1965
*June 11
June 24

ULTRAVITE LABORATORIES LIMITED ..... APPELLANT;

AND

WHITEHALL LABORATORIES LIMITED ..... RESPONDENT.

ON APPEAL FROM THE EXCHEQUER COURT OF CANADA

Trade marks—Registration—"Resdan" and "Dandress"—Whether confusing—Whether distinctive—Trade Marks Act, 1952-53 (Can.), c. 49, ss. 6(2), (5), 12(1)(d), 37(2)(d).

The Registrar of Trade Marks allowed the application of the appellant to register the trade mark "Dandress" over the opposition of the respondent which alleged that it was confusing with its already registered trade mark "Resdan". The Exchequer Court rejected the registration on the grounds that it was confusing and was not distinctive. The appellant appealed to this Court.

Held: The appeal should be allowed.

The first impression test is the test which should be used in determining the issue of whether a trade mark is confusing, but it should not be applied by separating the syllables and finding that there is in each of them the same syllable without referring to the variations between the two marks and the order in which that syllable appears in each mark to determine whether they are phonetically confusing. Applying this test, the average person, not skilled in semantics, going into the market to purchase a dandruff remover and hair tonic, could not be phonetically confused.

Both the words "Resdan" and "Dandress" adopt a part of the word "dandruff" and, nothing could be more ordinary in the trade than the word "dandruff". The opposition by the respondent to the use of the syllable "dand" would effect the wholesale appropriation of the only apt language available. *General Motors Corpn. v. Bellows*, 10 CPR. 101. Under the circumstances, the proposed trade mark was distinctive.

*PRESENT: Taschereau C.J. and Abbott, Martland, Ritchie and Spence JJ.

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ULTRAVITE LABORATORIES LTD. v. WHITEHALL LABORATORIES LTD.

Marques de commerce—Enregistrement—«Resdan» et «Dandress»—Ces deux mots créent-ils de la confusion—Sont-ils distinctifs—Loi sur les Marques de Commerce, 1952-53 (Can.), c. 49, arts. 6(2), (5), 12(1)(d), 37(2)(d).

Le registraire des marques de commerce a maintenu la requête de l'appelante pour faire enregistrer la marque de commerce «Dandress» malgré l'opposition de l'intimée qui avait allégué que cette marque créait de la confusion avec la marque «Resdan» qu'elle avait déjà enregistrée. La Cour de l'Échiquier a rayé l'enregistrement pour les motifs que la marque créait de la confusion et n'était pas distinctive. L'appelante en appela devant cette Cour.

Arrêt: L'appel doit être maintenu.

Le critère de la première impression est le critère dont on doit se servir pour déterminer la question de savoir si une marque de commerce crée de la confusion, mais on ne doit pas s'en servir en séparant les syllabes de telle sorte que l'on trouve qu'il y a dans chacune la même syllabe sans se référer aux variations entre les deux marques et à l'ordre dans lequel cette syllabe apparaît dans chacune pour déterminer si phonétiquement elles créent de la confusion. Appliquant ce critère, l'homme moyen, non qualifié en science sémantique, achetant un produit pour enlever les pellicules du cuir chevelu et un tonique pour les cheveux, ne pourrait pas être phonétiquement porté à la confusion.

Les deux mots «Resdan» et «Dandress» adoptent une partie du mot «dandruff» et on ne peut trouver aucun mot dans ce commerce qui soit plus ordinaire que le mot «dandruff». L'opposition de l'intimé à l'usage de la syllabe «dand» effectuerait une prise de possession complète du seul langage approprié qui soit disponible. *General Motors Corpn. v. Bellows,* 10 C.P.R. 101. Dans les circonstances, la marque de commerce était distinctive.

APPEL d'un jugement du Juge Dumoulin de la Cour de l'Échiquier du Canada[1], infirmant une décision du Registraire des marques de commerce. Appel maintenu.

APPEAL from a judgment of Dumoulin J. of the Exchequer Court of Canada[1], reversing a decision of the Registrar of Trade Marks. Appeal allowed.

W. B. Williston, Q.C., for the appellant.

Cuthbert Scott, Q.C., and *D. W. Scott* for the respondent.

The judgment of the Court was delivered by

SPENCE J.:— This is an appeal from the judgment of the Exchequer Court[1] delivered by Dumoulin J. on March 11, 1964, allowing an appeal from the decision of the Registrar of Trade Marks made on February 7, 1962, and rejecting the application of the appellant for registration of a trade mark.

[1] [1964] Ex C.R. 913, 26 Fox Pat. C. 177, 42 C.P.R. 3.

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William Sorokolit had applied to the Registrar of Trade Marks for the registration of the word "DANDRESS" as a proposed trade mark in association with a dandruff remover, hair dressing and conditioner. Sorokolit subsequently assigned the application for the registration to the appellant. The respondent Whitehall having received notice of the said application, filed opposition thereto.

The Registrar, in his decision, said:

> I have considered the evidence on file, there being no oral Hearing and, having regard to all the circumstances, I have arrived at the decision that the two marks in their totalities are not confusing and that their concurrent use in the same area would not be likely to lead to the inference that the wares emanate from the same person.

From this decision, the respondent appealed to the Exchequer Court. Dumoulin J., in his reasons for judgment, considered the attack upon the proposed trade mark under two headings. Firstly, that it was confusing with a registered trade mark, and secondly, that it was not distinctive.

Section 37(2) of the *Trade Marks Act*, Statutes of Canada, 1952-1953, c. 49, provides:

> 37. (2) Such opposition may be based on any of the following grounds:
>
> * * *
>
> (*b*) that the trade mark is not registerable;
>
> * * *
>
> (*d*) that the trade mark is not distinctive.

Section 12(1) of the *Trade Marks Act* provides:

> 12. (1) Subject to section 13, a trade mark is registerable if it is not
>
> * * *
>
> (*d*) confusing with a registered trade mark;
>
> * * *

And section 6(2) of the statute provides as follows:

> 6. (2) The use of a trade mark causes confusion with another trade mark if the use of both 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.

Subsection (5) of the same section directs the Court or the Registrar that in determining whether trade marks or trade names are confusing to 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.

Dumoulin J. referred to the said s. 6, subs. (5), and dealt particularly with para. (*e*) thereof, being of the opinion that for the purpose of determining whether the degree of resemblance between the proposed trade mark and the existing trade mark with which it was alleged to be confusing in appearance or sound, or in the idea suggested by them, was largely a matter of first impression, citing Kerwin J. in *Battle Pharmaceuticals v. British Drug Houses Ltd.*[1], and used what he described as that touchstone to determine that "RESDAN", the trade mark which was the property of the respondent, and "DANDRESS", the trade mark proposed by the appellant, sound phonetically confusing, at least on first impression. I agree that the first impression test is the test which should be used in determining the issue of whether the trade mark is confusing, but I am of the opinion that it should not be applied by separating the syllables and finding that there is in each of them the same syllable without referring to the variations between the two marks and the order in which that syllable appears in each mark to determine whether they are phonetically confusing. I adopt here the view of Thorson P. in *Sealy Sleep Products Ltd. v. Simpson's-Sears Ltd.*[2], as follows:

> The principle thus stated is as applicable in cases under the Trade Marks Act as it was in cases under the Unfair Competition Act. 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 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 similiarities 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.

If one avoids slicing up the two words, presuming they may be considered words, and speaks each so-called word then, in my view, there can be no phonetic confusion. I come to this conclusion realizing that the test to be applied is with

[1] [1946] S.C.R. 50 at 53, 5 Fox Pat. C. 135, 5 C.P.R. 71, 1 D.L.R. 289.

[2] (1960), 33 C.P.R. 129 at 136, 20 Fox Pat. C. 76.

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the average person who goes into the market and not one skilled in semantics. In expressing my view, I am putting myself in the position of the average person going into the market to purchase a dandruff remover and hair tonic.

Is the proposed trade mark "DANDRESS" distinctive? Section 2(f) defines "distinctive" as follows:

> (f) "distinctive" in relation to a trade mark means a trade mark that actually distinguishes the wares or services in association with which it is used by its owner from the wares or services of others or is adapted so to distinguish them;

Rand J., in giving the judgment of the majority in *General Motors Corporation v. Bellows*[1], approved of the submission by Mr. Fox that when a trader adopts words in common use for his trade name some risk of confusion is inevitable. It is quite evident that both the words "RES-DAN" and "DANDRESS" adopt a part of the word "dandruff" and, of course, nothing can be more ordinary in the trade than the word "dandruff". I am of the opinion that the opposition by the respondent to the use of the syllable "dand" would, in the language of Rand J. in *General Motors v. Bellows, supra,* "effect the wholesale appropriation of the only apt language available". I am, therefore, of the opinion that under the circumstances the proposed trade mark "DANDRESS" is distinctive.

I would allow the appeal with costs.

Appeal allowed with costs.

Solicitor for the appellant: R. H. Saffrey, Toronto.

Solicitors for the respondent: Scott & Aylen, Ottawa.

[1] [1949] S.C.R. 678, 10 C.P.R. 101 at 116.