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GENERAL MOTORS CORPORATION APPELLANT;
 AND
 NORMAN WILLIAM BELLOWS RESPONDENT.

ON APPEAL FROM THE EXCHEQUER COURT OF CANADA

Trade-marks—"Frigidaire"—Whether an invented word—Whether distinctive per se—Whether descriptive—Proof of acquisition of secondary meaning required under The Trade Mark and Design Act; The Unfair Competition Act, 1932—Whether "Frozenaire" similar to "Frigidaire"—The Trade Mark and Design Act, R.S.C. 1927, c. 201, ss. 11 (e), 52 (1); The Unfair Competition Act, 1932, (Dom.) 1932, c. 38, ss. 2 (k), 23 (5), 29, 32, 52 (1).

*Present: Rinfret C.J., and Kerwin, Rand, Kellock and Locke JJ.

(1) [1949] 1 W.W.R. 842.

(3) [1946] S.C.R. 462 at 465.

(2) [1949] 2 W.W.R. 39.

The appellant appealed from a judgment of the Exchequer Court which dismissed its motion to expunge from the Register of Trade Marks the trade mark "*Frozenaire*" as applied to electric refrigerators and refrigeration on the ground that such trade mark was similar to the trade mark "*Frigidaire*" previously registered by appellant in respect of refrigeration apparatus. It further appealed from a judgment of that Court whereby a motion of the respondent to expunge from the Register the trade mark "*Frigidaire*" on the ground that it was descriptive, was allowed.

1949
 GENERAL
 MOTORS
 CORP.
 v.
 BELLOW'S

Held: (Rinfret C.J. and Kerwin J. dissenting), that "*Frigidaire*" is not an invented word but a combination of "frigid" and "air". It is not distinctive *per se* but is descriptive of the "character" of the article and the mark, without proof under r. 10 of the *Trade Mark and Design Act* that it had become distinctive by use, should have been rejected.

Held: also, that the evidence submitted in support of the application under *The Unfair Competition Act, 1932*, s. 29, that the mark had in fact become distinctive at the time of application for registration, was insufficient.

Per Rinfret C.J. and Kerwin J., dissenting,—Applying the principles laid down in *Lightning Fastener Co. Ltd. v. Canadian Goodrich Co. Ltd.* (1) to the evidence adduced in the present case, it should be held that "*Frigidaire*" was not descriptive within the meaning of the *Trade Mark and Design Act* and that the alternative application under *The Unfair Competition Act* should be dismissed with costs.

Held: further that the trade mark "*Frozenaire*" was not similar to the trade mark "*Frigidaire*" within the meaning of *The Unfair Competition Act, 1932*, s. 2 (k). *Aristoc Ltd. v. Rysta Ltd.* (2) applied.

Kellock J. was of opinion that "*Frozenaire*" was not properly registered under *The Unfair Competition Act* because of its descriptiveness in connection with the goods to which it was applied, and applying the principle laid down in *Paine v. Daniels* (3) would have directed that it be expunged from the Register.

APPEALS from two judgments of the Exchequer Court of Canada, the first of which (4) dismissed the appellant's motion to expunge from the Register of Trade Marks the trade mark "*Frozenaire*"; the second of which allowed the respondent's motion to expunge from the said Register the trade mark "*Frigidaire*" (5).

C. Robinson for the appellant.

H. G. Fox, K.C., and *G. F. Henderson* for the respondent.

The CHIEF JUSTICE and KERWIN, J. (dissenting in part): These are appeals from two judgments of the Exchequer Court of Canada. One judgment (6), rendered

(1) [1932] S.C.R. 189.

(2) [1945] A.C. 68.

(3) [1893] 2 Ch. 567.

(4) [1947] Ex. C.R. 658.

(5) [1948] Ex. C.R. 187.

(6) [1947] Ex. C.R. 568.

1949
 GENERAL
 MOTORS
 CORP.
 v.
 BELLOWS
 Rinfrét, C.J.

on the 30th of August, 1947, dismissed the appellant's motion of December 19, 1946, to expunge from the Register of Trade Marks the trade mark "*Frozenaire*" (registration Number NS68/17883, as applied to electric refrigerators and refrigeration, which motion was made on the sole ground that such trade mark is similar to the trade mark "*Frigidaire*" registered by the appellant on January 24, 1933, in respect of refrigeration apparatus. The other judgment (1) was rendered on January 22, 1948. It allowed a motion of the respondent to expunge from the Register the above-mentioned registration of the trade mark "*Frigidaire*" on the ground that the said trade mark was descriptive of the character or the quality of the wares in association with which it has been used and registered, and then allowed an alternative motion by General Motors Corporation under section 29 of *The Unfair Competition Act*. General Motors Corporation appeals from the Order expunging "*Frigidaire*", but no appeal is taken by Bellows from the Order made on the alternative motion.

Dealing first with the judgment in respect of the trade mark "*Frozenaire*", on the strength of the judgment in this Court in *Battle Pharmaceuticals v. The British Drug Houses, Ltd.* (2), and on the principle laid down by the House of Lords in *Aristoc, Ltd. v. Rysta, Ltd.* (3), we think the appeal of the General Motors Corporation from that judgment should be dismissed with costs. According to those judgments the question of similarity must be determined as a matter of first impression, and the learned trial judge has dealt with that case by applying the principles laid down in the two judgments above mentioned.

We now turn to the appeal from the Order obtained by "*Frozenaire*" expunging the registration of the trade mark "*Frigidaire*". The allegations state that the word "*Frigidaire*" is descriptive of the wares in connection with which it is used, that it lacks distinctiveness and, therefore, should not have been registered. The learned trial judge observed that the *Trade Mark and Design Act*, under which "*Frigidaire*" was registered, did not define what are "the essentials necessary to constitute a trade mark properly speaking", but that it was settled by the Judicial Com-

(1) [1948] Ex. C.R. 187.

(3) [1945] A.C. 68.

(2) [1946] S.C.R. 50.

mittee of the Privy Council in *Standard Ideal Company v. Standard Sanitary Manufacturing Company* (1), that "distinctiveness is the very essence of a trade mark". In that case Lord Macnaghten, delivering the judgment of the Privy Council, said at p. 84:—

1949
 GENERAL
 MOTORS
 CORP.
 v.
 BELLOWES
 Rinfret, C.J.

Now the word "standard" is a common English word. It seems to be used not infrequently by manufacturers and merchants in connection with the goods they put upon the market. So used it has no very precise or definite meaning * * *

It seems to their Lordships perfectly clear that a common English word having reference to the character and quality of the goods in connection with which it is used and having no reference to anything else cannot be an apt or appropriate instrument for distinguishing the goods of one trader from those of another. Distinctiveness is the very essence of a trade mark * * * The result is in accordance with the decision of the Supreme Court of Canada in *Partlo v. Todd* (2), that the word though registered is not a valid trade mark.

It might be added that in *The Canadian Shredded Wheat Co. Ltd. v. The Kellogg Co. of Canada, Ltd.* (3), Lord Russell of Killowen, speaking for the Judicial Committee, at p. 142, pointed out that the effect of section 11 (e) of *The Trade Mark and Design Act*, R.S.C. 1927, chapter 201, under which Act "*Frigidaire*" was registered, is that a word is not registrable under that Act as a trade mark which is merely descriptive of the character and quality of the goods in connection with which it is used, citing the *Standard case supra* and *Channell v. Rombough* (4).

In the present case the learned judge found that the word "*Frigidaire*" was not a registrable mark under the general provisions of the Act, that it was not *per se* a distinctive word; that, on the contrary, it was at the time of registration merely a descriptive word, lacking that distinctiveness which is necessary to constitute a trade mark properly speaking, and that it should not have been registered under the general provisions of the Act. He noted that the respondent's predecessor in title had applied for registration of the mark in the United States under the Act of 1905, but the application was refused, it is said, on the ground that the word was descriptive, although subsequently it was registered under the Act of 1920 which forbids registration of any mark that could have been registered under the Act of 1905. The learned judge also

(1) [1911] A.C. 78.

(3) (1938) 55. R.P.C. 125.

(2) (1888) 17 Can. S.C.R. 196.

(4) [1924] S.C.R. 600.

1049
 GENERAL
 MOTORS
 CORP.
 v.
 BELLOWES
 Rinfrét, C.J.

came to the conclusion that an invalid registration cannot become valid because of the acquisition of a secondary meaning after registration, thus becoming distinctive, and retain its registration. He pointed out that the new section 52 (1) changed the law as declared in the case of *The Bayer Company v. American Druggists Syndicate* (1), in which it was held that the authority to expunge (under the then section 42 of *The Trade Mark and Design Act*) "any entry made without sufficient cause" meant "without sufficient cause at the time of registration". The present section 52 (1) gives jurisdiction to the Exchequer Court to order that "any entry in the Register be struck out or amended on the ground that at the date of such application, (to wit on the application of the Registrar or any person interested) the entry as it appears on the Register does not accurately express or define the existing rights of the person appearing to be the registered owner of the mark."

The learned judge expressed the opinion that no evidence that a secondary meaning had been acquired subsequent to the registration can affect the question as to whether or not the mark, at the time of registration, was distinctive. He said:—

If the registration was invalid, it remains invalid * * * Insofar, therefore, as the question of registrability arises, the inquiry must be directed to the time of the application for registration.

He accordingly granted the application to expunge the trade mark "*Frigidaire*".

The appellant suggested in the Exchequer Court that "*Frigidaire*" was an invented word; that appears in the judgment of that Court. The learned trial judge rejected that contention and referred to Astbury J. in the application by the *Yalding Manufacturing Co. Ltd.* (2), where it was said that the mere fact that a new word, or a word which has not been included in the dictionaries, is produced, is not sufficient to make it an invented word within the meaning of the Statute. And Lord Halsbury's remarks in the *Solio case* (3), are quoted as follows:—

I can quite understand suggesting other words—compound words or foreign words—as to which it would be impossible to say that they were invented words, although, perhaps, never seen before, or that they did not indicate the character or quality of the goods, although as words of the English tongue they had never been seen before.

(1) [1924] S. C. R. 558.

(3) (1898) 15 R.P.C. 476 at 483.

(2) (1916) 33 R.P.C. 285.

And Lord Herschell is quoted at p. 485:—

I do not think the combination of two English words is an invented word, even although the combination may not have been in use before, nor do I think that a mere variation of the orthography or termination of a word would be sufficient to constitute an invented word, if to the eye or ear the same idea would be conveyed as by the word in its ordinary form.

1949
 GENERAL
 MOTORS
 CORP.
 v.
 BELLOWES

Rinfret, C.J.

And Lord Macnaghten at p. 486:—

The word must be really an invented word; nothing short of invention will do. On the other hand nothing more seems to be required * * * If it is "new and freshly coined" (to adopt an old and familiar quotation), it seems to me that it is no objection that it may be traced to a foreign source, or that it may contain a covert and skilful allusion to the character or quality of the goods.

And Lord Shand at p. 487:—

There must be invention, and not the appearance of invention only. It is not possible to define the extent of invention required, but the words I think should be clearly and substantially different from any word in ordinary and common use. The employment of a word in such use, with a diminutive or a short and meaningless syllable added to it, or a mere combination of two known words, would not be an "invented" word; and a word would not be "invented" which, with some trifling addition or very trifling variation, still leaves the word one which is well-known or in ordinary use, and which would be quite understood as intended to convey the meaning of such a word.

Astbury J. concluded his remarks in the *Yalding Manufacturing Co. Ltd.* application *supra* by saying:—

Those passages show clearly that the mere fact that a word is previously unknown, or that it has not got into any technical Dictionary, is not sufficient to make it an invented word within the meaning of the Act.

Seeking to apply the principle established in that case, and also as a result of a judgment of the Court of Appeal by Smith L.J. in *Farbenfabriken Vormals Fried. Bayer and Co's. Application* (1), the learned trial judge concluded that the word "*Frigidaire*" was clearly not an invented word, but a combination of two well-known English words long in use; and to the eye and ear the same idea is conveyed, he says, by the composite word "*Frigidaire*" as by its two component parts—"frigid" and "aire(e)". He added:—

The respondent manufactures refrigerators and refrigeration apparatus, articles which by their nature are intended to produce frigid or cooled air to preserve perishable articles placed within the apparatus. I think that the word "*Frigidaire*", used in connection with such goods, was used originally to describe and did, in fact, describe that character or quality of the respondent's goods and the purpose to which such goods were to be applied. It was, therefore, not a registrable mark under the general provisions of the Act."

1949
 GENERAL
 MOTORS
 CORP.
 v.
 BELLOWS
 Rinfret, C.J.

The learned judge accordingly held that the word "*Frigidaire*" was not *per se* a distinctive word; that, on the contrary, it was at the time of registration merely a descriptive word, lacking that distinctiveness which is necessary to constitute a trade mark properly speaking, and that it should never have been registered.

With due respect, we cannot read the judgments of Lord Halsbury, Lord Herschell, Lord Macnaghten and Lord Shand in the *Solio case supra* as having the meaning ascribed to them by the learned judge. They do say that it would be impossible to hold that words were invented, although, perhaps, they were never seen before; that a mere variation of the orthography or termination of a word would not be sufficient to constitute an invented word; and that it must be clearly and substantially different from any word in ordinary and common use—a mere combination of two known words would not be an "invented" word. But, in our opinion, these statements do not exclude the registrability of the word "*Frigidaire*" in the circumstances shown in the evidence. Moreover, special attention should be directed to the judgment of Lord Macnaghten, who says that nothing more than invention seems to be required and that, if it is "new and freshly coined", it seems that it is no objection that it may be traced to a foreign source, or that it may contain a covert and skilful allusion to the character or quality of the goods.

We, therefore, are forced to disagree with the conclusion reached by the learned trial judge when he says that, on the principle established in the *Solio case*, "*Frigidaire*" is clearly not an invented word." We can hardly come to the conclusion that it is clearly not so, and, as precisely pointed out by Astbury J. in the *Yalding Manufacturing Co. Ltd. case*, we would at least say that it is frequently a difficult matter to determine whether or not a word is an invented word, as it is a matter on which different minds may reach different conclusions. Personally, applying the principles established by their Lordships in the *Solio case* to the word "*Frigidaire*", we reach a different conclusion from that arrived at by the learned trial judge in the present case.

We have it in evidence that the word "*Frigidaire*" was not in the dictionaries when it was adopted by the appel-

lant and up to that time it had never been used by the public and had never been seen before. We concede that, as a result of the decision in the *Solio case*, these two circumstances would not be sufficient to hold that "*Frigidaire*" was an invented word. We concede also that the word is a combination of two well-known English words, although the combination had not been used before; and that the mere variation of the orthography of the word "air" ("aire") is also not sufficient to constitute an invented word. But, on the other hand, as said by Lord Macnaghten, although the word "*Frigidaire*" may be traced to a foreign source, to wit, in fact that it may have been inspired by the "frigidarium" of the Romans—as to which no evidence can be found in the record—there has been no explanation offered as to how the predecessors of the appellant came to choose that word.

1949
 GENERAL
 MOTORS
 CORP.
 v.
 BELLOWS
 Rinfret, C.J.

There remains the observation that the noble Lord makes in his judgment that a word may be none the less an invented word although "it may contain a covert and skilful allusion to the character or quality of the goods." And why should we say that "*Frigidaire*" describes the quality or character of the goods? We realize, of course, that it describes the air and it says that it is frigid, but, in our opinion, it does not describe the article, or the quality of the goods in connection with which it is used. It does not necessarily apply to a refrigerator. Up to the time when it was adopted by the predecessor of the appellant, the article or the goods in question were exclusively known as refrigerators. Nobody was using the word "*Frigidaire*"; and it is only since the word was invented by the owners of the mark that people started calling refrigerators "*Frigidaires*".

In *Lightning Fastener Co. Ltd. v. Canadian Goodrich Co. Ltd.* (1), at 197, it is stated:—

But, in order to deny registration of a word on the ground that it is descriptive, it must be shown that, at the date of the application (which is the date to be taken into consideration), the word was a descriptive name in current use, descriptive of the article itself as distinguished from a name exclusively distinctive of the merchandise of a particular dealer or manufacturer.

By the application of our decision in that case and upon the evidence adduced in the present, it should be held

1949
 GENERAL
 MOTORS
 CORP.
 v.
 BELLOWS
 —
 Rinfret, C.J.

that the word "*Frigidaire*" was not descriptive within the meaning of *The Trade Mark and Design Act* and that it should be allowed to remain on the Register.

The application of the appellant under section 29 of *The Unfair Competition Act, 1932*, was granted only as an alternative if the trial judge decided in favour of the respondent that the word "*Frigidaire*" was not registrable at the time when the registration of the mark took place on the 24th of January, 1933, under *The Trade Mark and Design Act*. The learned judge granted the latter application, because he came to the conclusion that "*Frigidaire*" should be expunged from the Register. As we come to a different conclusion, and as we are of opinion that on that point the appeal of the General Motors Corporation should be allowed, it follows that the order granting the application under section 29 disappears; it should be set aside and the second appeal of the General Motors Corporation should be allowed, with costs, and the respondent's application should be dismissed with costs. The alternative application under section 29 should be dismissed with costs.

The judgment of Rand and Locke JJ. was delivered by

RAND J.:—This appeal arises out of three applications between the parties in the Exchequer Court. The first was a motion by the appellant to expunge the word "*Frozenaire*", the trade mark of the respondent, from the register, as being similar to its own previously registered mark "*Frigidaire*"; the respondent countered with a motion to remove the latter as being descriptive; whereupon the appellant applied under section 29 of the *Unfair Competition Act* for a declaration in the terms of that section. In the consolidated proceedings before Cameron J. the first motion was rejected; the word "*Frigidaire*" was held to be descriptive and was ordered to be struck off; and the declaration requested under section 29 was made. From this latter no appeal has been taken; but the appellant seeks a reversal of the other two orders.

The word "*Frigidaire*" as applied to mechanically operated refrigerators and refrigerating equipment of a wide variety was originally adopted in the United States about the year 1918 by the *Frigidaire Corporation*, the appellant's

predecessor in title. The word from then on was used in elaborate advertising, some of which was contained in magazines circulating in Canada, and the business developed to very large proportions. An application to register the mark in that country under the Act of 1905 was refused, a fact mentioned in *Frigidaire v. Carp* (1); but registration was later allowed under the Act of 1920. The significance of this, as stated in the case of *Albany Packing Co. Inc. v. Registrar of Trade Marks* (2) at 267, and not challenged here, lies in the fact that the Act of 1905 did not permit registration of descriptive words and only marks not registrable under that statute were within the 1920 legislation. From at least the early 'twenties, considerable local advertising was done in Canada, the volume of the business grew steadily, and on September 19, 1929, application for registration was made. After some delay of no materiality here, the entry was allowed on January 24, 1933; and from that time the products have become increasingly well-known throughout the Dominion.

1949
 GENERAL
 MOTORS
 CORP.
 v.
 BELLOWS
 Rand J.

The respondent's mark was registered for the same class of goods as of April 23, 1940, the date of application; but it is stated that the mark had been used by the respondent for several years before that time.

The Unfair Competition Act came into force in 1932, and by its terms the validity of the original entry of "Frigidaire" must be determined under the preceding enactment, the *Trade Marks Act*. The pertinent provision of the latter was section 11 which, among other things, provided that the Minister might refuse registration "(e) if the so-called trade mark does not contain the essentials necessary to constitute a trade mark, properly speaking." Under a power to make regulations, rule 10 was promulgated:—

10. A Trade Mark consisting either of * * * a word having a direct reference to the character or quality of the goods in connection with which it is used, may be registered * * * upon furnishing the Commissioner with satisfactory evidence, * * * that the mark in question has, through long continued and extensive use thereof in Canada acquired a secondary meaning, and become adapted to distinguish the goods of the applicant.

This rule as specifying "essential particulars" of a trade mark was held by Sir Lyman Duff, speaking for himself

(1) (1936) 29 USPQ 49.

(2) [1940] Ex.C.R. 256.

1949
 GENERAL
 MOTORS
 CORP.
 v.
 BELLOWES
 Rand J.

and Hudson J., to be within the power conferred: *Magazine Repeating Razor Company v. Schick* (1). In *Canadian Shredded Wheat v. Kellogg* (2), at p. 142 Lord Russell referring to s. 11 observes: "The effect of this provision is that a word is not registrable under the Act as a trade mark which is merely descriptive of the character or quality of the goods in connection with which it is used"; citing *Standard Ideal Co. v. Standard Sanitary Co.* (3).

The first question is, then, whether the word "Frigidaire" was properly placed on the register in 1933. The rule quoted illustrates the conflict early recognized by the courts before the subject matter came under legislation, i.e. between the appropriation by a trader of a word within the range of language that would ordinarily be used by traders to describe particular goods, and the right of other traders in the normal carrying on of their business to employ the same or similar words. In the technique of advertising, the more complex and expensive the goods are, the greater the imaginative seeking by those producing them for attractive and arresting words; but in fixing the limits of legislative protection the courts must balance the conflicting interests and avoid placing legitimate competition at an undue disadvantage in relation to language that is common to all.

Now, "Frigidaire" may be viewed either as a single word or a combination of words, but for the present purpose I cannot see that it makes any difference which is taken. The former might claim descent from the Latin "*frigidarium*", meaning the cooling room in a Roman bath, and the Oxford dictionary shows an English use in 1706: but such an employment would be confined to classicists. That it is not an invented word is clear from the language of Lord Hershell in the *Solio* case (4), at p. 485. As a combination of "frigid" and "air", and not being distinctive *per se*, it is not only within the scope of the well-used vocabulary but particularly, I should say, within the immediate and inevitable, if not exclusive, category of terms that would first occur to the mind of an alert manufacturer of refrigerators bent on announcing his goods by means of suggestive words invitingly set up. Mr. Robinson argued that "Frigidaire" in this sense is not descriptive of the "character" of the

(1) [1940] S.C.R. 465.

(2) (1938) 55 R.P.C. 125.

(3) [1911] A.C. 78.

(4) (1898) 15 R.P.C. 476.

article, but I must say I can imagine no term more so. In our mastery of environment we have devoted a great deal of attention to foods, a most important treatment of which has been their preservation against high temperatures. What is the essence of the idea of a refrigerator? Unquestionably, that of cold air for preservation; not the precise mode of operation by which the conserving effect is achieved but the effect itself, which is the functional property of the article itself; all the rest is implied. The air must obviously be held within a container, but the result, however brought about, is what is looked at. If evidence of that were needed, it is furnished by the material filed in the case. Forty-five names are shown to have appeared in the trade of which the following are examples: "Iced-Aire", "Frigice", "North-Eaire", "Frostair", "Airgard", "Sanidaire", "Coolair" and "Friguator". These indicate that both words of the combination have some degree of effectiveness, and that would seem to follow from their commonness. The claim goes apparently to the monopoly of the word "aire". The affidavit of Shannon asserts that the company has taken successful proceedings against the use of "Ideal-Aire", "Filtaire", "Gouvernaire"; and with a similar exclusiveness of adjectives signifying coldness in combinations, the company would have successfully withdrawn from use virtually the entire group of the most apt and descriptive words for this class of goods. The case contains a number of letters to third persons which make it evident that the appellant deems itself to have the equivalent of a copyright in the word mark and in each component; but that is not so; the trade mark monopoly is to protect the business of the appellant, not a proprietorship of the word itself. The mark, therefore, without proof under rule 10 that it had become distinctive by use, should have been rejected.

Mr. Robinson points out that if the Registrar had taken such a stand, the owner could at the time have attempted at least to bring the application within that rule, and that it is unfair at this time to permit the question to be raised. He cites Lord Dunedin in *re Reddaway & Co. Ltd.*, (1) at 36, to the effect that the Registrar's decision should not now be interfered with unless he has clearly

(1) (1926) 44 R.P.C. 27.

1949
 GENERAL
 MOTORS
 CORP.
 v.
 BELLOWS
 Rand J.

gone wrong. But that, I think, is precisely what has happened here; and the applicant must be taken to have assumed the risk involved in it.

It is next urged that the evidence submitted in support of the application under section 29 shows at the same time that the mark had in fact become distinctive at the time of the application in 1929, but I am unable to find it so. Between 1926 and 1929 these new units were being introduced into Canada; and keeping in mind the cost and the likely number of persons then interested in purchasing them, where natural ice was then and had always been the only means of domestic refrigeration, and commercial refrigeration, with the same means, in its early stages, the material is quite insufficient.

Mr. Robinson finally contended that as a declaration has been made under section 29 the original entry is preserved by the effect of section 52(1) which reads:

The Exchequer Court of Canada shall have jurisdiction, on the application of the Registrar or of any person interested, to order that any entry in the register be struck out or amended on the ground that at the date of such application the entry as it appears on the register does not accurately express or define the existing rights of the person appearing to be the registered owner of the mark.

But I cannot interpret this language to do more than to allow the Court to deal with a properly registered mark as the exigencies of time may have affected it. In the other view, a retroactive validation would be given without restriction. A word mark may lose distinctiveness through, for instance, becoming the common name of the goods or from disuse or abandonment; and it is these changes leading to residual rights which the section envisages.

The question remains whether "Frozenaire" is objectionable as being similar to "Frigidaire". Clause (k) of section 2 thus defines "similar":

"Similar," in relation to trade marks, trade names or distinguishing guises, describes marks, names or guises so resembling each other or so clearly suggesting the idea conveyed by each other that the contemporaneous use of both in the same area in association with wares of the same kind would be likely to cause dealers in and/or users of such wares to infer that the same person assumed responsibility for their character or quality, for the conditions under which or the class of persons by whom they were produced, or for their place of origin;

With the elimination of the original entry "Frigidaire" the immediate question of similarity disappears; but the point has been dealt with on its merits by Cameron J. and

was argued fully and ably by both counsel before this Court. It would, I think, be both unfair to the parties and unsatisfactory generally not to deal with it here in a like manner, and I do so.

1949
 GENERAL
 MOTORS
 CORP.
 v.
 BELLOWS
 ———
 Rand J.
 ———

Mr. Fox submitted this basic consideration: that where a party has reached inside the common trade vocabulary for a word mark and seeks to prevent competitors from doing the same thing, the range of protection to be given him should be more limited than in the case of an invented or unique or non-descriptive word; and he has strong judicial support for that proposition: *Office Cleaning Services Ltd. v. Westminster Window & General Cleaners Ltd.*, (1), at 135; (2); *British Vacuum Co. Ltd. v. New Vacuum Company Co. Ltd.*, (3), at 321; *Aerators Limited v. Tollitt*, (4). In *Office Cleaning Services*, *supra*, Lord Simonds used this language:

It comes in the end, I think, to no more than this, that where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolize the words. The Court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered.

No doubt there is a public interest against confusion of these marks, but on the other hand there is a like interest in the freedom of the individual trader in ordinary trade practices and in particular in using the main stock of the language. If the latter interest is disregarded, a single word might effect a wholesale appropriation of the only apt language available. Section 2(k) does not, as argued, exclude the consideration just mentioned; the language is, "so resembling each other or so clearly suggesting the idea conveyed by each other" that the contemporaneous use would mislead as to the person responsible for their character or quality. If that is taken to exclude a competing mark by which the same idea *simpliciter* is suggested, then no other trader could use words indicating the essential idea of a refrigerator. But the idea must not only be similar; it must also be of a nature as to link the article with the person who assumes the responsibility mentioned. How in this case could the idea conveyed by

(1) (1944) 61 R.P.C. 133.

(3) [1907] 2 Ch. 312.

(2) (1946) 63 R.P.C. 39.

(4) [1902] 2 Ch. 319.

1949
 GENERAL
 MOTORS
 CORP.
 v.
 BELLOWS
 Rand J.

“Frozenaire” of itself lead a person of ordinary understanding to infer a common responsibility for the goods of both marks? The idea of each is that conveyed by the common name “refrigerator” itself. If there is any confusion, it arises from resemblance in the sound or appearance of the words. But in determining that we must take into account the entire circumstances of the trade, including the prices, the class of people purchasing, and the ordinary manner in which they do that. As Cameron J. has pointed out, prospective purchasers deliberate before buying this somewhat high class apparatus; refrigerators are not hurriedly picked off a shelf; they represent a substantial purchase and to each transaction some degree of attention and consideration are given.

Do the words then in that situation lend themselves to the errors of faint impression or recollection of the average person who goes to their market? In this I agree with Cameron J. that they do not. The word “frigid” in the one case and “frozen” in the other colour the perceptive effect of the combinations. The former, although familiar in meaning, cannot be said to be of wide and frequent use; both as seen and heard, it is a term of more precise application from a more extended vocabulary. But “frozen” is a word of daily speech among the entire population and in the combination it is intimate and general. “Frigidaire” seems also to possess a slight degree of inherent aptness for the combination which tends to blend the two words and weaken the descriptiveness; while in “Frozenaire” the adjective loses none of its robust meaning and effect, if both are not, in fact, accentuated.

Similarity is to be dealt with, of course, on the assumption that “Frigidaire” has acquired a distinctive significance; but that circumstance here seems only to enhance the dissimilarity by weakening still further the conveyance of its primary meaning. In contrast to that, a certain ruggedness and familiarity in appearance, sound and idea of the components of “Frozenaire” rules out, in my opinion, any reasonable likelihood of the objectionable association.

Mr. Fox raised a further point that the mark “Frigidaire” was by virtue of section 23(5) a design mark and as the word in that view must be treated as “emptied of all meaning” (the *Schick* case, *supra*) there can be no question

of similarity; but I am unable so to construe the original registration. There is nothing to indicate any special form of lettering and that is all that could be suggested. Certainly to the public it was, at the beginning, a word conveying only its ordinary meaning and that would seem to be the best evidence that it is not accompanied by any feature of design.

1949
 GENERAL
 MOTORS
 CORP.
 v.
 BELLOWES
 Rand J.

I would, therefore, dismiss the appeal with costs.

KELLOCK, J. (dissenting in part): I agree that the appeal from the judgment expunging the mark "Frigidaire" should be dismissed for the reasons given by my brother Rand.

With respect to the appeal from the judgment dismissing the appellant's motion to expunge the mark "Frozenaire", that motion was based on the contention that the two marks were similar within the meaning of *The Unfair Competition Act, 1932*. However that may be, I think the law applicable is to be found in the judgment of Bowen L.J., in *Paine v. Daniells*, (1), at 584:

The purity of the register of trade marks—if one may use the expression—is of much importance to trade in general, quite apart from the merits or demerits of particular litigants. If on a motion like the present the attention of the Court is called to an entry on the register of a trade-mark which cannot in law be justified as a trade-mark, it seems to me that the Court's duty may well be, *whatever the demerits of the applicant*, to purify the register and to expunge the illegal entry in the interests of trade, as was done in the *Stone Ale* case. As a rule, the Court on being seised of the matter would doubtless put an end to the existence of a trade-mark which could not possibly be justified by law.

If, as in my view, is the case, the word "Frigidaire" was not properly registered under the Act of 1906 because of its descriptiveness in connection with the goods to which it was applied, the same is even more true with respect to the word "Frozenaire" under the Act of 1932 and Mr. Fox, for the respondent, does not contend that in this view the jurisdiction to expunge does not exist, notwithstanding that the appellant did not base its application to expunge on that ground. No doubt the appellant did not do so because to have done so would have invited the attention of the court to the descriptiveness of his own client's mark. That circumstance, however, ought not to affect the duty to expunge.

1949
GENERAL
MOTORS
CORP.

I would therefore allow the appeal and direct that the word "Frozenaire" be expunged, but without costs here or below.

v.
BELLOWS
Kellock J.

Appeal from the judgment dismissing appellant's application to expunge "Frozenaire" from the Register of Trade Marks, dismissed with costs. Appeal from the judgment expunging "Frigidaire" from the Register, dismissed with costs.

Solicitors for the appellant: *Smart & Biggar.*

Solicitor for the respondent: *H. G. Fox.*
