

<p>1936 Oct. 13 & 14.</p>	<p>THE KITCHEN OVERALL & SHIRT } CO. LTD.</p>	<p>PLAINTIFF;</p>
<p>AND</p>		
<p>1937 Oct. 28.</p>	<p>THE ELMIRA SHIRT & OVERALL } CO., LTD.</p>	<p>DEFENDANT.</p>

Trade-mark—Passing off—Unfair Competition Act, 22-23 Geo. V, c. 33, s. 11 and s. 4, ss. 4—Trap orders—Insufficient notice given of instances relied upon—Isolated instances—Onus on plaintiff not discharged—Conduct of defendant calculated to deceive—Unfair dealing on part of defendant—Injunction granted.

The plaintiff, a manufacturer of goods consisting chiefly of men's overalls, shirts and pants, brought this action against defendant to restrain it from using the words "Bruce Kitchen" in association with its goods, on the ground that the same is calculated or likely to cause confusion between the goods of the plaintiff and those of the defendant. The statement of claim contained a general allegation that the defendant had sold and passed off its goods as those of the plaintiff.

Plaintiff's business had been originally founded by two brothers of the name of Kitchen and its goods have been sold for many years under the trade name of "Kitchen," "Kitchen's" or "Kitchens" by means either of a small label sewn on the garments, or by a card affixed in some way to the garments, or by both means. The plaintiff also advertised its goods extensively, displaying the word "Kitchen" or "Kitchen's" quite conspicuously in all advertising matter. Plaintiff's business was a large one and its customers, who were retailers, in ordering specific garments, would very frequently describe them by the prefix "Kitchen."

Bruce Kitchen, a brother of the original founders of plaintiff's business, is manager of defendant company, having been appointed in May, 1934; he is also a shareholder, a director and treasurer of defendant company. From 1909 to 1934 he had been employed by plaintiff company or its predecessors, and had become personally acquainted with dealers in the plaintiff's goods throughout a large part of Canada. In December, 1935, defendant obtained registration of the words "Bruce Kitchen" as a trade-mark, for use in connection with the manufacture and sale of overalls, pants, coats, windbreakers and other garments, and on all garments sold by defendant to retailers

the words "Bruce Kitchen" appear more conspicuously than any other words on the labels attached to such garments; examples of the wording are "The Bruce Kitchen" (Guaranteed Shirt) of Elmira, "The Bruce Kitchen (Guaranteed Product) of Elmira," or "A Bruce Kitchen Guaranteed Product."

Plaintiff adduced evidence of certain instances of passing off of defendant's goods as those of the plaintiff in response to oral trap orders given by a person on behalf of plaintiff. The reception of this evidence was objected to by defendant on the ground that particulars of such evidence should have been given to the defendant immediately after the occurrence of those incidents.

Defendant objected that since plaintiff's trade-mark was unregistered, no action for infringement would lie by virtue of s. 4, ss. 4, of the Unfair Competition Act.

Held: That the plaintiff's action is founded on s. 11 of the Unfair Competition Act, 22-23 Geo. V, c. 38, and therefore properly instituted irrespective of whether or not plaintiff's trade-mark were registered.

2. That in an action for passing off the offence must be proved in the fullest possible way and notice as soon as practicable of the incidents relied upon should be given to the defendant.
3. That the defendant's conduct is not one of fair dealing, and its course of conduct is such as is likely to lead to confusion and the plaintiff is therefore entitled to the relief claimed.

ACTION by the plaintiff asking for an injunction restraining defendant from using the words "Bruce Kitchen" in association with its goods.

The action was tried before the Honourable Mr. Justice Maclean, President of the Court, at Ottawa.

E. G. Gowling and *D. K. MacTavish* for plaintiff.

O. M. Biggar, K.C. and *C. Robinson* for defendant.

The facts and questions of law raised are stated in the reasons for judgment.

THE PRESIDENT, now (October 28, 1937) delivered the following judgment:—

In this action the plaintiff, having its principal office at Brantford, Ontario, seeks to restrain the defendant from using the words "Bruce Kitchen" in association with its goods, on the ground that the same is calculated or likely to cause confusion between the goods of the plaintiff and those of the defendant, the former of which, it is alleged, have been distinguished for a long number of years by the use of the unregistered trade mark or trade name of "Kitchen"; and it is alleged that the plaintiff's goods, of the same general character as those produced by the de-

1937

KITCHEN
OVERALL
& SHIRT
CO. LTD.

v.

ELMIRA
SHIRT &
OVERALL
CO. LTD.

Maclean J.

1937

KITCHEN
OVERALL
& SHIRT
Co. LTD.
v.
ELMIRA
SHIRT &
OVERALL
Co. LTD.

Maclean J.
—

defendant, chiefly men's overalls, shirts and pants, bearing the said name "Kitchen," have become known to the trade and public in Canada as the goods of the plaintiff company. The facts of the case are unusual, and the point to be determined is of importance and not free from difficulty.

It will be convenient first to dispose of a preliminary point raised by Mr. Biggar. The statement of claim refers frequently to the word "Kitchen" as a "trade mark" and Mr. Biggar very properly contended that if the word were a trade mark, and unregistered, no action for infringement would lie by virtue of s. 4, ss. 4, of the Unfair Competition Act which provides that no person shall institute any proceedings to prevent the infringement of any trade mark unless the trade mark is registered. It is evident that the action here is not one for "infringement," that word not being once used in the statement of claim, nor is it alleged that the word "Kitchen" is registered as a trade mark. On the other hand, one paragraph of the statement of claim alleges that the defendant wrongfully sold and passed off, and continues to do so, the plaintiff's goods as its own. I do not think therefore that the defendant could have been led to believe that the action was one for the infringement of a trade mark. Whether the mark "Kitchen" falls within the definition of "trade mark," as found in s. 2 (m) of the Act, is perhaps questionable, but I can hardly say that the plaintiff was not entitled in its pleadings, or at the trial, to refer to the mark in question as a "trade mark," even though it be not strictly accurate. The action is what has been long known as one for "passing off," that is to say, it is based on the allegation that the defendant has represented, or has done some act calculated to lead the ordinary purchaser to believe that its, the defendant's goods, are the goods of the plaintiff. That may be proved by establishing that the defendant has adopted methods of business which are calculated to lead purchasers intending to buy the goods of the plaintiff to buy in mistake the goods of the defendant. In a trade mark action the plaintiff must prove his title to the mark he claims, and proof of registration is, at least *prima facie* proof of title. If the mark has been actually or substantially copied that constitutes infringement although it is not shown that the copy is calculated to deceive. In a passing-off action the plaintiff's case

is very similar to this, but registration forms no part of it, and it must be established that the conduct of the defendant is calculated to pass off the defendant's goods as his. That is the nature of the plaintiff's action here, whatever it be called, and I do not think it important how the plaintiff describes the name or mark which it alleges the defendant substantially copies in such a way as to deceive or cause confusion, between their respective wares, in Canada.

In this case, however, we are governed by the Unfair Competition Act, enacted in 1932, which by s. 11 gives a statutory right of action for the same wrongs for which a remedy was given at common law in passing off cases. The plaintiff's action is founded upon that statutory provision, which is as follows:—

No person shall, in the course of his business, (a) make any false statement tending to discredit the wares of a competitor; (b) direct public attention to his wares in such a way that, at the time he commenced so to direct attention to them, it might be reasonably apprehended that his course of conduct was likely to create confusion in Canada between his wares and those of a competitor; (c) adopt any other business practice contrary to honest industrial and commercial usage.

This provision of the Unfair Competition Act was no doubt intended to give legal effect, in Canada, to Article 10 *bis* of the International Convention for the Protection of Industrial Property, made at The Hague on November 6, 1925, to which Canada was a signatory, and adhered to by His Majesty on behalf of the Dominion of Canada. That Article is as follows:—

The contracting countries are bound to assure to persons entitled to the benefits of the Union an effective protection against unfair competition. Every act of competition contrary to honest practice in industrial or commercial matters constitutes an act of unfair competition. The following acts among others shall be prohibited: (1) All manner of acts, of such a nature as to create confusion by any means whatsoever with the goods of a competitor; (2) False allegations in the course of trade, of such a nature as to discredit the goods of a competitor.

Article 10 *ter* of the Convention provided:—

The contracting countries undertake to assure to persons within the jurisdiction of other countries of the Union appropriate legal remedies to repress effectively all acts referred to in Article 9, 10 and 10 *bis*.

Within the terms of Article 10 *bis* of the Convention, and s. 11 of the Unfair Competition Act, would fall those acts or offences for which there was a remedy at common law in actions for passing off, a branch of the law which primarily concerns commerce and which was built up chiefly for the protection of traders and for the prevention of com-

1937

KITCHEN
OVERALL
& SEIRT
Co. LTD.
v.
ELMIRA
SEIRT &
OVERALL
Co. LTD.

Maclean J

1937

KITCHEN
OVERALL
& SHIRT
Co. LTD.

v.
ELMIRA
SHIRT &
OVERALL
Co. LTD.

Maclean J.

mercial dishonesty. If therefore the acts or conduct of the defendant here complained of fall within the ambit of s. 11 of the Unfair Competition Act, the plaintiff then as of right would be entitled to restrain the defendant against the continuance of such acts or conduct, as it would at common law prior to the enactment of s. 11 of the Unfair Competition Act; and that statutory provision seems to express substantially the common law in such cases while at the same time implementing Canada's obligations, in part at least, under the Convention. The decisions of courts in passing off cases may therefore be of assistance in this case. No question was raised as to the jurisdiction of this court to entertain actions of the nature contemplated by s. 11 of the Unfair Competition Act.

For a considerable number of years, since 1918 at least, the goods of the plaintiff, and its predecessors, have been sold under the trade name of "Kitchen," or "Kitchen's" or "Kitchens," by means either of a small cloth label sewn on the garments, or by a card affixed in some way to the garments, or by both means; in the former case the trade name would usually be accompanied by a registered trade mark such as "Railroad Signal," or "Jiffy," or some other registered mark, to distinguish particular garments, for example, "Kitchen's Railroad Signal," on shirts, and similarly by unregistered marks. The cards, while prominently displaying the trade name, would carry other printed matter, for example, "Kitchen's Coat Style Shirt," or "Kitchen's Green Label Quality Shirts," the cards being green in colour in the latter case. For a time, and in the case of some goods, the labels or cards would bear the trade name or words "Kitchen-Peabody," "Kitchen-Peabody Pants," or "Kitchen-Peabody Jumbo Overall"; the word "Peabody" had its origin in the fact that a business concern so known, and engaged in a similar business, also at Brantford, I think, was acquired by the Kitchen concern. The plaintiff advertised its goods quite extensively through trade journals and newspapers, and by circulars, booklets, and otherwise, expending in this connection between 1918 and 1935 inclusive, approximately the sum of \$135,000. In all this advertising matter the word "Kitchen" or "Kitchen's" was displayed quite conspicuously. Customers of the plaintiff, who were retailers, in ordering specific

garments, would very frequently describe the same by the prefix "Kitchen," for example, "Kitchen Shirts," of a given size.

As I understand it, the founders of the plaintiff's business were two brothers of the name of "Kitchen." Later, it would appear from the evidence, the business was conducted for a time under the partnership name of "Whitaker and Kitchen," and then for about two years prior to 1912 under the name of The Kitchen Overall and Shirt Company, which company was incorporated in 1912 under the laws of the Province of Ontario. Later, that corporation forfeited its provincial charter and acquired another under the provisions of the Dominion Companies Act, under which charter the plaintiff company now carries on its business. The Kitchen brothers, founders of the business, were, in their lifetime, shareholders in both corporations, and their several interests in the plaintiff corporation, or a portion of the same, is presently held by their heirs.

One, Bruce Kitchen, a brother of the original founders of the plaintiff's business, is the manager of the defendant company, having been appointed in that capacity in May, 1934; he is also a shareholder, a director, and the treasurer, of the defendant company. The defendant company was incorporated in 1933 under the name of the "Elmira Garment Company Ltd.," under the laws of the Province of Ontario, and in that year it first began business. In 1934 its name was changed to "The Bruce Kitchen Company Ltd.," and in 1935, as a result of the protest of the plaintiff company, that name was abandoned at the instance of the Provincial Secretary of the Province of Ontario, and the present name of the defendant company was adopted. From 1909 to 1934 Bruce Kitchen was in the employ of the plaintiff company, or its predecessors, in one capacity or another, but from 1920 to 1934 he acted in the capacity of travelling salesman, and he thus became personally acquainted with dealers in the plaintiff's goods throughout quite a section of Canada. When he joined the predecessor of the defendant company, the Elmira Garment Company Ltd., he acquired shares therein to the par value of \$1,500, which then made the issued capital of the company \$15,000, and he states that that company then agreed to sell its business to him whenever he was ready to take over the

1937
 KITCHEN
 OVERALL
 & SHIRT
 Co. LTD.
 v.
 ELMIRA
 SHIRT &
 OVERALL
 Co. LTD.

Maclean J.

1937

KITCHEN
OVERALL
& SHIRT
Co. LTD.

v.
ELMIRA
SHIRT &
OVERALL
Co. LTD.

Maclean J.

same. He shortly afterwards caused an application to be made to change the name of the company to "The Bruce Kitchen Company Ltd.," the alleged reason being that he did not want to build up a business under the name of the "Elmira Garment Company Ltd.," if it were to become his business, and because he had "such a wide clientele." By "clientele" I think he must refer to the plaintiff's clientele with whom he had become acquainted, and who, Kitchen himself states, "always called him Bruce." The name "The Bruce Kitchen Company Ltd.," as already explained, was a few months afterwards changed to that of the defendant company. In April, 1934, an agreement was entered into between the Elmira Garment Company Ltd., and Bruce Kitchen, wherein the former gave the latter the exclusive option to purchase, on giving thirty days' notice in writing, its assets, subject to certain stated exceptions. There was no stated time within which Kitchen was to exercise the option and he has not yet done so. If the option is exercised at any time the amount to be paid the defendant company is to be agreed upon between the parties, and failing that to be determined by three arbitrators.

In December, 1935, the defendant company applied for and obtained registration of the words "Bruce Kitchen," in the form of the facsimile signature of "Bruce Kitchen," as a trade mark, for use in connection with the manufacture and sale of overalls, pants, coats, shirts, windbreakers, etc. The cloth labels, or printed cards, sewn or affixed to the defendant's goods, shirts at least, when forwarded to dealers, bear the words "The Bruce Kitchen (Guaranteed Product) of Elmira," or "The Bruce Kitchen (Guaranteed Shirt) of Elmira," or, "A Bruce Kitchen Guaranteed Product," sometimes with other words added. In all cases the words "Bruce Kitchen" seem to be displayed more conspicuously than any other words used. In the case of the cloth labels sewn on the defendant's garments the word "Elmira" is used quite distinctly in addition to the words "Bruce Kitchen," but without any other words; in the case of the printed cards, affixed otherwise to the garments, while the words "Bruce Kitchen" and other words stand out in very conspicuous type, the words "The Elmira Shirt & Overall Company Limited, Elmira, Ontario," are in rela-

tively inconspicuous type. I should state that before Bruce Kitchen joined the Elmira Garment Company Ltd., that company used certain trade marks or names, but so far as I can recall, it does not appear from the evidence what they were.

Coming now to a brief review of the evidence adduced by the plaintiff in support of its action, Mr. Learie, Secretary of the Canadian Association of Garment Manufacturers, for fifteen years prior thereto general manager of W. R. Johnston Company, of Toronto, clothing manufacturers, and acquainted more or less with the plaintiff's product since 1914, and which he stated have been generally known throughout the trade as "Kitchens," testified that the similarity of the trade names used by the plaintiff and the defendant would undoubtedly mislead or confuse him. Mr. Linahan, for seven years in the employ of J. M. Strachan, of St. Clair avenue, Toronto, and who sell men's work pants and shirts among other articles of wear, testified that customers always asked for the plaintiff's goods as "Kitchen's shirts," or "Kitchen's overalls," as the case might be. A Mr. Laughlin, a commercial traveller for Bradshaw & Sons, of Toronto, manufacturers of overalls and shirts, gave evidence but, if it has any value at all, it would be favourable to the defendant. Mr. Biggs, a son of the president of the plaintiff company, gave evidence in respect of purchases made by him, what is frequently described as "trap orders," that is, purchases made for the purpose of procuring evidence to establish infringement or passing off. This witness went into seven different retail shops in different towns in the Province of Ontario, and in each case he asked for a "Kitchen Navy Blue Shirt, size 16," and in five instances he was sold the defendant's product, while in the remaining cases he received the plaintiff's product. Biggs, I might here point out, did not call the attention of the persons serving him, in the cases where he was sold the defendant's product, to the fact that he had not been sold the article requested, or anything of that sort. The defendant was not advised of these incidents before the trial. Mr. Habbishaw, for fifteen years in the employ of the Canadian Department Stores of Ottawa, Ontario, and its predecessor, testified that the goods of the plaintiff had been known to him by the trade name of

1937

KITCHEN
OVERALL
& SHIRT
Co. LTD.

v.

ELMIRA
SHIRT &
OVERALL
Co. LTD.

Maclean J.

1937

KITCHEN
OVERALL
& SHIRT
Co. LTD.

v.
ELMIRA
SHIRT &
OVERALL
Co. LTD.

Maclean J.

"Kitchen" during the whole of that period, and that the buying public would ask for such goods under the name of "Kitchen." On cross-examination he stated that the public ask for such goods by the name of the "Kitchen Overall & Shirt Company Limited of Brantford," which would seem to me to be a most improbable thing if he intended to say that the buying public would ask for the plaintiff's goods in precisely that way. Another witness, McElroy, a commercial traveller for concerns manufacturing workmen's clothing, testified that the plaintiff's goods were known to him as "Kitchen Overall and Shirts," which, of course, is practically the name of the plaintiff company.

Mr. Biggar objected to the reception of the evidence of Biggs on the ground that the incidents related by him referred to transactions with a party other than the defendant, and that in any event any evidence concerning a trap order given to a defendant, or a third party, should not be received unless particulars are given to the defendant immediately afterwards so that he may investigate the same, and it will be convenient to discuss this evidence before referring to the balance of the plaintiff's evidence.

The plaintiff's statement of claim did not allege, as is sometimes done in such cases, that in response to orders, the defendant, his servants or agents, or a retailer of the plaintiff's goods, passed off the defendant's goods as those of the plaintiff, and all that is alleged is that the defendant has distributed its goods throughout Canada bearing the name "Bruce Kitchen," and has "used" the name "Bruce Kitchen" in association with its wares "by publication of price lists, catalogues and other material bearing the said name 'Bruce Kitchen' identified with the said articles of clothing," and that "the defendant has thereby wrongfully sold and passed off . . . its goods as those of the plaintiff." There being no specific allegation of passing off in response to orders for the plaintiff's goods, particulars were not requested by the defendant, and it is possible that the defendant, upon the pleadings, did not expect to meet that sort of evidence, and at the time of the trial, as Mr. Biggar urged, it was hardly practical to do so because in the meantime about one year had elapsed. Whether or not the plaintiff would have been required to furnish any or all particulars of the incidents, had particulars been

demanded, I need not decide. It does appear that the plaintiff has merely put in issue the fact that the defendant by the use of the words "Bruce Kitchen," on its goods and otherwise, has caused confusion in the trade and in the minds of the public, between the goods of the plaintiff and those of the defendant. The evidence of Biggs is before me and I must decide what weight is to be attached to it, and I propose viewing that evidence just as if the trap orders were given to the defendant, or its servants, and as if the same were not complicated by the intervention of a third party.

It is, of course, open to a trader if he suspects anything in the nature of passing off by any person, in the same line of business, to send trap orders to get at the truth of the matter. It has been frequently held, however, that the order must be clear and unambiguous, it must be brought to the mind of the shopman what was really wanted, and for that reason a written order is always preferable. The words used in asking for the article must denote the plaintiff's goods and the order should be given to a person of responsibility; and when a trap order is executed the defendant, or his assistant, should be informed at once that it is proposed to give evidence in court of the incident relied upon so that he may recall his recollection of the circumstances and be ready to give his reply in court. These rules regarding evidence of this character have been laid down, I apprehend, because in allegations of actual passing off, the burden of proof resting upon a plaintiff is an unusually onerous one. The words of Tomlin J. in the case of *C. C. Wakefield & Co. Ltd. v. Board* (1) are, I think, applicable here. He said:—

There is this observation again to be made here that, if a plaintiff goes and gives an order of this kind, intending to found an action on it and believing that the order is going to be executed dishonestly, it is essential that he should give the order in terms which are clear and capable of being understood and that he should give it to somebody who is sufficiently responsible. I confess that the plan of campaign here seems to me wholly inadequate, that you should go to a place, give an order to a boy in a casual offhand sort of way and then rest on the result of that order, without satisfying yourself in any way at all that the order has been heard or understood or that it has been executed in the sense in which you desire it to be executed; that is to say, in a fraudulent way, although as a matter of fact what has been done may have been done as a result of a pure misunderstanding.

(1) (1928) 45 R.P.C. 261 at 267.

1936
 KITCHEN
 OVERALL
 & SHIRT
 Co. LTD.
 v.
 ELMIRA
 SHIRT &
 OVERALL
 Co. LTD.
 Maclean J.

Again,, I might refer to the remarks of Farwell J. in *C. C. Wakefield & Co. Ld. v. Purser* (1). He said:—

Test orders or, as the Defendant prefers to call them, trap orders are in a case of this kind, it seems to me, quite essential. I fail to see how the Plaintiffs can safeguard themselves or the public without having resort to some such method of testing the matter as is used in the present case; but, trap orders or test orders, whichever they may be called, are scrutinised by the Courts with some jealousy, and rightly so, because, if, as the result of a trap order or a test order, a person is to be charged with the very serious offence of fraudulently misrepresenting the goods which he is supplying to the public, to the detriment of the public as well as of the Plaintiffs, the Court must be satisfied that the offence has been proved strictly. Further, if a person is resorting to a test order or a trap order, even in a case of this kind, where the necessity for such a device may be a real one, that person is bound to carry out the proceeding with the utmost fairness to the prospective defendant to the action. It is essential, if the plaintiff is to succeed in the action which he ultimately brings, that he should be able to satisfy the Court that he has acted throughout with the most exact fairness to the defendant and has given him every reasonable chance of investigating the matter for himself, so that he may be in a position to put forward in the action, if one follows, any and every defence properly open to him.

In many respects, what I have just quoted from the cases mentioned, is applicable to the evidence of Biggs, and if this case rested alone on the incidents testified to by him, I think it would be impossible for me to come to the conclusion that the plaintiff had sufficiently discharged the burden of proving that the defendant's goods had been passed off as those of the plaintiff; if I am correct in this then it follows, I think, that the evidence of Biggs is valueless in respect of the general allegations that the defendant's course of conduct was likely to create confusion between its goods and those of the plaintiff because that point was not put to that witness. The evidence of Biggs is, I think, altogether too bare to warrant my attaching weight to it. There was but a single purchase made in each shop, and it was open to the defence to say that those were isolated incidents and were explicable by reason of some honest mistake, which might well have happened. It therefore becomes unnecessary to consider that evidence with regard to the fact that the purchases were made from third parties.

I come now to the balance of the plaintiff's evidence, which I have reviewed, some of which may be disregarded altogether because it is valueless so far as the plaintiff is concerned, or the same is inconclusive. A plaintiff is not

(1) (1934) 51 R.P.C. 167 at 171.

permitted to put it to a witness, that some one, other than himself, or the public, would be deceived or confused by reason of conflicting or similar trade names, since this would be merely his opinion about a conclusion to which the court is to arrive. But a witness may be asked the question whether he himself, being in the trade and familiar with the subject matter concerned, would be misled. See Lord Loreburn in *Claudius Ash, Sons & Co. Ltd. v. Invicta Manufacturing Co. Ltd.* (1). And evidence may be called as to whether certain features are common to the trade, how intending purchasers describe certain articles, who the intending purchasers are likely to be, and other matters. There was some evidence, though small in quantity, given on behalf of the plaintiff, tending to show that, using the words of the statute, it might be reasonably apprehended that the defendant's conduct was likely to create confusion between its goods and that of the plaintiff. And I refer particularly to the evidence of Learie, who was conversant with the trade, and he said the rival marks would mislead him. I think the fair inference from the evidence of Habbishaw and McElroy is that the plaintiff's goods were known to the public as "Kitchen's," something which the plaintiff must establish. All that evidence I accept. In the passing off case of *Iron-Ox Remedy Company Ltd. v. Co-operative Wholesale Society Ltd.* (2), Parker J. said:—

The real question I have to ask myself is whether there is anything in the words "Iron Oxide Tablets" which would lead persons of average intelligence, in that class of the public likely to buy proprietary articles of that sort, into accepting the goods of the Defendants as and for the goods of the Plaintiffs—that is to say, under the impression that they were getting "Iron-Ox Tablets." I have to consider not only the case of a person who has been accustomed to buy the Plaintiffs' goods and might, therefore, having regard to the difference of get-up, be unlikely to be deceived, but I have also to consider the case of a person who has, for example, seen an advertisement of, or has otherwise been told of "Iron-Ox Tablets," and who goes into a retail shop with the intention of buying them. In considering a question of this sort it is always very material to know the precise circumstances under, and the precise reasons for which the trade description to which objection is made, has been adopted. If the conclusion is once arrived at that the description was adopted not with the object of fairly describing the goods to which it is applied, but with the object either of actually misleading the public, or taking an undue advantage of the business connection, or the expenditure, of a rival trader, it does not, I think, require much further evidence to justify the conclusion that the public is likely to be misled; and, on the assump-

1936
 KITCHEN
 OVERALL
 & SHIRT
 Co. LTD.
 v.
 ELMIRA
 SHIRT &
 OVERALL
 Co. LTD.
 Maclean J.

(1) (1912) 29 R.P.C. 465 at 476. (2) (1907) 24 R.P.C. 425 at 430.

1936
 ~~~~~  
 KITCHEN  
 OVERALL  
 & SHIRT  
 Co. LTD.  
 v.  
 ELMIRA  
 SHIRT &  
 OVERALL  
 Co. LTD.  
 \_\_\_\_\_  
 Maclean J.

tion that the goods are so described as to be likely to mislead the public, it is not necessary to prove that anyone has been actually deceived or misled; and, therefore, further, the person who supplies the goods with the misleading description may be liable to an injunction, even though the class of persons to whom he supplies them are certain to know what the goods are, and are not themselves likely to be in any way misled.

Before expressing my final conclusion in this case there are several decisions, in passing off actions, to which I wish to refer, and which I think are of some assistance here, and I must also refer to the contention of Mr. Biggar that the defendant, or Bruce Kitchen, was justified in using the name "Bruce Kitchen" in the manner already described.

Mr. Biggar contended that by reason of the option to purchase given to Bruce Kitchen by the defendant, and his acquaintance with the trade, it was permissible in law for the defendant to use, or to permit to be used, the name of "Bruce Kitchen," as a trade name. Mr. Biggar referred to the case of *The Hurlbut Co. v. The Hurlburt Shoe Co.* (1) and others of a similar nature, but it seems to me they are entirely irrelevant here because Bruce Kitchen is not a defendant in this action; it is the defendant who is here charged with a course of conduct likely to create confusion between the goods of the plaintiff and those of the defendant, and not Bruce Kitchen; and it is fair to assume that to the public the relation of Bruce Kitchen to the defendant company is unknown, except that to some he may be known as manager of that company. It is not the business of Bruce Kitchen that the defendant carries on, and it is not the goods of Bruce Kitchen that are being sold. The contingency of Bruce Kitchen exercising the option to purchase the defendant's business is altogether irrelevant presently, and, in my opinion, does not warrant the defendant using the name of Bruce Kitchen as a trade name in its business, nor does it justify the defendant in permitting Bruce Kitchen to impose upon the defendant the use of his name in that way, if such be the fact. The motives of Bruce Kitchen in the matter are altogether beside the question.

In the two passing off actions of *Croft v. Day* (2), and *Clayton v. Day* (3), a person of the name of Day, the defendant in each case, obtained the authority of one Martin to use his name, and under the name of Day and

(1) (1925) S.C.R. 141.

(2) (1843) 7 Beav. 84.

(3) (1881) 26 Sol. J. 43.

Martin set up the business of making and selling "black-  
ing," which was sold in bottles with labels having a general  
resemblance and only colourably differing from those used  
by the long-established firm of Day and Martin, who also  
manufactured and sold "black-  
ing." It was held by Lang-  
dale M.R. in the first case, that there was quite sufficient  
to mislead the ordinary run of persons, and that the object  
of the defendant was to persuade the public that the new  
establishment was, in some way or other, connected with  
the old firm or manufacturer, and an injunction was  
granted. In the second case Chitty J. was of the opinion  
that the facts showed an attempt to obtain the benefit of  
the plaintiff's long-established business, and that the court  
should protect a trade name as well as a trade mark, and he  
granted an injunction until the trial. In the case of  
*M. Melachrino and Co. v. The Melachrino Egyptian Cigar-  
ette Co. and U. Melachrino* (1), one U. Melachrino, a bro-  
ther of the plaintiffs, a well-known firm of cigarette manu-  
facturers, and who had been formerly employed by the  
plaintiffs as their servant or employee, entered into an  
agreement with one Poulides to act as manager of a cigar-  
ette business for Poulides, to be carried on under the style  
of "The Melachrino Cigarette Co.," and the new firm used  
every device to attract to themselves the plaintiff's custom.  
On motion for an interim injunction after an action was  
brought Chitty J. granted an injunction restraining the  
defendants from carrying on the business then being car-  
ried on under the name of Melachrino & Co. or The Mela-  
chrino Egyptian Cigarette Co. "I shall hold," he said,  
"that a man cannot sell his own name to another for the  
purpose of carrying on a rival trade fraudulently." He  
also said: "I say he has lent the use of his name to Pou-  
lides for the fraudulent purpose of taking away the plain-  
tiff's business." In the case of *Kingston, Miller & Co. Ld.  
v. Thomas Kingston & Co. Ld.* (2), it appears that one  
Thomas Kingston, a son of one of the founders of the  
plaintiff company, had been an assistant manager of that  
company; he left their service on the termination of his  
agreement and took steps to obtain the formation of a new  
company, of which he should be the managing director.

1936

KITCHEN  
OVERALL  
& SHIRT  
Co. LTD.v.  
ELMIRA  
SHIRT &  
OVERALL  
Co. LTD.

Maclean J.

(1) (1887) 4 R.P.C. 215.

(2) (1912) 29 R.P.C. 289

1936

KITCHEN  
OVERALL  
& SHIRT  
Co. LTD.  
v.  
ELMIRA  
SHIRT &  
OVERALL  
Co. LTD.

Maclean J.  
—

Accordingly the defendant company was formed having the same objects as the plaintiff company, and Thomas Kingston was engaged as managing director of the new company. The defendants contended that Thomas Kingston had that which was equivalent to a good will which he could transfer to a company, and that he might by such transfer give the company the right to use his name. It was held that all he had was a certain qualification attaching to himself, which he might make use of for his own benefit or transfer to somebody else, but his name was not incident to that qualification in the sense that it could be transferred to another person and give that person the right to use it whether or not it deceived the public. In the case of *M. P. Guimaraens & Son v. Fonseca & Vasconcellos Ltd.* (1), the defendant company was perpetually restrained from carrying on business in Great Britain as importers of or dealers in port wine under the name of Fonseca and Vasconcellos Ltd. or any other name of which the name Fonseca forms a part, although Fonseca was the name of one of the three directors of the company. I should point out, however, that Younger L.J. indicated that the plaintiffs might not have been entitled to the injunction if the defendants had been a partnership instead of a limited company. I would refer also to the case of *W. H. Dorman & Co. Ltd. v. Henry Meadows Ltd.* (2).

From the cases to which I have just referred it is to be inferred that the courts will not hesitate from forbidding persons to trade under a name, even though the firm name is a true description of the persons belonging to it, if the intention of the defendant is fraudulent and calculated to deceive. However, in such cases it is not necessary to establish actual fraud. Ordinarily a man will not be restrained from carrying on business in his own name, however much confusion be caused thereby so long as he does it honestly, but no person is entitled to carry on his business in such a way as to represent that it is the business of another. The distinction is of course very subtle and hard sometimes to enforce in practice. It has been put in this way by Warrington J. in *Teofani & Co. Ltd. v. A. Teofani* (3): "the mere fact that the name which the defendant is

(1) (1921) 38 R.P.C. 388.

(2) (1922) 2 Ch. 332.

(3) (1913) 30 R.P.C. 76 at 90.

using is his own name is not conclusive evidence that he is not passing off his goods as the goods of somebody else." The very fine distinctions that arise in this class of cases need not seriously concern us here because the defendant is not selling the goods of Bruce Kitchen, and Bruce Kitchen is not selling his goods under his own name. The case of the defendant here is much weaker than that of the defendants in the cases which I have just mentioned.

The plaintiff's case is founded on the probability of confusion between the goods of the plaintiff and those of the defendant by reason of the latter's use of the trade mark "Bruce Kitchen"; it is based on the allegation that the defendant has done some act calculated to lead intending purchasers or customers to believe that its goods are the goods of the plaintiff. Using more precisely the language of the statute, the plaintiff claims that the defendant has directed public attention to his goods in such a way that it may be reasonably apprehended that its course of conduct is likely to create confusion between its goods and those of the plaintiff. As in most cases of this kind the complaint is not quite that the defendant expressly and falsely represents its goods to be those of the plaintiff, which is the rare case, but rather it is that there is an implied representation in the use or imitation of a mark or trade name, with which the goods of the plaintiff are associated in the minds of the public, or of a particular class of the public, and the question to be decided is whether, having regard to all the circumstances of the case, the use by the defendant of the trade mark "Bruce Kitchen" impliedly represents its goods to be the goods of the plaintiff, or, whether it may be reasonably apprehended that such use is likely to create confusion between the goods of the plaintiff and the defendant.

It has been sufficiently established, I think, that the use of the word "Kitchen," or "Kitchen's," in association with the class of goods with which we are here concerned, is reputed in the market to import that the goods are the plaintiff's goods. Considering the name of the plaintiff company, its history and that of its predecessors, one could hardly expect anything else to occur. That phase of the issue, I think, requires no further discussion. Now, is the conduct of the defendant likely to cause confusion? One

1936

KITCHEN  
OVERALL  
& SHIRT  
Co. LTD.

v.  
ELMIRA  
SHIRT &  
OVERALL  
Co. LTD.

Maclean J.



1936  
 KITCHEN  
 OVERALL  
 & SHIRT  
 Co. LTD.  
 v.  
 ELMIRA  
 SHIRT &  
 OVERALL  
 Co. LTD.  
 Maclean J.

feels compelled to ask oneself the question: Why does the defendant use, or permit to be used, as a trade mark or trade name, the name of its manager, Bruce Kitchen, to designate its goods? The goods are not his, they are not made or sold for him. It must be because Bruce Kitchen had come to know the plaintiff's trade and customers, and that trade name being similar to that used by the plaintiff, some advantage would accrue to the defendant's business, in some way or other, by the use of Bruce Kitchen's name, as a trade name. The defendant's mark, being the name of a person, is so used as to leave the impression that the goods are those of Bruce Kitchen, in fact on some of the cards attached to the defendant's goods they are referred to as "A Bruce Kitchen Guaranteed Product," which is not, I think, true, and even while the words "Manufactured by The Elmira Shirt & Overall Company Limited, Elmira, Ontario," appear on the same card in smaller type, yet one cannot but feel that the form and arrangement of the printed matter on the card was designed to leave the impression that the goods were those of Bruce Kitchen, or were manufactured for Bruce Kitchen; in fact the statement of defence alleges that "the business of the defendant is in effect carried on for the direct benefit of Bruce Kitchen whose name in facsimile constitutes the defendant's trade mark," which plea has not in fact been established, and even if it were I do not think it would assist the defendant in this case. On another card which is used, we find the words "The Bruce Kitchen Shirt of Elmira," which, I think, is far from being a frank representation of the facts; I think it is quite plain that these words are used to convey the idea that the shirt was manufactured by Bruce Kitchen, the addition of the words "of Elmira" being, I think, merely a precautionary measure adopted for the purpose of explaining away any subsequent complaint of "confusion." It is not of importance, in my opinion, that Bruce Kitchen is a shareholder in, or a director of, the defendant company, or that he holds an option to purchase the defendant's business; that could be no answer in an infringement action, or in an action to expunge, or in a passing off action. I cannot avoid the conviction that the plaintiff's complaint is well founded, that the defendant's conduct is not one of fair dealing, and that its course of

conduct is likely to lead to confusion. In fact, I do not see how confusion could possibly be avoided in all the circumstances of the case. The defendant has advanced no convincing explanation or reason for the use of the mark.

I think therefore the plaintiff is entitled to the relief claimed. If the plaintiff desires to press its claim for damages there will be a reference to assess the same. The defendant must pay the plaintiff's costs.

1937

KITCHEN  
OVERALL  
& SHIRT  
Co. LTD.

v.

ELMIRA  
SHIRT &  
OVERALL  
Co. LTD.

Maclean J.

*Judgment accordingly.*