
 BETWEEN:

J. V. BOUDRIAS FILS LIMITEE

PLAINTIFF;

AND

BOUDRIAS FRERES LIMITEE

DEFENDANT.

1933

 Dec. 15, 16,
20 & 21.

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Mar. 15.

Unfair Competition Act—Use of name or surname in connection with partnership or incorporated company—Conditions relating to use of name or surname.

Held: That s. 9 of the Unfair Competition Act, 22-23 Geo. V, c. 38, does not restrict an individual or a group of individuals to the use, as a trade name, of his or their personal names or surnames alone, thereby debaring him or them from adding any word or words thereto indicating a body corporate or a partnership.

2. That no man can be deprived of the right of using his name honestly in connection with his business.
3. That under s. 9, 22-23 Geo. V, c. 38, any individual or group of individuals may use his or their names or surnames in connection with his or their business, provided such business be commenced and carried on for his or their own direct benefit, in good faith and without any intention to deceive. Given these three conditions, confusion is immaterial.

ACTION by the plaintiff company under The Unfair Competition Act, 22-23 Geo. V, c. 38, asking for an injunction restraining the defendant company from using the name "Boudrias" as part of its corporate name and from selling any of its wares having the name "Boudrias" prominently exhibited thereon.

In 1896 one J. V. Boudrias started in business in the city of Montreal as a manufacturer of, and dealer in tea, coffee, extracts and spices, under his own name. In 1912 he organized a company called J. V. Boudrias Limitée, which took over the business and carried it on until 1920

when that company sold its assets to the plaintiff company, in which J. V. Boudrias held the controlling interest. In 1928 he sold this interest to one J. L. Freeman coven-
 anting with him not to carry on, directly or indirectly, for a period of five years, any business similar to that of the plaintiff company. J. V. Boudrias also assigned to plaintiff company his right, title and interest in all formulas, recipes and processes, controlled or used by him, relating to any products then or formerly manufactured by him or by the company, as well as his right, title and interest in any trade names, trade-marks or patents relating to any products being then manufactured by the company or formerly owned, controlled or manufactured by the assignor.

The five years having elapsed, J. V. Boudrias and his sons, in 1933, caused the defendant company to be incorporated and began to manufacture and sell tea, coffee, spices and extracts, distributing the same as "products of Boudrias Frères Limitée". The defendant company from the commencement of its operations carried on business in the premises formerly occupied by the plaintiff company. These premises were the property of J. V. Boudrias who had leased them to plaintiff company in 1928 for a term of five years, the lessee having the option of renewal for a further five-year term. J. V. Boudrias offered to renew the lease to plaintiff company at a rental fifty per cent lower than the one stipulated in the lease for its renewal, but plaintiff company vacated the premises.

The Court found that the defendant company had, since it started its operations, carried on business in good faith and without any intention to deceive; that as far as the plaintiff company is concerned, the name "Boudrias" had not acquired a secondary meaning and had not become identified with its goods.

The action was tried before the Honourable Mr. Justice Angers, at Montreal.

O. M. Biggar, K.C., and *R. Chenevert, K.C.*, for plaintiff.

H. Gerin-Lajoie, K.C., and *C. H. Macnaughten* for defendant.

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ANGERS J., now (March 15, 1934) delivered the following judgment:

[The learned Judge, stated the nature of the action and then continued.]

Before discussing the proof in relation to the facts posterior to the commencement by the defendant company of its operations, I believe it expedient to examine the law bearing upon the question at issue, viz., the right of J. V. Boudrias and his sons to use the surname "Boudrias" as part of a corporate name.

Counsel for plaintiff submitted that a cause of action in a case of this nature is established when it appears that the names of the two companies are sufficiently similar as to create a danger of confusion, even though the defendant had acted in good faith and without any intention of creating confusion. Counsel, in support of his contention, relies on section 7 and subsection (b) of section 11 of The Unfair Competition Act. Section 7 is in these terms:

7. No person shall knowingly adopt for use as the name under which he carries on business, or knowingly adopt for use in connection with any business, any trade name which at the time of his adoption thereof is the name, or is similar to the name, in use by any other person as the trade name of a business of the same general character carried on in Canada, or of such a business carried on elsewhere if its name is known in Canada by reason of the distribution therein of wares manufactured or handled by such person under such trade name, or of the advertisement of such wares in Canada in association with such trade name, in any printed publication circulated in the ordinary course among potential dealers in and/or users of similar wares in Canada.

Section 11 reads thus:

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 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.

Section 11 lays down the general rule forbidding acts of unfair competition in the course of business. I do not think it applies to the present case: the plaintiff in fact is merely seeking to restrain the defendant from using the word "Boudrias" as part of its corporate name and from selling its wares with the word "Boudrias" thereon.

The sections in the Act concerning trade names are sections 7, 8, 9 and 10.

Section 7 sets forth the principle that no one is entitled to knowingly adopt in connection with his business a trade name which, at the time of its adoption, is the name, or is similar to the name, in use by another person as the trade name of a business of the same character carried on in Canada, or elsewhere if such name is known in Canada.

Section 8 has no application herein: it stipulates that no person shall have the right to continue using in Canada a trade name which, when he adopted it, he knew was, or was similar to, the trade name of a business of the same character then being carried on in Canada, or elsewhere if its name was then known in Canada. This section deals with trade names adopted before the coming into force of the Unfair Competition Act.

Section 10 deals with the burden of proof and states that it is incumbent upon a person, who adopts a trade name similar to one already in use, to show that, at the time of his adoption thereof, he was in ignorance of the use of a similar trade name and that in adopting it he did so in good faith.

As already stated, section 7 states the general principle concerning the adoption and use of trade names; section 9 lays down an exception:

9. Nothing in the last two preceding sections shall affect the right of any individual or group of individuals to adopt for use and use his or their own personal names or surnames as a trade name for a business commenced and carried on for his or their own direct benefit in good faith and without any intention to deceive.

Counsel for plaintiff submitted that section 9 has no application in the present case, because the defendant's business is not carried on under a personal name or surname, or personal names or surnames, but under a corporate name including the words "Frères" and "Limitée"; now, as counsel says, nobody has a personal name of which the word "Frères" or the word "Limitée" forms part. If the second proposition does not admit of controversy, I must say that I do not agree with the first one. I do not think that section 9 must be so narrowly interpreted as to have it mean that an individual or a group of individuals are only entitled to the use, as a trade name, of his or their personal names or surnames alone and that he or they are

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debarred from adding any word or words thereto indicating a body corporate or a partnership, as, for instance, the words "Limitée", "et Compagnie", "et Frères" or "et Fils".

Assuming for a moment with counsel for plaintiff that the meaning of section 9 is that a group of individuals have the right to use their personal names or surnames, as a trade name, without any addition thereto, the result, in the present instance, would be that the Boudrias family could either use, for the purposes of their business, the surname "Boudrias" alone or a firm name composed of the names of all the partners, such as, for instance, "J. Victor Boudrias, Paul Boudrias, Adrien Boudrias, Girard Boudrias and—I suppose counsel for plaintiff would not want to ostracize this harmless conjunction—René Boudrias". Needless to say, the order of the names could be interverted. Firm names as "Boudrias père et fils", "Paul Boudrias et Frères", "Boudrias et Compagnie", to mention only a few examples, would not be permitted and these trade names would still be more objectionable if followed by the word "limitée", thereby indicating a corporation instead of a mere partnership. Why that should be is beyond my comprehension. It is indeed hard to conceive that the legislators ever intended to deprive a person from using his surname as part of a firm name or a corporate name, for the sole reason that another person, bearing the same surname or having acquired, as in the present case, a corporate name of which this surname forms part, is already using it in connection with his business. If section 9 is so rigidly drafted as to mean that an individual is deprived of the right of using his patronymic name in a firm name or corporate name simply because another individual or group of individuals has or have previously included the same patronymic name in a firm name or corporate name, assuming naturally that the only resemblance between the two trade names consists in the patronymic names and the words "Limited" or "Company", I think that the section ought to be amended. What I believe however the legislators' intention was, as I have already said, in adopting section 9, even though they did not say it very plainly, is that no one is to be deprived of using his personal name or surname as a trade name,

be this trade name a firm name or a corporate name, provided it be done for his own direct benefit in good faith and without intention to deceive; and the same remarks apply *mutatis mutandis*, to a group of individuals.

If the case does not come within the purview of section 9, for the reason that this section only applies to the use, as a trade name, of the name and surname of an individual or the names and surnames of a group of individuals, it must be governed by section 7. This section, as we have seen, prohibits the adoption of a trade name which is the name, or is similar to the name, in use by another person.

Subsection (k) of section 2 defines the word "Similar", as applying to trade names, as follows:

"Similar", in relation to . . . trade names . . . describes . . . names . . . 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.

I do not think that the name "Boudrias Frères Limitée" so closely resembles the name "J. V. Boudrias et Fils Limitée" as to come within the definition of said subsection (k); its adoption therefore would not be prohibited by section 7.

At all events I may repeat that I am of opinion that the adoption of the name "Boudrias Frères Limitée" by J. V. Boudrias and his sons was permissible under the provisions of section 9 and that the defendant company is entitled to use it, provided of course its business was commenced and is carried on in good faith, without intention to deceive and for the direct benefit of the Boudrias family.

Before dealing with the question of fact raised by this proviso, I deem it appropriate to examine as briefly as possible the authorities cited by counsel, bearing in mind that they are all decisions rendered under the common law and, with respect to the decisions of our own tribunals, anterior to the enactment of the Unfair Competition Act.

The first case upon which counsel for plaintiff relied is that of *F. W. Woolworth & Co. Ltd. v. Woolworths (Australia) Limited* (1). The facts were these. The plaintiff

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company was incorporated in Great Britain in 1909 with the object of carrying on a business for the sale of a large variety of inexpensive articles. It was promoted by an American company of the same name, which had had prior to 1909 a successful career. The defendant company, incorporated in 1929, was the buying agency of a company incorporated in Australia in 1924, under the name of Woolworths Limited, for the sale of articles of a similar class to the plaintiff company's goods and also of a certain quantity of articles at a higher price. There was no one bearing the name Woolworth connected with the defendant company or its parent company in Australia.

It was held

that the evidence had not shown that there had been up to the time of the action any real confusion; but that by the name "Woolworths" the Plaintiff Company was understood to be meant, not only among the general public, but also among traders and manufacturers; that the name Woolworths (Australasia) Ld. must suggest some connection with the Plaintiff Company; that the Defendant Company's name so nearly resembled the name of the Plaintiff Company as to be calculated to deceive.

Judgment was given for the plaintiff and an injunction granted.

The Woolworth case differs from the present one, in that there was no one with the name Woolworth connected with the defendant company and that the latter had accordingly no particular reason to adopt this name.

The next case to which my attention was drawn on behalf of plaintiff is the case of *J. H. Coles Proprietary Ltd. (in liquidation) v. Need* (1).

Lord Wright (at page 386) says:

It may be noted that both the Chief Justice and the Full Court of Victoria proceeded on the basis that the Appellant's trade names had not lost their distinctive character and this also was the conclusion of the dissentient Judges of the High Court. Their Lordships, after considering the evidence, agree with that opinion, and also with the further opinion of all these judges that all the right that the Respondent ever had in regard to the user of the Appellant's trade names was a revocable licence to use these names so long as the business arrangement continued between the Appellant and the Respondent.

This case is of no assistance; the principle involved is not the same as the one with which we are concerned in the present suit.

A third case cited by counsel for plaintiff is that of *Heppells Limited v. Eppels Limited & Isaac Jacob Eppel* (1).

Heppells Limited was incorporated in 1924 for the purpose of carrying on the business of wholesale and retail chemists and druggists. It had a number of retail shops in the West End of London. Eppels Limited was incorporated in 1928 for the purpose of carrying on the business of dispensing chemist in the neighbourhood of Barons Court, in London, and had one store in that district. The defendant, Isaac Jacob Eppel, a qualified chemist, carried on in Dublin the business of a chemist's shop for several years and later organized the defendant company. Before the latter had opened its shop the plaintiff sought an injunction to restrain the defendant company from trading under the name of Eppels Limited.

It would appear from the report that Mr. Justice Clauson, before whom the motion was made, arrived at the conclusion that the defendant company's name so closely resembled the plaintiff's name as to be calculated to deceive, although he does not say so explicitly. After citing the facts and noting the difference between the names "Heppells" and "Eppel", the learned judge adds:

It is suggested on his behalf that the name Eppels Limited does not so closely represent the Plaintiffs' name as to be calculated to deceive, it being admitted that the business which is going to be carried on, in so far as it is a chemist's business, has at least some features in common with the chemist's business carried on in various parts of London by Heppells Limited, the Plaintiffs. This is an application for an injunction, and I desire to say nothing further than that having perused the evidence I can see no ground disclosed by it on which the Defendants can effectively resist this injunction, and I propose to grant an injunction as asked.

Of the three cases referred to the last one is surely the most in point. The two names, although spelled differently, do not differ greatly in their pronunciation; as Mr. Justice Clauson put it: "Can I not take judicial notice of the fact that some people don't sound their aitches (h's)?" To the ear both names were alike and one might easily have been mistaken for the other; this is seemingly the reason which led Mr. Justice Clauson to grant an injunction. The judgment does not in the least intimate that Eppel was not entitled to use his surname as part of

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a corporate name; it merely says that he could not use it in such a way that his trade name would so closely resemble that of plaintiff as to be calculated to deceive.

The next cases brought to my attention by counsel for plaintiff are those of *The Hurlbut Company v. The Hurlburt Shoe Company* (1) and *Brewster Transport Co. Limited v. Rocky Mountain Tours and Transport Co. Limited et al* (2).

The first of these two cases deals with trade-marks. The Hurlbut Company had registered a trade-mark consisting of the name "Hurlbut" and the family crest and another one consisting of the name alone, for use on shoes. The Hurlburt Shoe Company, a partnership composed of Frank H. Hurlburt and his wife, later registered a trade-mark consisting of the name "Hurlburt" with a device of a bow and arrow and sold a special kind of shoe with the mark on it. The Hurlbut Company took an action for the expunging the the trade-mark and for an injunction. The Exchequer Court dismissed the action (3) and, on the offer made by the defendant company before the institution of the action and repeated in its defence, to vary its trade-mark by substituting for the word "Hurlburt's" the name of the company, ordered the trade-mark to be so varied. The plaintiff appealed. Upon the respondent, the Hurlburt Shoe Company, undertaking to state in its advertisements that it had no connection with The Hurlbut Company and to amend its trade-mark by adding thereto the name of the respondent Frank Hurlburt, the Supreme Court dismissed the appeal. The judgment of the majority of the Court (Anglin C.J. and Duff, Mignault, Newcombe and Rinfret JJ.; Idington J. dissenting) was delivered by Mr. Justice Duff. The learned judge, in a brief and clear statement, sets forth what he considers to be the law concerning the right of an individual to use his surname in connection with his goods or business (p. 142):

The law is quite clear that no man can acquire a monopoly of his own surname in such a way as to prevent another person of the same name honestly using that name in connection with his goods or his business, but that is subject to the important qualification that no man is entitled by the use of his own name or in any other way to pass off his goods as the goods of another, and if he is using his own name with that purpose, or

(1) (1925) S.C.R., 141.

(2) (1931) S.C.R., 336.

(3) (1923) Ex.C.R. 136.

even, without the conscious intention of doing so, with the effect of doing so, and if, when he becomes aware of the fact that such is the effect of his conduct, he persists in that conduct without taking reasonable care to qualify the representation implied in his conduct in such a way as to avoid deceiving persons who otherwise would be deceived by it, he cannot be said to be using his own name in good faith for his own legitimate business purposes.

Mr. Justice Duff referred to certain cases upon which counsel for the defendant particularly relied; I shall deal with them later.

The action brought by Brewster Transport Co. Limited against Rocky Mountain Tours and Transport Co. Limited, Rocky Mountain Royal Blue Line Motor Tours Limited and others was to restrain the defendants from using a trade name, containing the words "Royal Blue Line", in connection with motor passenger transportation in Alberta, the plaintiff claiming, as first user in that territory, an exclusive right to the name; the question of the use of a surname as a trade name did not arise. The Supreme Court (Anglin C.J., Newcombe, Rinfret and Lamont JJ., and Cannon J. dissenting) affirming the judgment of the Appellate Division of the Supreme Court of Alberta, which by a majority had reversed the decision of Ives J. and dismissed the action, held that:

In view of the existing prior extensive use of the name by a certain company and its affiliated corporations in the tourist transportation business in other territories, the use by plaintiff of that name in a like business was not proper, being a use that would mislead the tourist public, and therefore plaintiff had not shown a right to the use entitling it to claim the protection of a court of equity (*McAndrew v. Bassett*, 4 De G. J. & S. 380, at 384; *In re Heaton's Trade-Mark*, 27 Ch. D. 570).

The case was decided mainly on facts; besides it is not in point. Counsel for plaintiff admitted that the case turned on a question of territoriality, but contended that it served to introduce a word or two on the subject of the statute which is now in force. I must say that I fail to see how this decision can be of any help in interpreting the statutory provisions with which we are concerned.

Counsel for plaintiff also cited the following cases: *Prof. Dr. G. Jaeger v. Jaeger Company Limited* (1); *Heels v. Stafford Heels Limited et al* (2); *Edison Accumulators Limited v. Edison Storage Batteries Limited* (3); *C. & A. Modes v. Central Purchasing Association Limited et al* (4);

(1) (1927) 44 R.P.C., 83 and 437.

(2) (1927) 44 R.P.C., 299.

(3) (1929) 46 R.P.C. 432.

(4) (1931) 43 R.P.C. 163.

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British Legion v. British Legion Club (Street) Limited (1); *J. Lyons & Company Limited v. J. Lyons* (2).

Of these six cases, only three relate to trade names, including patronymic names; the Jaeger case, the Edison case and the Lyons case. The other three deal with anonymous trade names; they have little, if any, application to the point in question, except in so far as they uphold the principle that no one can adopt a trade name so similar to that of another as to be a source of confusion; it is unnecessary to comment upon the decisions in these three cases; a few remarks regarding the others may however be apposite.

I shall first take the Jaeger case. The plaintiffs brought action seeking: (a) a declaration that they were entitled to use the word "Jaeger" in connection with articles of clothing and to carry on business under the style of "Prof. Dr. G. Jaeger", provided they took precautions to distinguish their goods and business from those of the defendant; (b) an injunction to restrain the defendant from stating that the use by plaintiffs of the word "Jaeger" was calculated to deceive or that plaintiffs were not entitled to use the said name; (c) an injunction to restrain the defendant from continuing to prosecute its application for the registration of the trade-mark "Jaeger". The defendant counterclaimed for an injunction restraining the plaintiffs from passing off their goods as those of the defendant by the use of the name "Jaeger". At the trial the plaintiffs asked for the declaration aforesaid qualified by the addition of the words "as part of their business name" after the word "Jaeger".

Mr. Justice Romer refused the injunctions claimed by the plaintiffs and held that the only relief that could be granted was the qualified declaration asked for at the trial; that the name "Jaeger" had come to be distinctive and to indicate the defendant's goods; that the precautions taken by the plaintiffs had not been sufficient to avoid confusion and that the injunction claimed by the defendant ought to be granted.

The defendant appealed and the plaintiffs gave notice of cross-appeal. The Court of Appeal held that the defendant's appeal ought to be allowed and the order for a

(1) (1931) 48 R.P.C. 555.

(2) (1931) 49 R.P.C. 188.

declaration discharged and that the injunction granted against plaintiffs ought to be modified so as to safeguard the right of the latter to trade in their firm name.

This case, decided exclusively on facts, offers no interest, save that it acknowledges the right of a person to the use of his name in connection with his business, under certain conditions.

The Edison case also turned on a question of fact. On motion by plaintiff an interlocutory injunction was granted restraining the defendant from using its name on the ground that the words "Accumulators" and "Storage Batteries" were synonymous and that confusion was likely to arise. The defendant appealed; the appeal was dismissed. At page 438 of the report (*ubi supra*) the Master of the Rolls (Lord Hanworth) says:

What is plain is that these two companies are carrying on a business, the integral part of their names being in fact synonymous the one with the other. It is found by the evidence, and it is clear, that accumulators are in this country sometimes called storage batteries, and storage batteries may be called accumulators.

I think it can be gathered from the report, although it is not so stated expressly, that the name "Edison" was not the surname of any one interested either in the plaintiff or the defendant company.

The last case cited by plaintiff, to wit *J. Lyons & Co. Limited v. J. Lyons*, is a clear case of deliberate passing off. The defendant was not prohibited from using his name, but was restrained from using it in such a way as to deceive. The plaintiff company, established for some time, carried on business as restaurateurs and purveyors on a large scale. It had numerous shops in Great Britain, four of which in the neighbourhood of Brighton. It also sold its goods through retailers. For many years the plaintiff had packed and blended, and widely advertised and sold, tea and cocoa as "Lyons Tea" and "Lyons Cocoa". The defendant was originally registered as Sidney Lyons but, at an early age, his name was changed to Joseph; he was a nephew of Sir Joseph Lyons who had been connected with the plaintiff company. The defendant, who was the keeper of a boarding house at Brighton, in December, 1930, commenced to advertise and offer for sale in Brighton and the vicinity packets of tea and cocoa labelled "J. Lyons Superior Tea, Depot Brighton" and "J. Lyons Pure Digestive Cocoa".

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The plaintiff company took action to restrain the defendant from selling goods and passing them off as being the plaintiff company's goods.

It was held that the phrase "Lyons Tea" and "Lyons Cocoa" had come to mean the goods of the plaintiffs, that the packets of tea sold by the plaintiffs and the defendant respectively were alike, that the phrase "Brighton dépôt" was misleading, that the defendant had intended to deceive and had deceived the public into buying his goods as and for the plaintiffs' goods and an injunction was granted.

Dealing with the question of law, Mr. Justice MacKinnon says (p. 191):

There has been cited one of the best known passages about such a case, the quite short Judgment of Lord Justice Turner in the case of *Burgess v. Burgess* (1853, 3 De G. M. & G. 896) where he said: "No man can have any right to represent his goods as the goods of another person, but in applications of this kind it must be made out that the defendant is selling his own goods as the goods of another. Where a person is selling goods under a particular name, and another person, not having that name, is using it, it may be presumed that he so uses it to represent the goods sold by himself as the goods of the person whose name he uses; but where the defendant sells goods under his own name, and it happens that the plaintiff has the same name, it does not follow that the defendant is selling his goods as the goods of the plaintiff. It is a question of evidence in each case whether there is false representation or not."

That I believe to be a perfectly sound statement of the law. *Prima facie* any man has a right to use his own name in carrying on trade and selling goods. If it happens that somebody else of the same name is also engaged in the same trade, certainly this proposition is true in every case: that the man who is trading in his own name must not do that in such a way, *otherwise than by using his own name*, as to pass off his goods as being those of the other trader bearing the same name. That would be true in every case. But there may also be cases in which it is also true "that a man may so use even his own name in connection with the sale of goods as to make a false representation." I quote there a sentence from the opinion of Lord Herschell in *Reddaway v. Banham* (L.R., 1896, App. Cas. 199, at page 211; 13 R.P.C. 218 at p. 229). Such a case arises where the name common to himself and the other trader has become so closely associated with the goods sold by the other trader as to become part of the well-known description of the goods. The more closely a particular surname is associated with a particular class of goods, the more difficult must it become for another trader happening to own that same name so to use his own name with sufficient distinction as to make it clear to the purchasing public that the goods he is selling are not the goods of the earlier and better known trader.

This was a case in which a deliberate attempt had been made by the defendant to pass off his goods as those of the plaintiff. Yet the defendant's right to use his surname was

not denied; the defendant was merely prohibited from using it in such a way as to cause deceit.

Counsel for defendant relied on the following decisions: *Burgess v. Burgess* (1); *John Brinsmead & Sons Ltd. v. Edward George Stanley Brinsmead* (2); *Actiengesellschaft Hommel's Maematogen v. Hommel* (3); *Dunlop Pneumatic Tire Co. Ltd. v. Dunlop Motor Co. Ltd.* (4); *John Dewar & Sons Limited v. James Haggart Dewar* (5); *S. Chivers & Sons v. S. Chivers & Company Limited* (6); *Jamieson & Company v. Jamieson* (7).

The principle that a man is entitled to use his name in connection with his business, even though the similarity of his name to that of another trader, previously established in the same class of business, may occasionally lead to confusion, provided there be no fraud, was laid down in the case of *Burgess v. Burgess (ubi supra)*. It is useless to repeat here the remarks of Lord Justice Turner cited by MacKinnon J. in his judgment in the Lyons case, an extract whereof containing the said quotation is hereinabove reproduced; but I think it is proper to quote the judgment of Lord Justice Knight Bruce, which, although worded differently, and, as has been said, in a more epigrammatic form, does not, in my opinion, differ substantially from that of Lord Justice Turner; it reads as follows (p. 903, in fine):

All the Queen's subjects have a right, if they will, to manufacture and sell pickles and sauces, and not the less that their fathers have done so before them. All the Queen's subjects have a right to sell these articles in their own names, and not the less so that they bear the same name as their fathers; nor is there anything else that this defendant has done in question before us. He follows the same trade as that his father follows and has long followed, namely, that of a manufacturer and seller of pickles, preserves, and sauces; among them one called "essence of anchovies". He carried on business under his own name, and sells his essences of anchovies as "*Burgess's Essence of Anchovies*", which in truth it is. If any circumstance of fraud, now material, had accompanied, and were continuing to accompany, the case, it would stand very differently; but the whole case lies in what I have stated. The whole ground of complaint is the great celebrity which, during many years, has been possessed by the elder Mr. Burgess's essence of anchovies. That does not give him

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| (1) (1853) 3 de G. M. & G., 896. | (4) (1907) 24 R.P.C., 572. |
| (2) (1913) 30 R.P.C., 137 and
493. | (1906) 23 R.P.C., 761. |
| (3) (1912) 29 R.P.C., 378. | (5) (1900) 17 R.P.C., 341. |
| | (6) (1900) 17 R.P.C., 420. |
| | (7) (1898) 15 R.P.C., 169. |

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such exclusive right, such a monopoly, such a privilege, as to prevent any man from making essence of anchovies, and selling it under his own name.

Notwithstanding the fact that the plaintiff, the elder Burgess, had sold his essence of anchovies as Burgess's Essence of Anchovies, the injunction by which he sought to restrain his son from selling the same product under the same name was refused.

The case of *Dunlop Pneumatic Tyre Co. Limited v. Dunlop Motor Co. Limited (ubi supra)* was decided on the facts; it was held by the Second Division of the Inner House, in the Court of Session in Scotland, that there was no proof of probable deception of persons acting with reasonable care, the business of the two companies being mostly in different goods; that the term "Dunlop tyres" was the proper and usual name of certain (formerly patented) articles which might be sold by all under that name; that, as regards articles other than tyres, the complainants had acquired no exclusive right to the name Dunlop; also that there was no proof of *mala fides*. An appeal was taken to the House of Lords and dismissed: see 24 R.P.C., 572.

Lord Kyllachy, who was one of the judges sitting in the Second Division of the Inner House, made the following observation (23 R.P.C., p. 770):

The one (observation) is that, far as the law may have gone in its justifiable anxiety to prevent imposition upon the unwary purchaser, and content as it has sometimes been to pursue that object at the expense of encouraging the acquisition of virtual monopolies by traders and companies prepared to spend largely in systematic advertising and litigation, it has never as yet, at least so far as I know, gone the length of debarring any merchant or manufacturer from selling his own goods under his own name, unless there has been, in addition to the use of that name, some overt act or course of conduct plainly indicative of fraud—that is to say, of dishonest effort to pass off his own goods as the goods of another. The authorities—beginning with the case of Burgess and other cases not yet overruled—appear to me to make that proposition fairly clear. I myself so held, after full consideration, in the case of *Dewar* (7 S.L.T. 462), a case which was not carried further; and if the case of *Valentine* (17 R.P.C. 673), or the opinions there expressed, should be held—which I greatly doubt—to affirm or imply any broader proposition, all I can say is that, with the greatest respect, I am unable to agree with that judgment.

Commenting upon these two decisions (*Burgess v. Burgess* and *Dunlop Pneumatic Tyre Co. Ltd. v. Dunlop Motor Co. Ltd.*) Kerly (The Law of Trade-Marks, 6th edition, p. 617) says:

In the present state of the authorities, however, no such general rule can now be laid down as an absolute rule of law. The inclination of the courts is to treat the question whether the use of the name in question by a defendant is calculated to pass off his business or goods as that or those of the plaintiffs as one of fact in each particular case, *as though there were no difference in principle between a man's own name and any other apparently descriptive word.*

The last proposition is, in my opinion, too broad. The inclination of the Courts may have been to treat the question whether the use by a defendant of his own name is calculated to deceive as one of fact in each case, but I do not think that they have gone as far as holding that there is no difference in principle between a man's own name and *any other apparently descriptive word*; at least I am unable to interpret the decisions, brought to my attention, in that sense. If such is the trend of the jurisprudence, I must say, with all due respect, that I cannot agree with it; I believe that there is a difference between a man's surname and another apparently descriptive word. Every man has the undeniable right to the use of his patronymic name in his business and he cannot be absolutely restrained from using it, even though another person bearing the same name, previously established in a business of the same character, has adopted it; he can only be prevented from making use of it in such a way as to cause confusion. With regard to a common descriptive word it is obviously different; no one has a particular title thereto and a trader can be restrained from using it, if someone else has previously adopted it and if its use by the newcomer is calculated to deceive. The restriction is and should naturally be stricter in the case of a descriptive word than in that of a patronymic name.

More in point are the remarks contained in the following paragraph of Kerly's work (p. 617):

There is, as already stated, no reported instance, where, apart from fraud, a defendant has been absolutely restrained from using his own name, but in one case (*J. & J. Cash, Ltd. v. Cash*, 18 R.P.C. 213; 19 R.P.C. 181) an order was made restraining him from using it without taking reasonable precautions to distinguish his business and goods from those of the plaintiff, and orders have occasionally been made restraining the use of the name descriptively, e.g., as *Cash's Frillings (J. & J. Cash, Ltd. v. Cash, ubi supra)* or *Fownes' Gloves (Rigden v. Jones*, 22 R.P.C. 417). But such orders will only be made in the rare and highly exceptional cases where it can be proved that a personal name has become so identified by use in a widespread and well-known business with a particular trader as to be necessarily deceptive when used without qualification by anyone else in the same trade (*Joseph Rodgers & Sons, Ltd. v. W. N. Rodgers & Co.*, 41 R.P.C. 277).

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In the Brinsmead case, cited by counsel for defendant and to which Kerly refers in support of his statement that there is no difference in principle between a man's own name and any other descriptive word, the facts were briefly these. John Brinsmead & Sons Limited, pianoforte makers, brought an action against Edward George Stanley Brinsmead, pianoforte manufacturer, and Waddington & Sons Limited, pianoforte dealers, to restrain them from passing off pianos made by the said Edward George Stanley Brinsmead as pianos of the plaintiff; the plaintiff also charged the defendants with conspiring together to pass off the pianos. The plaintiff put on the fall of its pianos the words "John Brinsmead & Sons, London" in capital Roman letters surrounded by lines. On the fall of the defendant's pianos there appeared, in a running hand, the name "Stanley Brinsmead" with a dash at the foot of the "d" coming back under the name and the word "London" in printed Roman characters underneath. In the curls of the initial "S" in small type were the names "Edward" and "George". The evidence showed that a "Brinsmead piano", to the trade and public, meant a piano made by the plaintiff and that the Christian names of the plaintiff and the defendant were not generally known. The evidence further showed that the defendant's pianos were cheap pianos and had a sale among a different class of people from that to which the plaintiff's pianos were sold. Waddington & Sons Limited offered to submit to an injunction restraining it from passing off, if the charge of conspiracy were withdrawn; the offer was rejected. The evidence showed that Waddington & Sons Limited had advertised pianos of the defendant Brinsmead as "Brinsmead" and represented to customers that one of such pianos was a "Brinsmead" piano. The Chancery Division of the High Court of Justice (Warrington J.) refused the injunction (30 R.P.C. 137).

Held—(1) that the defendant Brinsmead had put his name Stanley on his pianos as prominently as the word "Brinsmead" and had not attempted to imitate the mode in which the plaintiff company's name was used, and that he had not acted dishonestly, notwithstanding that he knew that he was deriving some advantage from the fact that his name was the same as that of well-known manufacturers; (2) that the charge of conspiracy failed. The action as against him was dismissed with costs.

The plaintiff appealed from the order dismissing the action as against the defendant Brinsmead; the Court of

Appeal upheld the decision of Warrington J. (30 R.P.C. 493).

Held that the use by the defendant of his name alone did not deceive, and that the appellants had failed to prove any intention on his part to enable or induce dealers to pass off his pianos for those of the appellants.

Lord Justice Buckley says (p. 506) that

if a man makes a statement which is true, but which carries with it a false representation and induces the belief that his goods are the plaintiffs' goods, he will be restrained by injunction

and he cites cases in which that proposition is found.

Coming to the deception arising from the use of one's own name, Lord Justice Buckley adds (p. 507):

Thirdly, in the application of the principles which I have stated there is, in my opinion, no difference whatever where the true statement consists in an accurate statement of the defendant's name as distinguished from any other true statement of fact, if of course you have evidence that from the use of his own name deception results. If a trader takes a name which is not his own name, but is that of a rival trader, and uses it in his trade, no doubt that is very strong evidence that he intends to deceive, and the Court will fasten upon that in any case in which it occurs; but if that is not so, if he is simply using his own name and it is proved that its use results in deception, he will be restrained even from using his own name, without taking such steps as will preclude the deception which, by hypothesis, is engendered by his using his own name. There are many authorities for this proposition. I am only going to refer to two or three of them. In the first place, *Burgess v. Burgess* of course is a case so familiar to us all that I need not stop to refer to it, but I will read a passage presently from which it will be shown that, if you are going to seek to apply *Burgess v. Burgess* rightly, you may say that it is the judgment of Lord Justice Turner which more accurately states the exact effect of the law than the dramatic and brilliant sentences of Lord Justice Knight Bruce. The sentence in Lord Justice Turner's judgment which involves—it does not state, but it involves—the whole proposition which I am stating, is this: "Where the defendant sells goods under his own name and it happens that the plaintiff has the same name it does not follow that the defendant is selling his goods as the goods of the plaintiff." Of course, that sentence involves this as an idea which is communicated by the same words; it does not follow, but it may be that it is the fact, and if you prove it is the fact that the defendant is selling his goods as the goods of the plaintiff, then even that he is using his own name is no defence.

Lord Justice Buckley then refers to the case of *Massam v. Thorley's Cattle Food Company* (1). This case turned mainly on facts; the defendant company was not prohibited from using the name "Thorley" in connection with its cattle food but it was declared not to be at liberty to use the name "Thorley's Food for Cattle" unless it took such precautions as would prevent purchasers from assuming

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that the food it sold was manufactured at the original establishment of Joseph Thorley.

At page 752 Lord Justice James, referring to the case of *Burgess v. Burgess*, cites Lord Justice Turner's judgment and says that he takes it to be an accurate statement of the law.

In the *Hommel* case it was held by Mr. Justice Eve (p. 385)

That this Court will not intervene to prevent a man using his own name unless he is so using it as to lead the Court to the conclusion that he is so doing for the fraudulent and dishonest purpose of filching improperly the trade of the plaintiff.

Then we come to the *Dewar* case. It deals particularly with the trade mark "Dewar's Whisky" registered by John Dewar & Sons Limited. The mark was ordered expunged. The case was decided mainly on facts, but the following remarks from Lord Kyllachy's judgment are interesting (p. 358):

In particular I might, I think, hazard the observation that, although it may be possible to establish as against a person using his own name to describe his own goods, that his name is already so appropriated as to make such description unlawful, I do not myself know of any case in which the use by a man of his own name has been successfully challenged—except in circumstances which plainly involve fraud on the part of the user.

The proposition that no one is entitled to claim a monopoly of his surname was very explicitly expounded in the case of *Jamieson & Co. v. Jamieson (ubi supra)*, in which the plaintiff carrying on business as Jamieson & Co. at Aberdeen, as manufacturer of harness composition, was seeking to restrain one George Jamieson, also a manufacturer of harness composition in the same locality, from passing off his goods as those of the plaintiff; the Court of Appeal, reversing the decision of Byrne J. held

That the distinctive features of the plaintiff's tins were the signature, "Jamieson & Co.", and the trade-mark, and that the defendant's goods had no similarity to the plaintiff's goods, except in features that were common to the trade, and that he had not passed off his goods as the goods of the plaintiff.

The Master of the Rolls (Lord Lindley) expressed himself in a very clear and concise manner on the question of the right of every man to use his own name in connection with his business (p. 181):

Now, when we are asked to restrain a man who is carrying on business in his own name, we must take very great care what we are about. The principle applicable to the case, I take it, is this: The Court ought not to restrain a man from carrying on business in his own name simply because

there are people who are doing the same and who will be injured by what he is doing. It would be intolerable if the Court were to interfere, and to prevent people from carrying on business in their own names in rivalry to others of the same name. There must be something far more than that, viz., that the person who is carrying on business in his own name is doing it in such a way as to pass off his goods as the goods of somebody else.

Lord Justice Vaughan Williams was of the same opinion as Lord Justice Lindley on this subject; at page 192 he says:

Now, I want to say, first, that I do not understand that there is any case, or ever has been any case, in which it has been laid down that a man, who happens to bear a particular name, is debarred from entering into any trade which he chooses to enter into merely because there is somebody else of the same name who has acquired a great reputation in the manufacture of the particular goods dealt with in this trade. The truth of the matter is that, inasmuch as the trader who has established a good business acquires, as I have said, no right of property in either his own personal name or in the name by which he chooses to denote his goods, it follows that the cause of action which the plaintiff has must always be this action for deceit by the defendant in attempting to pass off his goods as being the goods of the plaintiff; and the personal name of the plaintiff only comes into the matter, because the plaintiff, by the reputation that he has acquired in the business, has really come to denote his goods by his own personal name, just as he might denote them by some fancy name that he chose to use.

The next and last reference is to *S. Chivers & Sons v. S. Chivers & Co. Limited*. In this case Farwell J. says (at p. 426):

The principles on which the Courts proceed are not really in dispute, and, to my mind, the question is one purely of fact. I think it is well established that no man is justified in attempting to pass off his goods as the goods of another, whatever may be the means he uses for the purpose. I have heard an ingenious argument from Mr. Kerly this morning as to fraud being necessary. I will say a word or two about it presently; but speaking generally and apart from what I have to say presently, to my mind fraudulent intention is not material, partly because a man is presumed to intend the natural consequence of his own act, and partly because, although he may have acted in ignorance in the first instance, yet if he continues that course of conduct after he has got knowledge of the facts he then becomes guilty of the fraud, because he knows then in what the fraud consists. The other proposition which seems to me to be also undisputed is this: that no man is entitled to a monopoly of his own surname.

Mr. Justice Farwell then refers to the case of *Jamieson & Co. v. Jamieson* and quotes passages from the judgments of the Master of the Rolls and of Lord Justice Vaughan Williams, which I have heretofore cited in dealing with the Jamieson case. Reference is also made to the case of

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Powell v. Birmingham Vinegar Brewery Company (1), where (at p. 69) Lindley L.J. said:

A person who designs or adopts a mark to denote his goods imposes no unreasonable burden on rivals in trade by forbidding them from using the same mark to denote similar goods if the public are thereby misled. But to monopolize the use of words imposes a much more serious burden. Consequently, limits have been put to the right to complain of the use of words which have not been put to the right to complain of the use of marks. For example, if a man uses his own name to denote his own goods, it would be intolerable to confer upon him the right to prevent other people of the same name from honestly using their own name to denote their own goods, even although they might be of the same kind as his, and be undistinguishable from them: *Burgess v. Burgess*; *Turton v. Turton* (42 Ch. D. 128).

The case was taken to the House of Lords and the decision of the Court of Appeal affirmed (2). At page 711, the Lord Chancellor (Lord Halsbury) says:

The proposition of law is one which has been accepted by the highest judicial authority and acted upon for a great number of years. It is that of Turner L.J. who says in *Burgess v. Burgess*: "No man can have any right to represent his goods as the goods of another person, but in applications of this kind it must be made out that the defendant is selling his own goods as the goods of another." That is the only question of law which, as it appears to me, can arise in these cases. All the rest are questions of fact. The most obvious way in which a man would be infringing the rule laid down by Turner L.J. is if he were to say in terms, "These are the goods manufactured by" a rival tradesman; and it seems to be assumed that unless he says something equivalent to that no action will lie. It appears to me that that is an entire delusion. By the course of trade, by the existence and technology of trade, and by the mode in which things are sold, a man may utter that same proposition, but in different words and without using the name of the rival tradesman at all.

I may perhaps add to this already long list of authorities two decisions to which no reference was made by counsel, namely, those of *Teofani & Co. Ltd. v. A. Teofani* (3) and *Turton v. Turton* (4).

In the *Teofani* case the Master of the Rolls (Lord Justice Cozens-Hardy) refers to the *Burgess* case and after quoting Lord Justice Turner's remarks (herein previously cited), he adds (p. 456):

I do not think that there is any case in which any doubt is expressed that that is the true principle of law.

In the same case Kennedy L.J. says (p. 458):

As I understand the law there is nothing to prevent a person who is setting up in a trade in which there are already others of the same name from using his own name, but alike from the legal and from the moral point of view a person is forbidden to use his own name in connection

(1) (1896) L.R. 2 Ch. 54.

(3) (1913) 30 R.P.C. 446.

(2) (1897) L.R., App. Cas. p. 710.

(4) (1889) L.R., 42 Ch. Div. 128.

with the goods in that business in such a way as to represent that the goods are the goods of somebody else of that same name. If he does that he is doing that which is wrong and which the Court, as it seems to me, has consistently through a long list of cases refused to allow him to do. He must carry on the business under his own name honestly, and he does not carry on the business in his own name honestly if he so uses his name in connection with the business or goods—in this case it is the goods—as to lead those who deal with him in that business as purchasers to believe that they are goods which are the goods of another trader of the same name.

It was held in this case (*inter alia*) that the use by the defendant of his name on his goods was not only calculated but intended to deceive.

In *Turton and Turton* the facts and judgment are briefly and, I think, accurately summed up in the head note:

The plaintiffs had for many years carried on the business of steel manufacturers under the name of Thomas Turton & Sons. The defendant John Turton had for many years carried on a similar business in the same town, at first as John Turton, then as John Turton & Co. In 1888 he took his two sons into partnership and carried on the same business as John Turton & Sons. There was no evidence that the defendants imitated the trade-marks or labels of the plaintiffs or otherwise attempted to deceive the public:—

Held (reversing the decision of North, J.), that although there was a probability that the public would be occasionally misled by the similarity of the names the plaintiffs were not entitled to an injunction restraining the defendants from the use of the name John Turton & Sons.

After having stated that the defendants, in doing business under the name of John Turton & Sons, merely represented that the business was being carried on by the father, John Turton, and his sons, which was the truth, Lord Esher said (p. 134, in fine):

Therefore the first question of law in the case is this: Supposing that, and that only, is done by the defendants, but, nevertheless, some people, or, if you please, many people, in the market, do from time to time give orders intending them for the plaintiffs' firm which on account of the similarity of name go to the defendants' firm, are the plaintiffs entitled to an injunction? If there had been anything more than the mere use of the name by the defendants in the way I have stated, that there might have been a necessity for an injunction, I think, cannot be denied. Here are two firms, Thomas Turton & Sons and John Turton & Sons: well, careless people may not notice the difference of Christian name, and may look more to the words "Turton & Sons" which are the same in both. That might be so. Therefore, for this purpose, I assume that the names are sufficiently alike to cause those blunders in trade; but they are blunders of the people who make the blunders. Has the defendant done anything to so far cause those blunders even though he did not intend it, which entitles the Court to stop him from doing what he is doing? He is simply stating that he is carrying on business with his two sons as partners. I say that is the accurate and exact truth of what he is doing. I will assume for the moment that it is pointed out to him that, he doing that, blunders will

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occur in the business and that the results which are complained of will happen. Is there anything dishonest—is there anything wrong morally, in any, even in the strictest sense, in a man using his own name, or stating that he is carrying on business exactly as he is carrying it on? Is there anything wrong in his continuing to do so, because people make blunders, and even, if you please, because they make probable blunders? What is there wrong in what he is doing?

Further on Lord Esher refers to the Burgess case and after quoting therefrom the proposition that “Where a person is selling goods under a particular name, and another person, not having that name is using it, it may be presumed that he so uses it to represent the goods sold by himself as the goods of the person whose name he uses”, he goes on to say (p. 137):

It looks to me rather as if that would be a prima facie case. One name is stamped with peculiar value which is given to it; another man who has not that name comes and takes that name. I think prima facie that would look as if he were doing it for the purpose of interfering, and for the purpose of representing his goods to be the goods of the other. “But where the defendant sells goods under his own name, and it happens that the plaintiff has the same name, it does not follow that the defendant is selling his goods as the goods of the plaintiff.” That is to say, if only those two facts are established, that does not make a prima facie case. The first does make a prima facie case, but the second does not. Then Lord Justice Turner goes into the second case. He does not say so, but the next sentence is: “It is a question of evidence in each case.” The first is a prima facie case, but it may be answered by evidence. In the second case, although that is not a prima facie case there may be other circumstances. “It is a question of evidence in each case whether there is false representation or not.” He does not say whether there is “representation” or not, but “false representation.” That is he goes back to his fundamental proposition: No man can have the right to represent his goods as the goods of another person. Therefore if a man uses his own name, that is no prima facie case, but if besides using his own name he does other things which shew that he is intending to represent, and is in point of fact making his goods represent, the goods of another person, then he is to be prohibited, but not otherwise.

I take that to be a perfectly correct representation of what I think the law is, and I think that when you look at the judgment of Lord Blackburn in the case of *Singer Machine Manufacturers v. Wilson* (3 App. Cas. 376), you will see that he really comes to the same conclusion.

Lord Justice Cotton adopted the same view (pp. 141, 142 and 143).

In the case of *Reddaway v. Banham* (1) in which the plaintiffs had brought an action to restrain the defendants from selling belting as “Camel-hair Belting”, under which name the plaintiffs had sold belting for a number of years, Lord Macnaghten, referring to the Burgess and Turton cases, said (p. 233):

(1) (1896) 13 R.P.C., 218.

The judgment of Lord Justice Turner in *Burgess v. Burgess*, 3 De G. M. & G. 896, though eclipsed, as it has been said, in public favour by the brilliancy and point of his colleague's language, is an accurate and masterly summary of the law. But it seems to me to be an authority in favour of Reddaway, and not in favour of Banham. I am quite at a loss to know why *Turton v. Turton*, 42 Ch. D. 128, was ever reported. The plaintiffs' case there was extravagant and absurd.

Extravagant and absurd for Thomas Turton & Sons Limited to endeavour to restrain John Turton and his sons from carrying on a business of a similar description under the name of John Turton & Sons. Yet the names Thomas Turton & Sons Limited and John Turton & Sons offer as much similarity, if not more, as the plaintiff's and the defendant's names in the present case.

In a comparatively recent case, not alluded to in the argument, namely, that of *Joseph Rodgers & Sons Limited v. W. N. Rodgers & Company* (1), in which the defendant Wilfred Newbound Rodgers was prohibited from doing business under the name of W. N. Rodgers & Co., but allowed to do it under his own name, Mr. Justice Romer, after dealing with the facts, stated what he considered to be the law and made a brief reference to the Turton case; I think I had better quote his remarks (p. 291):

It is the law of this land that no man is entitled to carry on his business in such a way as to represent that it is the business of another, or is in any way connected with the business of another; that is the first proposition. The second proposition is, that no man is entitled so to describe or mark his goods as to represent that the goods are the goods of another. To the first proposition there is, I myself think, an exception: a man, in my opinion, is entitled to carry on his business in his own name so long as he does not do anything more than that to cause confusion with the business of another, and so long as he does it honestly. It is an exception to the rule which has of necessity been established. It is impossible to say, because Mr. Joseph Rodgers (for example) in the past established a business in cutlery, which has now become so successful that his goods are known as "Rodgers' Cutlery," that no one whose name is Rodgers may embark upon a cutlery business if, as I say, he does it honestly, and if he does not do anything more to cause confusion than merely carry on business in his own name. That is what I think was meant by Lord Justice Cotton in the well-known case of *Turton v. Turton*, where, at page 143, he says: "In my opinion, the Court cannot stop a man from carrying on his business in his own name, although it may be the name of a better-known manufacturer, when he does nothing at all in any way to try and represent that he is that better-known and successful manufacturer." The exception to the first rule is, however, an exception made in the interests of honest trading; again, it is an exception which only authorizes the use by a man of his own name; it is not an exception which, even in an honest case, entitles a man to use

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(1) (1924) 41 R.P.C., 277.

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something that is not his own name; that is to say, it does not entitle him to use his name in combination with something else, such as the words "& Company." I do not pause to consider the question which, I think, was dealt with by Lord Justice Stirling (then Mr. Justice Stirling) in another case, as to how far the exception enables a business to be carried on under a man's name with the addition of the word "Limited"; that is, perhaps, a more difficult question.

If the exception to the first rule set forth by Mr. Justice Romer is to be applied rigidly, perhaps it is right to say that a man who carries on business alone is not entitled, even in an honest way, to use his name in combination with the words "and Company", on the ground that such use would constitute a false representation, assuming, of course, that there is already another firm established in the same class of business under a similar name and that the addition of the words "and Company" is apt to render confusion more likely. But I must say that I am not inclined to carry this doctrine too far and I would feel loath indeed to prevent a trader, who becomes associated with a *bona fide* partner, from doing business under his name and adding thereto the words "and Company", provided this was done honestly and the firm name adopted was not the same as the one of another concern or so similar thereto as to be inevitably calculated to deceive.

Of the several cases *relied upon by counsel*, not one deals explicitly with the right to use, in conjunction with one's name, words such as "and Company", "Limited" or others of a like nature. The point was touched upon during the argument but no authorities were cited. Yet it is the crucial and practically the only question in dispute. The matter was considered and discussed in a few cases other than the Rodgers case and I think I ought to refer briefly to the decisions rendered therein.

In the case of *Turton v. Turton (ubi supra)* Lord Esher (at p. 139) says:

John Turton has done nothing more than that he has carried on business under this statement, "I carry on my business as the father, John Turton, with my two sons as partners." That is strictly accurate, and he has done nothing more. And I desire to say, that if the name of the plaintiffs' business which they had carried on had been Thomas Turton & Co., and that name had become valuable, and if the defendant had *bona fide* and honestly formed a company himself and had carried on business merely stating that his business was carried on by John Turton & Co., if that were an accurate description of a *bona fide* company constituted by himself, the same result would have followed if he had done nothing more than that because that statement also would be only simply and perfectly accurate.

In the case of *J. and J. Cash Limited v. Cash* (1) the Court of Appeal modifying the injunction granted by Keke-wich J. (2), ordered *inter alia* that the defendant Joseph Cash be restrained from carrying on business under the name of "Joseph Cash & Co." *while not in partnership with any other person*. The order will be found at the bottom of page 186 of the report (19 R.P.C.).

Mr. Justice Romer in the Rodgers case refers to a judgment of Lord Justice Stirling (then Mr. Justice Stirling) in a case in which the question arose "as to how far the exception enables a business to be carried on under a man's name with the addition of the word 'Limited,'" without pausing to consider it. I assume that the case alluded to is that of *Tussaud v. Tussaud* (3).

The action was brought by "Madame Tussaud & Sons Limited" against "Louis J. Tussaud", claiming an injunction to restrain the defendant from applying to the Registrar of Joint Stock Companies for registration under the Companies Act of any company to be incorporated under the name of "Louis Tussaud, Limited".

At page 687, Stirling J. says:

It follows from the decisions in those two cases that the defendant is at perfect liberty to open on his own account and to carry on in his own name an exhibition of waxworks. Further, he might take partners into his business and carry it on under the name of "Louis Tussaud & Co." That seems to me to have been expressly decided in *Turton v. Turton* (42 Ch. D. 128). Having commenced business on his own account, I apprehend that he might sell it with the benefit of the goodwill to third parties, and that the third parties might, if they thought fit, continue to carry on the business under the same name—that of the defendant: that is to say, they would be entitled to the full benefit of the goodwill which they had honestly and legitimately purchased from the defendant. Again, the third parties might transfer the business and the goodwill to a joint stock company, and without expressing a final opinion on the point I am not prepared at the present moment to say that that company might not be registered under the same name as had previously been used in connection with the business.

On the other hand, I conceive it to be clear that the defendant could not, either for valuable consideration or otherwise, confer on another person the right to use the name of "Tussaud" in connection with a business which the defendant had never carried on, and in which the defendant had no interest whatever.

(1) (1902) 19 R.P.C. 181.

(2) (1901) 18 R.P.C. 213.

(3) (1890) 44 Ch. Div. 678.

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The same doctrine was laid down by Mr. Justice Farwell in the Chivers case (*ubi supra*), where at page 426 he says:

In my judgement also if a man, as here, has an old-established business which he has been carrying on for fifteen years or so under his own name he does not, within the meaning of the exception to which I have just referred, and which would in itself be probably evidence of a fraudulent intent, adopt a name which does not belong to him if he simply continues to use his own name, but attaches that name of his own to a company which he formed to carry on the business which he has himself carried on. To my mind, no element of suspicion of fraud attaches to the man who has established a business under his own name if he turns that business into a limited company and applies to that limited company his own name with the word "limited", because the reason for doing so is obvious, that he desires to retain the goodwill which he has gained for that name, and the Court is not driven to infer a fraudulent intention which would otherwise probably be inferred if he had, as I have already said, assumed a name to which he was not born, and to which there was attached some goodwill in the shape of another man's trade.

In the case of *Pine Cotton Spinners and Doublers' Association Limited and John Cash & Sons Limited v. Harwood Cash & Co. Limited* (1), it was held *inter alia* that:

A new company with a title of which the name "A" forms part has none of the natural rights that an individual born with the name "A" would have.

An individual named "A", not transferring to a company a business and goodwill, cannot confer upon the company a title to use his name as against persons who would be damaged thereby.

See also *Kingston, Miller & Co. Limited v. Thomas Kingston & Co. Limited* (2) in the same sense.

The last case to which I will refer is that of *Baird & Tatlock (London) Limited v. Baird & Tatlock Limited* (3); it is, I think, more in point than the two preceding cases. Lord Cullen (at page 93) says:

But the complainers say that the state of matters was materially altered to their prejudice when, in 1915, the Glasgow business became converted into that of a joint stock company designated Baird & Tatlock, Limited. The addition of the word "Limited" to the previous bare "Baird & Tatlock" was, they say, a step of piratical tendency—although not intentionally so, as now conceded—inasmuch as both businesses thereafter were businesses of companies both designated as "Limited" whereby, say the complainers, there was originated the cause of such confusion between the businesses as figures in the evidence, which the complainers affect to trace to the fact of each business being carried on under the name of a "Limited" company. In this connection the complainers contend that the respondents' company, Baird & Tatlock Limited, was a new legal entity, entirely dissociated from the pre-existing firm of Baird & Tatlock, whose business and goodwill it acquired; that it can borrow nothing from the pre-existing use of the name of Baird & Tatlock by that

(1) (1907) 24 R.P.C., 533, at 538. (2) (1912) 29 R.P.C., 289.

(3) (1917) 34 R.P.C., 85.

firm, and so falls to be regarded as presumably piratical, in effect, although not in intention. This contention appears to me to be equally without foundation in fact and in law. In the first place, there is no ground whatever in the evidence for saying that the addition of the word "Limited" to the previous name of Baird & Tatlock in the case of the Glasgow business was in any way responsible for the instances of confusion which occurred; and, in the absence of any such evidence, it is, I think, clear enough that what led to the confusion was the use in the designation of both businesses of the distinctive names Baird and Tatlock in combination.

Knowing the circumstances which surrounded the organization of the defendant company and the conditions which obtained since its inception, I am satisfied that the members of the Boudrias family were entitled to form a joint stock company, as they did, and to embody in its corporate name their patronymic.

There is one point on which all the decisions cited are in accord, viz., that no man can be deprived of the right of using his name honestly in connection with his business. Beyond that opinions are divided. A first doctrine maintains that the principle that a man is entitled to the use of his name as a trade name is subject to the restriction that no one has the right to pass off his goods as those of another and that, if the use of one's name has that effect, he may be restrained from using it without taking the necessary precautions to distinguish his goods from those of the earlier trader. The other doctrine is that a man may, so long as he acts honestly and without intent to deceive, use his name in connection with his trade, even though the similarity of the names may occasionally lead to confusion; in other words, no one can be prohibited from using his name in his business, unless the use he makes of it is fraudulent and intended to deceive.

The first doctrine was upheld in, among others, the cases of *Brinsmead v. Brinsmead*, *Chivers v. Chivers*, *Reddaway v. Banham*, and *Rodgers v. Rodgers*, above referred to.

The second doctrine, on the other hand, was adopted in *Burgess v. Burgess*, *Dunlop Pneumatic Tyre Co. v. Dunlop Motor Co.*, *Actiengesellschaft Hommel's Haematogen v. Hommel*, *Dewar v. Dewar*, *Jamieson & Co. v. Jamieson*, *Powell v. Birmingham Vinegar Brewery Company*, and *Turton v. Turton*.

I must say that I would have felt inclined to follow the second doctrine but for the judgment of the Supreme Court

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in the case of *Hurlbut Company v. Hurlburt Shoe Company* (*ubi supra*), by which I consider myself bound.

The situation would have been different had the plaintiff company established that the name "Boudrias" had acquired a secondary meaning and become identified with its wares; but this the plaintiff has not done. On the contrary, the evidence discloses that it advertised and sold its goods under various names, but particularly and to a very large extent under the name "Condor". When Freeman acquired from J. V. Boudrias his controlling interest in J. V. Boudrias & Fils Limitée, the company already owned two trade-marks of which the Condor formed a prominent part. On May 2, 1930, after Freeman had taken over the plaintiff company, the latter registered a trade-mark consisting of the words "Condor Coffee", a cup and saucer with vapour and the words "just real good coffee" under No. 49286: see exhibit J. Of its several trade-marks (see list exhibit 6) the most commonly used were the divers "Condor" trade-marks. In fact, the use of the "Condor" marks greatly exceeded that of all the others combined. I do not propose to dwell on this subject at length; reference may be had to the depositions of Freeman, Paul Boudrias, Mathieu, Carrier, Pérusse, Larue and Couvrette and to exhibits B, F, P, Z², Z¹¹, Z¹⁷ and Z¹⁸.

In the telephone directory the name "Condor Food Products" appeared as well as "J. V. Boudrias & Fils Limitée": see exhibit E.

When Freeman took control of the plaintiff company, the latter owned an "International" truck; two or three months later the company replaced it by a "Reo" truck. This truck for some time had no inscription of any kind on it, but after a few months two plates with the word "Condor" were put on it; the name of the company did not appear; a photo of the Reo truck was filed as exhibit 29. The plaintiff company shortly after acquired four small trucks on which appeared the words "Moutarde Condor" or "Condor Mustard", with underneath, in smaller type, the name of the company; see exhibit Z². Sometime later the four small trucks were repainted and the name of the company was left off. See depositions Mathieu and Carrier.

In the application the plaintiff company filed with the Commissioner of Patents in Ottawa for the registration of

the word mark "Boudrias" it mentioned the 10th of February, 1933, as the date on which it had first used the said word mark: see exhibit C.

It seems obvious to me that the plaintiff company, from the time Freeman acquired a controlling interest directed its efforts to make itself and its wares known under the name "Condor". The name "Boudrias", if not totally discarded, was never put forward. It is only when the Boudrias started to organize their new company that the plaintiff company thought of using the word Boudrias as a word mark.

In the face of the evidence I have no hesitation in saying that, as far as the plaintiff company is concerned, the name Boudrias has not acquired a secondary meaning and it has not become identified with its goods. In this respect the following cases may be consulted profitably: *S. Chivers & Sons v. S. Chivers & Co.* (*ubi supra*, at p. 429), *J. Lyons & Company Limited v. J. Lyons* (*ubi supra*, at p. 191), *Cellular Clothing Co. v. Maxton & Murray* (1).

The plaintiff company has, in my judgment, failed to establish such a usage of the name "Boudrias" in connection with its wares as would confer upon it a monopoly therein.

Assuming that under the common law a man is not entitled to use his name in connection with his business, if such use, although made in good faith and without any intent to deceive, may occasionally lead to confusion, without taking additional precautions to distinguish his wares from those of the other trader, has the law been changed by the enactment of the Unfair Competition Act? I think it has, by the insertion of the words "without any intention to deceive" in section 9.

Under this section any individual or group of individuals may use his or their names or surnames in connection with his or their business provided such business be commenced and carried on for his or their own direct benefit, in good faith and without any intention to deceive. If these three conditions are fulfilled, confusion is, to my mind, immaterial.

(1) (1899) L.R. App. Cas., 326, at 336.

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Are these three conditions realized in the present case? Question of fact with which I shall deal as briefly as possible.

There can be no doubt that the defendant's business was commenced and that it has been carried on since its inception for the direct benefit of J. Victor Boudrias and his four sons. It is admitted that from the date of the incorporation of the defendant company to the date of the institution of the action they have been the only shareholders and officers thereof; see paragraph 10 of the statement in defence and paragraph 1 of the reply.

The other two conditions, namely, the good faith and the lack of intention to deceive are correlative and may conveniently be treated together.

[The learned Judge here considered the evidence adduced at trial touching these matters and then continued.]

After weighing carefully the evidence I have no hesitation in saying that the defendant company has, since it started its operations, carried on business in good faith and without any intention to deceive. Referring in particular to J. V. Boudrias and his son Paul, I may say that both impressed me favourably and that both gave their evidence in an open and straightforward manner.

The action accordingly fails and there will be judgment dismissing it with costs. The defendant should remove the sign on which appears the name J. V. Boudrias, a photograph whereof was filed as exhibit 30, or the name J. V. Boudrias should be obliterated therefrom and an order will be made in the judgment accordingly.

Judgment accordingly.