

1929
 April 15.
 June 19.

JOURNAL OF COMMERCE PUBLISH- }
 ING COMPANY LIMITED..... } PLAINTIFF;
 AND
 RECORD PUBLISHING COMPANY }
 LIMITED..... } DEFENDANT.

*Trade Marks—Name of newspaper—Section 5 of Trade Mark and
 Designs Act—“Trade Marks”—“Trade”—“Manufacture,
 product or Article.”*

Held, that the name of a newspaper is not a proper subject of a trade mark susceptible of being registered under the provisions of the Trade Mark and Designs Act (R.S. 1927, chap. 201).

- (2) That the words “trade mark” have reference to marks applied to goods that are the subject of trade, trade signifying the business of exchanging commodities by barter or by buying and selling for money, and not in the sense of the word as applied to the mechanical arts.
- (3) That a newspaper is not a “manufacture, product or article” within the meaning of section 5 of the Trade Mark and Designs Act.

Hearing on the questions of law raised by the pleadings.

The matter was heard before the Honourable Mr. Justice MacLean, President of the Court, at Ottawa.

W. D. Herridge, K.C. for the plaintiff.

W. F. Schroeder for the defendant.

The facts are as stated in the reasons for judgment.

THE PRESIDENT, now (June 19, 1929), delivered judgment.

This matter comes up by way of hearing before trial on a point of law raised by the pleadings. An order that it be so heard has been duly made.

Shortly stated, the question is as to whether or not the name of a newspaper—the “Canadian Journal of Commerce”—is the proper subject of a trade mark susceptible of being registered under the provisions of the Trade Mark and Designs Act (R.S. 1927, chap. 201). As a matter of fact the name is now registered in the name of the plaintiff as a specific trade mark. The Act provides that “a specific trade mark” means a trade mark used in connection with the sale of merchandise of a particular description. Section 5 describes what shall be deemed to be trade marks, and as such registerable. That section reads:—

All marks, names, labels, brands, packages or other business devices, which are adopted for use by any person in his trade, business, occupation or calling, for the purpose of distinguishing any manufacture, product or article of any description manufactured, produced, compounded, packed or offered for sale by him, applied in any manner whatever either to such manufacture, product or article, or to any package, parcel, case, box or other vessel or receptacle of any description whatsoever containing the same, shall, for the purposes of this Act, be considered and known as trade marks.

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That it is possible in the present state of the newspaper business to argue that the newspaper in its common form is an article "manufactured or produced" must be admitted. But it is only a plausible argument as related to a correct interpretation of the Act in question when it was passed by the legislature.

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The very words "trade mark" are not without significance. It has reference I think to marks applied to goods that are the subject of trade. And I use the word "trade" here as signifying the business of exchanging commodities by barter or by buying and selling for money; not in the sense of the word as applied to the mechanical arts. I venture to observe further that the legislature when enacting the Trade Mark Act, had in mind that a commercial meaning attached to the word "trade," that is, that it related to merchandise, goods, or manufactured articles, all of which words are used in the Act, and that it never considered a newspaper as a commodity of trade and commerce, or something that was traded in. I do not think that section 5 of the Act ever contemplated the inclusion of a newspaper as a "manufacture, product or article," the name of which might be registered as a trade mark. One does not ordinarily refer to a newspaper as a manufactured article or as a class of merchandise, and these words afford, in my opinion, the best key as to what things it was intended a trade mark might be applied to, within the meaning of the Trade Mark Act. The words "marks, names, labels, brands, packages or other business devices," do not seem to suggest the name of a newspaper as a trade mark, but rather something that might be applied to what is undeniably an article manufactured or produced as a commodity of commerce. The words "manufactured, produced, compounded, packed or offered for sale" would seem to have reference to ordinary articles of commerce rather than a newspaper. The provisions of the Inter-

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national Convention which relate to trade marks, distinctly leave one with the impression that "trade marks" was there understood as something to be applied to "goods," in fact that word is frequently there to be found. I do not think that that word can be appropriately applied to newspaper. A newspaper is a record of facts or representation of facts, events, opinions, speeches, advertising matter, etc., and this, printed upon paper, is sold to the public under a certain name. A newspaper is fundamentally different from the ordinary articles of commerce. I think that the name of a newspaper is the name of the thing itself which is different from a name used as a trade mark. In practice some name has to be given a newspaper, and the name of a thing is not usually registerable as a trade mark; it may be, if it happens to be a fancy or invented word or name applied to a new article of commerce being introduced to the public. Invented names are not so easily applied to newspapers, as to manufactured goods or commodities of commerce. I do not think the Act ever contemplated that the name of a newspaper was registerable as a trade mark, although it is conceivable that a newspaper might adopt a trade mark other than its name.

There are practical difficulties in the way of the registration and user of the names of newspapers as trade marks, and that is one of the reasons which influence me to the conclusion that the legislature never intended that the names of newspapers might be registered as trade marks. Usually newspaper names are descriptive, or at least suggestive, of what a newspaper is, a purveyor of news. For instance, such names as "News," "Herald," "Journal," or "Gazette," and many others, indicate that the newspaper carries, records, gazettes, or heralds in printed form what is popularly spoken of as news of the day or time. The appropriate names available to newspapers to-day are therefore limited. There is therefore to be found a great similarity the world over in the names of newspapers, and this is true also of any particular country. If such names might be registered as trade marks great confusion would arise because so many newspapers have already adopted the same in Canada, and I doubt very much, if one newspaper is entitled to a monopoly of a word or words, such as is commonly used as newspaper names.

I also doubt if it would be possible to satisfactorily administer the Trade Mark Act, in respect of newspapers, if their names were registerable as trade marks. For instance how would the International Convention be made operative or practical, if it was found that twenty newspapers in twenty different countries registered the same name. Newspapers bearing the same name, and published in substantially separate localities, rarely if ever cause confusion to their respective readers. I do not say that this may be true of this case because I have not yet heard the facts. There is usually something in the make-up of newspapers which distinguish them, even to the most casual. In this fact there is again found something, which seems to place newspapers in a different category to that which the world regards as articles of commerce. It was not therefore intended, I believe, to include newspapers as articles to which trade marks might be applied, and for the reason, that at the time of the passage of the Act, newspapers were not regarded as merchandise or manufactured articles or matters of trade and commerce; a registered trade mark was not regarded as necessary for newspapers.

The names of newspapers are apparently not registered as trade marks in England, but I was informed that newspapers are there required to be registered at Stationer's Hall, but what this means was not made clear to me. It is probably a practice of ancient origin and in the nature of a license. English cases were cited to me in which the names of newspapers were regarded by courts as trade marks. The name of a newspaper is, in a certain sense, a trade mark, that is, it is what is known as a common law trade mark. Courts of equity in England, in long past years, in the exercise of their jurisdiction in the matter of fraud, had been in the habit of issuing injunctions against the false use of a trade name—which would include the name of newspapers—practised for the purpose of "passing off" goods as those of another person. It is not now necessary to aver or prove fraud, to sustain passing off actions. It is sufficient to show that the act complained of is calculated to deceive the public, and cause probable injury to the complainant. That was and is also true of the Courts of the United States, and almost every American decision cited to me in this proceeding were actions of this kind.

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Unregistered trade marks notwithstanding the prohibiting sections of the Act, which purport to make registration a condition precedent to litigation to restrain or to obtain damages for infringement, are protected in passing off actions, upon the equitable principle that no man shall pass off his goods as the goods of another. Clear of the statute therefore, what is known as a common law trade mark, is entitled to protection in equity, in case of another using that mark in such a way as to deceive the public and to do injury to another. And the common law is probably ample, in the domain of the press to afford all necessary protection in respect of newspaper names. The reported decisions in England and the United States, upon what is known in both countries as common law trade marks, must be distinguished from those referable to statutory trade marks.

The case of the *New York Herald Co. v. The Ottawa Citizen Co.* (1) was pressed upon me as conclusive of the issue here. The real issue there was so different from that with which I am dealing, that I can hardly regard that case as relevant or authoritative in this matter. A case is only useful for the principle it decides, and what was actually decided in that case does not seem related to the matter before me.

My conclusion is that the Trade Mark and Designs Act does not contemplate or intend the names of newspapers, to be trade marks, and they are not therefore registerable as trade marks. The trade mark in question is not in my opinion proper subject matter for trade mark registration. I reserve for the present the matter of the cost of this proceeding.

Judgment accordingly.