1914
Dec. 19.

MICKELSON SHAPIRO COMPANY AND HENRY DOERR.....PLAINTIFFS;

AND

MICKELSON DRUG AND CHEMICAL COMPANY LIMITED AND ANTON MICKELSON.....DEFENDANTS.

Trade-mark—Application for—Drawing—Infringement—Limited jurisdiction of the Exchequer Court of Canada—Passing-off—Remedy.

In applying for a trade-mark under the Canadian statute the applicant must describe in writing what he claims as his mark. A drawing must also be filed. But the claim in the written application cannot be extended by reason of something appearing in the drawing which has not been claimed.

2. The Exchequer Court of Canada has jurisdiction to restrain any infringement of a trade-mark but has no jurisdiction to entertain an action seeking damages for passing off goods of the defendant as those manufactured and sold by the plaintiff.

3. Trade-mark for gopher poison, registered in Canadian Trade-mark Register No. 79, folio 19,498, ordered to be expunged.

THIS was an action begun by statement of claim seeking an injunction against the defendants to restrain them from infringing the plaintiffs' trade-mark, and an order to expunge the registration of the defendants' trade-mark.

The facts are stated in the reasons for judgment.

November 16, 1914.

The case came on for hearing before the Honourable Mr. Justice Cassels at Ottawa.

W. L. Scott and *A. J. Fraser* for the plaintiffs.

F. H. Chrysler, K.C., and *G. St. J. van Hallen* for defendants.

CASSELS, J., now (December 19, 1914) delivered judgment.

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The statement of claim was filed by the plaintiff company, a corporation incorporated under the laws of the state of Minnesota, against the defendants, a corporation incorporated under the laws of Manitoba with its head office in the city of Winnipeg, and one Anton Mickelson.

By their statement of claim the plaintiffs claim an injunction against the defendants restraining them from infringing their trade-mark, which I will subsequently refer to. They also seek an order that the registration of the trade-mark by the defendant company be expunged.

The case came on for trial before me at Ottawa on the 16th day of November last, when certain evidence was adduced, and counsel for the plaintiffs and defendants undertook to furnish authorities in support of their respective contentions.

I have lately been furnished with a full memorandum of authorities, both on the part of the plaintiffs and on the part of the defendants, and have considered the authorities together with many others, but I regret that I am unable to come to a different conclusion from that which I expressed at the trial, namely, that as a matter of trade-mark law the defendants' trade-mark does not infringe that sued upon by the plaintiffs. I would have been glad, under the circumstances of this case, to have been able to come to a different conclusion.

The Exchequer Court has no jurisdiction in passing-off cases. The Court has jurisdiction to restrain any infringement of a trade-mark. If there is no infringement of the trade-mark, no matter what the wrong may be, the remedy must be sought in some other tribunal.

The *Trade-Mark and Design Act* (Chap. 63, R.S. 1906) provides by section 20,—

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"That no person shall institute any proceeding to "prevent the infringement of any trade-mark unless "such trade-mark is registered in pursuance of the "Act."

By the 13th section the proprietor of a trade-mark may on forwarding to the Minister a drawing and description in duplicate of such trade-mark, etc., be entitled to have his trade-mark registered and thereafter to have the exclusive right to use the trade-mark to designate the articles manufactured or sold by him.

The trade-mark upon which the plaintiffs sue and which duly became by assignment the property of the plaintiffs, was applied for in accordance with the provisions of the statute, and a certificate of registration was granted on the 25th day of May, 1909.

The application for the trade-mark is in part as follows:—

The applicant "hereby requests you to register "in the name of the Mickelson Chemical Company "a specific trade-mark, to be used in connection "with the sale of a poison for gophers and prairie "dogs, which the said Mickelson Chemical Company "verily believes to be its property on account of it "having been the first to make use of the same." "The said Mickelson Chemical Company hereby "declares that the said specific trade-mark was not in "use to its knowledge, or to the knowledge of any of "its officers, by any other person than by the said "corporation."

"The said specific trade-mark consists of an oval "cut in which appears four gophers in the grass, one "of which has its front paws resting on the head of "a cylindrical can."

The description which I have just referred to is very clear and unmistakable, and if this trade-mark is as

specified there is no room to question the fact that the defendants do not infringe the trade-mark of the plaintiffs as a matter of trade-mark law.

The defendants' trade-mark was registered on the 16th March, 1914. The application of Anton Mickelson defines his trade-mark as follows:—

"The said Specific Trade-Mark consists of the "words "Kill-Em-Quick" hyphenated as above "written accompanied by the fac-simile signature "of the owner preferrably written across the words ""Kill-Em-Quick"; the letters may be in red as "shown in the drawings, etc."

The application for the plaintiffs' registration in addition to the statement of what the said specific trade-mark consists of, has the following:—

"A drawing of the said specific trade-mark is "hereunto annexed."

When the drawing is referred to, there appears to be written on the cylindrical can in small letters the words "Mickleson's Kill-Em-Quick Gopher Poison." If these words form part of the plaintiffs' trade-mark I would grant them relief, but I do not see how it can be held that they form part of the trade-mark in question. The statute is specific in requiring a description. The description is specific in its terms, and does not claim these words as part of the trade-mark. According to patent law it is clearly settled that in regard to a patent it is the specification which governs, and the drawings are merely for the purpose of illustration. (1).

In an application for a trade-mark the drawing might disclose more than the applicant desires to claim as a trade-mark, but in my judgment where the application is described as in the trade-mark upon which the plaintiff relies, it cannot be extended by reason of

(1) See Hogg v. Emmerson, 6 How. p. 337.

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something appearing on the drawing which has not been claimed.

Mr Scott strongly argues that the words "Mickleson's Kill-Em-Quick" have acquired in favour of the plaintiffs a secondary meaning, by the continuous length of sales. This, however, does not touch the point in question. I am not called upon in this case to decide that the plaintiffs are entitled to a registration of the trade-mark by reason of its having acquired a secondary meaning. It is time enough to consider that question if it ever arises. All that at present I am dealing with is to ascertain as far as I am able what is the trade-mark that they have registered.

The case of *De Kuyper* vs. *Van Dulken*, (1) is very much in favour of the defendants' contention. That case appears to me to be stronger in favour of the label in question forming part of the plaintiffs' trade-mark in that particular case. It was shown in the drawings, and something necessarily had to be used in order to affix the trade-mark to the bottle. Nevertheless the majority of the Supreme Court in the judgment delivered by Mr. Justice King, held that the drawing in question formed no part of the trade-mark in question in that case. Stress was laid upon the fact that the statute required a description and a drawing. It is quite true that as appears in the judgment of Mr. Justice King he apparently was of the opinion that if a label was claimed it should have been specifically claimed by a separate application, and that to a certain extent differentiates the case from the one before me. If I am right in my view as to what the plaintiffs obtained by their registration, then I think the numerous cases cited by Mr. Scott have no application. In all the cases, other than the passing-off cases, the

(1) 4 Ex. C. R. 71, and 24 S. C. R. 114.

plaintiff was entitled to the trade-mark claimed. The question was whether the defendant infringed.

In *Kerly on Trade-Marks*, for instance, at page 277 Mr. Kerly cites certain of the cases; and on page 278 he sums them up in this way :—

"The cases cited are cases where the name applied "to the opponent's or plaintiff's goods was taken "from the device used as a trade-mark."

"Take for instance, for illustration, a trade-mark "consisting of the full-length figure of a milkmaid "carrying two pails, one on her head and one in her "right hand, with the words *milkmaid brand* above "it, was registered for condensed milk, etc., and the "goods upon which it was used were known as the "*milkmaid or dairymaid* brand."

The goods obtained that name in the market by reason of the trade-mark.

Subsequently a trade-mark "consisting of a half-length figure of a woman carrying a pail under her right arm, with the words *dairymaid* at the side of the figure, was registered for butterine, etc."

And the Court granted an order "confining the second registration to goods other than those included in the first, and to restrain the use of the second mark upon any of the goods for which the first was registered."

In the case cited by Mr. Scott, *In re La Société Anonyme des Verreries de L'Etoile* (1), the plaintiff's trade-mark was the figure of a star, and his glass came to be known as star glass, although those words did not appear on the trade-mark. The defendant was restrained from using the words "Red Star Brand" for glass on the ground that it was an infringement of the plaintiff's mark.

(1) (1894) 1 Ch. 61; (1894) 2 Ch. 26.

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It is obvious that the figure of a star with the continous user was infringed by a trade-mark which sought to register in words what was practically shown by the figure.

I therefore dismiss such portion of the plaintiffs' case as relates to their claim for an infringement of the trade-mark. I think that the plaintiffs are entitled to have the trade-mark registered, and claimed by the defendants, expunged from the register. In the first place I do not think that it is the subject-matter of a trade-mark at all. The evidence is clear that the words "Kill-Em-Quick" had been used for years before plaintiffs' application, for the same class of goods by numerous other persons. The putting of a man's name over them would not constitute a valid trade-mark; but furthermore, in the face of the assignments to the plaintiffs, it was a fraud on the part of Mickleson to apply for registration of his trade-mark.

As I pointed out, the trade-mark upon which the plaintiffs sue was registered on the 25th May, 1909. It came direct to them through Mickleson. As far back as May, 1909, the words "Mickleson's Kill-Em-Quick" was shown upon the can referred to in the plaintiff's trade-mark. I have to hold that that did not form part of the plaintiff's trade-mark, but nevertheless it can be utilized in getting rid of the trade-mark registered by the defendants. I order that this trade-mark be expunged from the register.

Under the circumstances of the case each party succeeding and failing in part, there will be no costs to either party of the action or of the application to expunge.

Judgment accordingly.

Solicitors for the plaintiffs: *Moren, Anderson & Guy.*

Solicitors for the defendant, Anton Mickleson: *G St. J. van-Hallen.*

Solicitors for the defendant Mickleson Drug & Chemical Company: *Campbell, Pitblado, Haig, Montague & Drummond-Hay.*