
1948 BETWEEN:
 Nov. 22, 23, FAWCETT PUBLICATIONS INC..... PLAINTIFF;
 24, 25, 26

AND

1950
 Mar. 1 ALEXANDER VALENTINE..... DEFENDANT.

Trade mark—Infringement—Passing off—Registrability—The Unfair Competition Act 1932, 22-23 Geo. V, c. 38, ss. 2(k), 2(m), 11, 26(1)(c), 28(1)(d), 29, 32—Mark lacking registrability expunged from the register—Claim based on infringement dismissed—Claim based on passing off dismissed—“True Confessions”—“Startling Confessions”—“Sensational Crime Confessions”—“Similar”—Secondary and distinctive meaning—Get-up of magazine common to the trade—Motion for declaration under s. 29 of The Unfair Competition Act, 1932, dismissed—Failure to prove that word has become recognized “generally” by Canadian dealers as attaching responsibility to the owners—Costs.

In an action for infringement of a trade mark and passing off the Court found that at the time of registration of the plaintiff's trade mark it lacked registrability as being in contravention of s. 26(1)(c) of The Unfair Competition Act, 1932, and that it did not comply with s. 28(1)(d) of the Act nor was any application made under s. 29 of the Act, nor was the procedure required under s. 32 of the Act followed.

(1) (1930) S.C.R. 307, 316.

(2) (1914) 31 R.P.C. 385.

In considering plaintiff's claim for passing off on the ground that defendant's magazines published under the names of "Startling Confessions" and "Sensational Crime Confessions" resemble plaintiff's mark "True Confessions" the Court found that the evidence did not establish that actual confusion had arisen; nor did the evidence indicate that the combination of the features of the magazine, all common to the trade, as used by the plaintiff had in Canada become distinctive of or identified with the plaintiff's trade.

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Held: That the plaintiff's mark lacking registrability must be expunged from the Register of Trade Marks and plaintiff's claim based on infringement fails.

2. That the evidence did not establish that the mark "True Confessions" or "Confessions" had through use in Canada acquired a secondary and distinctive meaning nor that the defendant had passed off or had attempted to pass off his magazines as those of the plaintiff or that the defendant had practised any fraud and that on the whole of the evidence the titles of the defendant's magazines are not "similar" to that of the plaintiff within the meaning of the definition in s. 2(k) of the Act and the claim for passing off fails.
3. That a motion for a declaration under s. 29 of The Unfair Competition Act must be dismissed since the evidence in support fails to establish that the word mark "True Confessions" has become recognized "generally" by Canadian dealers as attaching responsibility to the owners.

ACTION for infringement of word-mark, passing off and damages.

The action was tried before the Honourable Mr. Justice Cameron at Toronto.

Cuthbert Scott for plaintiff.

G. E. Maybee and *Mrs. Iva S. Goldstick* for defendant.

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

CAMERON J. now (March 1, 1950) delivered the following judgment:

This is an action for infringement, passing off, damages and other incidental relief. The plaintiff is a Delaware corporation having its head office at New York City. Since its inception in 1924 it has been engaged in a very substantial way in the publication and distribution of monthly and other periodical magazines. Since that date it has been the owner of the trade name and trade mark

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“True Confessions”, to be used in connection with the sale of periodical publications, which trade mark was registered by its predecessor in title in the United States Patent Office on January 23, 1923, under the Act of 1905, and was renewed in the name of the plaintiff in 1943 for a period of twenty years. The plaintiff also registered that mark in Canada on May 17, 1941, as No. N.S.-15636-Register 60, for use on wares described as a periodical publication. That registration was *not* made under the provisions of section 28(1)(d) of The Unfair Competition Act, 1932. Since 1922 the plaintiff and its predecessor in title have published in the United States a monthly magazine entitled “True Confessions.” It has been widely circulated in the United States since that date and, as will be seen later, was first circulated in Canada in 1932 and has been circulated here at intervals since that date.

The defendant is a publisher residing in Toronto. It is established—and, in fact, admitted—that in 1946 the defendant published in Toronto three issues each of magazines entitled respectively “Startling Confessions” and “Sensational Crime Confessions”. (There is no evidence, however, that the defendant ever published a magazine entitled “Daring Confessions” as alleged in the Statement of Claim.)

The plaintiff alleges that by publishing such magazine with such titles, the defendant has infringed its trade mark, and that by the use of the word “Confessions” thereon and by adopting, imitating and copying the form and get-up of the plaintiff’s magazine, the defendant was thereby fraudulently passing off his magazines as those of the plaintiff. The defendant denies that he has in any way interfered with the plaintiff’s rights, and, alleging invalidity of the plaintiff’s registered mark in Canada, asks that it be expunged from the Register.

By order dated February 26, 1948, this action and another action brought by the plaintiff against Pastime Publications Limited were consolidated and at the trial, by consent, evidence in both cases was heard.

I shall consider first the question of infringement. On that branch of its case the plaintiff can succeed only if it has a valid registered mark, and the question of the validity of the registration of “True Confessions” is challenged. The

defendant alleges that it should not have been registered as the words "True Confessions" are clearly descriptive—or, alternatively, misdescriptive—of the character or quality of the plaintiff's magazine, "True Confessions," and that such registration, therefore, is in contravention of section 26(1)(c) of The Unfair Competition Act which is as follows:

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

(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.

Now, as I have said, plaintiff has used its word mark as the title of one of its magazines and in no other way. It becomes necessary, therefore, to ascertain whether the mark as so used is descriptive (or, alternatively, misdescriptive) of the character or quality of that magazine. It is in evidence that about 40 per cent of the space in the magazine is taken up with advertisements from which a very large revenue accrues to the plaintiff; that about 27 per cent has to do with articles concerning women's dress, cosmetics, home and gardens, and matters of that sort; and that confession stories comprise about one-third of the total space. While, therefore, the "Confessions" part of the title does not perhaps accurately describe all the contents of the magazine, there can be no doubt whatever that it sufficiently describes the main features of the reading material, and of course it is for the purpose of reading that material that the magazine is primarily purchased. The plaintiff throughout has stressed the "Confessions" character of the contents by the blurb on the front cover. A few such cover blurbs selected at random from the exhibits filed are "A Chorus Girl's Romance," "Famous Sheik Tells Secrets of His Life," "Autobiography of a Forger," "Why Wives go Wrong—By One Who Did," "Diary of a Discarded Wife," and "I Didn't Know Enough About Love." The Shorter Oxford English Dictionary gives one meaning of "Confession" as "a making known or acknowledging of one's fault, wrong, crime, weakness, etc.," and that definition would aptly describe the nature of the stories to which I have alluded.

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Further, the stories are written in the first person singular and purport to be true confessions. In fact, a substantial number of the issues contained in Exhibit 1 assert that they are, in fact, true, and certainly in no place is it indicated that they are otherwise. The evidence at the trial, however, was that they were written by professional authors and while said to be "true to life", were, in fact, not true.

The second part of the word mark therefore aptly and clearly describes the character of the plaintiff's wares in that they are confessions; the first part also aptly and clearly describes—or misdescribes—the nature of the confessions, according to whether they are in fact true or untrue. The word mark as a whole alludes directly and unmistakably to the contents of the magazine and to nothing else, and *prima facie* does not meet the negative requirements of section 26(1)(c) (*supra*). It does not come within the class of invented words which may be registrable even though containing a covert and skilful allusion to the character or quality of the goods; the *Solio* case (1). The word mark, therefore, per se, lacked registrability.

It is of interest to note that in the case of *Crime Confessions v. Fawcett Publications, Inc.*, before the Court of Customs and Patent Appeals of the U.S. (2), the Court had occasion to comment on the plaintiff's mark as follows:

It would seem obvious to all that the terms "Crime Confessions" and "True Confessions" are descriptive. While we cannot pass upon that question in this kind of proceeding, it seems proper to suggest that since the registration of purely descriptive trade-marks is clearly a violation of the law, it would be better for the Patent Office to comply with the law rather than to follow the precedents that have been followed throughout the years.

Counsel for the plaintiff submits, however, that at the time of the application for registration, the mark had acquired a secondary and distinctive meaning and that, therefore, the registration was valid. Now, as I have said, the mark was registered under The Unfair Competition Act of 1932 and must be considered under the provisions of that Act. Under the provisions of the old Act—The Trade Mark and Designs Act—a special provision was made by Rule X which permitted the Commissioner to consider (*inter alia*) whether a mark, unregistrable because it was clearly descriptive, had at the time of the application for registration acquired a secondary meaning and

(1) (1898) 15 R.P.C. 476 at 486. (2) (1944) 139 F. 2d. 499.

become adapted to distinguish the goods of the applicant, and upon being satisfied that such was the case, to register the mark.

But The Unfair Competition Act materially changed the law in that regard. Nowhere in the Act, nor in any regulations promulgated by the Governor-in-Council under section 60, is any such power conferred on the Registrar to consider that question. Section 29 of The Unfair Competition Act, however, recognizes that certain marks, otherwise unregistrable, have by use become distinctive of the manufacturer or dealer, or of the conditions under which or the class of persons by whom they have been produced, or of their place of origin, and provides for their registration following a declaration by the Court.

As I have said, the plaintiff's registration was not effected under the provisions of section 28(1)(d) of the Act; the procedure required under section 32 was not followed. Nor was an application made under the provisions of section 29. As pointed out by the President of this Court in *J. H. Munro Limited v. Neaman Fur Co. Ltd.* (1), at p. 15:

If the plaintiff must rely upon a secondary and distinguishing meaning of the word mark as denoting only the wares of the plaintiff to support the registration of its alleged trade mark, it must show not only that the words had acquired such meaning at the time of the registration but also that the application for it had been made under the provisions applicable thereto.

In this case the required procedure was not followed and in my opinion, therefore, the plaintiff is not entitled to support its registration of the mark on the ground that at the time of registration it had, in fact, acquired a secondary and distinctive meaning. The mark, therefore, at the time of registration lacked registrability as being in contravention of section 26(1)(c), should not have been registered, and the defendant's claim to have it expunged from the Register will be granted. It follows from that conclusion that the plaintiff's claim insofar as it is based on infringement must fail. *Partlo v. Todd* (2); *J. H. Munro and Neaman Fur Co. Ltd.* (*supra*).

I may state, however, that quite apart from these somewhat technical considerations, had I given consideration to the evidence as to the acquisition of a secondary meaning at the time of registration, I would have found that the

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(1) (1947) Ex. C.R. 1 at 15.

(2) (1888) 17 S.C.R. 196.

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plaintiff had failed to established its case. That evidence was confined to that given at the trial. Counsel for the plaintiff asked leave to use the declarations filed on his alternative application under section 29, but I ruled that such were inadmissible as evidence on the main matter and, later, counsel agreed that he could take no objection to that ruling. My reasons for stating that the plaintiff had failed to establish its case will more fully appear later herein.

I may further add that had I found that the plaintiff's mark was validly registered, I would have reached the conclusion that there was no infringement thereof by the defendant. The reasons for my so stating will be apparent from my conclusions on the passing off branch of the case.

I turn now to the question of passing off. The plaintiff's rights on this aspect of the matter do not depend on the validity of its registration. The basis of the right to restrain "passing off" was described by Farwell, J. in *Maclean's, Ltd. v. J. W. Lightbown and Sons, Ltd.* (1), as follows:

No trader can complain of honest competition, but no trader is entitled to steal the property of his rival by endeavouring to attract to his goods members of the public by inducing them to believe that the goods that are being offered for sale are the goods of a rival firm.

The Unfair Competition Act, 1932, provides statutory authority for that principle in sections 3 and 11 which are as follows:

3. No person shall knowingly adopt for use in Canada in connection with any wares any trade mark or any distinguishing guise which

- (a) is already in use in Canada by any other person and which is registered pursuant to the provisions of this Act as a trade mark or distinguishing guise for the same or similar wares;
- (b) is already in use by any other person in any country of the Union other than Canada as a trade mark or distinguishing guise for the same or similar wares, and is known in Canada in association with such wares by reason either of the distribution of the wares in Canada or of their advertisement therein in any printed publication circulated in the ordinary course among potential dealers and/or users of such wares in Canada; or
- (c) is similar to any trade mark or distinguishing guise in use, or in use and known as aforesaid.

11. No person shall, in the course of his business,

- (a) make any false statement tending to discredit the wares of a competitor;
- (b) direct public attention to his wares in such a way that, at the time he commenced so to direct attention to them, it might be

(1) (1937) 54 R.P.C. 230 at 239.

reasonably apprehended that his course of conduct was likely to create confusion in Canada between his wares and those of a competitor;

(c) adopt any other business practice contrary to honest industrial and commercial usage.

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There is no dispute that the titles which the defendant used are subject to the above prohibitions if they are "similar" to the plaintiff's mark. The other requirements as to "knowingly" (under s. 10) and similarity of wares are established.

The word "similar" in relation to trade marks is defined thus:

2. (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 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.

The contemporaneous use of the plaintiff's and defendant's marks in association with wares of the same kind is not in dispute. The question for decision may therefore be stated thus—"Do the words used by the defendant, namely, 'Startling Confessions' and 'Sensational Crime Confessions' so resemble the plaintiff's mark 'True Confessions,' or so clearly suggest the idea conveyed by it that their use is likely to cause dealers in or users of magazines to infer that the plaintiff assumed responsibility for their character or quality or place of origin?"

The two main submissions made by the plaintiff are that the defendant has no right to use the word "Confessions" as part of the title of its magazines; and that by the use of the word "Confessions" and the similarity of the "get-up" of the defendant's magazines to that of the plaintiff's, confusion is likely to occur. I shall consider the matters separately.

The plaintiff asserts that "Confessions" is the conspicuous part of its trade mark, that its magazines have come to be known as "Confessions" and that no other magazine publisher is entitled to use that word as part of the title of a magazine. It is established that the plaintiff has been active in asserting that claim and in the United States has successfully objected to the use of the word "Confessions"

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as part of the title of magazines in conjunction with the words "intimate," "thrilling," "real life," "real," "candid," and "secret." In Canada proceedings were taken in respect of the titles "Fireside Confessions," "Rare Confessions," "Romantic Confessions" and "Whispered Confessions," and, by consent, judgments were entered enjoining the use of the word "Confessions" in those titles and their registrations were expunged. Under threat of proceedings by the plaintiff, the publishers of "Personal Confessions," "True Life Confessions," "Rare Confessions," "Wordly Confessions" and "Private Confessions" agreed to discontinue the use of the words "Confession" and "Confessions" in their titles. In effect, the plaintiff claims a monopoly in the use of "Confessions" as applied to magazines.

Now, as I have said above, the trade mark "True Confessions" is not a "fancy" word but is *prima facie* descriptive. The plaintiff must therefore show that it has acquired a distinctive meaning amongst those who are purchasers of the goods in question within a definite area, and if the word still continues to be used and understood with its original and descriptive meaning by any considerable section of such persons, it cannot be monopolized: Kerly on Trade Marks, 6th Ed., 590. The principles of law applicable to a case where the plaintiffs are endeavouring to establish—as here—that their mark had become distinctive were summarized in the case of *Burberrys v. J. C. Cording & Co. Ltd.* (1), where Parker, J. said:

The principles of law applicable to a case of this sort are well known. On the one hand, apart from the law as to trade marks, no one can claim monopoly rights in the use of a word or name. On the other hand, no one is entitled by the use of any word or name, or indeed in any other way, to represent his goods as being the goods of another to that other's injury. If an injunction be granted restraining the use of a word or name, it is no doubt granted to protect property, but the property, to protect which it is granted, is not property in the word or name, but property in the trade or good-will which will be injured by its use. If the use of a word or name be restrained, it can only be on the ground that such use involves a misrepresentation, and that such misrepresentation has injured, or is calculated to injure another in his trade or business. If no case of deception by means of such misrepresentation can be proved, it is sufficient to prove the probability of such deception, and the Court will readily infer such probability if it be shown that the word or name has been adopted with any intention to deceive. In the absence of such intention, the degree of readiness with which the Court will infer the probability of deception must depend on the circumstances of each particular case, including the nature of the word or name, the use of which

(1) (1909) 26 R.P.C. 693 at 701.

is sought to be restrained. It is important for this purpose to consider whether the word or name is prima facie in the nature of a fancy word or name, or whether it is prima facie descriptive of the article in respect of which it is used. It is also important for the same purpose to consider its history, the nature of its use by the person who seeks the injunction, and the extent to which it is or has been used by others. If the word or name is prima facie descriptive or be in general use, the difficulty of establishing the probability of deception is greatly increased. Again, if the person who seeks the injunction has not used the word or name simply for the purpose of distinguishing his own goods from the goods of others, but primarily for the purpose of denoting or describing the particular kind of article to which he has applied it, and only secondarily, if at all, for the purposes of distinguishing his own goods, it will be more difficult for him to establish the probability of deception. But whatever be the nature of history of the word or name, in whatever way it has been used, either by the person seeking the injunction or by others, it is necessary, where there has been no actual deception, to establish at least a reasonable probability of deception. In such cases the action is, in effect, a quia timet action, and unless such reasonable probability be established, the proper course is, in my opinion, to refuse an injunction, leaving the plaintiff to his remedy if cases of actual deception afterwards occur.

I can find nothing in the evidence which establishes that there has been any actual deception or confusion. Birk, a witness called by the plaintiff, is the Manager of E. H. O'Brien News Company of Hamilton and has been distributing "True Confessions" for about twelve years to two hundred and forty retailers. His firm also distributed the magazines of the defendant. While stating that from personal observation he knew that the magazines of both the plaintiff and defendant were sold from the same rack, he gave no evidence as to actual confusion having arisen or as to the probability that such might arise.

R. F. Hendry, a clerk in his father's cigar store and newsstand in Toronto, stated that his firm sold "True Confessions" and "Startling Confessions," as well as "Vivid Confessions" and "Unusual Confessions." He said that he knew that when a customer asked for "Confessions" magazine he knew that "True Confessions" was meant, but that "If I were busy or in a hurry I probably would not ask them and they might get another copy and hand it back to me and say that was not what they wanted, that they wanted 'True Confessions'." This evidence is not helpful to the plaintiff as Hendry did not say that the defendant's magazines were the ones he handed in error to the customer; they were not identified in any way. Inasmuch as Hendry states that he knew that "Confessions" meant

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"True Confessions," there was no confusion on his part and the handing over of the wrong magazine was merely an error caused, as he says, "by my being busy." It does establish, however, that the purchaser of the magazine knew exactly what was wanted—namely, "True Confessions," and could immediately distinguish it from the other "Confession" magazine received in error. I cannot accept this statement of Hendry as in any way establishing actual or probable confusion between the plaintiff's and defendant's magazines.

Mr. D. Fleishman, a tobacconist and newsstand proprietor in Toronto, has sold "True Confessions" for fifteen years. He says that customers occasionally referred to it as "Confessions" and that he would re-order it by that name. He has also sold many other magazines, the titles of which included the word "Confessions" such as the defendant's, and "Daring," "Candid" and "Vivid." His only evidence as to confusion was put in this way, "A person would come in, buying for someone else, or a child, and would ask for 'Confessions' magazine, you see, and they would—sometimes they would ask and sometimes they would pick it up themselves, and they would come back and say, 'That is not the correct one.'" Again, that evidence is not helpful to the plaintiff. It does not indicate what magazine was intended to be purchased or what was delivered. Neither the magazine of the plaintiff or the defendant is in any way identified with that confusion. It is to be noted further that the error arose only on occasions when the purchase was being made by a child or by a person buying for someone else, in both of which cases errors would be most likely to occur.

R. Sinnott, a witness called by the plaintiff, is Manager of Sinnott News Company at Toronto and has been with that firm for twenty-nine years. It is engaged in the wholesale distribution of magazines. It has twenty-eight hundred retail outlets in Ontario and since 1937 has distributed "True Confessions," at times as many as sixteen thousand per month. He says that on occasions his firm would be asked by dealers for "Confessions" and as he handled only "True Confessions," he understood the order to mean "True Confessions." He frequently visits his outlets and has seen there the defendant's magazines and

also "Daring Confessions." He has never heard of any actual confusion resulting from the contemporaneous sale of the magazines of the plaintiff and defendant.

James Burgin is the proprietor of a cigar and magazine store in Toronto. For twelve years he has sold "True Confessions" and for some time has sold six or seven other magazines the titles of which include the word "Confessions," such as the defendant's, and "Vivid" and "Candid." He says that at first there was confusion when the new "Confession" magazines came out and described it as follows:

You see, there was a short period when there were no "Confession" books, not even "True Confessions"; and then when these others came out, the women saw them, the "Confession" books, and they said, "Oh, here is 'Confessions' back," and they would buy them. But they only did that maybe two or three times and then they stopped, because I have had it said to me that the quality of these other "Confession" books printed here was so poor they would not bother with them.

This evidence is scarcely sufficient to establish any actual confusion and does not purport to identify the defendant's magazines as the ones purchased.

The defendant called several witnesses selling the magazines of both plaintiff and defendant and all agreed that there had been no confusion of any sort. None of the witnesses—either those of the defendant or the plaintiff—ventured to say that the defendant's titles could reasonably be mistaken for the plaintiff's title.

As I have noted, the plaintiff submits that the mark "True Confessions" has acquired a secondary and distinctive meaning. It is well settled that there are words which have a direct relation to the character or quality of goods which nevertheless may lose their primary meaning and acquire in a particular trade a secondary meaning as indicating to people interested, whether as traders or as the public in the trade, the goods of the particular manufacturer; *Application of J. & P. Coats Ltd. for the Registration of "Sheen"* (1). The difficulty of establishing that such a secondary meaning has been acquired in such a case is pointed out in *Cellular Clothing Co. Ltd. v. Maxton & Murray* (2), where at p. 343 Lord Davey said:

But there are two observations which must be made: one is that a man who takes upon himself to prove that words, which are merely descriptive or expressive of the quality of the goods, have acquired the

(1) (1936) 53 R.P.C. 355 at 384. (2) (1899) A.C. 326.

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secondary sense to which I have referred, assumes a much greater burden—and, indeed, a burden which it is not impossible, but at the same time extremely difficult, to discharge—a much greater burden than that of a man who undertakes to prove the same thing of a word not significant and not descriptive, but what has been compendiously called a “fancy” word.

It is well established that the plaintiff’s magazine was well known and widely circulated. Its predecessor was the first to use the words “True Confessions” as the name of a monthly magazine. It has been published continuously in the United States since 1922 and its sales have increased from a monthly average of 60,000 in 1925 to over 2,000,000 in 1945, and to 1,680,000 in 1947. The plaintiff’s gross income from the magazine in 1946 was in excess of three and one-third million dollars. It was widely advertised in American publications and over the radio.

The circulation in Canada has not been continuous. It commenced in March, 1932, and continued to January, 1933, the last issue having a circulation of about 21,000 copies. Distribution in Canada was then discontinued until 1937 (in which year the average monthly circulation was 33,400) and continued from that year until January, 1941, in which month the circulation was 62,426. At that time the importation of the “Confessions” type of magazine into Canada was barred on account of wartime conditions. In 1944 circulation was resumed in Canada and increased from a monthly average in that year of 21,115 to 74,349 in 1947. About the beginning of 1948, due to Canadian Foreign Exchange Regulations, the distribution in Canada had to be dropped. Later in that year arrangements were made to print a Canadian edition and distribution was thereupon resumed.

Sales in Canada were made almost entirely from newsstands. Until production commenced here in 1948 the magazine was consigned by the plaintiff company to its Canadian distributors who in turn distributed it to the various newsstands in the district. There are approximately 9,700 retailers in Canada alone and the evidence clearly indicates that the magazine was sold in Canada from coast to coast. In the city of Toronto alone there are approximately 1,200 retailers selling the magazine.

I have examined carefully the evidence of all the witnesses on this point. Dacks, a defence witness who operates

a magazine and tobacco shop in Toronto said, "I know it (True Confessions) is a Fawcett publication. I was not sure before whether Fawcett published it or not, but I know now. I never worried who published the magazines. They are delivered to us and we sell them."

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That evidence is not helpful to the plaintiff on this point. So far as I can recall the only witness who gave any evidence relating to this matter was A. M. Adams, the Circulation Manager of the plaintiff and in its employment since 1934. In the period 1937 to 1938, he was District Manager for the plaintiff, supervising circulation of its products in eleven western states and the four western Canadian provinces. In answer to the somewhat leading question, "To your knowledge during the years you came to Canada, was 'True Confessions' known in the trade as the publication of your company?" he answered:

"True Confessions" was synonymous with Fawcett Publications during the time I worked for the company in Canada

That statement, made by an executive of the plaintiff company and entirely unsupported by any other evidence, is totally inadequate to establish that the word mark "True Confessions" had through use in Canada acquired a secondary and distinctive meaning. That witness could speak only for himself, and being then and still an employee of the plaintiff, would, of course, know that the magazine "True Confessions" was one of its products. No doubt all the distributors in Canada who received their goods direct from the plaintiff also knew that the plaintiff was the publisher of the magazine. But mere knowledge of that fact does not in any way indicate that the word as used had become distinctive of the plaintiff's goods; *Channell Co. v. Rombough* (1). My impression at the trial was that most of the retailers were like the witness Dacks and did not concern themselves in any way with the publisher of the magazine. Their dealings were entirely with local distributors, each of whom handled a great variety of magazines and determined what should be supplied to the retailer. There is no evidence whatever that purchasers of the magazine had at any time asked for it as a product of the plaintiff company.

In *Mathieson v. Sir Isaac Pitman & Sons Ltd.* (2), action was brought to restrain the defendants from selling or

(1) (1924) S.C.R. 604.

(2) (1930) 47 R.P.C. 541.

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offering for sale two books which they had recently put upon the market, entitled "How to appeal against your rates within the Metropolis;" and "How to appeal against your rates outside the Metropolis," as being books offered for sale under titles likely to be confused with two books published by the plaintiff entitled "How to appeal against your rates in the Metropolis," and "How to appeal against your rates outside the Metropolis." In that case Maugham, J. said at p. 550:

It is often said that in cases of this kind you have to consider whether the descriptive words under which the goods are sold have acquired a secondary or a special meaning. In connection with the title of a book, that means this: does the title used indicate to the minds of the public the specific work in question in connection with the author of it, or it may be in some rare cases in connection with the publisher of it? For instance, taking such a work as we have to deal with here: if we are going to use the words "secondary meaning" in connection with a book published for all these years by the Plaintiff on "How to appeal against your rates," that secondary meaning is not proved by saying that anybody who asked "How to appeal against your rates" before January of the present year must mean, if he knows anything about the work, the book written by Mr. Lawrie. That does not show a secondary meaning. The secondary meaning in this connection must connote that in the market, where such books are purchased and among the members of the public who are buyers of these books, the mere title "How to appeal against your rates" indicated the work of Mr. Andrew Douglas Lawrie, and perhaps further indicated that it was published by Effingham Wilson; and unless that can be established as a fact, it seems to me that the case of the Plaintiff must fail.

In *International Press Ltd. v. Tunnell* (1), Rowell, C.J.O., when considering a similar matter, after referring to the cases which I have cited and other cases, said at p. 417:

In all these cases there was evidence of some confusion in the minds of the public, growing out of the use of the same descriptive name by two different producers of similar articles, and in some of them there was a great deal of evidence to show that by long advertising and publicity the name of the article had become associated with the name of the firm manufacturing it, but, notwithstanding this evidence, it was held in all these cases that the words being descriptive words had not acquired a secondary meaning. The very heavy onus referred to in the Reddaway case had not been discharged.

The evidence submitted does not in my opinion establish that either "True Confessions" or "Confessions" have in Canada acquired a secondary and distinctive meaning.

It is of interest to note that in *Fawcett Publications, Inc. v. Bronze Publications, Inc., et al.* (2), the Court

(1) (1938) 1 D.L.R. 393.

(2) (1949) 81 U.S.P.Q. 175 and 519.

of Appeal, 5th Circuit, held that "Confessions" is a mere descriptive or generic term, that the trade mark "True Confessions" for monthly magazines did not contemplate or grant exclusive right to the use of "Confessions," there being no deception or fraud of the public shown, and that "Confessions" does not have a secondary meaning identifying only the publication "True Confessions."

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I turn now to the "get-up" of the magazines, it being alleged that the defendant has imitated that of the plaintiff. Exhibit 26 is the issue of "True Confessions" for November, 1947, and it is admitted that it is typical of the plaintiff's magazine. The evidence is directed only to the alleged similarity of the front cover and the back-spine. It is pointed out that on the front cover there appears "a pretty girl," that the price is prominently displayed, that there are cover blurbs indicating the nature of the leading articles, that the background is of a solid colour and that, while the whole title is "True Confessions," the second part, "Confessions," extends throughout the whole width of the cover. The backspine has the full name of the magazine, date of issue and the price, the obvious purpose being to give an intending purchaser this information when the magazine is in stacks and the backspine only in view. "Startling Confessions" (Exhibit 19) includes all these features except that the price (fifteen cents) is in the upper right corner, whereas in "True Confessions" the price (ten cents) is more central and at the left. The word "Startling," while prominently displayed in the title, is in somewhat smaller type than "Confessions" and does not extend across the page.

"Sensational Crime Confessions" (Exhibit 23) also includes the features of "True Confessions" which I have mentioned, except for the fact that the pictures thereon are not in the category of "a pretty girl," and that on the issues of April and July the prominent word on the title is "Crime," above which is the word "Sensational," and below and in smaller print, the word "Confessions." On the other issue, that of January, 1946, the word "Confessions" is emphasized, but above it is the word "Sensational," and the word "Crime" is superimposed on the

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first two letters of "Confessions." The background colour used in both the defendant's magazines is different from that on Exhibit 26.

Now it is admitted that each of these features is common to the trade. But it is submitted that while there is no monopoly in the individual things, that they are so combined by the defendant as to pass off its magazine as those of the plaintiff. The plaintiff in that case must prove that the get-up has become associated with his goods, that its use by others is calculated to deceive. The fact that the peculiarities of get-up which are relied on by the plaintiff have become identified with and distinctive of its trade must be proved as in any other case of passing off. I find nothing in the evidence which would indicate that the combination of the features (all common to the trade) and as used by the plaintiff, had in Canada become distinctive of or identified with the plaintiff's trade. None of the Canadian witnesses referred to the matter of get-up in any way, and the only evidence given on this point was by two officials of the plaintiff company residing in the United States, and no part of their evidence on this point was directed to the situation in Canada.

One small matter has not previously been mentioned. It is pointed out that in "True Confessions" (Exhibit 26) the first letter of "Confessions" is in red (the rest being on a different colour) and that it is overlapped by the "T" of True. In "Startling Confessions" the "C" of Confessions is the same colour as the rest of the word but is much larger and overlaps the "T" of Startling above. It is not admitted that this feature of "True Confessions" is common to the trade but in the absence of any evidence that in Canada it has become distinctive of the plaintiff's goods, I must consider it to be a matter of no importance at all.

I have already said that there is no proof of actual confusion having arisen, nor do I think that the use of the defendant's titles with or without the get-up which I have described is calculated to deceive purchasers of the goods into believing that they are getting the plaintiff's goods. The evidence is that the plaintiff has always used the full title of "True Confessions" both on the magazine itself and in its very extensive advertising. All the magazines

are sold in newsstands where they may receive full cover display when space permits, or where at least the titles may be seen in whole or in part where space is more limited. Almost invariably the purchaser makes his own selection, and presumably being able to read, would not have the slightest difficulty in distinguishing "Startling Confessions" and "Sensational Crime Confessions" from "True Confessions." It is in evidence and is a matter of common knowledge that there are many magazines bearing titles which are in part composed of the same word; for example, journal, digest, sports, movie, film, police, western, detective and the like; and others conveying the same idea such as "Look," "See," "Glance." All of these are common English words descriptive of the contents of the magazines and the public has become accustomed to discriminate between them. The plaintiff has not proven that the defendant has passed off or attempted to pass off his magazines as those of the plaintiff, and I am quite unable to find that there is any likelihood of any confusion arising because of their contemporaneous use in the same area. While the publisher's name of the defendant's magazine does not appear on the cover, it appears on the contents page; all the advertisements there are of Canadian firms, those of the plaintiff being of American companies. The defendant's magazines are of different size, poorer paper and quite inferior print. It is impossible to say that on isolated occasions some slight confusion might not occur, but I think it extremely unlikely. If it should occur, it would be the result of the plaintiff having chosen for its title two common English words to describe the contents of the magazine. It is in evidence that the word "Confessions" has been used in Canada for many years as the title or part of the title of books, and since 1940 as part of the title of magazines.

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Reference may be made to *Office Cleaning Services, Ltd. v. Westminster Window and General Cleaners, Ltd.* (1). In that case the House of Lords held:

(1) That the differentiation between the two names ('Office Cleaning Services, Ltd.,' and 'Office Cleaning Association') was sufficient to avert any confusion which might otherwise arise from the use of two ordinary descriptive words, "office cleaning."

(2) That where a trader adopts a trade name containing words in common use, some risk of confusion may be inevitable, but that risk

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must be run unless the first trader is allowed an unfair monopoly, and in such cases the Court will accept comparatively small differences as sufficient to avert confusion.

In that case Lord Simonds, after pointing out that there was a close analogy between trade names and trade marks, said at p. 43:

So long as descriptive words are used by two traders as part of their respective trade names, it is possible that some members of the public will be confused whatever the differentiating words may be. I am ready to believe that in this case genuine mistakes were made. I think they ought not to have been made. In the *Vacuum Cleaner* case it appeared that ninety per cent of its customers had addressed the Plaintiffs, the *British Vacuum Cleaner Coy., Ltd.* as the "*Vacuum Cleaner Coy.*" In spite of this fact and of instances of actual confusion Parker J. refused to grant an injunction to restrain the *New Vacuum Cleaner Coy., Ltd.* from using the words "vacuum cleaner" in conjunction as part of its registered or other name. So in *Turton v. Turton* (42 Ch D 128) the possibility of blunders by the public was held not to disentitle the defendant from trading in his own name though the plaintiff had long traded in the same name. It comes in the end, I think, to no more than this, that where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The Court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered.

The plaintiff has not shown any fraud on the part of the defendant or that he in any way intended to pass off his goods as those of the plaintiff. On the whole of the evidence I must find that the titles of the defendant's magazines are not "similar" to that of the plaintiff within the meaning of that word as defined in section 2(k) of the Act, and the claim of passing off must also fail.

In the result the plaintiff's action will be dismissed with costs.

As I have intimated above, the plaintiff launched a motion asking the Court, in the event that its registered mark was expunged from the Register (as has been done), for a declaration under section 29 of the Act that:

The said word mark "True Confessions" has been so used by it as to become generally recognized by dealers in and/or users of the class of wares in association with which the said word mark has been used, as indicating that Fawcett Publications Incorporated assumes responsibility for their character or quality throughout Canada, and that the said registration should extend to the whole of Canada.

The plaintiff relies not only on the evidence given at the trial but on twelve affidavits filed on this motion. These

affidavits are made by individuals from all provinces in Canada except Newfoundland, and in every case the affiant is or has been associated with a firm which distributes or did distribute "True Confessions."

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It was agreed by counsel for both parties that on this motion all the relevant evidence given on the main issues, as well as the affidavits filed on the motion, should be considered.

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As stated above, I find nothing in the evidence on the main issue which would establish that the trade mark of the plaintiff had in Canada acquired a secondary and distinctive meaning. My consideration must therefore be directed to the affidavits now filed.

The application is made under the provisions of section 29(1) which is as follows:

29. (1) Notwithstanding that a trade mark is not registrable under any other provision of this Act it may be registered if, in any action or proceeding in the Exchequer Court of Canada, the court by its judgment declares that it has been proved to its satisfaction that the mark has been so used by any person as to have become generally recognized by dealers in and/or users of the class of wares in association with which it has been used, as indicating that such person assumes responsibility for their character or quality, for the conditions under which or the class of person by whom they have been produced or for their place of origin.

One of the most recent cases in our Courts where the provisions of section 29 have been considered is that of *Registrar of Trade Marks v. G. A. Hardie & Co. Ltd.* (1). In that case it was held by a majority of the Court that the word "Super-weave" was a laudatory epithet of such common and ordinary usage that it could never become "adapted to distinguish" within section 2(m) of the Act. Rand, J., referring to the provisions of section 29, said at p. 493.

But the proof required by the section is both the fact that the mark has become adapted to distinguish certain goods from other goods of the same class as required by the definition and that the owner of it has become generally known as assuring quality or character, etc.

In referring to the expression, "has become adapted to distinguish," as found in the definition of a trade mark in section 2(m) of the Act, he said at p. 492:

The expression "has become adapted to distinguish" includes then any case in which the word mark has in fact become the identifying badge of the article to which it is attached; that when it is presented to the mind associated with goods of a particular trade, whatever primary meaning it

(1) (1949) S.C.R. 483.

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may have had is submerged, and only the trade designation remains: J. & P. Coats, Ltd., (1935) 53 R.P.C. 355. If, therefore, a word is used which describes or imports characteristics or qualities of goods, that connotation must have so disappeared before it can be said to have become so adapted; and when it is proposed to withdraw an ordinary word from the common use the task of establishing that exclusive secondary meaning becomes greater according to the extent of that use.

In considering the evidence submitted in regard to the word "Super-weave," he said further, at p. 493:

What, then, is the evidence of these matters offered to the Court? There are eight affidavits by customers of the applicant who are familiar with the wares and who say, incorporating the language of the section, that in effect "Super-Weave" means to them the goods of the applicant. There is also evidence of considerable advertising over the period of its use. What is asked for is the monopoly of this mark throughout the Dominion. The purchasers generally are laundries, dry cleaners, linen suppliers, hotels, hospitals and other institutions; but that the exclusiveness of the identifying sense of the word is in fact present to the minds of the customers, apart from that part of the trade which has not spoken, is by no means made out; and much less has it been shown to be recognized "generally" by Canadian dealers as attaching responsibility to the owner. Obviously, to customers purchasing these goods over some years the word would be associated with their origin; but that is short of the identification with the goods in which the descriptive sense of the word has disappeared. Neither that nor the general recognition required has, in my opinion, been made out and the application fails.

All but one of the twelve affidavits filed by the plaintiff include the following paragraph, or words to the same effect:

That the name and title "True Confessions" indicates to me a magazine or publication of the romance story type written in the first person and published by said Fawcett Publications, Inc., and has no other meaning to me.

These statements it seems to me are most significant, indicating as they do that even to the distributors of the magazine (who, as such, have a direct contact with the publishers), the title of the magazine has not lost the descriptive sense in which it was first used to indicate the main contents of the magazines. They are all in agreement as to that. The original connotation has not disappeared but still remains and, as pointed out by Rand, J. in the "*Super-Weave*" case (*supra*), it cannot therefore be said to have become "adapted to distinguish."

The fact that in all these affidavits the affiants have stated that the title also means to them a product of the plaintiff falls far short of establishing that the word has become recognized "generally" by Canadian dealers as

attaching responsibility to the owners. There are thousands of retailers throughout Canada selling the plaintiff's magazine and not one of them has stated that the word to him indicated merely the goods of the plaintiff.

The defendant, on the other hand, has filed affidavits in opposition to the motion. Marie Crawford of Victoria Harbour, Ontario, a waitress, has for many years been reading women's magazines, particularly those which contain romantic stories. She says, "The title 'True Confessions' describes the kind of stories which are published in that magazine. Most of them are written in the first person singular and describe romantic experiences which are usually of a sinful or wrongful kind. The stories are written in a way which makes the reader think that the writer is admitting her sin and is telling her story as a warning to others."

Irving Lederman of Toronto, the proprietor of a book and cigar store, has been selling popular magazines for about four years. He says that the magazine contains stories which sound like confessions and which seem to be true, although he is unable to state whether they are, in fact, true or not. Margaret Gonneau of Toronto, has for many years been a reader of romantic type stories, including "True Confessions," as well as other magazines bearing the word "Confessions" as part of their title. She says that the title "True Confessions" has always seemed to her to describe a type of magazine in the same way as the word "Digest"; that the stories in "True Confessions" are mostly confessions and are written as though they are true and that they relate to romantic experiences. Gloria M. Dawkins, of Unionville, Ontario, has been reading different confession magazines for over ten years, including "True Confessions." She states that to her the title "True Confessions" describes the kind of story which is published in the magazine. Harry Krauss, the manager of a drug-store in Toronto, has for many years been engaged in selling magazines, including "True Confessions," as well as many other magazines using the word "Confession" as part of the title. He believes that such magazines contain stories which sound like "confessions" and seem to be true, although he does not know whether, in fact, they are true. Keith Elliot Sinclair of Toronto has been connected with

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the distribution of popular magazines. He states that for many years he has been familiar with the magazine "True Confessions" and also has known a good many other magazines using the word "Confessions" as part of their title, published in Canada since 1939. He states that to him "True Confessions" describes the magazine in the same way that "Home Journal" describes "Ladies' Home Journal" and "Canadian Home Journal."

In my opinion, the evidence adduced is quite insufficient to warrant the declaration asked for by the plaintiff. The motion will therefore be dismissed with costs to be taxed as hereinafter provided.

In view of the consolidation of this matter with that of *Fawcett v. Pastime* and that at the hearing the same counsel appeared for both defendants, I think it necessary to give special directions as to the taxation of the defendant's costs.

The defendant's costs up to and including the issue of the order for consolidation will be taxed on the usual scale.

All subsequent costs of the trial and the motion made under section 29, up to but not including the entry of judgment, will be taxed in the usual way, but only one-half thereof and of the costs now fixed will be allowed to the defendant in this matter, except as hereinafter provided. Included therein will be (a) the costs of the motion made by the plaintiff for leave to use affidavit evidence on the main issue, which motion was dismissed with costs and which I now fix at \$20; (b) the costs of the plaintiff's motion to use affidavit evidence on the hearing of the motion under section 29, which motion was granted, and the costs of which will be taxed by the taxing officer.

The defendant herein will be entitled to the full costs of a further motion made by the plaintiff for leave to amend its statement of claim in this matter only, the costs of which, by consent, were to be to the defendant in the cause. I fix these costs, including the consequent amendment of the statement of defence, at \$25.

The defendant is also entitled to his full costs for the entry of this judgment.

Judgment accordingly.