

1939
Oct. 30
Nov. 25

BETWEEN :

TUCKETT TOBACCO CO. LTD.....PETITIONER;

AND

ROMEO ST. GERMAIN, trading as }
J. O. FOREST & COMPANY, and }
the said J. O. FOREST & COM- }
PANY }
RESPONDENTS.

Trade mark—Petition to expunge—“Bell Boy”—“Page Boy”—Mark likely to lead to confusion—Unfair Competition Act, 22-23 Geo. V, c. 38, secs. 26 (g), 31 (3) & 38.

Petitioner applied for registration of design marks described as “the representation of the upper part of the body of a bell boy holding a package of cigarettes” and as “a medallion containing the representation of a bell boy’s head.” The marks had been used by petitioner for some time in connection with the manufacture and sale of cigarettes prior to the date of the applications for registration.

The Registrar of Trade Marks rejected the application on the grounds *inter alia* that the figure shown in one application represented a “page boy’s head, and not that of a bell boy,” and that in the other application the figure shown represented “a page boy and not that of a bell boy.”

Subsequent to the adoption of petitioner’s design marks, the respondent J. O. Forest & Company began to use and applied for registration of the words “Bell Boy” as a trade mark to be used on leaf tobacco, cigarettes, cigars and cut tobacco.

Petitioner, as required by the Registrar, amended its applications by substituting the word “page” for the word “bell” and the applications as so amended were allowed and the design marks were registered in November, 1938. On June 27, 1939, petitioner learned that the issue of the Canadian Patent Office Record of June 20, 1939, contained a notice of the registration of the word mark “Bell Boy” at the instance of the respondents.

The petitioner prays that the word mark “Bell Boy” be expunged from the register of trade marks.

Held: That the word mark “Bell Boy” should be expunged from the register of trade marks.

- 2. That the petitioner in its application might have described its design mark as a representation of either a “bell boy” or a “page boy,” or both.
- 3 That the word mark “Bell Boy” on the goods of the respondents would be liable to lead to confusion, and would be calculated to permit of and encourage the passing off of the respondent’s goods for those of the petitioner.

4. That the Registrar should have treated the application of J O Forest & Company as a fresh one, and that the petitioner, then the owner and registrant of the design marks in question, and there being no change in the state of facts since the first consideration of the case, should have been notified thereof in conformity with s 38 of the Unfair Competition Act and should have been asked if it had any objection to the proposed registration of J O. Forest & Company.

1939
TUCKETT
TOBACCO
CO. LTD.
v.
ROMEO
ST. GERMAIN
AND
J. O. FOREST
& Co
Maclean J.

PETITION by petitioner herein to have respondents' design mark expunged from the Register of Trade Marks.

The petition was heard before the Honourable Mr. Justice Maclean, President of the Court, at Ottawa.

O. M. Biggar, K.C. for petitioner.
C. E. Ferland for respondents.

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

THE PRESIDENT, now (November 25, 1939) delivered the following judgment:

The petitioner, Tuckett Tobacco Company Ltd., prays that the word mark "Bell Boy," registered by the respondent J. O. Forest & Company, in June, 1939, and numbered N.S. 11,673, be expunged from the register of trade marks. The salient facts are established to be as follows.

In April, 1923, the petitioner, for the purpose of distinguishing certain goods manufactured by it, from similar goods manufactured by others, adopted and commenced to use pictorial representations of a boy in buttons in a red tunic and wearing a round red forage cap, certain of the representations showing the figure of the boy down to the waist and in the act of offering a package of cigarettes, while others represented only his head. The goods manufactured by the petitioner upon which the said marks were used, were cigarettes, described as "Navy Cut Virginia," and bearing the name of Phillip Morris & Company Ld., of which company the petitioner was the successor in Canada, and such cigarettes have been from the date of the adoption of the said mark continuously sold throughout Canada in a very substantial way, both in quantity and value. No application to register the said mark was made by the petitioner until November 20, 1936.

1939
 TUCKETT
 TOBACCO
 Co. LTD.
 v.
 ROMEO
 ST. GERMAIN
 AND
 J. O. FOREST
 & Co.
 ———
 Maclean J.
 ———

In the month of September, 1936, the petitioner's attention was directed to the sale by the respondents of a cigarette tobacco in a package bearing the words "Bell Boy" and a pictorial representation of a boy in a red tunic and trousers and wearing a red forage cap, and, on October 2nd following, the petitioner wrote to the respondent J. O. Forest & Company drawing attention to the fact that the design on this package conflicted with that used by the petitioner for many years, and requesting the discontinuance of the use of such mark.

No answer to this communication having been received the petitioner, by its solicitors, made a search at the Trade Marks Office and ascertained that the respondent J. O. Forest & Company had made an application under the Unfair Competition Act, 1932, for the registration of the words "Bell Boy" as a trade mark to be used on leaf tobacco, cigarettes, cigars and cut tobacco, the said application being based upon the allegation that the respondent's use of the said mark had begun in September, 1935. Thereupon the Registrar was advised on November 4, 1936, by the petitioner's solicitors, that the petitioner had for many years been using a design consisting of the head and shoulders of a bell boy as a trade mark for cigarettes, and that it objected to the allowance of such application, and the Registrar was requested to refuse the same.

On November 20th following, the petitioner filed applications for the registration as design marks of the pictorial representations used by it as already mentioned, the principal feature of the mark being described in one of the applications as "the representation of the upper part of the body of a bell boy holding a package of cigarettes," and in the other as "a medallion containing the representation of a bell boy's head." The petitioner proposed the use of such design marks in connection with the sale of tobacco in all its forms, and particularly cigarettes, cigarette papers, cigarette tubes, tobacco snuff and cigars.

On December 3, 1936, the Commissioner of Patents, then the Registrar under the Unfair Competition Act, 1932, notified the petitioner's solicitors that the said applications were defective in certain particulars, among others in the fact that the descriptions of the design marks were inaccurate in that the figure shown in one application represented a "page boy's head, and not that of a bell boy,"

and that in the other application the figure shown represented "a page boy and not that of a bell boy." In response to this notification the Commissioner was advised on behalf of the petitioner that the defects suggested were not in fact defects, that the Commissioner was free to index the applications as he saw fit, and that the applications should either be allowed or refused as they stood.

No further communication was received by the petitioner or its solicitors on the subject until on August 6, 1938, when the petitioner's solicitors made an oral enquiry from the then Registrar of Trade Marks as to the reasons for the delay of more than eighteen months in dealing with the petitioner's applications, and they were advised that the Registrar desired to consider further whether or not he had power to compel the petitioner to adopt his view that the occupation of the boy shown in the design marks sought to be registered was properly described as that of a "page boy."

On September 21st following, the Registrar advised the petitioner's solicitors that if the petitioner's applications were amended so as to describe the boy shown in the design marks as a "page boy" instead of a "bell boy" he would allow such applications, and that he proposed to refuse the application of J. O. Forest & Company for the registration of the word mark "Bell Boy," having he said, regard to the fact that the petitioner's use of its design marks long antedated the first use of the former's word mark.

The petitioner's solicitors, while adhering to the view that the Registrar had no right to insist upon the amendment suggested, decided, about September 21, 1938, to submit to the requirement made by the Registrar in order to avoid further delay, and on the faith, it is alleged, of the Registrar's statement that the application of J. O. Forest & Company, which, like the petitioner's application, was still pending, would be rejected, implying thereby that the registration of the petitioner's design marks would prevent the registration of the word mark "Bell Boy," according to the rule laid down in sec. 26 of the Unfair Competition Act, and particularly clause (g) thereof. Accordingly the petitioner's applications were amended by substituting the word "page" for the word "bell," and the petitioner's applications as so amended were thereupon

1939
 TUCKETT
 TOBACCO
 Co. LTD.
 v.
 ROMEO
 ST. GERMAIN
 AND
 J. O. FOREST
 & Co.
 Maclean J.

1939
 TUCKETT
 TOBACCO
 CO. LTD.
 v.
 ROMEO
 ST. GERMAIN
 AND
 J. O. FOREST
 & Co
 Maclean J

allowed and the design marks registered in November, 1938, as of November 20, 1936, and as Nos. N.S. 10,440 and 10,441. On September 29, 1938, which was apparently subsequent to the amendment of the petitioner's description of its design marks, the respondents were notified by the Registrar that the application of J. O. Forest and Company was refused on the ground of its similarity to the design marks of the petitioner which had been in use since April, 1923, whereas the trade mark "Bell Boy" had been first used by J. O. Forest & Company only in September, 1935. When the notice of this refusal was communicated to J. O. Forest & Company the petitioner's design marks had either been registered or stood approved by the Registrar for registration.

The respondents, within the time limited by sec. 51 of the Unfair Competition Act, then gave notice to the Registrar and to the petitioner of an appeal to the Exchequer Court from the refusal to register the application of J. O. Forest & Company, and such notice was duly filed with the Registrar of the Exchequer Court, but no notice of the hearing of the respondent's appeal was given at any time. Later, the appeal was abandoned by notice filed in the Exchequer Court on June 1, 1939, which notice was dated May 31, 1939, but no notice of the abandonment was ever given to the petitioner, and no advice was at any time received by the petitioner from the Registrar on the subject of the appeal, or of its abandonment.

On or about June 27, 1939, the attention of the petitioner was drawn to the appearance, in the issue of the Canadian Patent Office Record dated June 20, 1939, of notice of the registration of the word mark "Bell Boy" at the instance of the respondents, and thereupon the petitioner, through its solicitors, caused enquiries to be made from the Registrar as to the explanation of the publication of this notice. The particulars of the explanation made by the Registrar need not be mentioned except to say that the Registrar, and it is not denied, expressed his regret for his failure to notify the petitioner's solicitors of the fact that he had reversed his former decision.

The respondents then commenced to use their registered word mark "Bell Boy" in association with a pictorial representation of a boy in a red tunic and trousers, and wearing a round forage cap. The respondents now allege

that after the commencement of this proceeding, on advice of counsel, they ceased to employ the said pictorial representation and now use instead thereof a representation of a boy or young man in civilian clothes, presumably discharging the duties of an hotel porter or some such hotel employee, carrying several pieces of luggage for a hotel guest.

I find it difficult to appreciate the action taken by the Registrar in this matter. I cannot easily appreciate why any serious distinction should be made between the functions of a "bell boy" and a "page boy," even though a distinction may be made in some large and fashionable establishments, and particularly in a trade mark case where the contest is essentially as to whether the figure of a boy represents a "page boy" or a "bell boy." I think the public would understand the petitioner's design marks to represent a youth employed for doing errands, carrying messages, and so on, as in a hotel; the dress or uniform of the boy, and its colour, is not described or limited in the petitioner's application. I apprehend that a pictorial representation of the head, or the upper part of the body, of a bell boy, would be much the same as that of a page boy, and it is the representation of such portions of the body of a boy that the petitioner has registered. It is, I think, a matter of common knowledge that the words "bell boy" and "page boy" are used interchangeably by the public to describe the employment of a youth in a hotel, and who performs such duties as responding to calls from rooms, carrying messages to hotel guests, and carrying out a variety of duties assigned to him. A severance of such duties may be convenient and desirable in some cases, but even then the public are not, I think, meticulous about describing one as a "page boy" and the other as a "bell boy"; and the youth who once responded to the title of "bell boy" is in fact now almost as extinct as the dodo, his enemy having been the telephone. It seems to me to be altogether unnecessary to engage in any refinements between a page boy and a bell boy, in determining the registrability of the word mark in question here. I think the petitioner, who does not in actual practice use the words "page boy" in association with, or as part of, its design marks, might well have described his design mark, in his application, as a representation of

1939

TUCKETT
TOBACCO
CO. LTD.

v.

ROMEO
ST. GERMAINAND
J. O. FOREST
& Co.

Maclean J

1939
 TUCKETT
 TOBACCO
 Co. LTD.
 v.
 ROMEO
 ST. GERMAIN
 AND
 J. O. FOREST
 & Co.
 ———
 Maclean J.
 ———

either a "bell boy" or a "page boy," or both, and they might well have been indexed under both names. The petitioner was required by s. 31 (3) of the Act to describe the principal features of its design marks, so as to enable the Registrar to index the same, but for no other purpose so far as I can discern. The amendment made to the description as originally filed would not really alter the significance attached to the design marks themselves by the public, as the public would have no knowledge of the verbal amendment made, or in fact how the design marks were originally described, or how they were indexed in the office of the Registrar.

The petitioner, in order to avoid further delay in obtaining registration of his marks, assented to amend its application as suggested by the Registrar, on the faith, as alleged by the petitioner and which is not in any way denied, that the respondents' application would be refused, and this is supported by the fact that almost contemporaneously with the granting of the petitioner's application, the respondents' application was officially refused, and the respondent was so advised and in the terms to which I have already made reference. The Registrar then decided that there was a similarity between the petitioner's design marks and the respondents' word mark, and the respondents themselves have virtually admitted that similarity by ceasing to use a pictorial representation of what they call a "bell boy" in association with their registered word mark. It is provided by s. 26 (g) of the Act that a word mark shall not be registrable if it suggests some feature of a design mark already registered for use in connection with similar wares and which is so characteristic of the design mark that its name would not be unlikely to be used to define or describe the wares in connection with which the design mark is used. Clear of the statute altogether that would be a fair statement of the law, and reference to this principle may be found in Kerley on Trade Marks, Sixth Edition, at page 275. It seems to me that it would not be unlikely that the word mark "Bell Boy" on the goods of the respondents might be accepted as a description of the goods of the petitioner in connection with which its design marks are used. It would I think be liable to lead to confusion, and would be calculated to permit of and encourage the passing off of the respondents'

goods for those of the petitioner, and thus unfair trading would be the consequence, not so much by the respondents as by dealers. For the foregoing reasons the registration of J. O. Forest & Company should, I think, be expunged. I have no doubt but that the Registrar's first view of the case was the correct one.

Furthermore, I might add, that in view of all the facts here disclosed, and in view of the grounds of the first decision made by the Registrar in the premises, the Registrar must be deemed to have entertained some doubt as to the propriety of granting the application of J. O. Forest & Company, upon any reconsideration of the same. In any event, I think, the Registrar, in all the circumstances of the case, should have treated the application of Forest & Company as if it were a fresh one, if he were to reconsider it at all, and that the petitioner, at that date the owner and registrant of the design marks in question, and there being no change in the state of facts since the first consideration of the case, should have been notified thereof in conformity with s. 38 of the Unfair Competition Act, and asked whether or not it had any objections to the proposed registration of Forest & Company. I find it difficult to believe that the Registrar did not entertain some doubt as to whether the application of Forest & Company should be granted without the petitioner being heard, after it had been refused earlier on the grounds I have already mentioned, and there being no change in the state of facts in the meanwhile. In the circumstance here, I think, the procedure laid down in s. 38 of the Act should have been followed, and the petitioner should have been asked if it had any objection to the proposed registration. The failure to do so would, I am inclined to think, afford sufficient ground alone for expunging the registration of Forest & Company, or, for opening up that registration so that the petitioner might be heard, though I do not propose to make any definite pronouncement upon that aspect of the case.

The petition is therefore allowed and with costs.

Judgment accordingly.

1939
 TUCKETT
 TOBACCO
 CO. LTD.
 v.
 ROMEO
 ST. GERMAIN
 AND
 J. O. FOREST
 & Co.
 Maclean J.