

1929
 May 8.
 May 29.

DOBBS AND COMPANY.....PETITIONER.

vs.

ROBERT CREAN AND COMPANY, }
 LIMITED.....} RESPONDENT.

Trade Marks—misleading—expunging—Trade Mark and Designs Act.

In 1923 the respondent registered, and began using in Canada, a trade mark consisting of a triangle bearing the words "Deer Skin Finish" above the words "Dan Dobbs", and a triangle below bearing the words "Character Hats", for use in the sale of felt and straw hats. Some years before, namely, 1913, the Petitioner, who was in similar business adopted its president's name "Dobbs" as a trade mark, to be used in the sale of its hats, and has since used the name to the present in Canada, and now by its petition asks that the respondent's trade mark be expunged.

Held, that the words "Dan Dobbs" and "Dobbs" are obviously words as applied to a particular kind of goods that can be confused and would tend to deceive the ordinary purchaser. The name "Dobbs" having acquired a secondary meaning as distinguishing petitioner's goods from that of other merchants and having been used in Canada long before the use made by the respondent of his trade mark, the respondent's trade mark should be expunged.

(2) That the applicant for registration of a trade mark in Canada must be the first user thereof in Canada.

A PETITION by the petitioner to have the trade mark of the respondent expunged from the register of Trade Marks.

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

Harold G. Fox for the petitioner.

C. A. Thompson and *H. J. Stuart* for the respondent.

The facts are as stated in the reasons for judgment.

AUDETTE J., now (May 29, 1929) delivered judgment.

1929
 DOBBS AND
 COMPANY
 v.
 ROBERT
 CREAN AND
 COMPANY,
 LIMITED.
 —
 Audette J.
 —

This is an action whereby the petitioner seeks, *inter alia*, to expunge, from the Canadian Register of Trade Marks, the objecting party's

Specific Trade Mark to be applied to the sale of men's felt and straw hats, and which consists of a triangle bearing the words "Deer skin Finish" above the words "Dan Dobbs", and a triangle below bearing the words "Character Hats".

The trade mark was registered in Canada, on the 1st May, 1923, upon the usual declaration, as required by sec. 13 of The Trade Marks and Designs Act,

that the said specific trade mark was not in use to our knowledge by any other person than ourselves at the time of our adoption thereof.

At the time the objecting party subscribed to this declaration it was wrong to state that it was the first to make use of the trade mark, as is now well established by conclusive evidence. Even if the statement were made in good faith, to maintain the purity of the Register it is evident that the statement should not remain unchallenged. *Billings, et al v. Canadian Billings* (1).

The question as to whether or not part of this trade mark consisting of the words "Deer Skin Finish" and the words "Character Hats" is both descriptive and intended to convey the notion that the goods in connection with which they are used are as described and of high class or superior quality or acknowledged merit—and if so the said trade mark does not contain

the essentials necessary to constitute a trade mark properly speaking, as required by subsec. e of sec. 11 of the Trade Mark Act, is a question I need not decide as it has not been raised by either party. See *Standard Ideal Co. v. Standard Sanitary Co.* (2).

Now it is the use of a trade mark, not its invention, that creates a right to it.

The test in all cases of conflict as to the priority of adoption is, which claimant was first to use the mark as to fix on the market a conviction that the goods so marked had their origin with him.

Paul on Trade Marks 148 and 153, sec. 92. See also *Candee, Swan and Company v. Deere and Company* (3).

The applicant for the registration of a trade mark in Canada must be the first user in Canada. *Vess Jones v. Horton* (4). The law upon this question is well settled.

(1) (1921) 20 Ex. C.R. 405.
 (2) (1911) A.C. 78, at p. 85.

(3) (1870) 54 Ill. Rep. 439.
 (4) (1922) 21 Ex. C.R. 330.

1929

DOBBS AND
COMPANY
v.

ROBERT
CREAN AND
COMPANY,
LIMITED.

Audette J.

The recent observation of Tomlin J. upon this subject in re *Impex Electrical Ltd. v. Weinbaum* (1) is quite apposite and reads as follows:—

. . . foreign markets are wholly irrelevant, unless it be shown by evidence that in fact goods have been sold in this country with a foreign mark on them, and that the mark so used has thereby become identified with the manufacturers of the goods. If a manufacturer having a mark abroad has made goods and imported them into this country with the foreign mark on them, the foreign mark may acquire in this country this characteristic, that is distinctive of the goods of the manufacturer abroad. If that be shown, it is not afterwards open to somebody else to register in this country that mark, either as an importer of the goods of the manufacturer or for any other purpose. The reason of that is not that the mark is a foreign mark registered in a foreign country, but that it is something which has been used in the market of this country in such a way as to be identified with a manufacturer who manufactures in a foreign country. That, I venture to think is the basis of the decision in the *Apollineris* case. It seems to me to be the basis of the decision in the case before Mr. Justice Clouston of *Lacteosote Limited v. Alberman*, and it seems to me to be consonant with good sense.

It has been abundantly established, by conclusive evidence, that the petitioner, as far back as 1913, to the present day, sold and is selling in Montreal, Canada, his hats with his trade mark thereon and he further sold them in Vancouver, B.C. in 1917 and during some time subsequent thereto.

The objecting party's goods with his trade mark was not put on the market in Canada before 1922 or 1923. Samples were sent in 1922 to one witness, and he placed orders for some of these goods in 1923; but this purchaser failed before the delivery of the goods.

Possibly something should be said about the origin of such trade marks. William H. Dobbs was president and founder of the petitioner company and has honestly adopted and used his own name in devising this trade mark. Moreover the name Dobbs, through its long and continuous user has acquired a secondary meaning. It is a word or name that has been advertised and given great publicity. Re *Elkington and Company* (2); *Christie Brown and Co.* (3); Re *Pacific Lime Company* (4); Re *Horlick* (5); *Hurlbut Shoe Co. v. Hurlbut Shoe Co.* (6).

(1) (1927) 44 R.P.C. 405 at 410.

(2) (1908) 11 Ex. C.R. 293.

(3) (1929) 20 Ex. C.R. 119.

(4) (1920) 20 Ex. C.R. 207.

(5) (1917) 64 S.C.R. 466.

(6) (1925) S.C.R. 141.

These goods have been sold in Canada under the License (filed as exhibit No. 13) and were so sold under that name as per such license. *Qui facit per alium facit per se.*

1929
 DOBBS AND
 COMPANY
 v.
 ROBERT
 CREAN AND
 COMPANY,
 LIMITED.
 Audette J.

Suffice it to say with respect to the origin of the objecting party's trade mark, as disclosed by the evidence, that it is a story of extraordinary character. *Se non è vero è molto ben trovato.* With the "Dobbs" hat already on the Canadian market it would require the credulity of a Judaeus Appella to believe that the objecting party was not influenced in adopting the mark "Dan Dobbs" by a desire to benefit by the reputation that the petitioner's hats had acquired in the trade. "The world is wide," said Lord Bowen in *John Harper & Co. Ltd. v. Wright & Butten Lamp Mfg. Co. Ltd.* (1) "and there are many names. There is really no excuse for imitation."

"Dan Dobbs" and "Dobbs" are obviously words as applied to a particular kind of goods that can be confused and would tend to deceive the ordinary purchaser.

Having found that the petitioner was the first to use his trade mark in Canada and much before the time the objecting party registered his trade mark, I am forced to the conclusion that the petitioner is thereby entitled to the mark as against all others in this country.

Having so found, it becomes unnecessary to say any more and to pass upon secondary questions raised at trial.

Therefore there will be judgment ordering the expunging from the entry in the Canadian Trade Mark Register of the objecting party's specific trade mark, under No. 147, Folio 33279, in accordance with the Trade Mark and Design Act. This being done, the petitioner will be at liberty to renew or proceed with his application for the registration of his own trade mark, as alleged in par. 4 of his petition.

See *Jones v. Horton* (2); *Gold Medal Furniture Co. v. Gold Medal Camp Furniture Mfg. Co.* (3); *Williamson Candy Co. v. W. J. Crothers Company* (4).

The whole with costs against the objecting party.

Judgment accordingly.

(1) (1895) 2, Ch. 593.

(3) (1928) Ex. C.R. 65; (1928) S.C.R. 575.

(2) (1922) 21 Ex. C.R. 330.

(4) (1924) Ex. C.R. 183; (1925) S.C.R. 377.