

IN THE MATTER OF THE PETITION OF }
 THE PACIFIC LIME COMPANY, } PETITIONER.
 LIMITED..... }

1920
 Nov. 25.
 Argument of
 Counsel.

Trade-Mark—Geographical name—Secondary signification—Registration.

Held; That a geographical name is not ordinarily the subject of a trade-mark and is not *per se* registerable; but when by long user thereof the name has acquired a secondary signification in derogation of its primary geographical meaning and has become the trade designation of a manufactured article, such a name may be registered.

APPLICATION by petitioners herein to have the words "Blubber Bay Lime" registered as their trade-mark.

November 16th, 1920.

Application before the Honourable Mr. Justice Audette at Ottawa.

L. P. Sherwood, for petitioners.

No one appeared for Commissioner of Patents.

L. P. Sherwood: I would refer to section 5 and part of section 11 of the Trade-Mark and Design Act (ch. 71 R.S.C. 1906).

The Act contains no precise definition of a trade-mark, but it is to be remarked that section 5 states that names may be "considered and known as trade-marks." Section 11 (e) "the essentials necessary to constitute a trade-mark properly speaking," it is submitted, must mean the essentials of a Common Law trade-mark as modified by the Canadian Trade-Mark Act.

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The various English Acts have little or no bearing upon the Canadian Act. See *New York Herald Co. v. Ottawa Citizen Co.* (1).

In the United States a large proportion of trade-marks granted consist of surnames of manufacturers or producers, but geographical names have also been registered, as, for instance, "Winchester" for rifles, and "Yale" for locks.

The law in regard to names is understood to be that whilst they are not primarily the subject of a trade-mark, they may nevertheless by use in connection with the goods of a certain individual, acquire a secondary meaning as a trade-mark, and may be registerable under the Canadian Trade-Mark Act. See *Hortlick's Malted Milk Company case*, decided in the Supreme Court, 1st May, 1917 (2); *Canada Foundry Company v. The Bucyrus Company* (3); See also English cases, *Wetherspoon v. Currie*, *The Glenfield Starch case* (4), and particularly the remark of Lord Westbury at p. 251. See also *Seixo v. Provezende* (5), and *In re National Starch Company's application* (6), for registration of word "Oswego."

I submit that the case of *Grand Hotel Company, of Caledonia Mineral Springs v. Wilson and others* (7), can be distinguished and does not adversely affect the present application (See particularly Lord Davey at p. 113).

In the present application, the evidence which is submitted, shows that the words "Blubber Bay Lime" have acquired a secondary meaning as distinguishing the product of the Pacific Lime Company, and as

(1) 41 S.C.R., 229 at p. 232.

(4) 5 H. of L. (E. & I. App.) 508.

(2) 35 D.L.R. 516.

(5) [1865] 14 L.T. (N.S.) p. 314.

(3) [1912] 47 S.C.R. 484.

(6) [1908] 2 Ch. D. 698.

(7) [1904] A.C. 103.

such, in accordance with the authorities referred to, the words have become a trade-mark which is properly registerable. Furthermore, the words are not in use as a distinguishing feature or as a trade-mark by any other individual, firm or corporation in connection with the sale of lime.

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It is submitted therefore, that the applicants are entitled to have registered in their name as a trade-mark the words "Blubber Bay Lime" for the reason that the evidence shows these words to have acquired a secondary meaning as a trade-mark distinguishing the product of the applicants, and that the evidence shows that the words are not in use by any other person.

The facts are stated in the reasons for judgment.

AUDETTE J. now (November 25, 1920) delivered judgment.

This is an application, by the petitioners, who carry on the business of manufacturers or producers of lime, to register as their trade-mark the words "Blubber Bay Lime."

Blubber Bay is a small place situate in the electoral district of Comox-Alberni, in the province of British Columbia.

Therefore, it appears that the word "Blubber Bay" is, in its ordinary signification, a geographical name, and, *per se*, is not subject to registration as a trade-mark. (*Columbia Mill Co. v. Alcorn* (1).

The Canadian Act does not contain a definition of trade-marks capable of registration. To find what trade-marks in Canada are subject to registration, one must read together sections 5 and 11 of the Act.

(1) 150 U.S. 460.

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Section 5 provides what may be the subject of a trade-mark, but that section must also be read with the provisions of sec. 11 whereby, among other things, it is set out what the minister may refuse to register. Sub-section (c) of that section reads as follows:—
“(c) if the so-called trade-mark does not contain the essentials necessary to constitute a trade-mark, properly speaking.”

And as said in the *Standard Ideal Co. v. Standard Sanitary Co.* (1): “the Act does not define or explain the essentials of a trade-mark, it does not provide for taking off the register an alleged trade-mark which does not contain the requisite essentials. In applying the Act the Courts in Canada appear to consider themselves bound or guided mainly by the English law of trade-marks and the decisions of the courts of the United Kingdom.”

By sub-sections 4 and 5 of section 9 of the English Act of 1905, it is provided that a geographical name cannot be registered as a trade-mark, unless upon an order of the Board of Trade, or the Court.

The words “Blubber Bay Lime” standing by themselves may not, strictly speaking, have reference to the character or quality of the lime as derived from the strata of the stone or the formation of the soil; but will not the registration of these words preclude any other resident of Blubber Bay, who might choose to manufacture lime, to use that name? Nothing could prevent him from manufacturing lime, if he so saw fit. Would not also that mark appear to be generic, in its very nature? Does it not convey the idea that Blubber Bay lime is the product of one individual residing at Blubber Bay, while it may also designate

(1) [1911] A. C. 78.

the product of many hundred manufacturers or residents of Blubber Bay, to whom the trade-mark sought to be registered would equally apply? Would not the mark, in such a case, cease to be distinctive and therefore become objectionable?

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Wood, V. C., in the *Anatolia liquorice case* (*McAndrew v. Bassett* (1)) said that: "the plaintiffs had established beyond all doubt the connection of their name with that mark, that was beyond dispute," and that "he could not treat the word as being otherwise than a designation mark, which the plaintiff had caused to be attached to that particular article of liquorice which they so manufactured, and which they had a right to consider, in that qualified sense, property."

See Sebastian, 5th Ed. at p. 87. (Abstract recited.)

Lord Westbury, C., in that case strongly confirmed the opinion of the Vice-Chancellor; and in the later case of *Wetherspoon v. Currie* (2), where the subject of the dispute was the word "Glenfield," applied to starch, he stated that the word had acquired a secondary signification or meaning in connection with a particular manufacture; in short, it had become the trade designation of the starch made by the appellants. It was wholly taken out of its ordinary meaning, and in connection with the starch had acquired that peculiar secondary signification to which he had referred. The word "Glenfield," therefore, as a denomination of starch, had become the property of the appellants. It was their right and title in connection with the starch.

(1) 33 L.J., Ch. 561; 4 DeG.J. & S. (2) 5 H. of L. (E. & I. App.) 508. 380 (App.).

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In view of the liberal modifications in previous jurisprudence, together with the legislation, introduced by sub-sec. 5 of section 9 of the English Trade-Mark Act of 1905, and the decision above referred to,— would it not be attaching an excessive regard to the geographical aspect of this mark to refuse its registration?

The American law upon the present subject would appear to be the same.

See Paul, on *Trade-Marks*, pp. 101 to 104 inclusively, and pp. 434 et seq. (Abstracts from these pages were here given at length.)

At p. 103 he states that geographical names, designating districts of country are incapable of appropriation as trade-mark and concludes by saying (p. 104) that one must avoid, in selecting devices for trade-mark, “geographical names which are descriptive of the local origin of the goods, if other persons have the right to deal in goods of a similar origin.”

The words “Blubber Bay Lime” may not suggest to ordinary observers a geographical origin and may, therefore, remain special and distinctive. *In re Magnolia Metal Company* (1). The user of these words for the period mentioned in connection with the lime manufactured or sold by the petitioners has given such words a secondary signification in derogation of their primary geographical meaning and has become the trade designation of the lime manufactured by them.

It would appear that if a word is strictly geographical according to its ordinary signification, that, where it is not calculated or likely to deceive, it may still be registered in a proper case by the leave of the court.

(1) [1897] 2, Ch. Div. 371.

In re Appollinaris Brunnen (1); *In re The National Starch Co.* (2); and *In re California Fig Sirup Co.* (3); *The Stone Ale case* (*Montgomery v. Thompson*) (4); *The Bucyrus Company* (5).

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It appears from the allegations of par. 5 of the petition that the application for registration made to, and refused by, the Minister of Trade and Commerce, was for a *general* trade-mark. It is obvious that the petitioners are applying for the registration of this trade-mark for the use of the same in connection with the sale of a class merchandise of a particular description,—namely, lime. In such a case they are not entitled to a general, but only to a specific trade-mark.

Therefore, I have come to the conclusion, under the circumstances of the present case, but not without some hesitation,—after considering the *de facto* distinctiveness arising from fairly long and exclusive user in the past,—although the words are originally geographical,—to allow the registration of the same as a *specific trade-mark* to be used in connection with the sale or manufacture of lime or of that class of merchandise coming within that particular description.

The granting of an order for the registration of this trade-mark does not conclude the validity of the trade-mark, should an action be hereafter brought contesting it. It amounts to no more than a *prima facie* decision, open to being varied or set aside upon evidence produced by opponents. *In re Crosfield* (6); *In re Akt. Hjorth* (7). *In re Christie* (8) the present

(1) 24 R.P.C. 436.

(2) 25 R.P.C. 802. & [1908]
 2, Ch. D. 698.

(3) 26 R.P.C. 846.

(4) 1891 A.C. 217.

(5) 14 Ex. C.R. 35, 47, S.C.R. 484.

(6) 26 R.P.C. 561, 837.

(7) 27 R.P.C. 461.

(8) 20 Ex. C.R. 119.

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decree does not declare that the mark ought to be registered because it is a good mark but merely allows and permits its registration under the circumstances of the case. Such order, it would seem, ought to be decreed when there is a sufficient *prima facie* case made out establishing a reasonably long user of the trade-mark. Sebastian, 5th Ed., p. 370.

Judgment accordingly.
