

JOHN DEKUYPER & SON.....PLAINTIFFS ;

1894

AND

Feb. 19.

VAN DULKEN, WEILAND & COM- } DEFENDANTS.
PANY }

Trade-mark—Registered and unregistered mark—Jurisdiction of court to restrain infringement—Exactness of description of device or mark—Use of same by trade before registration—Effect of—Rectification of register.

This court has no jurisdiction to restrain one person from selling his goods as those of another, or to give damages in such a case, or to prevent him from adopting the trade label or device of another, notwithstanding the fact that he may thereby deceive or mislead the public, unless the use of such label or device constitutes an infringement of a registered trade-mark.

2. In such a case the question is not whether there has been an infringement of a mark which the plaintiff has used in his business, but whether there has been an infringement of a mark as actually registered.
3. When any one comes to register a trade-mark as his own, and to say to the rest of the world "here is something that you may not use," he ought to make clear to every one what the thing is that may not be used.
4. In the certificate of registration the plaintiffs' trade-mark was described as consisting of "the representation of an anchor, with the letters 'J. D. K & Z,' or the words 'John DeKuyper & Son, Rotterdam, &c.,' as per the annexed drawings and application." In the application the trade-mark was claimed to consist of a device or representation of an anchor inclined from right to left in combination with the letters 'J. D. K & Z,' or the words 'John De Kuyper & Son, Rotterdam,' which, it was stated, might be branded or stamped upon barrels, kegs, cases, boxes, capsules, casks, labels, and other packages containing geneva sold by plaintiffs. It was also stated in the application that on bottles was to be affixed a printed label, a copy or *fac simile* of which was attached to the application, but there was no express claim of the label itself as a trade-mark. This label was white and in the shape of a heart with an ornamental border of the same shape, and on the label was printed the device or representation of the anchor with the letters 'J. D. K & Z' and the words 'John

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De Kuyper & Son, Rotterdam,' and also the words 'Genuine Hollands Geneva' which it was admitted were common to the trade. The plaintiffs had for a number of years prior to registering their trade-mark used this white heart-shaped label on bottles containing geneva sold by them in Canada, and they claimed that by such use and registration they had acquired the exclusive right to use the same.

Held, that the shape of the label did not form an essential feature of the trade-mark as registered.

5. The defendants' trade-mark was, in the certificate of registration, described as consisting of an eagle having at the feet 'V. D. W & Co.,' above the eagle being written the words 'Finest Hollands Geneva'; on each side are the two faces of a medal, underneath on a scroll the name of the firm "Van Dulken, Weiland & Co., and the word 'Schiedam,' and lastly at the bottom the two faces of a third medal, the whole on a label in the shape of a heart (*le tout sur une étiquette en forme de cœur*). The colour of the label was white.

Held, that in view of the plaintiffs' prior use of the white heart-shaped label in Canada, and the allegation by the defendants, in their pleadings, that the use of a heart-shaped label was common to the trade prior to the plaintiffs' registration of their trade-mark, that the defendants had no exclusive right to the use of the said label, and that the entry of registration of their trade-mark should be so rectified as to make it clear that the heart-shaped label forms no part of such trade-mark.

THIS was an action to restrain the infringement of a trade-mark, and for incidental relief.

The facts of the case are sufficiently stated in the reasons for judgment, but in order to give a clearer apprehension of the essential features of the conflicting trade-marks, copies of the two applications for registration, showing diagrams of the respective labels, and the two certificates of registration are given below.

PLAINTIFFS' TRADE-MARK.

APPLICATION.

To the Minister of Agriculture,

Ottawa.

SIR,—I, John de Kuyper, one, and on behalf, of the firm of John de Kuyper & Son, carrying on business as distillers in Rotterdam, Kingdom of the Netherlands, hereby furnish a duplicate copy of a trade-mark,

which I verily believe is the property of our Firm on 1894
account of having been the first to make use of the DEKUYPER
same.

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The said trade-mark consists of a device or repre-
sentation of:

On the casks containing our Geneva
is marked near or under the bung,
hot iron brand



J D K & Z

and on one head

is painted in black letters



JOHN DE KUYPER AND SON.

ROTTERDAM.

On the cases and boxes on the fore-side right hand
is painted, in white letters,

JOHN DE KUYPER AND SON.



and amid at the foot, in an unpainted spot, in hot iron
brand



J D K & Z.

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On the bottles is affixed a printed label,



and the corks green waxed and sealed with the seal



J D K & Z



the whole
 or any part thereof forming our trade-mark, the said
 device may be branded or stamped upon barrels, kegs,
 cases, boxes, capsules, corks, labels and other packages
 containing Geneva sold by us, and I hereby request
 the said trade-mark to be registered in accordance with
 the law.

In testimony thereof I have signed in the presence
 of the two undersigned witnesses, at the place and
 date hereunder mentioned.

ROTTERDAM, 3rd March, 1875.

Witnesses :

(Sgd) Charles de Kuyper. } (Sgd.)
 " Jacob van der Plas. } JOHN DE KUYPER.

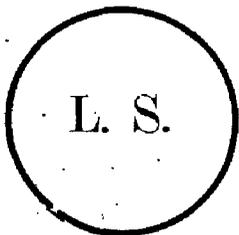
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I, the undersigned, Her Britannic Majesty's Consul for the Provinces of South Holland and Zeeland, do hereby certify, that the signatures to the annexed document dated Rotterdam, 3rd March, 1875, are those of Mr. John de Kuyper, member of the firm John de Kuyper & Son, Distillers in this City, of Mr. Charles de Kuyper and of Mr. Jacob van der Plas, the witnesses, all residing in this City, and that the same are entitled to all due faith and credit as valid and effectual.

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Given under my hand and Seal of Office at the British Consulate at Rotterdam, this fifth day of March, 1875.

(Sgd.) ALEX. TURING,
H. B. M. Consul.



CERTIFICATE OF REGISTRATION.

This is to certify that this trade-mark which consists of the representation of an anchor with the letters J. D. K & Z or the words John de Kuyper & Son, Rotterdam, &c., &c., as per the annexed drawings and application has been registered in

"The Trade-Mark Register No. 4, Folio 666"

in accordance with "*The Trade-Mark and Design Act of 1868.*"

By

John de Kuyper, one, and on behalf, of the firm,

John de Kuyper & Son, of Rotterdam,
 Kingdom of the Nétherlands, on the 21st day of April,
 A. D. 1875.

Department of Agriculture,
 Ottawa, Canada, this 21st
 day of April, A.D. 1875. }

(Sgd.) J. C. TACHÉ,
Deputy Min. of Agr.

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Certified to be a true copy of the Application and
 Registration of trade-mark label herein mentioned on
 Folio 666 of Register No. 4.

Department of Agriculture,
 Ottawa, Canada, this 7th } (Sgd.) J. LOWE,
 day of January, A.D. 1893. } *Dep. of the Min. of Agr.*

DEFENDANTS' TRADE-MARK.

DEMANDE.

*Au Ministre de l'Agriculture,
 Branche des Marques de Commerce et des Droits
 d'Auteurs,
 Ottawa.*

Je, Damase Masson, de la cité de Montréal, comté d'Hochelaga, un des représentants au Canada de la maison Van Dulken, Weiland & Co., de Rotterdam, Hollande, et autorisé par eux, transmets ci-joint copie en double d'une marque de commerce spéciale (conformément aux clauses 9 et 10 de "l'Acte des Marques de Commerce et des Dessins de Fabrique de 1879") dont je réclame la propriété parce que je crois sincèrement qu'ils en sont les véritables propriétaires.

Cette marque de commerce spéciale consiste en un aigle ayant à ses pieds VD W & Co.; au dessus de l'aigle sont écrits les mots "Finest Hollands Geneva;" de chaque côté sont les deux faces d'une médaille; en dessous, sur une guirlande, le nom de la maison "Van Dulken, Weiland & Co." puis le mot "Schiedam" et enfin au bas les deux faces d'une troisième médaille. Le tout sur une étiquette en forme de cœur.

Je demande par ces présentes l'enregistrement de cette marque de commerce spéciale conformément à la loi.

J'inclus un mandat de poste No. 7852, montant de la taxe de \$25 requise par la clause 12 de l'Acte précité.

En foi de quoi j'ai signé en présence de deux témoins
 soussignés aux lieu et date ci-dessous mentionnés.
 Montréal, 27 mars, 1884.

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Témoins :

(Sgd.) L. P. Pelletier. }
 " H. P. Bruyère. } (Sgd.) D. MASSON.

Ottawa, 7th January, 1893. } Attested,
 J. LOWE,
 Dep. of the Min. of Agr.

Ottawa, 7th January 1893.



Attested,
 J. LOWE,
 Dep. of the Min. of Agriculture.

CERTIFICATE OF REGISTRATION.

CANADA. }

LES PRÉSENTES SONT À L'EFFET DE CERTIFIER que
 la MARQUE DE COMMERCE (*Spéciale*) laquelle consiste
 en un aigle ayant à ses pieds VD W & Co., au-dessus
 de l'aigle sont écrits les mots "Finest Hollands
 Geneva;" de chaque côté sont les deux faces d'une
 médaille; en-dessous, sur une guirlande, le nom de la
 maison "Van Dulken, Weiland & Co.," puis le mot
 "Schiedam," et enfin au bas les deux faces d'une
 troisième médaille, le tout sur une étiquette en forme

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de cœur, tel qu'il appert par l'étiquette et la demande ci-contre, a été enregistrée au "Registre des Marques de Commerce No. 10, Folio 2242," conformément à "l'Acte des Marques de Commerce et Dessins de Fabrique de 1879," par Van Dulken, Weiland & Co, de Rotterdam, Hollande, ce 2ème jour d'avril A.D. 1884.

Ministère de l'Agriculture,
 (Branche des Marques de
 Commerce et Droits d'Au-
 teurs.)
 Ottawa, Canada, ce 7ième
 jour de janvier A.D. 1893. } J. LÖWE,
 Dep. of the Min. of Agr.

On the 10th and 11th of January, 1893, the case was tried at Montreal.

Campbell, for the plaintiffs:—

The plaintiffs' trade-mark was registered under 31 Vict. c. 5. Under sec. 3 thereof by such registration they acquired the right to its exclusive use, the words being "and thereafter he [the person registering] shall have the exclusive right to use the same to designate articles manufactured or sold by him."

This being the case, the plaintiffs are entitled to an injunction restraining the defendants from infringing it. This remedy the court is entitled to give under 54-55 Vict. c. 26 sec 4. Under 54-55 Vict. c. 35 also the Exchequer Court of Canada is empowered to exercise practically the jurisdiction that has been heretofore exercised by the Minister of Agriculture in regard to the rectifying, expunging and varying of all entries which have been made without sufficient cause. There is no doubt about the court having jurisdiction to decree an injunction in this case. [Cites *McKinnon v. Thompson* (1); *Darling v. Barsalou* (2)]. We ask for an injunction to restrain infringement by the defendants, and a declaration that we are the proprietors of the trade-mark.

(1) 26 L. C. J. 329.

(2) 9 Can. S. C. R. 677.

In reference to the limitation of the issues arising here I cite the following authorities under the English Judicature Act, because the practice of the High Court is applicable to this case. As I understand the English Judicature Act, you must deal specifically with each allegation and raise, in substance, the grounds upon which the defence is based. There are several reported cases in which that has been fairly discussed; and it has always been held that where the rule has not been complied with you are entitled to judgment upon the constructive admission. [Cites *Thorpe v. Holdsworth* (1); *Byrd v. Nunn* (2); *Collette v. Goode* (3); *Harris v. Gamble* (4); *Rutter v. Tregent* (5); *Lowther v. Heaver* (6).]

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The evidence shows that the plaintiffs were the first to use the trade-mark in question, and are entitled to be declared the owners of it. [Cites *Somerville v. Schembri* (7).] As this case arises in the Province of Quebec I would refer to the law dictionary of *Ruben de Couder* under the heading *Marque de Fabrique*, secs. 70 and 102. It is there stated that by the old law of France there is a common law ownership, independent of the statutes, which it says only give a sanction to the use.

[Cites, generally, *Ford v. Foster* (8); *Montgomery v. Thompson* (9), *Biegel's Trade-Mark* (10); *Re Rosing's Application* (11); *Johnston v. Orr-Ewing* (12); *Perry Davis v. Kennedy* (13); *Collins v. Brown* (14); *Sebastian on Trade-Marks* (15); *Eddleston v. Vick* (16).]

(1) L. R. 7 Eq. 139.

(2) 5 Ch. D. 781; 7 Ch. D. 284.

(3) 7 Ch. D. 842.

(4) 6 Ch. D. 748.

(5) 12 Ch. D. 758.

(6) 59 L. T. 631.

(7) 12 App. Cas. 453.

(8) 41 L. J. Ch. 689.

(9) 60 L. J. Ch. 757.

(10) 57 L. T. 247.

(11) 54 L. J. 975.

(12) 7 Ap. Cas. 219.

(13) 13 Grant. 523.

(14) 3 Jur. (N. S.) 929.

(15) P. 125 (ed. of 1878).

(16) 18 Jur. 7.

1894 *Abbott*, Q.C. followed on the same side:—

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The Act which has given jurisdiction to this court does not create any new right, nor, does it even create a new remedy; it merely provides new machinery, or procedure; by which an already existing right, and an already existing remedy, may be enforced by this court. We had our rights and our remedies under the law before other courts, and the most that can be said is that this statute has provided a new procedure. I do not think it will be contended on the other side, that statutes providing as to procedure merely are exempted from that rule which holds that statutes, unless it is expressly stated, are not to be construed retroactively,—in other words, that statutes making new rules of procedure are given a retroactive effect. Apart from that, however, for the purposes of this case alone, we have shown that the offence which we complain of has been committed since this statute has come into force. As my learned friend, Mr. Campbell, pointed out, one of the statutes came in force in September, 1891, and we have proved the selling of these goods under this incriminated mark since that date, and up to the institution of the present suit, so that, as far as our remedies are concerned, with regard to the injunction at least, there can be no question, it seems to me, as to the jurisdiction.

[Cites *Singer Mfg. Co. v. Loog* (1); *Eugène Pouillet, Des Marques de Fabrique* (2).]

I submit the general proposition that the trade-mark does not consist, as some of the witnesses here certainly seemed to think, of any emblematical design, such as an anchor, or an eagle, or any device of that kind, but it consists in the whole label which is claimed by the owner of the trade-mark. The law says that the proprietor may register a label. We have proved that we

(1) 8 App. Cas. 15

(2) P. 79.

were the proprietors of this label containing our trade-mark long previous to the registration; and we have proved that we registered this label as our trade-mark, the whole of it. My proposition is that if another person uses a label which is similar in shape and general design and general appearance, the *tout ensemble* (the French expression conveys the sense perhaps better than the English), then there is an infringement of the trade-mark. The mere fact that they have not copied the anchor on the trade-mark, it seems to me, makes no difference. It is quite possible they might take our anchor and use it on a different label, a square blue label, or a round red label arranged in an entirely different way. I do not pretend that we have any property in any particular word or in any particular mark upon that label, I contend that our property is in the trade-mark, its shape and general appearance as presented in the application, and I submit that there is such a general resemblance between the two as constitutes an infringement.

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Generally speaking, according to my apprehension of the rules, the court must look at the general appearance of the two labels, and not at any particular detail.

In the case of *Darling v. Barsalou* (1) the first court granted an injunction and it was reversed by the Court of Appeal with strong dissent by Mr. Justice Cross. He laid down the principle we contend for, that where there is a general resemblance which will deceive parties purchasing who use ordinary care, it is sufficient. The case went to the Supreme Court of Canada, and there it was reversed.

Your lordship will find that Mr. Justice Cross made use of words in that case practically the same as were used by Lord Cransworth in the case of the *American*

(1) 1 Dor. 218; 9 Can. S.C.R. 677.

1894 *Leather Cloth Co. v. The Leather Cloth Co.* (1). He said there, that no general rule can be laid down as to what is or is not a mere colourable imitation, that is not the design of the Trade-Marks Act; all that can be done is to ascertain, in every case as it occurs, whether there is such a resemblance as to deceive a person using ordinary caution. Mr. Justice Cross used the same words. Your lordship will see in following the history of the decisions that they rather tend to widen the interpretation placed upon the Act, instead of restricting it, as Lord Cransworth said, to the case of the deception of a person using ordinary caution. The court is to hold that the thing to be looked at is whether the unwary purchaser or incautious person would be deceived.

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[Cites *Wotherspoon v. Currie* (2); *Johnston v. Orr-Ewing* (3); *Brown on Trade-Marks* (4); *Reeve v. Richardson* (5); *Oakey v. Dalton* (6); *Hennessy v. White* (7); *Hennessy v. Hogan* (8); *Swift v. Day* (9); *Gillespie v. Poupert* (10); *Eugène Pouillet, Des Marques de Fabrique* (11).

Ferguson, Q.C., for the defendants: It was said by Lord Bramwell, in one of the leading cases on trade-marks, that the decisions in trade-mark cases, no matter how elaborate they may be, are a very little guide to a judge coming to a conclusion under the particular circumstances of a particular case, because each case presents itself under peculiar circumstances and upon peculiar facts which will never be found applicable to any other; and that, after all, it is a simple question of deciding whether a trade-mark is an infringement of

(1) 11 Jur. N. S. 513.

(2) L. R. 5 H. L. 508.

(3) 7 App. Cas. 219.

(4) Sec. 34.

(5) 45 L. T. 54.

(6) 35 Ch. D. 700.

(7) Seb. Dig. 401.

(8) Seb. Dig. 403.

(9) 2 Abb. P. 459.

(10) 14 L. N. 41.

(11) Secs. 184 to 190.

another, and each case must rest upon its own foundation, and must be decided almost apart from authority. But, there are some general principles, notwithstanding that truism, which are well to bear in mind in considering a case of this sort.

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In the first place, I will draw attention shortly to the jurisdiction which this court has the right to exercise in cases of trade-mark. By the Act of 1891, which repealed what was found to be an insufficiently worded Act in 1890, it will be found that under section 1, the old section which dealt with the jurisdiction of the Minister—giving him the right to refuse the registration of trade-marks in certain cases,—was repealed and a new one substituted therefor, and in the succeeding sections are stated five grounds upon which the Minister might refuse to register a trade-mark. This section of course dealt wholly and entirely with pending applications and gave the Minister no jurisdiction whatever to expunge in respect of any of such grounds. Although he may refuse to register, it gives him no jurisdiction to expunge on the same ground; and, by this section, he may, if he pleases, refer to the Exchequer Court the question of whether registration should be granted or not. The second part of section 1 is the one which, in that Act, confers upon this court, if it has jurisdiction in this case, the jurisdiction to grant any relief.

Section 12, which is the substituted section for the Trade-Marks Act, as provided by the Act of 1891, gives simply a jurisdiction to the court to make, expunge, or vary an entry where registration has been refused without sufficient cause, or where it is alleged that an entry has been made without sufficient cause.

Then the sub-section following provides that the said court may in any proceeding under this section decide any question which it may be necessary

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or expedient to decide for the rectification of the register. These are the only provisions of that Act giving any jurisdiction in trade-mark cases to this court.

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Now, turning to *The Exchequer Court Amendment Act*, 1891, c. 26 sec. 4, we find the provision there dealing with the question of jurisdiction in trade-mark cases. That of course clearly and obviously refers to the provisions of the eleventh section of the Trade-Marks Act of 1891, where there are applications pending, and where the Minister refers the question as to which is entitled to the trade-mark to the Exchequer Court.

[He quotes at length sub-secs. (b) and (c) of 54-55 Vict. c. 26]. These are the only statutory provisions which give jurisdiction to this court.

Now, what is the meaning of an entry "without sufficient cause?"

In sections 3, 8, 9, 10, 13, and 14 of *The Revised Statutes of Canada c. 63* will be found what are the requirements and conditions upon which a person applying for the registration of a trade-mark shall be entitled to it, and what effect it shall have when granted.

By these sections it is provided that the Minister may make regulations with reference to applications for trade-marks, the form the application should be in, and what facts should be stated in support of them. It is then provided that, upon these conditions being complied with to the satisfaction of the Minister, he shall grant the registration, and that it shall endure for twenty-five years, is renewable, and may be sold or assigned to a purchaser.

I submit, in the first place, that there is no ground established for saying that the defendants' certificate was improvidently issued. The certificate itself is put in by the plaintiffs; it shows what was claimed by

the defendants, Van Dulken, Weiland & Co., it shows on its face a compliance with the rules and regulations. The certificate, *primâ facie*, shows that we are entitled to the trade-mark under which we have been carrying on business.

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Now, I submit that what is included or meant by "registration without sufficient cause" must be that these conditions were not complied with, and that if they are complied with there is no jurisdiction under this particular section to set that registration aside.

What is the other possible jurisdiction that this court may exercise? The expression "in all cases in which it is sought to impeach or annul a patent of invention, or have the entry in any register, etc., made, expunged, varied or rectified" is taken really from *The Revised Statutes*, or is an adaptation of *The Revised Statutes* in several sections where it refers, for instance, to applications made by the holder of the certificate himself. If he finds that he has made an error, that he has made a mistake in registering his own trade-mark, he may make an application to have it amended or have it expunged, or a new one substituted in its place.

I submit that the court must construe these provisions strictly in favour of the defendants' certificate. We have, as I have already pointed out to your lordship in the sections of *The Trade-Marks Act*, acquired a property, we have acquired rights, we have been enjoying these rights; we applied, in the way pointed out by the Act, for the registration of a particular trade-mark, and we complied with the regulations and the provisions of that Act. The Minister after proper consideration, it must be presumed, granted that registration, which we have been in the enjoyment of for at least 8 or 9 years, and the court ought not lightly or by any strained construction, interfere with or take

1894 away the rights, the property, or the privileges which
 DEKUYPER we have by virtue of the registration.

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 DULKEN. The distinction now between an unregistered trade-
 mark and a registered trade-mark is, that a man
 claiming an unregistered trade-mark has no right of
 action. Until it is registered there is no right of
 action.

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If I am right the plaintiffs' case must fall to the ground; unless their registration covers the heart-shape, which is, after all, what they are basing their case upon, they would have no remedy or right of action.

The plaintiffs are confined strictly, so far as their right of action is concerned, to what is given to them by their certificate.

[Cites *Horsburg's Trade-Marks* (1); *Singer Mfg. Co. v. Loog* (2); *Ellis & Son v. Ruthin Soda-Water Co.* (3); *Lawson on Trade-Marks* (4); *Martin v. Wright* (5).]

Duhamel, Q. C. followed for defendants:—

The authorities on the matter are very clear. [Cites *Eugène Pouillet, Des Marques de Fabrique* (6).] This clearly states that in order to judge of the possibility of confusion of trade-marks it is not proper to take as a basis of comparison the degree of attention given by the first man that passes, the ignorant, or the unintelligent consumer; but that it is necessary to take the degree of attention given by a vigilant and sufficiently careful man who examines the article. This authority, in this instance, is supported by many instances which are contained in the report. In support of this quotation from *Pouillet*, I quote *Adams on Trade-Marks* (7). The court will not restrain the use of a trade-mark on the ground of general similarity, nor if it is different in

(1) 53 L. J. Chy. 237.

(2) 8 App. Cas. 15.

(3) Sebastian 3rd ed. p. 137.

(4) (2nd ed.) p. 213.

(5) 6 Sim. 297.

(6) P. 203, paragraph 189.

(7) Ed. 1876, p. 112.

the part to which the consumer would look to see whose manufacture he was purchasing.

[Cites *Blackwell v. Crabb* (1); *Bondier v. Dépatie* (2).]

Ferguson, Q.C. cites the following additional authorities: *Beard v. Turner* (3); *Reddaway v. Bentham Hemp Spinning Co.* (4); *Perry Davis v. Harbord* (5); *Baker v. Rawson* (6).

On the 26th June, 1893, on motion of the defendants the trial was reopened for the purpose of taking further evidence as to the user of the heart-shaped label in the trade in the Kingdom of Holland.

February 19th, 1894.

The commission having been returned, *Campbell* now moved for judgment for plaintiffs, citing, in addition to the authorities presented on the argument, *Re Trade-Mark of La Société Anonyme des Verriers de l'Étoile* (7); *Sebastian on Trade-Marks* (8).

Ferguson, Q.C. and *Duhamel*, Q.C., *contra*, cited *Re Loftus' Trade-Mark* (9); *Re Payne & Co's. Trade-Mark* (10); *Re Powell's Trade-Mark* (11).

BURBIDGE, J.:—The plaintiffs, who are distillers residing at Rotterdam in Holland and who carry on business there and in the Province of Quebec, bring their action (1st) to restrain the defendants, who are also distillers residing at Rotterdam and who also carry on business there and in the Province of Quebec, from infringing a trade-mark which the plaintiffs registered in the office of the Minister of Agriculture on the 21st of April, 1875, and (2ndly) for the recti-

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|-------------------------------------|------------------------|
| (1) L. J. [1867] No. 36. N. S. 504. | (6) 45 Ch. D. 519. |
| (2) 3 Dor. 233. | (7) [1894] 1 Ch. 61. |
| (3) 13 L. T. R. N. S 746. | (8) P. 127. |
| (4) [1892] Q. B. 639. | (9) [1894] 1 Ch. 193. |
| (5) 15 App. Cas. 316. | (10) [1893] 2 Ch. 567. |
| | (11) [1893] 2 Ch. 388. |

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fication of the Register of Trade-Marks in the office of the said Minister in respect of the entry and registration of a certain trade-mark therein registered on the 2nd of April, 1884, by Mr. Damase Masson, of the City and District of Montreal, acting as agent of the defendant firm.

The plaintiffs' trade-mark is, in the certificate of registration, described to consist of "the representation of an anchor with the letters 'J. D. K & Z,' or the words 'John de Kuyper & Son, Rotterdam,' &c., &c., as per the annexed drawings and application." Turning to the application we find that the trade-mark is claimed to consist of a device or representation of an anchor inclined from right to left in combination with the letters 'J. D. K & Z,' or the words 'John de Kuyper & Son, Rotterdam,' which it is stated may be branded or stamped upon "barrels, kegs, cases, boxes, capsules, casks, labels and other packages containing Geneva" sold by plaintiffs, and the manner of applying the trade-mark to casks, cases and bottles is described. On bottles was to be affixed a printed label, a copy or *facsimile* of which was attached to the application, but without any express claim of the label itself as a trade-mark. This label is white and in the shape of a heart with an ornamental border of the same shape. On the label is printed the device or representation of the anchor with the letters 'J. D. K & Z' and the words 'John de Kuyper & Son, Rotterdam,' and also the words 'Genuine Hollands Geneva' which it is admitted are common to the trade. The plaintiffs had for a number of years prior to registering their trade-mark used this white heart-shaped label on bottles containing geneva sold by them in Canada, and they claim that by such use and registration they have acquired the exclusive right to use the same.

The defendants' trade-mark is in the certificate of registration described to consist of an eagle having at its feet 'V D. W & Co.,' above the eagle being written the words 'Finest Hollands Geneva'; on each side are the two faces of a medal, underneath on a scroll the name of the house 'Van Dulken, Weiland & Co.,' and the word 'Schiedam' and lastly at the bottom the two faces of a third medal, the whole on a label in the shape of a heart, (*le tout sur une étiquette en forme de cœur.*) The colour of the label is white.

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Tested by an examination of the two labels, or by the opinions of the witnesses examined, it will be seen that in the shape, colour and general arrangement of the two labels there is a somewhat marked similarity; but the differences are such, I think, as to prevent persons of reasonable care and caution from mistaking the one for the other. That would clearly be the case with persons who could read, and for the illiterate there is in the one case the distinctive mark or device of an anchor, and in the other that of an eagle.

There is no evidence that the defendants have ever sold their geneva for the plaintiffs' or that any one has ever been misled or deceived by the defendants' label or bought their geneva for the plaintiffs,' and with respect to those who purchase for the wholesale or retail trade there is, I think, no danger of such deception. At the same time there may be, and there probably are, a number of the ultimate purchasers of gin—the unwary and incautious among the illiterate consumers—who are likely to be misled and deceived by the general resemblance in shape, colour and arrangement between the two labels. The plaintiffs' trade has been established for many years and their geneva is well and favourably known, and has acquired a reputation throughout the Province of Quebec. It is known generally, I think, by the name of 'De

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Kuyper' but also by the brand or mark of an anchor, and in some sections of the Province, and among some classes, by the heart-shaped label. And the fair inference from the facts and circumstances disclosed by the case is, I think, that the defendants, while not perhaps attempting to sell their geneva as that of the plaintiffs', thought to gain a trade advantage by adopting and using a label which in shape and colour resembled that used by the plaintiffs, though otherwise distinguishable from it.

It will have been observed that the defendants in their application to register their trade-mark claimed to be the proprietors of the words and device mentioned, written or printed upon a heart-shaped label. They claimed, I think, to register a label in that form—with such words and device printed or written upon it. Now a label in that shape had been in use for years in Canada by the plaintiffs upon the same class of goods. This fact must, I think, have been known to the defendants' agent when he made the application for them to register their trade-mark. Clearly they had no exclusive right to the heart-shaped label which they claimed. / That they do not now deny, for they seek to protect themselves against the charge of infringing the plaintiffs' trade-mark by alleging that the use of a heart-shaped label was common to the trade prior to the plaintiffs' registration of their trade-mark. / If the heart-shaped label was common to the trade the defendants were not the proprietors of it, and they had no right to an exclusive use of it. / Possibly in view of the evidence in this case they had no right to use it at all. It is clear in any view of the case that they were not entitled to register as their trade-mark one of which an essential feature and claim was a heart-shaped label. / Perhaps in such a case the registration of the trade-mark should be cancelled, and the

entry thereof expunged from the registry. But that is not necessary in the present case in order to do justice between the parties, and I shall limit the order and direction of the court to the rectification of the entry in the registry in such a way as will make it clear that the heart-shaped label is no part of the trade-mark. For that purpose it will probably be sufficient to expunge from the entry and certificate the words "*le tout sur une étiquette en forme de cœur*," or the words "*en forme de cœur*." If any question arises as to that it may be decided when the minutes of the judgment are settled.

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That brings us to the other question of the infringement of the plaintiffs' trade-mark. And here it is necessary to bear in mind that the court has no general authority or jurisdiction to restrain one person from selling his goods as those of another or to give damages in such a case, or to prevent any one from adopting, in his business, labels or devices that may be calculated to deceive or mislead the public, unless the use of such labels or devices constitute an infringement of a registered trade-mark (1). In such a case as has been pointed out the point is not whether there has been an infringement of the mark which the plaintiff has used in his business, but whether there has been an infringement of the mark which he has actually registered (2). And in considering whether there has been an infringement of the registered trade-mark, it is necessary to see whether the essential particular in that registered trade-mark has been imitated. Now what is the essential particular of the plaintiffs' trade-mark? Clearly the anchor in combination with the letters 'J. D. K & Z' or the words 'John de

(1) R. S. C. c. 63 s. 19; 54-55
 Vict. c. 26 s. 4 (c).

(2) Sebastian, 3rd ed. p. 137,
 citing *Ellis & Sons v. Ruthin Soda
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Kuyper & Son, Rotterdam.' That is what we find to be common to all the forms in which the trade-mark is to be applied to packages containing geneva manufactured by them. That is what they say may be branded or stamped upon such packages or upon capsules, casks or labels, and that is what in the certificate of registration issued to, and accepted by, them their trade-mark is said to consist of. Their claim is for the device or representation that I have mentioned, and they say it may be stamped upon labels, which are of course to be affixed to bottles containing their geneva. It is true that a heart-shaped label bearing the device was affixed to the plaintiffs' application, but they did not, so far as I can see, claim the form of the label as constituting a part of the trade-mark. When any one comes to register a trade-mark as his own, and to say to the rest of the world, "here is something that you may not use," he ought to make clear to everyone what the thing is that may not be used. If he seeks to register a label he should say so, and no one is, I think, bound to infer that because he registers a device that he says may be stamped or printed on labels, that it was intended that the form of a label accompanying or affixed to the application, but not claimed, not even described, is an essential part of the mark, to the exclusive use of which the applicant is entitled. A label may, no doubt, be registered as a trade-mark, and it may be that the plaintiffs are entitled to the exclusive use of the one in question, and on application to the Minister of Agriculture to have it registered. On that question I express no opinion for it is not now, I think, before me. What I have to do with at present is the trade-mark that they have registered, of which it does not seem to me that the shape of the label forms, or is claimed to form, an essential or any feature. If that is so the defendants,

whatever else they may have done, have not infringed the plaintiffs' registered trade-mark. 1894

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The application for an order to restrain the defendants from infringing the plaintiffs' trade-mark will be refused.

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On the issues as to the rectification of the entry in the registry of the defendants' trade-mark the plaintiffs are entitled to costs, and that will carry the general costs of the cause.

On the other issues of fact, those raised by the 4th paragraph of the statement in defence, each party has succeeded in part, and there will be no costs on such issues. Both parties may have sixty days from this date in which to appeal, and the leave shall apply as well to the judgment on demurrer herein.

Judgment accordingly.

Solicitors for plaintiffs: *Abbotts, Campbell & Meredith.*

Solicitors for defendants: *Duhamel & Merrill.*