

1907 E. KIRSTEIN SONS & COMPANY }
 { *May 30, 31. (PLAINTIFFS) } APPELLANTS;
 *June 24.

AND

THE COHEN BROTHERS, LIMITED }
 { (DEFENDANTS) } RESPONDENTS.

ON APPEAL FROM THE COURT OF APPEAL FOR ONTARIO.

Trade-mark—Infringement—Inventive term—Coined word—Exclusive use—Colourable imitation—Common idea—Description of goods—Deceit and fraud—Passing-off goods.

The hyphenated coined words “shur-on” and “staz-on” are not purely inventive terms but are merely corruptions of words descriptive of the goods (in this case, eye-glass frames) to which they were applied, intending them to be so described, and, therefore, they cannot properly be the subject of exclusive use as trade-marks. A trader using the term “sta-zon” as descriptive of such goods, is not guilty of infringement of any rights to the use of the term “shur-on” by another trader as his trade-mark, nor of fraudulently counterfeiting similar goods described by the latter term; nor is such a use of the former term a colourable imitation of the latter term calculated to deceive purchasers, as the terms are neither phonetically nor visually alike.

The judgment appealed from (13 Ont. L.R. 144), was affirmed.

APPEAL from the judgment of the Court of Appeal for Ontario (1), affirming the judgment of Mulock C.J. at the trial (2), by which the plaintiffs’ action was dismissed without costs.

The action was brought to restrain the defendants from continuing an alleged infringement of the trade-

*PRESENT:—Fitzpatrick C.J. and Davies, Idington, Maclellan and Duff JJ.

(1) 13 Ont. L.R. 144.

(2) 11 Ont. L.R. 450.

mark "shur-on" claimed by the plaintiffs as their registered trade-mark as applied to eye-glass frames, sold by them as traders in optical goods, by the use of the coined word or term "sta-zon," as applied to similar optical goods sold by the defendants, and to restrain them from fraudulently counterfeiting the plaintiffs' goods and from selling such similar goods with the brand, label or description "sta-zon," for an account in the usual manner and for damages.

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At the trial, Mulock C.J. held that there was no similarity in the terms in question calculated to mislead the public and that there had been no infringement of a trade-mark. This decision was affirmed by the judgment of the Court of Appeal for Ontario from which the present appeal is asserted by the plaintiffs.

The questions at issue on the present appeal are stated in the judgment of His Lordship, Mr. Justice Davies, now reported.

Cassels K.C. and *McIntosh* for the appellants.

J. H. Moss and *C. A. Moss* for the respondents.

THE CHIEF JUSTICE.—I am of opinion that the appeal should be dismissed for the reasons given in the court below.

DAVIES J.—I am for dismissing this appeal on both grounds on which it was sought to be supported, viz.—the infringement of a trade-mark and the fraudulent counterfeiting of plaintiffs' goods. I do not think either of the words or distortions of words "Shur-on"

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or "Sta-zon" is merely an inventive word which could be used as a trade-mark.

On the contrary, I hold these terms to be merely corruptions of words descriptive of the eye-glass frames to which they were intended to be applied—and that they were intended to be so descriptive. They cannot therefore be properly trade-marks.

I agree with Mr. Justice Osler that neither visually nor phonetically are these words, or distortions of words, alike, and I do not think that the mere use of "Sta-zon" as applied to their eye-glass frames by the respondents was calculated to mislead purchasers into the belief that they were buying plaintiffs' goods, which they had advertised under their trade-mark or trade-name of "Shur-on." The idea intended to be conveyed by the use of these corruptions of words may have been the same, but the fact that there is a common idea underlying the use of both words or corruptions and intending to describe some special merit in the article would not of itself be sufficient to enable plaintiffs to maintain the action. He could not pre-empt nor claim the exclusive use of the idea descriptive of some merit in the article. The very fact of it being descriptive and not inventive would be fatal to its validity as a trade-mark, while, if not descriptive, his only claim, on the ground of the fraudulently passing off of defendants' goods as his, lay in the use of a word which, as I agree, is neither visually or phonetically like the word he claimed as his trade-mark or name, and is not calculated to mislead the purchasing public into the belief that they were obtaining plaintiffs' eye-glass frames.

In many of the cases cited the question as to the passing off of one man's goods for those of another turned upon the appearance of the goods or the pack-

ages in which they were wrapped as they were put upon the market or upon other misleading methods adopted.

And if the defendants here had by advertising or otherwise adopted means which would mislead the public into the belief that in buying their goods they were really buying plaintiffs', they would have brought themselves within the well-known rule relating to passing off goods.

But the case turns entirely upon the use of the word "Sta-zon" instead of "Shur-on" and the contention that the use of the former word would mislead the public into the belief that they were purchasing the plaintiffs' goods known under the name of "Shur-on."

For the reasons given I do not think it would.

IDINGTON J.—I think, for the reasons assigned by Mr. Justice Osler, in the court below, which though brief cover all the grounds upon which the action might, by any possibility, on the evidence before us, have been rested in either alternative put before us, this appeal should be dismissed with costs.

MACLENNAN J.—I agree in the opinion stated by Mr. Justice Davies.

DUFF J.—I concur in dismissing the appeal for the reasons stated by Mr. Justice Davies.

Appeal dismissed with costs.

Solicitors for the appellants: *Macdonald & Macintosh.*

Solicitors for the respondents: *Aylesworth, Wright,
Moss & Thompson.*

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