

1932
May 5
June 1.

CONTINENTAL OIL COMPANY.....PETITIONER;
 vs.
 CONSUMERS OIL COMPANY LIM- } RESPONDENT.
 ITED

Trade-mark—Expunging—Use by importer of exporter’s mark—Knowledge of name of proprietor of mark not necessary

Held that an importer of goods may have a mark of his own for use in the sale of such goods and disregard the exporter’s mark, but he cannot register or appropriate to himself the exporter’s mark, the mark of the producer of the goods which he imported, though he may use it in connection with such goods imported with such mark.

2. It is not necessary for the validity of a trade-mark that the public should know the name of the proprietor of a trade-mark, but that, in the public mind such mark meant a particular manufacture.

PETITION by petitioner herein to expunge two registered trade-marks “Conoco.”

The action was tried before the Honourable Mr. Justice Maclean, President of the Court, at Ottawa.

O. M. Biggar, K.C., and M. B. Gordon for petitioner.

R. S. Robertson, K.C., and L. Davis for respondent.

The facts material to the decision of the case are stated in the Reasons for Judgment.

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THE PRESIDENT, now (June 1, 1932), delivered the following judgment.

The petitioner seeks to expunge two registrations of the trade-mark "Conoco" registered by respondent's assignor, Consumers Oil Co., Ltd., the first registration being applicable to gasoline, the second, to petroleum and all petroleum products except gasoline; the first registration was made in February, 1930, and the second in May following. The respondent company is engaged in the sale and distribution of oils, gasoline, etc., for motor cars, in both a wholesale and retail way. The respondent claims that it commenced to sell motor gas and oil under the name of Conoco in the last days of December, 1929. The petitioner claims to have sold similar products in Canada under the same trade name some months prior to the date of the adoption of this word mark by the respondent.

The petitioner is a United States corporation, and is engaged in a very large way in the production of motor gas and oil for the domestic and many foreign markets. For many years prior to 1929 a company known as Continental Oil Company was engaged in the production and sale of motor gas, oil, etc., and such products were marketed under the name of Conoco; in 1929 this company was merged with another well known company in the United States, Marland Oil Company, which was engaged in the same class of business, and this company had been selling motor oil and gas in Canada. In the merger of these two companies, it would seem according to the evidence, that the procedure adopted in effecting the amalgamation was that Continental Oil Company was absorbed by Marland Oil Co., and then Marland Oil Company changed its name to Continental Oil Company, the petitioner in this case. I have no doubt that in the end any trade-marks owned by either company were assigned to the petitioner, though

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there is no evidence of this; at any rate the petitioner company continued the use of the word Conoco as a trade-mark, or part of a trade-mark. It is not really necessary however to consider the business activities of the petitioner prior to July, 1929.

In the last half of 1929, a corporation known as Visco Gas and Oil Co., Ltd., which I shall hereafter refer to as Visco, sold and distributed to customers, in Toronto and adjacent territory, motor oil purchased from the petitioner under the name of Conoco, and during the same period Visco also purchased gasoline from the petitioner, but apparently it sold this gas in 1929, as it might do, under the name of Visco; prior to July, 1929, Visco was a customer of Marland Oil Co. About one hundred drums of oil, of forty-five gallons each, were purchased by Visco from the petitioner in 1929, and these drums bore the word mark Conoco associated with a red triangle. Signs, standards, bulletin boards, some of which I think were provided by the petitioner, were used by Visco to advertise the sale by it of Conoco oil; it advertised the sale of Conoco oil in a Toronto paper; cabinets or metal boxes for holding bottles of oil were furnished by Visco to some of its customers and the name of Conoco was applied to the same. Trucks used by Visco for delivering oil also displayed the name of Conoco oil. At the Canadian National Exhibition held in Toronto in September, 1929, at the joint expense of the petitioner and Visco, both Conoco oil and gasoline were prominently advertised in many ways, though in fact neither was there sold, that is on the exhibition grounds. A United States hydroplane at this time visiting Toronto, in consequence of this display concerning Conoco gas and oil, purchased from Visco a quantity of Conoco gasoline, it having a supply on hand at one of its service stations in Toronto, and which was purchased from the plaintiff as Conoco gasoline. Apparently this sale of Conoco gasoline occurred because the person in charge of the hydroplane knew of Conoco gasoline in the United States. At St. Boniface, Manitoba, a Mr. McKay doing business under the name of McKay Oil Co., purchased and imported from the petitioner some fifty thousand gallons of gasoline and a quantity of motor oil, under the trade name of Conoco, and sold the same under that name, during the months of

July, August, September, October, and part of November, 1929, when McKay went out of business. When McKay commenced importing Conoco gas and oil the petitioner supplied him with globes which were attached to pumps connected with gasoline tanks, and these globes which bore the word Conoco were continuously displayed at McKay's service stations, and also, I think, by some customers of McKay. Standards and signs were erected, and printed matter, supplied I think by the petitioner, was distributed to make known the fact that McKay was selling Conoco motor gas and oil. Then what is known as decalcomanias, a form of adhesive label, displaying the name Conoco, in association with the figure of a triangle, were placed on oil containers which McKay used in making deliveries of oil. The application of a trade-mark to cabinets, containers, bottles, and on globes, drums, etc., is, I think, a sufficient compliance with the statute.

The following facts are clearly established. McKay sold both gas and oil under the name of Conoco for several months in 1929, at St. Boniface and Winnipeg, and this was purchased from the petitioner under that name. Visco sold motor oil under the name of Conoco, in Toronto, for several months in 1929, and this motor oil was purchased from the petitioner under that trade name. Visco made one sale of Conoco gasoline in September, 1929, and while by itself this might not be important, yet, I think it is important when considered along with other facts disclosed in the case. The petitioner assisted both Visco and McKay in identifying the name of Conoco, and putting it before the public, as a manufacture known by that name. The petitioner has continued since 1929, according to the evidence, the sale of motor gas and oil in Canada under the name of Conoco; this would indicate that there was no intention of abandoning the use of that trade-mark in the Canadian market. There is no assertion of claim by Visco or McKay, to the word mark Conoco, in fact their course of conduct would indicate that they were using the petitioner's mark to denote the petitioner's manufacture. By reasons of advertisements in standard trade journals, such as National Petroleum News, and otherwise, the petitioner's trade-mark Conoco must have become known to many, to dealers particularly, as the mark of the manufacturer of gas and oil

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sold under that name, but I do not rest my decision upon this point.

An importer may have a mark of his own, and disregard the exporter's mark—as Visco did for a time in respect of gasoline purchased from the petitioner,—but he cannot register or appropriate to himself the exporter's mark, the mark of the producer of the goods which he imported, though he may use it I assume in disposing of such goods imported with such mark. In the case of *European Blair Camera Co's Trade-Mark* (1), it was held that where a manufacturer abroad sold and sent goods bearing the words Bull's-eye, his trade-mark, to a person in England, the importation of such goods into that country, coupled with the circulation of certain pamphlets containing the words, was such a use of those words by the manufacturer as to prevent the importer setting up a claim to the exclusive use of them, although the words were only known to the public in connection with goods sold by the importer. And the registration of the words by the importer was ordered to be expunged; it seems to me that the grounds for removing the marks in question from the register are much stronger. It is not necessary that the public should know the name of the proprietor of the trade-mark. In *Powell v. Birmingham Vinegar Brewing Co.* (2), there was evidence that many purchasers of "Yorkshire Relish" knew nothing of the plaintiff, but in reference to this Lord Hershell said, "in the present case, it seems to me that 'Yorkshire Relish' means the manufacture of a particular person. I do not mean that in the minds of the public the name of the manufacturer was identified, but that it meant a particular manufacture and that when a person sold 'Yorkshire Relish' as the appellants did, by selling it as 'Yorkshire Relish' and calling it 'Yorkshire Relish,' they represented to the public that it was that manufacture which was known as and by the name of 'Yorkshire Relish.'" In the case before me, Visco and McKay, I think, represented that the goods which they sold under the name of Conoco was that manufacture which was known as and by the name of Conoco, and upon the evidence, I should say that the petitioner was acting in co-

(1) (1896) 13 R.P.C. 600.

(2) (1897) A.C. 710, at p. 715.

operation with such parties in the use in Canada of the name of that manufacture.

The respondent was not the first to use the mark Conoco in Canada. In such circumstances I do not think it is proper to permit the respondent to use the marks in question, because it is calculated to mislead the public, and the respondent's use of them would hardly fail to lead some people to mistake the goods of the respondent for that of the petitioner. Further, these marks are not properly on the register because they were in use in Canada prior to the time of the respondent's adoption of the marks, and in connection with the same commodities. Whoever is entitled to the registration of these words it is not the respondent.

I am of the opinion, therefore, that the trade-marks in question should be expunged from the register. The petitioner will have its costs of the proceeding.

Judgment accordingly.

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