

IN THE MATTER OF THE PETITION OF THE
 BUCYRUS COMPANY of South Milwaukee, in the
 State of Wisconsin, one of the United States of
 America, Manufacturers;

1912
 June. 19.

AND

IN THE MATTER OF THE
 TRADE-MARK "CANADIAN BUCYRUS" as
 applied to the sale of Steam Shovels and Wrecking
 Cranes.

Trade-mark—Geographical name—Secondary meaning—Right to register.

Over thirty years before petition filed, the petitioners' predecessors in title set up business in the town of Bucyrus in the State of Ohio, as iron founders and manufacturers. Subsequently the petitioners became incorporated in that State under the title of the Bucyrus Shovel and Dredge Company. In 1893 the petitioners took over the business, removed to South Milwaukee, in the State of Wisconsin, and became incorporated under the laws of Wisconsin as the "Bucyrus Steam Shovel and Dredge Company". From that time on they made a specialty of the manufacture of railway wrecking cranes, steam-shovels and railway pile-drivers, and appliances connected therewith. The articles, so manufactured were not protected by patents or trade-marks in the United States, but the word "Bucyrus" was applied to such articles either alone or in some combination, to distinguish the goods, and became well-known to the trade. In 1904 the respondent was appointed sole agent for Canada and Newfoundland for the manufacture and sale of the petitioners' goods, under a written agreement whereby the petitioners undertook to supply the respondents with blue prints, drawings and other sources of information concerning their goods, for the purpose of promoting the sale thereof in Canada and Newfoundland. The agency under said agreement was terminated in 1909. Thereafter the respondent proceeded to manufacture in Canada goods similar to those made by the petitioners with the designation "Canadian Bucyrus" attached to them, and in 1911 caused these words to be registered as a specific trade-mark at Ottawa.

Held, that the respondents' trade-mark was bad, and should be expunged from the register.

2. That the word "Bucyrus" had become identified with the goods manufactured by the petitioners and had so acquired a secondary meaning;

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and that the petitioners were entitled to register in Canada the word "Bucyrus," as a specific trade-mark to be applied to the sale of goods manufactured by them.

THIS was a petition praying that the entry of a certain specific trade-mark be expunged from the register of trade-marks, and that the petitioners be allowed to register a certain specific trade-mark.

The facts of the case are sufficiently stated in the head-note.

June 6, 1912.

The case came up for trial at Toronto before Mr. Justice Cassels.

D. L. McCarthy, K.C., and *Britton Osler*, for the petitioners.

J. K. Kerr, K.C., and *J. A. Paterson, K.C.*, for the respondents.

At the trial the learned Judge delivered the following oral judgment, directing the respondents' trade-mark to be expunged from the register:—

"I have not the slightest doubt that the respondent's trade-mark has not been properly registered. The evidence before me is that the petitioners have been manufacturing these articles for years, and their product has become known in the trade as that of the Bucyrus Company. The respondents were under an agreement with the Bucyrus Company, had entered into covenants with them, by which they were to have the sole right to manufacture and sell these articles in Canada. The word "Bucyrus" was put on each article, and that went on for years. It became known to the trade, and their product became known as the product of the Bucyrus Company in the States. That being so, how can the respondents come in, and, by prefixing a word, get a valid trade-

mark? The result would mean this, that if the petitioners sent their articles into Canada, and called them "Bucyrus," a judge could restrain them from selling under the name under which they had been sold for years. It is not a passing-off case. The defendants are not guilty of any attempt to defraud. Circulars are issued marked "manufactured in Canada," and they are shown to be manufactured by the Canada Foundry Company, and most people would understand that they were manufactured by the Canada Foundry Company. Supposing that they advertised "Canadian Bucyrus," and did not use these particular words, they would simply run the risk of having a suit for passing-off; but they are not bound to use those words. The sole question is whether "Canadian Bucyrus" is capable of being a trade-mark after the word "Bucyrus" has been on the market for years.

I direct that the registration is to be expunged, and the trade-mark cancelled."

The question of the petitioners' right to register the word "Bucyrus" was reserved.

CASSELS, J. now (June 19th, 1912) delivered judgment on the question reserved.

This was a petition filed by the Bucyrus Company of South Milwaukee, asking to have a certain trade-mark consisting of the word "Canadian Bucyrus" registered by the Canada Foundry Company, Limited, expunged from the register of trade-marks. The Bucyrus Company also asked for an order that their trade-mark "Bucyrus," as applied to wrecking cranes, steam-shovels, and railway pile-drivers, together with appliances and devices for use therewith, should be registered.

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The case came on for trial before me in Toronto on the 6th June, 1912. At the close of the hearing in Toronto, I gave judgment ordering the trade-mark "Canadian Bucyrus" to be expunged. I gave my reasons for judgment orally at the trial. I reserved for further consideration the question of the right of the "Bucyrus Company" to register the word "Bucyrus" as a trade-mark. Since the trial I have considered the evidence and the various authorities, and I am of the opinion that the Bucyrus Company are entitled to register a specific trade-mark "Bucyrus" as applied to the articles mentioned. I think the word has become identified with the goods of their manufacture and has acquired a secondary meaning.

In a case lately decided by me, of the *Fruitatives, Limited v. La Compagnie Pharmaceutique de la Croix Rouge* (1). I had occasion to point out the care that had to be exercised in considering the English authorities. I do not wish to repeat what I there stated. It appears that "Bucyrus" is a small town in the State of Ohio, where the petitioners' predecessors in title originally started their business. Some years ago they moved to Milwaukee. The Canada Foundry Company rely upon the decision of the Privy Council, in the case of the *Grand Hotel Company v. Wilson*, (2) and contend that "Bucyrus" being a geographical name is not capable of registration as a valid trade-mark. This case, however, was not finally disposed of on the ground that the name was a geographical name. It was a case tried before the learned Chancellor of Ontario, who gave judgment for the plaintiffs.(3) This judgment was reversed by the Court of Appeal, Moss, C. J., dissenting and agreeing

(1) Reported *ante* p. 30.

(2) (1904) A.C. 103.

(3) 2 O.L.R. 322.

with the judgment of the Chancellor.(1) An appeal was taken to the Privy Council, and judgment was delivered affirming the Court of Appeal. It is necessary to consider the judgment. The judgment of their lordships was delivered by Lord Davey. He points out that the first fact to be noted is that the goods in question are not a manufactured article, or, in other words, the name which it is sought to protect is not the name for the appellants' make of goods, but, to put it most favourably for the appellants, designates water from particular springs belonging to them. The waters derive their virtues from the strata from which they spring, or through which they pass, before they reach the surface—that is to say, from the inherent properties of the soil itself in that particular locality.

Further on he states: "It is quite true that the same trade name may designate the goods of more than one person, but it is less easy to infer that a geographical description has acquired a secondary meaning when you find that it is used to designate the goods of two or more persons connected only by identity of geographical origin." (2)

In commenting upon the Stone Ale case (*Montgomery v. Thompson*, (3) His Lordship uses the following language: "Their Lordships are therefore of opinion that the appellants have not a right to the exclusive use which they claim of the word 'Caledonia' in connection with their waters. The Stone Ale case does not appear to them to have any bearing on the present case. That was a case of a manufactured article, etc."

(1) 5 O.L.R. 141.

(2) (1904) A.C. 110, 111.

(3) (1891) A.C. 217.

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I order that the petitioners be at liberty to register the word "Bucyrus" as a specific trade-mark to be applied to the articles mentioned.

I direct that the Canada Foundry Company, Limited, pay the costs of the petition and of these proceedings.

Judgment accordingly.

Solicitors for the Petitioners: *McCarthy, Osler, Hoskin & Harcourt.*

Solicitors for the Respondents: *Kerr, Davidson, Paterson & McFarlane.*