescriptive of the character or quality of the wares, namely, dog food, in connection with which it is intended to be used? After giving the matter my best consideration and examining carefully the authorities referred to by counsel as well as others not cited, I have reached the conclusion that the word "Gro-Pup" is not descriptive and that its registration as a trade mark is not excluded by subsection (1) (c) of section 26.

Counsel for appellant relied particularly on the following decisions: *Bale and Church Ltd. v. Sutton Parsons & Sutton et al.* (1) and *Davis et al. v. Sussex Rubber Co. Ltd.* (2).

The facts in the latter case were briefly these. The plaintiff Davis had since 1919 used the word "Ustikon" as a trade mark in connection with rubber soles for boots and shoes and in 1924 and 1925 respectively had obtained registration of the words "Davis Ustikon" and "Ustikon" in part B of the register of trade marks. Sussex Rubber Company Limited adopted as a mark the word "Justickon." Davis took an action to restrain Sussex Rubber Company Limited from infringing and passing off. The defendant moved to rectify the register by expunging Davis' trade marks. It was contended on behalf of Sussex Rubber Company Limited that there were two kinds of rubber soles, viz. those which "you nail on" and those which "you stick on"; that Davis' marks were applied to the last-mentioned kind of soles, that they were a mere misspelling and that they were descriptive of the goods; that the word "Ustikon" was incapable of being distinctive and that the word "Justickon" was not liable to be confused with the word "Ustikon."

The case was heard before Russell J. (later Lord Russell), who held that, in considering whether a mark registered in part B was adapted to distinguish the goods of the owner of the mark, the onus of proving the negative lay on the defendant; that the fact that a word was descriptive did

not necessarily prevent it from being distinctive; that the evidence showed that the word "Ustikon" was distinctive of Davis' goods; and that the word "Justickon" so closely resembled the word "Ustikon" as to cause a likelihood of deception.

It seems apposite to cite a passage from the notes of Mr. Justice Russell (p. 417):

Now is the word "Ustakon" descriptive of the goods to which it applies? In one sense, yes. The evidence shows that in this particular trade or in this particular line of goods there are two classes of rubber soles, one class being soles which you nail on, the other class being soles that you stick on, and what the defendants say is this: This is a purely descriptive word, "Ustakon," it merely says that the soles in question belong to the class which you stick on; that is the way it is put. As I read the authorities which have been cited, the matter stands in this way. A word which is so descriptive as that it could not acquire a secondary meaning and become distinctive ought not to be on the Register, and it makes no difference whether the mark in question is the word or phrase correctly spelt or, as in the present case, fantastically spelt, because marks such as these appeal at least as much to the ear as to the eye. As I read the authorities this is also true, that since the Act of 1905 the mere fact that a word is descriptive or has a descriptive flavour, does not necessarily prevent that word being distinctive of somebody's goods. That appears to me to be the plain result of the language used by Lord Justice Fletcher Moulton in the *Orlwoola* and *Perfection* cases reported in 26 Reports of Patent Cases \* \* \*

The learned Judge then quotes certain extracts from the judgment of Lord Justice Fletcher Moulton and concludes thus (p. 418):

It appears to me it is impossible to establish at the present day that because a word is descriptive or has a descriptive flavour it is not also distinctive of somebody's goods and is not properly registrable as a trade mark.

The defendants appealed; the appeal was dismissed.

Reference may be had with benefit to the observations of the Master of the Rolls, Lord Hanworth, at page 423 of the report and to those of Lawrence L.J. at page 427.

In *Bale and Church Ltd. v. Sutton Parsons & Sutton et al.* the trade marks of the plaintiffs and the defendants respectively consisted of the words "Kleenoff" and "Kleenup," both used in connection with cleaners for cooking stoves.

The plaintiffs who had sold their product under the name "Kleenoff" for a number of years, on the first of October, 1929, registered the word as a trade mark in part B of the register under section 2 of the Trade Marks Act, 1919. The defendants had recently put on the market

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a product under the name "Kleenup," which was at first advertised as a hand cleaner but was subsequently recommended for cleaning cookers. The plaintiffs brought an action against the defendants seeking to restrain them from infringing the trade mark and passing off.

The trial judge, Clauson J., held (*inter alia*): (1) that the defendants had failed to establish the special defence, to wit that the word "Kleenup" was not calculated to deceive under section 4 of the Trade Marks Act, 1919, and (2) that they had infringed the plaintiffs' trade mark.

The defendants appealed; the judgment was affirmed.

I may perhaps quote an excerpt from the notes of Maugham L.J., who dealt with the question of descriptiveness (p. 143, in fine):

There is a third point which Mr. Shelley took, which I will say a word about, and that is this. The marks which may be registered under Part B often, perhaps more often than not, will include descriptive marks, and he has argued that the element of descriptiveness contained in a mark makes the test of infringement far more stringent than in the case where the mark is registered either under Part A, or in a case where the marks have not got a descriptive element. With regard to that, I think there are some observations which were made by Lord Justice Fletcher Moulton in the celebrated *Perfection* case, which is to be found reported in 26 Reports of Patent Cases, at page 837. The remarks were cited by Lord Russell, then Mr. Justice Russell, in the *Ustikon* case, which is reported in 44 Reports of Patent Cases, page 412, at page 417. Those remarks seem to me to be very apposite in dealing with this particular question.

Maugham L.J. then quotes two passages from Lord Justice Fletcher Moulton's observations cited by Mr. Justice Russell and adds (p. 144):

Then Mr. Justice Russell adds for himself that it appeared to him that it was "impossible to establish at the present day that because a word is descriptive or has a descriptive flavour it is not also distinctive of somebody's goods and is not properly registrable as a trade mark" In the present case my view is that the test of infringement where the trade mark has a descriptive element is the same as the test where it has no descriptive element, except so far as the descriptive element is itself common to the trade. That, of course, you have to consider; but apart from that, the test of infringement is, I think, the same.

It seems to me convenient to cite an extract from the observations of Lord Justice Fletcher Moulton in the "Perfection" and "Orlwoola" cases concerning descriptiveness and distinctiveness, referred to or quoted in part in *Davis et al. v. Sussex Rubber Company Ltd.* and *Bale and Church Ltd. v. Sutton Parsons et al.* (1).

Much of the argument before us on the part of the opponents and the Board of Trade was based on an assumption that there is a natural and innate antagonism between distinctive and descriptive as applied to words, and that if you can show that a word is descriptive you have proved that it cannot be distinctive. To my mind this is a fallacy. Descriptive names may be distinctive, and vice versa. No class of words are more directly and intentionally distinctive than proper names, and yet originally they were usually, if not invariably, descriptive in all languages \* \* \* There is therefore no natural or necessary incompatibility between distinctiveness and descriptiveness in the case of words used as Trade Marks. The notion that there is such an incompatibility is confined to lawyers, and is, in my opinion, due to the influence of the earlier Trade Marks Acts. By those Acts, which are now repealed, the fact that words were descriptive of the goods was fatal to their registration as Trade Marks, and thus becoming in the eye of the law distinctive of the goods of a particular maker. But the question whether a word is or is capable of becoming distinctive of the goods of a particular maker is a question of fact, and is not determined by its being or not being descriptive. The law has never refused to recognize that this is the case, or to give protection to descriptive Trade Marks when once duly established in fact, although—except in the case of old marks—they refused registration, and left the owners to obtain protection in another form of action. This is now changed, and under the provisions of the present Act the Court clearly has power to allow descriptive words to be registered, if a case on the merits is proved before it sufficiently strong to induce it to do so.

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Counsel for the Registrar relied on the following decisions: *Bowker Fertilizer Co. & Gunns Ltd.* (1); *In the Matter of an Application by the Hotpoint Electric Heating Co. for a Trade Mark* (2); *In the Matter of an Application by the Minnesota Mining & Manufacturing Co. for a Trade Mark* (3); *Kirstein Sons & Co. and Cohen Brothers Ltd.* (4).

In the case of *Bowker Fertilizer Co. and Gunns Ltd.*, it was held that "Sure-Crop" or "Shur-Crop" as applied to fertilizers are ordinary words descriptive of the quality of the article, incapable of acquiring a secondary meaning and not registrable as a trade mark.

In the case of the application by the *Hotpoint Electric Heating Co.*, it was held that the word "Hotpoint" had reference to the character of the goods but that it had become distinctive of the applicants' electrical appliances, other than irons, in respect of which registration had been sought; that the word was so descriptive of irons that, even if the applicants had not abandoned their application for these goods, it would have been difficult to contend

(1) (1916) 16 Ex. C.R. 520.

(2) (1921) 38 R.P.C. 63.

(3) (1924) 41 R.P.C. 237.

(4) (1907) 39 S.C.R. 286

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that the word had become distinctive; that the fact that there might be confusion in the minds of some people, who buy irons, was no ground for refusing to allow the registration of a mark which had become distinctive of the applicants' goods in respect of other appliances.

In the case of the application by Minnesota Mining and Manufacturing Co., it was held that the word "Wetordry," which the company was seeking to register in respect of abrasives, had reference to the character or quality of the goods, that there was no evidence before the Registrar that the mark was distinctive and that the Registrar was right in refusing the application.

In the case of *Kirstein Sons & Co. and Cohen Brothers Ltd.* the Supreme Court of Canada, affirming the judgment of the Court of Appeal of the Province of Ontario, held that the words "Shur-on" and "Staz-on" are not inventive words which could be used as trade marks but are merely corruptions of words descriptive of eyeglass frames to which they were intended to be applied.

The words "Shur-on," "Staz-on," "Hotpoint" and "Wetordry" are, in my opinion, essentially descriptive, having a direct reference to the character or quality of the articles to which they were applicable; and besides they are surely more definite than the word "Gro-Pup." On the other hand, I may say, with all due deference, that I would have felt inclined to say that the words "Sure-Crop" and "Shur-Crop" were not descriptive of the article to which they were intended to apply, but that they rather indicated the object or purpose thereof or else the result thereby obtainable.

Decisions which may be consulted with interest are: *In the Matter of an Application of The Eastman Photographic Materials Co. Ltd. for a Trade Mark* (1); *J. C. & J. Field Ltd. v. Wagel Syndicate Ltd.* (2); and *Linotype Company's Trade Mark* (3).

As I have said, I do not think that the word "Gro-Pup" is descriptive of the article to which it is to be applied, namely, dog food; it is at the utmost suggestive of the

(1) (1898) 15 R.P.C. 476.

(2) (1900) 17 R.P.C. 266.

(3) (1900) 2 Ch. 238



result which it is liable to produce. The word, in my opinion, is registrable; the Registrar's decision refusing to register it is accordingly set aside.

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The parties agreed that there should be no order as to costs.

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*Appeal allowed.*

Angers J.