

BIRMINGHAM JEWELLERS AND } PETITIONER;
SILVERSMITHS' ASSOCIATION.. }

1929
June 10.
July 17.

AND

W. N. STOCK.....RESPONDENT.

Trade Marks—Party aggrieved—Locus standi—Convention for the Protection of Industrial Property, 1925—18-19 Geo. V, c. 10.

The petitioner asked that the trade mark of the objecting party, registered in Canada in 1902, consisting of three panels placed side by side, the maple leaf with the letter "E" thereon constituting the central panel, the left panel having the representation of an anchor and the right one that of a lion, be expunged as likely to be confused with the Birmingham Hall or Assay Office mark, consisting of an anchor to indicate that particular assay office, and a lion passant to indicate standard or quality, and as being calculated to deceive.

The petitioner is a mutual non-trading association of manufacturers of and wholesale dealers in silverware, etc. It is not itself a manufacturer or seller or user of Hall Marks and has no trade mark.

Held, that the petitioner is not a party aggrieved within the meaning of the Trade Mark and Designs Act.

- 2. That the amendment of the Trade Mark and Designs Act passed in 1928 (18-19 Geo. V, c. 10), adding paragraph (g) to sec. 11 of R.S. (1927), c. 201, was intended as a partial adoption of the terms of Article 6 (ter) of the Convention for the protection of Industrial Property, signed at The Hague in 1925, and to which Canada was a signatory.
- 3. That the effect of the addition of said paragraph (g) to sec. 11 of the Trade Mark Act was merely to add to the grounds upon which the Minister might refuse to register a mark. The fact that the Minister is now empowered, by said paragraph, to refuse to register trade marks which consist in whole or in part of "official control or guarantee signs or stamps" adopted by another country, is indicative of the fact that prior to 1928 it was not intended by the Trade Mark Act that a trade mark might be refused registration upon the ground that it consisted of "official control and guarantee signs or stamps."

PETITION by the petitioner to have a certain trade-mark of the respondent, comprising Armorial bearings and Emblems, expunged.

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

H. J. McNulty for the petitioner.

George Wilkie, K.C., for the respondent.

The facts are stated in the reasons for judgment.

THE PRESIDENT, now (July 17, 1929), delivered judgment.

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In this proceeding by way of petition, the Birmingham Jewellers' and Silversmiths' Association of the City of Birmingham, England, ask that a specific trade mark, registered in 1902 by P. W. Ellis & Co. Limited of the City of Toronto, manufacturers of silver goods, be expunged. The mark consists of three panels placed side by side, a maple leaf with the letter "E" thereon constituting the central panel, the panel to the left having the representation of an anchor, and the one to the right the representation of a lion. The mark was to be applied to sterling silver, jewellery, flat and hollow ware, medals, and other sterling silver goods. The business of Ellis & Co., and also the trade mark in question, has been recently acquired by W. N. Stock who now carries on the business as "W. N. Stock successor to P. W. Ellis & Company Limited," I should perhaps state, that the letter "E" in the central panel of the registered trade mark indicates the name of Ellis, and also that Stock appeared in opposition to the petition to expunge the mark in question.

In Great Britain, four marks are generally to be found upon gold and silver goods; the standard or quality mark indicating that the article is of gold or silver of the standard indicated; a hall-mark indicating the particular Hall or Assay Office at which the goods were tested and marked, and there are about six of such Halls or Assay Offices in Great Britain to-day, each having a different mark; the date letter indicating the year in which the article was assayed and marked; and lastly the initials of the maker of the article. The issue here relates to the Birmingham Hall or Assay Office marks, which consists of an anchor to indicate that Assay Office, and a lion passant to indicate the standard or quality; in practice then would follow the mark of the year of assay, and the makers mark. As I understand it, the only marks placed on an article by the Birmingham Assay Office are the anchor and the lion, the other marks if used are afterwards placed on the article by the maker, but as I understand it, such marks are not strictly speaking hall-marks; hall-marks are those marks placed on articles at the Assay Offices

The petitioner's case is that two of the symbols employed on the Ellis mark are identical with the symbols used by the Birmingham Assay Office, namely, the anchor and the

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The name "A. R. McMaster" on page 137, should read
"A. C. McMaster."

lion, and that this mark is therefore calculated to deceive the public, because, it is said, that marks of this kind are generally understood throughout the world as hall-marks and to be the marks of the British standard, for standard and sterling silverware.

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Several difficult questions arise here, altogether apart from the merits of the case, and perhaps the first to decide is whether or not the petitioner has a *locus standi* in this proceeding. It was not pleaded by Stock, the respondent, that the petitioner was not a person aggrieved. The Trade-Mark Act, sec. 45 states:—

The Exchequer Court of Canada may, on the information of the Attorney General or at the suit of any person aggrieved . . . make such order for making, expunging or varying any entry in any such register as the Court thinks fit; or the Court may refuse the application.

However, on the hearing of the petition, counsel for Stock urged that the petitioner was not a party aggrieved, and that upon this ground alone the petition should be dismissed. As this point is one relating to the jurisdiction of the Court, it is no objection to entertaining this defence, I think, that this provision of the Trade Mark Act was not pleaded. *Brunning v. Odhams Bros. Ltd.* (1). I shall allow the necesasry amendment to be made to the pleadings, so as to comprehend the objection that the petitioner is not a party aggrieved.

Upon a consideration of this objection to the petition, I am of the opinion that the petitioner is not a party aggrieved. In a printed publication, put in evidence, the Birmingham Jewellers' and Silversmiths' Association is said to have been founded in 1887, and is there described as a mutual non-trading association of manufacturers of and wholesale dealers in jewellery, silver and electroplate wares, rolled, gold, gilt and imitation jewellery, cases, fancy leather, and optical and all allied articles. The Association is therefore representative not only of those who manufacture but also of those who deal, in silver goods of a standard quality; it includes also manufacturers of and dealers in electroplate wares, imitation jewellery, leather goods, etc. The members of the Association are not necessarily manufacturers of and dealers in standard silver goods bearing the Birmingham hall-marks, because a Birmingham manu-

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facturer may, according to the evidence, have his goods assayed and marked at the London Assay Office, or at any other Assay Office in England. The Association does not manufacture or sell goods. It is not an Association of users of hall-marks. It has no trade-mark. I do not see how it can be said that the petitioner is a party aggrieved; it may be that some of its members might be persons aggrieved within the meaning of the Trade Mark Act. I should have some doubt, even if the Association were avowedly composed only of persons using the Birmingham hall-marks, that it would be a person aggrieved. The petitioner here asks that the Ellis mark be expunged, because it comprises the two hall-marks of Birmingham, the anchor and the lion, which are not trade marks either under the statute or by common law, here or in England, and it is these two marks—official marks of place and quality—that are asked to be expunged. Now can it be said that the Trade Mark Act of Canada ever contemplated that such marks—not trade marks in any sense—would make a person upon whose goods such marks were officially stamped, a person aggrieved, and entitle him to ask that a trade mark belonging to a third person should be expunged? To give one a *locus standi* in an action under the Trade Mark Act, one should I think own or claim to own, a trade mark registered or unregistered. No such claim is made here; what is claimed is that certain hall-marks so-called, markings required by law in one country to denote the quality of an article are not properly registerable as a trade mark in another country. It may be quite undesirable to permit the nationals of one country to use as trade-marks, any mark corresponding to the hall-marks in question, and which have been adopted for a purpose other than trade marks in another country. That I think can only be prevented by adequate legislation. And this leads me to the point whether this was done or not.

Section 11 of the Trade Mark Act, chap. 201, R.S.C. 1927, was amended by chap. 10 of the Statutes of Canada 1928, by adding thereto the following subsection:—

(g) If the trade mark consists in whole or in part of coats-of-arms, flags, and other state emblems of countries which by treaty, convention or agreement affords similar protection to nationals of Canada, official control and guarantee signs and stamps adopted by such countries, and imitations from a heraldic point of view, the registration of official control

and guarantee signs and stamps to be refused only in cases where such signs and stamps are intended to be used on merchandise of the same or a similar nature.

I think it is fairly clear that a portion of paragraph (g) has reference to hall-marks as used in England, that is to say, that hall-marks are "official control and guarantee signs and stamps." I think that such words were intended to refer to marks of that nature. The enactment of this provision of the statute was, I think, in consequence of some provisions of the International Convention for the Protection of Industrial Property which was signed at The Hague in May, 1925, and to which Canada was a signatory, and which made certain modifications to the International Convention signed at Paris in 1883, revised at Brussels in 1900 and at Washington in 1911. The Convention and the accession of Canada thereto may be referred to by the Court as a matter of history, in order to enable it to understand in what circumstances this provision of the Trade Mark Act was enacted; but the terms of the Convention cannot be employed as a guide to interpret the statute, because a treaty with another State binds, the citizens of Canada, only in so far as it has been embodied in legislation enacted in the ordinary way. *Carter Medicine Co's. Trade-Mark* (1), North J.; *California Fig Syrup Co's. Trade-Mark* (2), Stirling J.; and *Walker v. Baird* (3). I think it is clear that this particular amendment to the Trade-Mark Act under discussion, was intended as a partial adoption of the terms of Article 6 (ter) of the Convention. This I think will appear clear from a reading of the first paragraph of that Article where the words "official signs and hall-marks indicating control or warranty adopted by them" are used. The effect of the addition of this paragraph to sec. 11 of the Trade Mark Act, is merely to add to the grounds upon which the Minister might refuse to register a mark. The fact that the Minister is now empowered by paragraph (g) of the Statute of 1928 to refuse to register trade marks which consist in whole or in part of "official control and guarantee signs and stamps" adopted by another country—and they are not now being registered—is indicative of the fact, that prior to 1928, it was not intended by the Trade Mark Act that a trade mark

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(1) 1892) 9 R.P.C. 401.

(2) (1888) 6 R.P.C. 126.

(3) (1892) A.C. 491.

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might be refused registration upon the ground that it in whole or in part consisted of "official control and guarantee signs and stamps" adopted by another country. If I am correct in that conclusion then the registration of the trade mark of Ellis & Co. in 1902 was not an invalid registration under the Trade Mark Act of that date. It is also to be observed that this statutory provision is available only to the nationals of such other countries as afford similar protection to nationals of Canada, and it was not therefore intended to be of general application, which but adds force to the view that no such provision was by intendment to be found in the Trade Mark Act prior to 1928. If there be any doubt as to the proper construction of this provision of the Trade Mark Act, it should be construed in favour of those holding vested rights in the registered mark here sought to be expunged. That mark was used by Ellis & Co. for about twenty-seven years, and applied in that period to millions of dollars worth of goods, and it was recently acquired by Stock, by assignment, along with the business and good will of P. W. Ellis & Co. It would only be by very plain and apt words to be found in the statute, that I would feel justified at this date in ordering a cancellation of the mark.

The petition is therefore dismissed and the costs will follow the event.

Judgment accordingly.