

BETWEEN:

SEALY SLEEP PRODUCTS LIM-
ITED (Opponent)

APPELLANT;

1960
June 1-2
June 2

AND

SIMPSON'S-SEARS LIMITED (Ap-
plicant)

RESPONDENT.

Trade Marks—The Unfair Competition Act, 1932, S. of C. 1932, c. 38, ss. 2 (k), 2(l)—Trade Marks Act, S. of C, 1953, c. 49, ss. 2(b), 6(1), 6(2), 6(5), 12(1)(a), 12(1)(d) 13, 16(1)(b), 37, 37(2)(b), 37(2)(c), 37(8), 55(1)—Use of suffix in two trade marks not a test of confusion—Trade marks to be looked at in their totality—Whether two trade marks confusing a matter of first impression—Trade marks “Sears-O-Pedic” and “Posturepedic” not confusing—No monopoly in use of suffix “-pedic”—Registrar of Trade Marks not a party to proceedings—Name of Registrar of Trade Marks to be left out of style of cause.

The respondent applied on August 7, 1957, for the registration of “Sears-O-Pedic” as a trade mark under the *Trade Marks Act*, stating that it had used the trade mark in association with mattresses since April 18, 1956, and requested its registration in respect of such wares. Pursuant to section 37 of the Act the appellant filed a statement of opposition, dated February 10, 1958, to the respondent’s application, the grounds of opposition being that the trade mark was not registrable because it was confusing with the opponent’s registered trade mark “Posturepedic” which had been registered on June 27, 1953, for use in association with the sale of mattresses etc., that the applicant was not entitled to registration because on the date on which it or its predecessor in title first used the trade mark or made it known it was confusing with the opponent’s trade mark which had been previously used in Canada by the opponent and its predecessor in title Sears Incorporated and that the trade mark was not registrable because the prefix “Sears-” was primarily the name or the surname of an individual who was living or had died within thirty years. The Registrar of Trade Marks held that the suffix PEDIC was common to the trade and that in the light of this the two word marks were not confusing and he rejected the opposition pursuant to section 37(8) of the Act and notified the parties accordingly. The appellant appealed from this decision.

Held: That the appeal to this Court granted by section 55(1) of the Act is an appeal from the Registrar’s decision, not from the reasons on which he based it, that the Court is not concerned with whether the reasons given by the Registrar are right or not and that the only question for consideration is whether the Registrar was right in rejecting the opposition.

2. That the use of a suffix in two trade marks is not of itself a test of whether either of them is confusing with the other.
3. That it is not a proper approach to the determination of whether one trade mark is confusing with another to break them up into their elements, concentrate attention on the elements that are similar and conclude that, because there are similarities in the trade marks, the trade marks as a whole are confusing with one another.

1960
 SEALY SLEEP
 PRODUCTS
 LIMITED
 v.
 SIMPSON'S-
 SEARS
 LIMITED

4. That trade marks may be different from one another and, therefore, not confusing with one another when looked at in their totality, even if there are similarities in some of the elements when viewed separately.
5. That it is the combination of the elements that constitutes the trade mark and it is the effect of the trade mark as a whole, rather than that of any particular part of it, that must be considered. *British Drug Houses Ltd. v. Battle Pharmaceuticals* [1944] Ex. C.R. 239 at 251; [1946] S.C.R. 50 applied.
6. That the fact that both the respondent's trade mark "Sears-O-Pedic" and the appellant's registered trade mark "Posturepedic" both contain the suffix "-pedic" does not determine that the respondent's trade mark was, either as at April 18, 1956, or as at August 7, 1957, confusing with the appellant's registered trade mark.
7. That if the two trade marks are looked at in their totality it is clear that the respondent's trade mark was not and is not confusing with the appellant's registered trade mark.
8. That the principle of the decision in *Aristoc Ld. v. Rysta, Ld.* [1945] A.C. 68 that the question whether two marks are similar must be answered by the judge on whom the responsibility lies as a matter of first impression is applicable to cases under the *Trade Marks Act* and that the first impression made by the respondent's trade mark "Sears-O-Pedic" would be that it is not confusing with the trade mark "Posturepedic".
9. That anyone who saw or heard the two trade marks could not reasonably think that "Sears-O-Pedic" was confusing with "Posturepedic" and it is not likely that anyone who purchased a "Sears-O-Pedic" mattress would think that he was buying the appellant's product, or *vice versa*.
10. That the use of both trade marks in the same area would not be likely to lead to the inference that wares associated with such trade marks are manufactured, sold, leased or hired by the same person.
11. That the respondent's trade mark was and is plainly not confusing with the appellant's.
12. That the appellant does not have a monopoly in the use of the suffix "-pedic" or a right to prevent anyone from using a trade mark in which it was included.
13. That the respondent's trade mark is not "Sears-" but "Sears-O-Pedic" and the contention put forward on behalf of the appellant that the respondent's trade mark "Sears-O-Pedic" was not registrable because the prefix "Sears" is primarily the name or surname of an individual who is living or has died within the preceding thirty years should be dismissed out of hand.
14. That the Registrar of Trade Marks is not a party to the proceedings and his name should be left out of the style of cause.
15. That the appeal must be dismissed.

APPEAL from decision of the Registrar of Trade Marks.

The appeal was heard before the President of the Court at Ottawa.

G. E. Maybee, Q.C., for appellant (opponent).

G. F. Henderson, Q.C., for respondent (applicant).

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

THE PRESIDENT on the conclusion of the hearing (June 2, 1960), delivered the following judgment:

This is an appeal from the decision of the Registrar of Trade Marks, dated June 4, 1959, rejecting the appellant's opposition to the respondent's application for the registration of "Sears-O-Pedic" as a trade mark under the *Trade Marks Act*, Statutes of Canada, 1953, Chapter 49.

In its application for the registration, dated August 7, 1957, the respondent stated that it had used the trade mark in association with mattresses since April 18, 1956, and requested its registration in respect of such wares. The application was given No. 241,882.

Pursuant to section 37 of the *Trade Marks Act* the appellant filed a statement of opposition to the respondent's application, dated February 10, 1958, the grounds of opposition being as follows:

1. The trade mark "SEARS-O-PEDIC" is not registrable because it is confusing with the opponent's registered trade mark "POSTURE-PEDIC" which was registered on June 27, 1953, under N.S. 183/46693 for use in association with the sale of mattresses and bedding including studio couches, divans, studio lounge beds, sofa beds, upholstered furniture convertible to or usable as a bed, chairs, bed springs, box springs, foundation units, pillows, cushions and comforts.
2. The applicant is not the person entitled to registration because on the date on which the applicant or its predecessor in title first used the trade mark "SEARS-O-PEDIC" or made it known it was confusing with the opponent's said trade mark "POSTURE-PEDIC" and the opponent's said trade mark had been previously used in Canada on the said wares by the opponent and its predecessor in title "SEARS INCORPORATED".
3. The trade mark "SEARS-O-PEDIC" is not registrable as advertised because the prefix "SEARS-" is primarily the name or the surname of an individual who is living or has died within the preceding thirty years.

The trade mark "Posturepedic" was registered in Canada under No. 183 N.S. 46693 by Sealy, Incorporated, the United States counterpart of the appellant, on June 27, 1953, as a standardization trade mark, and in the same year it was assigned to the appellant together with the goodwill of the business carried on in Canada. The first use of the trade mark in Canada was on January 1, 1954, and since that date it has been used in Canada only by the appellant and its licensees. The registration was amended on September 4,

1960
 SEALY SLEEP
 PRODUCTS
 LIMITED
 v.
 SIMPSON'S-
 SEARS
 LIMITED
 THOMPSON P.

1960
 SEALY SLEEP
 PRODUCTS
 LIMITED
 v.
 SIMPSON'S-
 SEARS
 LIMITED
 Thorson P.

1958, limiting the wares in respect of which the trade mark was used to mattresses, bed springs, box springs, foundation units and cushions. It was thus established that the trade mark was used by the appellant and its licensees both as at April 18, 1956, when the respondent first used its trade mark and also as at August 7, 1957, when it applied for its registration.

In support of the opposition several affidavits were filed with the Registrar, namely, by Roy Vincent Jackson, George Rota, Bernard Nathanson and Earl H. Bergmann and against it there were affidavits by Frederick C. Aubrey, John G. MacLean, Joseph Betel, Walter E. Bray, Joseph R. O'Kell and Thomas L. Smith. In reply to the respondent's affidavits there was a further affidavit by Bernard Nathanson.

In addition to these affidavits the Registrar had before him the applicant's counter statement in answer to the statement of objection, a written argument by counsel for the opponent and a written argument on behalf of the applicant. There was also a hearing before the Registrar on April 20, 1959.

In his decision the Registrar stated that the issue to be determined in the opposition was whether the applicant's trade mark "SEARS-O-PEDIC" was confusing with the opponent's registered trade mark "POSTUREPEDIC" when used on the same wares. In his opinion, the suffix -pedic had been extensively used in Canada and he held that the suffix PEDIC was common to the trade and that in the light of this the two word marks were not confusing and he rejected the opposition pursuant to section 37(8) of the Act and notified the parties accordingly.

The appellant appealed from this decision on the following grounds:

1. That the learned Registrar erred in holding that the suffix PEDIC is common to the trade.
2. That the learned Registrar erred in holding that the trade mark SEARS-O-PEDIC is not confusing with the trade mark, "POSTUREPEDIC".
3. That the learned Registrar erred in rejecting the opposition.

On the hearing of the appeal a further affidavit by Earl H. Bergmann was submitted for the appellant and further affidavits were submitted on behalf of the respondent, namely by Joseph Betel, Lyman C. Johnston, and two affidavits by Walter Edmond Bray.

My first comment on the Registrar's decision is that the appeal to this Court granted by section 55(1) of the Act is an appeal from the Registrar's decision, not from the reasons on which he based it, and that his decision under section 37(8) was a decision to reject the appellant's opposition. Consequently, this Court is not concerned with whether the reasons given by the Registrar for his decision were right or not. The only question for consideration is whether the Registrar was right in rejecting the opposition. The jurisdiction of the Court is limited to the determination of this question.

1960
 SEALY SLEEP
 PRODUCTS
 LIMITED
 v.
 SIMPSON'S-
 SEARS
 LIMITED
 Thorson P.

While I do not accept the Registrar's reasons for rejecting the opposition I have no hesitation in finding that his decision was plainly right.

To succeed in its appeal the appellant must rely either on section 37(2)(b) of the Act or on section 37(2)(c), which read as follows:

37. (2) Such opposition may be based on any of the following grounds:
 (b) that the trade mark is not registrable;
 (c) that the applicant is not the person entitled to registration; or

Section 37(2)(b) throws the appellant back to section 12(1)(d) which provides:

12. (1) Subject to section 13, a trade mark is registrable if it is not
 (d) confusing with a registered trade mark or

and that in turn throws it back to section 6. Section 37(2)(c) throws the appellant back to section 16(1)(b) which provides:

16. (1) any applicant who has filed an application in accordance with section 29 for registration of a trade mark that is registrable and that he or his predecessor in title has used in Canada or made known in Canada in association with wares or services is entitled, subject to section 37, to secure its registration in respect of such wares or services unless at the date on which he or his predecessor in title first so used it or made it known it was confusing with

- (b) a trade mark in respect of which an application for registration had been previously filed in Canada by any other person; . . .

and this also throws the appellant back to section 6.

Thus, if the appellant is to succeed it must show that the respondent's trade mark "Sears-O-Pedic" was confusing with its registered trade mark "Posturepedic" as at April 18, 1956, when the respondent first used it and or as at August 7, 1957, when the respondent applied for its registration and that it is, consequently, not registrable by reason of section 12(1)(d) to which I have already referred.

1960
 SEALY SLEEP
 PRODUCTS
 LIMITED
 v.
 SIMPSON'S-
 SEARS
 LIMITED
 Thorson P.

Thus the issue in the case becomes the narrow one whether the respondent's trade mark "Sears-O-Pedic" was confusing with the appellant's registered trade mark "Posturepedic".

On the subject whether one trade mark is confusing with another the *Trade Marks Act* seeks to clarify some of the difficulties that arose under *The Unfair Competition Act, 1932*, Statutes of Canada, 1932, Chapter 38. It defines "confusing" by section 2(b) as follows:

2. In this Act,

(b) "confusing" when applied as an adjective to a trade mark or trade name, means a trade mark or trade name the use of which would cause confusion in the manner and circumstances described in section 6;

Then section 6 gives guidance in the determination of whether a trade mark or trade name is confusing. Section 6(1) provides:

6. (1) For the purposes of this Act a trade mark or trade name is confusing with another trade mark or trade name if the use of such first mentioned trade mark or trade name would cause confusion with such last mentioned trade mark or trade name in the manner and circumstances described in this section.

And section 6(2) provides:

6. (2) The use of a trade mark causes confusion with another trade mark if the use of such trade marks in the same area would be likely to lead to the inference that the wares or services associated with such trade marks are manufactured, sold, leased, hired or performed by the same person, whether or not such wares or services are of the same general class.

And then section 6(5) gives further guidance in setting out what should be considered in determining whether trade marks or trade names are confusing. It provides:

6. (5) In determining whether trade marks or trade names are confusing, the Court or the Registrar, as the case may be, shall have regard to all the surrounding circumstances including

- (a) the inherent distinctiveness of the trade marks or trade names and the extent to which they have become known;
- (b) the length of time the trade marks or trade names have been in use;
- (c) the nature of the wares, services or business;
- (d) the nature of the trade, and
- (e) the degree of resemblance between the trade marks or trade names in appearance or sound or in the ideas suggested by them.

These provisions replace, *inter alia*, such provisions in *The Unfair Competition Act, 1932*, as section 2(k), defining

“similar” in relation to trade marks, trade names or distinguishing guises, and section 2(l), defining “similar” in relation to wares.

In the material before the Registrar much was made of the use of the suffix “-Pedic” in the two marks and there was evidence of its use in trade marks other than those of the parties to these proceedings, but the use of a suffix in two trade marks is not of itself a test of whether either of them is confusing with the other. In the *British Drug Houses Ltd. v. Battle Pharmaceuticals*¹ I made the following statement:

It is, I think, firmly established that, when trade marks consist of a combination of elements, it is not a proper approach to the determination of whether they are similar to break them up into their elements, concentrate attention upon the elements that are different and conclude that, because there are differences in such elements, the marks as a whole are different. Trade Marks may be similar when looked at in their totality even if differences may appear in some of the elements when viewed separately. It is the combination of the elements that constitutes the trade mark and gives distinctiveness to it, and it is the effect of the trade mark as a whole, rather than of any particular part in it, that must be considered.

The decision in the above case was affirmed by the Supreme Court of Canada²: *vide* also *Re Christiansen's Trade Mark*³; *Sandow Ltd's Application*⁴; and *Freed & Freed Ltd. v. Registrar of Trade Marks et al.*⁵

The principle thus stated is as applicable in cases under the *Trade Marks Act* as it was in cases under *The Unfair Competition Act, 1932*. And its converse is equally true. It is not a proper approach to the determination of whether one trade mark is confusing with another to break them up into their elements, concentrate attention upon the elements that are similar and conclude that, because there are similarities in the trade marks, the trade marks as a whole are confusing with one another. Trade marks may be different from one another and, therefore, not confusing with one another when looked at in their totality, even if there are similarities in some of the elements when viewed separately. It is the combination of the elements that constitutes the trade mark and it is the effect of the trade mark as a whole, rather than that of any particular part in it, that must be considered.

¹ [1944] Ex. C.R. 239 at 251.

³ (1886) 3 R.P.C. 54.

² [1946] S.C.R. 50.

⁴ (1914) 31 R.P.C. 196.

⁵ [1950] Ex. C.R. 431.

1960
 SEALY SLEEP
 PRODUCTS
 LIMITED
 v.
 SIMPSON'S-
 SEARS
 LIMITED
 Thorson P.

Thus the fact that both the respondent's trade mark "Sears-O-Pedic" and the appellant's registered trade mark "Posturepedic" both contain the suffix "-pedic" does not determine that the respondent's trade mark was, either as at April 18, 1956, or as at August 7, 1957, confusing with the appellant's registered trade mark "Posturepedic". If the two trade marks are looked at in their totality it is, in my opinion, clear beyond dispute that the respondent's trade mark was not and is not confusing with the appellant's registered trade mark.

I should also, in this connection, refer to the decision of The House of Lords in *Aristoc Ltd. v. Rysta Ltd.*¹ that the question whether two marks are similar must be answered by the judge on whom the responsibility lies as a matter of first impression. They adopted as a fair statement of the duty cast upon the Court the following passage from the dissenting judgment of Luxmore L.J. in the Court of Appeal²:

The answer to the question whether the sound of one word resembles too nearly the sound of another so as to bring the former within the limits of section 12 of the Trade Marks Act, 1938, must nearly always depend on first impression, for obviously a person who is familiar with both words will neither be deceived nor confused. It is the person who only knows the one word, and has perhaps an imperfect recollection of it, who is likely to be deceived or confused. Little assistance, therefore, is to be obtained from a meticulous comparison of the two words, letter by letter and syllable by syllable, pronounced with the clarity to be expected from a teacher of elocution.

The Court must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description but also of the shop assistant ministering to that person's wants.

Lord Luxmore's statement was expressly approved by Kerwin J., as he then was, giving the judgment of the Supreme Court of Canada, in *Battle Pharmaceutical Ltd.*³ and must be regarded as the leading authority on the subject.

The principle laid down in the *Aristoc* case (*supra*) is applicable to cases under the *Trade Marks Act*. I must say that, in my opinion, the first impression made by the respondent's trade mark "Sears-O-Pedic" would be that it is not confusing with the trade mark "Posturepedic". I do not believe that any one who saw or heard the two trade marks could reasonably think that "Sears-O-Pedic" was

¹ [1945] A.C. 68.

² (1943) 60 R.P.C. 87 at 108.

³ [1946] S.C.R. 50 at 53.

confusing with "Posturepedic" or that anyone who purchased a "Sears-O-Pedic" mattress would be likely to think that he was buying the appellant's product, or *vice versa*. In my judgment, the use of both trade marks in the same area would not be likely to lead to the inference that the wares associated with such trade marks are manufactured, sold, leased or hired by the same person. The respondent's trade mark was and is plainly not confusing with the appellant's.

1960
SEALY SLEEP
PRODUCTS
LIMITED
v.
SIMPSON'S-
SEARS
LIMITED
Thorson P.

It appears from the material filed before the Registrar on behalf of the appellant and relied upon by counsel for it in this appeal that it assumed that because it had incorporated the suffix "-pedic" in its trade mark "Posturepedic" it had a monopoly in the use of that suffix and had a right to prevent anyone from using a trade mark in which it is included. The appellant has no such monopoly and no such right. In every case of a trade mark including such a suffix the question whether it was or is confusing with the appellant's trade mark must be determined by the appropriate tests.

There remains the contention put forward on the appellant's behalf that the respondent's trade mark "Sears-O-Pedic" was not registrable because the prefix "Sears" is primarily the name or surname of an individual who is living or has died within the preceding thirty years. This ground of objection was based on section 12(1)(a) of the Act which provides:

12. (1) Subject to section 13, a trade mark is registrable if it is not
(a) a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years;

The contention thus put forward should be dismissed out of hand. The respondent's trade mark is not "Sears-" but "Sears-O-Pedic" and that is not within the prohibition of section 12(1)(a).

In my judgment, the Registrar was plainly right in rejecting the appellant's opposition. This appeal must, therefore, be dismissed with costs. There will, of course, be no costs for or against the Registrar of Trade Marks. He is really not a party to these proceedings and I have accordingly left his name out of the style of cause used in these reasons.

Judgment accordingly.