

ROSARIO G. DASTOUS and ROSE CANNED FOOD PRODUCTS..... }	APPELLANTS;
AND	
MATHEWS-WELLS COMPANY LIMITED }	RESPONDENT.

1949
 * Mar. 7,
 28, 29
 * Nov. 23
 * Dec. 22

ON APPEAL FROM THE EXCHEQUER COURT OF CANADA

Trade Mark—Meaning of words “made pursuant to the provisions of this Act” as used in s. 18—Whether canned chicken “similar” wares to jams, pickles, sauces and vinegars within the meaning of s. 2(l)—Whether the mark “Rose Brand” and the mark “Rosie” are “similar” within the meaning of s. 2(k)—The Unfair Competition Act, 1932, S. of C. 1932, c. 38.

The respondent, a manufacturer of jams, jellies, pickles, sauces and vinegars, etc., is the proprietor of three trade marks; all carry the words “Rose Brand” and each bears the representation of a rose. The first two marks were registered in 1914 and 1931 respectively under the *Trade Mark and Design Act*, the third, a design mark, under the *Unfair Competition Act, 1932*. The appellant under the name of “Rosie Canned Food Products”, processes and sells various forms of canned chicken and chicken products. His labels had as their predominant feature the word “Rosie”, a contraction of his Christian name Rosario, followed by the word “Brand” in small letters, and a red rose with green leaves protruding from the sides. His application to register the mark “Rosie” was refused by the Registrar on the ground that it was confusingly similar to the registrations of the respondent.

In an action for infringement and passing off the Exchequer Court, restrained the appellant from using the word “Rosie” or any similar word, or the representation of a rose, on prepared food products similar to that of the respondent and in particular, canned chicken.

Held: (Reversing the judgment of the Exchequer Court), that the appeal should be allowed.

Per: Rinfret C.J., Taschereau, Rand and Estey JJ.—The wares of the respective parties are not, in the circumstances, within the scope of similarity defined by s. 2 (l).

Per: Rinfret C.J.—The wares are not of the same kind as required by the definition of s. 2 (k), and although they may have the common characteristics of food, that is not sufficient to declare them similar, as it would be contrary to the definition of trade mark under s. 2 (m).

*PRESENT:—Rinfret C.J., Taschereau, Rand, Estey and Locke JJ.

Reporter’s Note.—On November 23, 1949, at the request of the Court, counsel were heard further on three points of law suggested by the Court.

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Per: Taschereau, Rand and Estey JJ.—The facts of the case establish an intention to relegate the first mark to the role of a mere supporting registration and its abandonment as a mark for use in association with wares; the new designs of the later two marks have been so evolved and in such circumstances as to lead to the same conclusion.

Per: Rinfret C.J.—The word “Rose”, alone is not registrable under the Act, nor could the respondent by mere registration validly acquire a monopoly on the word “Rose” for its wares; there was no infringement of the marks so far as they are limited to the word “Rose Brand”, nor was there evidence of confusion or deception by the buying public between the products of the respective parties.

Per: Taschereau, Rand and Estey JJ.—The language of s. 18 as it speaks of registration “made pursuant to the provisions of this Act”, is to be taken as signifying the fact of being on the Register and the expression therefore embraces all registrations in the Register maintained under that Act.

Per: Taschereau, Rand and Estey JJ.—Although s. 18 (2) deals with the effect of a certified copy of the record of registration it implies necessarily that the registration itself would carry the like conclusive effect. In the circumstances of this case, the proof was made upon which the section is intended to operate.

Per: Locke J.—The certificates tendered as proof of the registration of the marks claimed to have been made under the *Trade Mark and Design Act* did not prove either the fact of registration nor that the marks were vested in the respondent. They were neither given under the provisions of s. 18 of *The Unfair Competition Act, 1932*, nor did they relate to registration made pursuant to that Act and proved nothing. The trade mark registered in November 1932 was properly proved by a certificate under s. 18 (2) but upon the evidence was only available upon the claim for infringement in respect of pickles and vinegar and the appellant’s products were not “wares of the same kind” within the meaning of s. 2 (k).

Held: Also, that the evidence did not establish the alternative claim of passing off.

APPEAL from a decision of the Exchequer Court, Cameron J. (1), whereby he held that the appellant had infringed three marks of the plaintiff; (a) a specific trade mark registered in 1914 under the *Trade Marks and Design Act* to be used in connection with the sale of jams, preserves, canned goods (except salmon), pickles, sauces, marmalades, jellies (excepting jelly powders), catsups and mustards, and consisting of a label, a rose on a green background with the wording “Rose Brand”; (b) a specific trade mark registered in 1931 under the *Trade Mark and*

(1) (1948) 8 C.P.R. 2; 7 Fox Pat. C. 8; (1948) Can. Cur. Law 161.

Design Act, to be applied to the sale of olives, vinegars, peanut butter, mayonnaise and salad dressing, consisting of a reproduction of a red rose with a green leaf on either side, and the word "Rose Brand" being represented in a black parallelogram; (c) a design mark registered in 1932 under *The Unfair Competition Act, 1932*, to be used in connection with the manufacture and sale of pickles, pickled goods, condiments, prepared mustards, salad dressings, spices, vinegars, jams, jellies, preserved and canned goods, excluding baking powders, flavouring extracts and jelly powders, consisting of a parallelogram-shaped panel having the reproduction of a rose protruding from one upper corner and a horizontally exposed rectangular panel superimposed upon the parallelogram-shaped panel and bearing the words "Rose Brand" and name of contents, and name of the respondent.

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Redmond Quain, K.C., and *T. R. Giles* for the appellant.

Christopher Robinson for the respondent.

The CHIEF JUSTICE:—This is an action for infringement of three trade marks and for passing off, and a reference as to damages and an injunction were granted in favour of the respondent.

The respondent company, whose Head Office is at Guelph, Ontario, is the proprietor of the following three marks:—

- (a) A specific trade mark to be used in connection with the sale of jams, preserves, canned goods (except salmon), pickles, sauces, marmalades, jellies (excepting jelly powders), catsups and mustards. This trade mark "consists of a label, a rose on green background with the wording "ROSE BRAND", name of contents grown and packed at Rosemount Orchards, Beamsville, Ontario.
- (b) A specific trade mark to be used in connection with the manufacture and sale of olives, vinegar, peanut butter, mayonnaise, and salad dressing. The trade mark "consists of a red rose with a green leaf on either side and the words "ROSE BRAND", the latter being represented in a black parallelogram".
- (c) A design mark to be used in connection with the manufacture and sale of pickles, pickled goods, condiments, prepared mustards, salad dressings, spices, vinegars, jams, jellies, preserved and canned goods, excluding baking powder, flavouring extracts and jelly powders. This design mark "consists of a parallelogram-shaped panel having the reproduction of a rose protruding from one upper corner and a horizontally exposed rectangular panel."

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The first and second trade marks were registered under the *Trade Mark and Design Act*, respectively on December 2, 1914, and on July 18, 1931. The design mark was registered under *The Unfair Competition Act, 1932*, on October 2, 1933.

The appellant carries on business under the name of "Rosie Canned Food Products" at Fruitland, Ontario, and is its sole proprietor. On August 7, 1946, he made application to register the mark "ROSIE" for use on wares described as canned chicken dinners (a mixture of chicken, vegetables and gravy), canned chicken stew (a mixture of chicken, vegetables and gravy), canned jellied chicken, and canned chicken sandwich spread. This application was refused by the Registrar on the ground that it was confusingly similar to the registration of the respondent.

The respondent has never manufactured canned chicken or chicken products of any sort. Most of its products are sold in jars or bottles. Only fifteen per cent of its jam is sold in tins, and about five per cent of its pickles also in tins, mostly in gallon size.

The appellant sells his products in small tins, confined entirely to canned chicken and chicken products, chicken being the main ingredient of the latter. He commenced business about 1945, and he adopted the word "ROSIE" as his trade mark (this being a contraction of his name, Rosario) and sold his products under the name of "ROSIE BRAND". The labels on the tins used by him have as their most prominent features the word "ROSIE" (followed by the word "Brand" in small letters), and a red rose with green leaves protruding from the sides.

At the outset the learned trial judge asked Counsel for the respondent his view of the meaning of the words "canned goods", which appear in the specific trade mark above described as (a) and in the design mark (c), and whether that was a proper term to indicate a particular ware or particular wares as described, to which Mr. Robinson answered as follows:—

I do not think it is and I am quite prepared to say that it is bad and that it ought to be disregarded. I think that would be the easiest way of dealing with that, my lord, because, quite apart from canned goods, the registration covers in terms jams, jellies, pickles and sauces.

I am not concerned with this registration, Exhibit 1, beyond jams, jellies, pickles and sauces, because those are the goods on which the plaintiffs have used the mark and I obviously can base my claim for infringement on the possible similarity between the goods to which the plaintiff is applying its mark and the goods to which the defendant is applying his mark and I am not concerned to base my contentions on the broad description of goods which may have been covered in the original registration but on which the plaintiff since 1931 does not appear to have used the mark. I do not concede that the mark was not properly registered but I am not relying on that. I am relying on that mark only in so far as jams, jellies, pickles and sauces are concerned. Then we come to the second registration which covers, of the goods on which the plaintiff has used the mark, vinegar, and the third registration covers, of these goods, vinegar and pickles. I will leave the question of infringement, my lord, to be decided on the basis of exhibit 1 as applied to the goods which I have mentioned, exhibit 2, as applied to vinegar, and exhibit 3 as applied to vinegar and pickles, and that my friend concedes is good.

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The effect of the above declaration is that while the trade marks or design mark are registered in respect of numerous and all-embracing classifications of wares, the marks were never used by the respondent except for a very limited number of classes of wares, and the issues were accordingly narrowed down. We have it from the admission of Mr. Robinson that the registration was bad and should be disregarded in respect of "canned goods", and that the respondent was not relying on the marks except in so far as they covered jams, jellies, pickles and sauces, or vinegar in the second registration, and vinegar and pickles in the third registration. The declaration further admits that since 1931 the respondent does not "appear to have used the marks".

The respondent complained of the use of the word "ROSIE" by the appellant, or any similar word, or the representation of a rose on prepared food products similar to those made and distributed by the respondent.

It should be noted at once that there is no evidence of confusion, or deception, by the buying public between the products of the respective parties, and this is very material. On this point it is stated by *Kerly on Trade Marks* at p. 206:—

Where the marks have been circulating side by side in the market where deception is alleged to be probable, the fact that no one appears to have been misled is very material.

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Moreover, I cannot persuade myself that the word "ROSE" considered alone may be registrable under the Act. It is a word of universal use. It is established in evidence that "there are literally scores of Rose Brand articles that grocers buy: smoked meats called 'Rosemount'; British Columbia salmon sold under the name of 'Red Rose Brand'; flour sold under the name of 'Rose Reno' and under the name of 'Rose Canadienne'; canned salmon and pilchard sold under the name of 'Rose Marie'; canned fruits or vegetables under the name of 'Royal Rose.'" All the former have been registered as trade marks and, in addition, "Empire Rose" by the Canada Rice Mills, Ltd., Vancouver, B.C., "Glen Rose" by the Kyabram Co-operative Fruit Preserving Co. Ltd., for canned apricot, peaches, pears, pineapple and fruit salad, "Cremerose" for sugar substitute, and "Calirose", on behalf of the firm of Ross MacKinnon, Vancouver, B.C., for canned tomatoes, tomato juice, tomato puree, beans, peas and asparagus. So it seems quite impossible to admit that by mere registration the respondent could have validly acquired monopoly of the word "ROSE" for its wares.

Eliminating, therefore, the use of the word "ROSIE" by the appellant, which is further explained by the fact that it is a contraction of the appellant's name Rosario, it does not seem possible to hold that there has been an infringement in that respect of the marks of the respondent so far as they are limited to the words "ROSE BRAND".

More difficulty, however, is encountered by the appellant when one looks at the get-up of its wares and the dress in which they are presented to the buyer. Kerly at p. 601 states that the material, colour and decoration of the wrappers and the lettering and arrangement of the labels should be looked at to decide whether they were meant as an imitation of the respondent's marks. (*Lever v. Goodwin* (1). In that case soap wrapped in the same peculiar parchment paper, with the similar type of printed matter, were treated as an obvious case of fraud. But, as observed by Farwell J. in *Chivers v. Chivers* (2), p. 420 at p. 429:—"The real difficulty is the finding of fact."

(1) (1887) 36 Ch. D. 1.

(2) (1900) 17 R.P.C. 420 at 429.

The complaint of infringement alleged by the respondent is based on sub-sections (a) and (c) of section 3 of *The Unfair Competition Act, 1932*, which read as follows:—

3. No person shall knowingly adopt for use in Canada in connection with any wares any trade mark or any distinguishing guise which

(a) is already in use in Canada by any other person and which is registered pursuant to the provisions of this Act as a trade mark or distinguishing guise for the same or similar wares;

* * * * *

(c) is similar to any trade mark or distinguishing guise in use, or in use and known as aforesaid.

The section reads “shall knowingly adopt” and the appellant contended that when he adopted the get-up of his wares he did not know that it bore similarity with the get-up registered by the respondent.

However, section 10 of the Act is to the effect that any person who adopts a mark identical with or similar to a mark already in use “shall be presumed to have knowingly adopted the same unless it is established” that it was adopted in good faith and in the belief that one was “entitled to adopt and use it”, or that the mark so adopted has been continuously used “in the ordinary course of business and in substantially the manner complained of during the five years immediately before the commencement of the proceedings”.

Now the proceedings in this case were commenced on January 11, 1947. The appellant did not urge before this Court that he could claim the benefit of section 10 (c) as having continuously used the get-up of his wares in the ordinary course of his business during the five years immediately before the commencement of the proceedings and the evidence, to my mind, would not justify the Court in coming to that conclusion. He did say, however, that he adopted the get-up complained of in ignorance of the use of the get-up adopted by the respondent; but it does not seem possible to give him the benefit of section 10, as one does not find in the record evidence sufficiently convincing that he has succeeded in rebutting the presumption of having knowingly adopted his get-up, if it is found to be similar to the marks of the

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respondent, within the meaning of the Act. I think, therefore, that the litigation must be decided independently of section 10.

Under section 2 (*k*)—

“Similar”, in relation to trade marks, * * * is meant to describe 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.

Under sub-section (*l*) of section 2—

“Similar” in relation to wares, describes categories of wares which, by reason of their common characteristics or of the correspondence of the classes of persons by whom they are ordinarily dealt in or used, or of the manner or circumstances of their use, would, if in the same area they contemporaneously bore the trade mark or presented the distinguishing guise in question, be likely to be so associated with each other by dealers in and/or users of them as to cause such dealers and/or users 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.

It should be noted that in s. 2 (*k*) (the definition just quoted) it is stated that the wares must be “of the same kind”.

In the judgment appealed from it is stated that as to the similarity of the respective marks of the plaintiff and the defendant “there can be no doubt”, and that they are similar within the definition of that word in section 2 (*k*). The judgment continues to say that the design used by the appellant is identical with the design of the respondent—a red rose with green leaves—and that the word mark “ROSIE” adopted by the appellant and used in connection with the word “BRAND” is obviously similar to that of the respondent.

But it is observed that the definitions of the word “similar” in sections 2 (*k*) and 2 (*l*) offer three particular requirements:—(1) characteristics of the wares, (2) the correspondence of the classes of persons by whom they are normally dealt in or used, and (3) the manner or circumstances of their use. However, when the learned judge speaks of the characteristics of the wares he says that little consideration need be given to the common characteristics; that chicken is the main ingredient of all the products

of the appellant and is not in use in any way by the respondent and that vegetables are used to some degree by the respondent and also by the appellant. He adds, further, that, as to the correspondence of the classes of persons by whom they are normally dealt in or used and the manner or circumstances of their use, it has been established in evidence that the products of both the appellant and respondent are dealt in by wholesale and retail grocers, and in some retail stores they appear alongside each other, and that the products of both parties are purchased by the general public. In that connection the learned judge refers to the judgment of this Court in *Proctor and Gamble Co. of Can. Ltd. v. LeHave Creamery Co. Ltd.* (1), where application was made to expunge the registered mark "White Clover", as applied to butter, the appellant having previously registered the same word mark as applied to hydrogenated cottonseed and vegetable oils, and it was held (p. 438) that "the two articles are so associated with each other as to cause the great majority of the purchasing public to infer that the same person assumed responsibility for their character and quality." But in that case it is to be noted that the word marks were identical and that the two products were used to a certain extent for the same purpose, i.e., for shortening; that observation is made by the learned trial judge himself.

Finally, the learned judge states—and that seems to be the main basis of his decision—that "while some of the products of the appellant are used for purposes other than those for which the respondent's goods are used, all are used for food and many of the products of the respondent are used for sandwiches, as are some of the appellant's products." On that ground his conclusion was that the wares of the parties were similar within the meaning of *The Unfair Competition Act, 1932*, and, as he had already indicated that their marks were also similar, he held that the appellant had infringed the respondent's marks and accordingly he granted an injunction to the respondent, with an order for the delivery up of labels and dies of the appellant, as claimed, and costs. As the respondent further had claimed damages, a reference to the Registrar was

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(1) [1943] S.C.R. 433.

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directed to inquire and report as to same, if any, sustained by the respondent by reason of the appellant's alleged infringement.

I find myself unable to give to sections 2 (*k*) and 2 (*l*) of *The Unfair Competition Act, 1932*, the application made by the learned trial judge. With respect, in my view, under section 2 (*k*) similarity is not established so long as the wares of the respective parties are not "of the same kind"; and it cannot be held that the wares of the respective parties come under the definition of the word "similar" in section 2 (*l*). As has been seen, Counsel for the respondent himself admitted that the respondent's marks, so far as they were meant to apply to canned goods generally, or to preserved goods, were bad, invalid and could not be upheld.

Trade marks, or design marks, in section 2 of the Act are meant to distinguish "particular wares falling within a general category from other wares falling within the same category"; and it is for that reason that a trade mark cannot be registered or held valid if it should be claimed for wares "of a general category", that is to say, for canned goods or for preserved goods. The trade mark must apply to particular wares in order to distinguish them, says the definition of "Trade mark" (section 2 (*m*)) from "other wares falling within the same category", and that is to say within the same general category.

So, therefore, whilst Counsel for the respondent properly admitted that he could not hold a trade mark generally for canned goods, or preserved goods, and that he had to limit his trade mark to jams, jellies, pickles, sauces and vinegar, in the same way must it be said that the respondent could never have obtained a trade mark, in the words of the learned trial judge, as "used for food".

The trade mark could be adapted, asked and prayed for registration only for "particular" articles of food; and it seems to be quite clear that although the wares of both parties may be classified as coming under the general category of "food", it cannot be held that if the respondent holds trade marks for the particular articles of food, to which Counsel for the respondent has himself limited the validity of the trade marks, to wit, jams, jellies, pickles, sauces and vinegar, it can come before the Courts to ask

them to exclude the appellant from using a trade mark, even if it has the same characteristics as the trade mark of the respondent, to be used in connection with different articles of food, to wit, canned chicken products in which the appellant deals alone. They are not wares of the same kind as required by the definition of "similar" in section 2 (*k*). They may have the common characteristic of food, but that is not sufficient to declare them similar, as it would be contrary to the definition of a trade mark under section 2 (*m*). Denying the use of the appellant's trade mark for his chicken products, on the ground that the latter are food, extends the meaning, or symbol, of the trade mark to a generality going much beyond the meaning of trade mark and its definition under the Act.

I need not repeat here that a trade mark can be registered only if "adapted to distinguish particular wares falling within a general category from other wares falling within the same category." Here the learned trial judge was right in deciding that the wares of both the appellant and the respondent fall within the general category of food; but the respondent's trade mark is limited to distinguish his particular wares falling within the general category of food from the appellant's particular wares falling within the same category.

Under *The Unfair Competition Act, 1932*, food generally cannot be considered a class of goods and no valid registration can be attributed to a trade mark pretending to cover all foods.

But, moreover, the registration obtained by the respondent was not for a general category, even if it could have been so obtained. It is expressly limited to the particular categories of food stated to be jams, jellies, pickles, sauces and vinegar. The trade mark here only preserved the right of the respondent to distinguish these particular wares from other wares falling within the general category of food and, therefore, it can never be claimed to exclude the appellant from using the same mark for chicken products which he alone puts on the market, even if it should be assumed that otherwise the whole of the trade mark adopted by the respective parties are held to be similar in other respects.

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I have already indicated that, in my opinion, the word "ROSE" used by the respondent cannot prevent somebody else from using the same word and, perhaps, more particularly the appellant from using the word "ROSIE", which is an abbreviation of his own name; and as the respondent's marks are composed not only of a rose with green leaves, but they include the words "ROSE BRAND", it may well be said that, as part of the marks registered by the respondent cannot exclude the use of the same part by another manufacturer or producer, for that reason also the respondent was not entitled in this case to the judgment which it secured in the Court appealed from.

So far as the complaint of passing-off is concerned, counsel for the respondent stated in this Court that he submitted it on the record as it stood and it does not appear that any particular evidence was directed to that issue. The learned trial judge, having found for the respondent on the question of infringement, did not consider it necessary to discuss the question of passing-off and in this Court counsel for the respondent merely referred to it.

The claim on that score would come under section 11 (b) of *The Unfair Competition Act, 1932*, and, to my mind, the respondent fails on that point in view of the fact that in order to make that section applicable he had to show that the course of conduct of the appellant was "likely to create confusion in Canada between his wares and those of a competitor". The word "competitor" is not defined in the Act and, therefore, must be taken to have its usual meaning. In the *Oxford Dictionary, 1933 Edition*, "competitor" is defined as "one of several who aim at the same object". The use of that word in section 11 (b) of the Act, which in section 2 (m) forbids the obtaining of a trade mark for a general category of wares and enacts that a trade mark must be limited to particular wares, clearly shows that a "competitor", within the meaning of the Act, is a man who aims at the same object as another, or several, and, therefore, cannot include the trader in chicken products as a competitor to the trader in jams, jellies, pickles, sauces and vinegar.

For these reasons I would allow the appeal and dismiss the action, with costs throughout.

The judgment of Taschereau, Rand and Estey JJ. was delivered by:—

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 Rand J.

RAND, J.:—The respondent claims infringement of three trade marks. The first was registered in 1914 and was described as consisting of “a label, a rose on green background, with the wording ‘Rose Brand’, the name of the contents and grown and packed at Rosemount Orchard, Beamsville, Ontario.” The words “Rose Brand” were printed across the face of the rose. On the register there is a notation of an assignment on May 28, 1931 by the original applicant, Davies, to Matthews and a further assignment on September 25, 1931 by the latter to the plaintiff. The mark was to be used in connection with jams, preserves, canned goods (except salmon), pickles, sauces, marmalades, jellies (excepting jelly powders), catsups and mustards.

The second mark was registered on July 18, 1931 and consisted of the “representation of a red rose with a green leaf on either side and the words ‘Rose Brand’, the latter being represented in a black parallelogram”; and was to be used in connection with the manufacture and sale of olives, vinegar, peanut butter, mayonnaise and salad dressing.

The third, which extends the parallelogram section of the second, was entered on November 12, 1932 and is described as “a parallelogram shaped panel, having the representation of a rose protruding from one upper corner and a horizontally disposed rectangular panel superimposed upon the parallelogram shaped panel”, the illustration of which contains, as its upper portion, the second mark including the words “Rose Brand”. It was to be used with pickles, pickled goods, sauces, condiments, prepared mustards, salad dressing, spices, vinegars, jams, jellies, preserved and canned goods, excluding baking powder, flavouring extracts and jelly powders. This registration was under *The Unfair Competition Act* which came into effect on May 13, 1932.

Mr. Robinson disclaims the use of the second and third marks for any other wares than vinegar and pickles, but he claims the benefit of the first for jams, jellies, pickles and sauces. Admittedly the first in its actual form has never been used by the respondent, but it is urged that by the

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effect of section 18 there is a conclusive presumption that in relation to the goods mentioned the first was in use at the time of its registration and in such a manner that the appellant cannot deny that his mark was adopted with knowledge of registration and use.

The language of section 18 as it speaks of registration "made pursuant to the provisions of this Act" presents a question of interpretation of some difficulty. Ordinarily what is done "pursuant" to a statute is done following the authority of the statute, and if we take the word "registration" to indicate the act of registering, then clearly that act in relation to the first mark could not be said to have been so done. But if "registration" is taken to signify the fact of being on the register, which clearly it can be, and if results are to be avoided for which at least no reason appears in the broad purposes of the Act, we are driven, I think, to the conclusion that the expression embraces all registrations in the register maintained under the present Act. As Mr. Robinson points out, section 4 (2) would seem to be inexplicable if the phrase as there used did not include all registered trade marks; and it would seem to me that the same thing can be said of section 3.

I should add perhaps that although section 18 (2) deals with the effect of a certified copy of the record of registration, I take it to imply necessarily that the registration itself would carry the like conclusive effect. The documents showing the registration in all three cases were offered and accepted without objection, and it was assumed that they brought before the court what the register itself could have done had it been offered. In these circumstances, the proof has been made upon which the section is intended to operate.

It is to be taken then that the defendant has adopted his trade mark knowingly in relation to those of the company, but he contends that the first mark has been abandoned. The designs and the circumstances of their adoption lead me to the view that the second and third were intended to supplant the first. In the last no colour of the rose is specified and it is on a green background. In the former, the rose is red with two green leaves projecting one on each side at the bottom; but the significant change is in

the mode in which the words "Rose Brand" as the prominent feature of the mark appear. These now show in silver on the black parallelogram producing, in contrast to the rose, a vivid and arresting effect. There are in evidence over 100 samples of these marks which, in the course of time, have come to be used with the wares, among others, for which the first is claimed.

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Another consideration supporting that intention arises from the inscription on the lower part of the first, containing the name of the orchard and the place at which the fruits were grown and packed. Under section 23 (5) (c) the first would now be taken to be a design mark without attributing any meaning to these descriptive words, but since they would not be registrable independently of the design, they do not constitute independently a word mark. The matters before us warrant the conclusion that, in representing in fact the place of business of the respondent to be at Rosemount Orchards, Beamsville, they would be misleading; whether or not the respondent is continuing the business of Davies, its place of manufacture, as advertised, is at Guelph. The inscription could, of course, have been dropped, but two modifications in the way of artistic improvement of the remaining design have already been dealt with.

The foregoing facts seem to me to establish the intention to relegate the first mark to the role of a mere supporting registration, and that as a mark for use in association with wares, it has been abandoned.

A similar question arose in *Hart's Trade Mark* (1). There, Hart was the owner of a conventional Red Rose mark registered for the whole of Class 42, which included "substances used as food, or ingredients in food." Although he sold condensed milk, his trade mark had not been used with it, but shortly before an application was made by a competing company to register a red rose device, Hart had decided to apply his own to that commodity. The company moved to have Hart's mark expunged or limited by excluding condensed milk from the goods for which it was registered and Byrne J. held that as there had been no intention to use the mark with condensed milk at the

(1) (1902) 19 R.P.C. 569.

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time of registration, the goods in question should be expunged. This made it unnecessary to decide the question of abandonment, but on that point he observed:—

I will only say that this must be a question of intention, as was pointed out by Mr. Justice Chitty in *Mouson v. Boehm* (1), and I should feel great difficulty in holding that where, as in the present case, the only user relied on, so far as concerns the particular goods, is that evidenced by the mark having been five years on the Register, there has been no abandonment, when, for more than 15 years subsequent to such five years, prior to the assignment to the respondent, there had been no user, but a sale of the description of goods with user of other and different marks.

The later marks here are not different, but their new designs have been so evolved and in such circumstances as to lead to the same conclusion. It is quite true that the respondent has renewed the first mark. That does indeed show an intention to keep the registration alive, but the intention with which abandonment is concerned is that of using the mark in connection with particular goods. Here we have not only no evidence other than the presumption from section 18(2) of the use at the time of registration in 1914 or thereafter by the original owner, but admittedly no user whatever from the time the company began its business in 1931 until the trial, a period of over fifteen years.

The remaining question then is whether the canned chicken goods, including sandwich spread, sold by the appellant and the vinegar and pickles of the respondent sold chiefly in jars are, in the circumstances, within the scope of similarity defined by section 2 (1), and I have come to the conclusion that they are not.

A rose is a well-known constituent of a trade mark; the evidence discloses nine or ten examples in which the word itself is used, and in one case with the adjective "red". Such marks are used on canned corn, pumpkin and salmon, the latter of which was, among others, excepted from the general class of canned goods in the application for the first mark. The word, therefore, with or without the flower or its colour or as the name of a "brand", is not unique or exceptional, and the evidence justifies our taking it as one of somewhat close differentiation by the general trade. This characteristic is highly relevant to the likelihood of con-

(1) (1884) 26 Ch. D. 398.

fusion as to the source of wares; and from the facts before us, it would appear that the actual practices in the trade negative that likelihood in relation to those in question.

An alternative claim for passing off was made, but weighing the whole of the evidence with care, I am unable to say that the company has established it.

I would, therefore, allow the appeal and dismiss the action with costs throughout.

LOCKE J.:—In this action the respondent claims an injunction restraining the appellants, their servants and agents, from using the word “Rosie” or any similar word, or the representation of a rose on prepared food products similar to those made and distributed by the plaintiff, an order for the delivery up to the plaintiff of all labels in the possession of the appellants bearing the word “Rosie”, and damages. The respondent claims the infringement of three registered trade marks, two of which are said to have been made under the *Trade Mark and Design Act* (R.S.C. 1906, c. 71: R.S.C. 1927, c. 201), and the third under *The Unfair Competition Act, 1932*. By the Statement of Defence the appellants put in issue the allegations that the plaintiff or its predecessor in title had adopted the trade marks in question, or that it was registered as the owner of the marks.

As proof of its ownership of the first of these marks, the respondent filed what appears to be the original certificate of its registration dated December 2, 1914, attached to which there was a certificate signed by the Commissioner of Patents reading “Certified to be a true and correct copy of a specific trade mark as registered in the Trade Mark Register No. 83, folio 20350, in accordance with the *Trade Mark and Design Act* by Arthur Henderson Davies on December 2, 1914, application for which was filed Nov. 16, 1914.” Attached to the document is a photostatic copy of Davies’ application for registration and of the mark, being the representation of a rose with the words “Rose Brand” printed across it and the words “Grown and packed at Rosemount Orchards, Beamsville, Ont.” Upon the back of the certificate of registration there appear two endorsements dated respectively May 28, 1931, and September 25, 1931, indicating that the mark had been assigned first

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to J. G. Mathews and thereafter to the respondent. The second certificate above referred to which, it is contended, proved that the trade mark was registered by Davies and thereafter assigned to the respondent is dated May 22, 1931. In regard to the 1931 mark, the respondent filed what appears to be the original certificate of the registration of a specific trade mark of the words "Rose Brand" in a described setting dated July 18, 1931, attached to which there is what purports to be a copy of the application for registration. There is, however, no certificate as to this document.

These certificates were apparently given by the Commissioner of Patents under the provisions of s. 48 of *The Trade Mark and Design Act*, c. 201, R.S.C. 1927. That section provided that such a certificate should, without proof of the signature, be received in all parts in Canada as prima facie evidence of the facts therein alleged. The certificates, therefore, if receivable in evidence would have shown that the mark had been registered respectively by Davies and by the respondent. The first would not have sufficed to prove the assignments which the respondent contends vested the right to the mark in it as to which it was silent. S. 48, however, was amended by s. 61 (2) of *The Unfair Competition Act, 1932*, by deleting from it the words "trade mark" so that as the section related to procedure only it could not be invoked in support of either certificate at the trial which took place in 1947. It is said for the respondent that the certificates, by virtue of s. 18 of *The Unfair Competition Act, 1932*, are prima facie evidence of the facts set out in the record of the registration of the marks, and further that the person named therein is the registered owner of the mark for the purposes and within the area therein defined and conclusive evidence that at the date of the registration the trade mark therein mentioned was in use in Canada or in the territorial area therein defined for the purpose therein set out, in such manner that no person could thereafter adopt the same or a similar trade mark on the same or similar goods in ignorance of the use of the registered mark by the owner thereof. The language of s. 18 is that "the production of a certified copy of the record of the registration of such trade mark made pursuant to

the provisions of this Act" shall be prima facie evidence of the matters above referred to. This language is capable of the construction that the words "made pursuant to the provisions of this Act" refer to a copy certified in accordance with its provisions, and also of meaning that they refer to the words "trade mark" which immediately precede them. The certificates were tendered in evidence and admitted without objection. The learned trial judge considered that the proper meaning of these words was that the certified copy referred to was one given pursuant to s. 25 of *The Unfair Competition Act, 1932*. It was not drawn to his attention that both of the certificates had been given prior to the date when that Act came into force. For the respondent, it is now said that the words "made pursuant to the provisions of this Act" refer to the registration of the mark and not to the certificate and that since the trade mark register made under the provisions of the earlier Act forms part of the register maintained under the provisions of *The Unfair Competition Act, 1932*, these trade marks fall within the section: the certified copy, it is contended, means a copy certified under any statutory authority. In my opinion, neither contention can be sustained. I think the words "made pursuant to the provisions of this Act" must be interpreted according to what I regard as their plain meaning, that being that the registration referred to is one made pursuant to an application under *The Unfair Competition Act, 1932*. The certified copies which were received being neither given under the provisions of that Act nor being copies of registrations made pursuant to it, were neither prima facie evidence of the facts set out in the record nor conclusive evidence of the matters above mentioned. Copies of the entries made in the trade mark register might have been admitted under s. 26 of the *Canada Evidence Act*, c. 59, R.S.C. 1927, had the seven day notice required by s. 28 been given and the fact that the record was one of the ordinary books kept in the Department proven by the oath or affidavit of an officer of such Department, as required by s. 26. Neither of these steps were taken and I think it is clear that in tendering the certificates either s. 48 of the *Trade Mark and Design Act* or s. 18 of *The Unfair Competition Act, 1932* was relied

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upon. There was no objection made to their reception but, in the circumstances of this case, I think this should not affect the matter.

The respondent seeking to take advantage of the assistance given by s. 18 to a plaintiff filing a certified copy of the record of registration, including the remarkable provision that such copy is conclusive evidence that at the date of the registration the trade mark was in use in Canada in such manner that no other person could thereafter adopt the same or a similar mark on the same or similar goods, must, I think, be required to comply strictly with the requirements of the section. In *Jacker v. The International Cable Company* (1), where certain evidence had been wrongly admitted without objection, Lopes, L.J. said that it was the duty of the Court of Appeal to disregard the document improperly admitted as the case should be decided upon legal evidence, a decision referred to and adopted in the judgment of Duff, C.J. in *The King v. The Ship "Emma K"* (2). The certificates, in my opinion, were inadmissible and the claim, in so far as it is one for infringement founded upon the alleged registration of the trade marks of 1914 and 1931 and their use, must fail.

The third of the trade marks in question was registered by the respondent as a design mark on November 12, 1932, under the provisions of the 1932 Act and proven in the manner permitted by s. 18. The mark is stated by the application to consist of a parallelogram shaped panel having the representation of a rose protruding from one upper corner and a horizontally rectangular panel superimposed upon the parallelogram shaped panel, and a specimen of the mark annexed shows a rose red in colour. By the application for registration the respondent represented to the Commissioner of Patents that he had adopted and continuously used the mark in connection with the manufacture and sale of pickles, pickled goods, sauces, condiments, prepared mustards, salad dressings, spices, vinegars, jams, jellies, preserved and canned goods, excluding baking powder, flavoring extracts and jelly powders from May 26, 1931. The president of the respondent company, however, disclosed by his evidence at the hearing that these statements as to the user of the mark were

(1) (1888) 5 T.L.R. 13.

(2) [1936] S.C.R. 256 at 262.

largely inaccurate. The respondent company was incorporated by letters patent in the year 1931 and in that year and apparently until the year 1935 the only products manufactured were pickles and vinegar. In 1935 the respondent commenced to put up olives, in 1937 jams and apple butter, in 1938 fruit juices and preserved cherries and in 1939 sauce for use with meat, and while the evidence is not entirely clear as to all of these products it would appear that the mark registered in 1932, with some slight variations in the case of some products, was used. S. 30 of *The Unfair Competition Act, 1932*, requires the applicant for registration of a mark to state in writing the date from which the applicant or his named predecessor in title has or have used the mark. While by the terms of s. 18 (2) of *The Unfair Competition Act, 1932*, a certified copy of the record of the registration of the mark, subject only to proof of clerical error therein, is stated to be conclusive evidence that at the date of the registration the trade mark was in use in Canada for the purpose therein set out in such manner that no person could thereafter adopt the same, it was thus shown as part of the plaintiff's case in the course of the proceedings that if there had been any use of this mark prior to its registration it was in respect of pickles and vinegar only. Counsel for the respondent at the trial, in these circumstances, very properly stated to the trial judge in the course of his argument that so far as the plaintiff's claim for infringement was concerned he relied upon the 1932 registration in respect of vinegar and pickles only.

S. 19 of *The Unfair Competition Act, 1932*, provides that:—

If it appears to the court that a registered trade mark was not registrable by the person by whom the application for its registration was made, the owner thereof shall not be entitled to any remedy or relief in an action for the alleged infringement of such mark without other evidence of his rights than the mere production of a certified copy of the record of the registration.

Following immediately, as it does, the provision in s. 18 (2) above referred to, that the certified copy is conclusive evidence of the use of the mark in such a manner that no other person could thereafter adopt the same on the same or similar goods, the sections appear to be inconsistent. Where, however, as in the present case, it is

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shown by the evidence tendered on behalf of the owner of the mark that there was no such user in respect of a large number of the products mentioned in the application until years after the registration of the mark, and in particular when counsel for the owner frankly admits that he cannot rely upon the mark in respect to the claim for infringement, except in respect of two of the numerous products mentioned, I think the claim may properly be dealt with on the facts disclosed by the evidence.

The plaintiff's claim should, therefore, be dealt with in so far as relief is claimed upon the basis of an alleged infringement upon the footing that it is properly registered in respect of pickles and vinegar only. The evidence shows that Dastous commenced the business of canning chicken in various forms in the year 1944. S. 3 of *The Unfair Competition Act, 1932*, in so far as relevant, provides that no person shall knowingly adopt for use in Canada in connection with any wares any trade mark or any distinguishing guise which is similar to any trade mark or distinguishing guise in use. "Similar" in relation to a trade mark is defined by subsec. (k) of s. 2 as describing marks 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 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. The respondent's design mark exhibits a rose and while the mark applied for and granted did not describe this as a red rose the design filed with the application may perhaps be taken as part of it and on this the rose is red in colour. The mark which the appellants sought to register was a word mark only but in use they exhibited the word written in prominent letters, in conjunction with a red rose. There is thus some likeness in the appearance of the two marks as used. The respondent does not, of course, claim the mark in respect of all articles of food and disclaims any claim to the mark in respect of canned goods generally. The respondent's registration enumerating various articles of food, while claiming the mark for canned goods, ex-

pressly excludes baking powder, flavouring extracts, and jelly powder. The evidence showed that there were a large number of other registered marks, one at least registered long prior to the year 1932, containing the word "rose" in various forms and some containing the representation of a red rose. Thus, as shown by the certified copy of the file relating to the appellant's application filed by the respondent as part of its case, "Rose Brand" was registered as a specific mark by The Canadian Packing Company, Limited, on August 26, 1920, for hams, bacon, lard, butter, cheese, eggs and oleomargarine. This mark was assigned to Canada Packers, Ltd., by an assignment registered on August 26, 1937. The "Red Rose Brand" was registered as a trade mark for canned salmon in 1933 by British Columbia Packers, Limited, and in addition registrations have been made of the words "Royal Rose" in respect of canned fruits, vegetables and canned fish, "Rose Marie" for mint products, and "Rose Canadienne", "Empire Rose", "Glen Rose", "Cremrose" and "Calirose" for various canned foods. The words "Red Rose", in conjunction with a representation of a red rose, have also been widely used for many years as a trade mark for tea. The cross-examination of Mr. Matthews also indicated that there is a rose or red rose mark for jelly powders used by some other manufacturer and, for this reason, these goods were excluded when applying for the registration of the mark. I do not consider that the appellants' chicken products are "wares of the same kind" as the pickles and vinegar sold by the respondent, nor, in view of the large number of other food products sold either with the mark "Rose Brand" or a representation of a red rose, do I think that the use of the appellants' mark will cause either dealers in or users of these chicken products to infer that they were produced by the respondent or that the respondent assumed responsibility for their character or quality. No doubt these various articles of food are exhibited in grocery stores in close proximity with each other. In so far as the dealers in these wares are concerned, I cannot think that there is any possibility of there being any confusion and, as to purchasers who are no doubt not given to scanning carefully what is written upon the labels of food products and who are, I would assume, confronted in

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grocery stores with many different kinds of food bearing the mark "Rose" in some form or another, I think there is no more probability of their being led by the mark to conclude that the chicken products are those of the respondent than they are to conclude that the respondent's goods are put up by the manufacturers of Red Rose tea, or of the hams, bacon and other products of the Canada Packers, or the canned fruits, vegetables and fish of the Windsor Canning Company, Ltd. I think that if there was any such risk the respondent would not have registered this mark in 1932 in the face of the registration of the "Rose Brand" by the Canadian Packing Company, Ltd., twelve years before. The claim for infringement, in my opinion, therefore fails.

The claim for passing-off was not dealt with by the learned trial judge since he was of the opinion that the claim for infringement had been proven. It is said in the Statement of Claim that the use by the defendants of these labels directs public attention to their wares in a manner that might reasonably be apprehended to be likely to cause confusion between the said wares and those of the plaintiff. Upon this aspect of the claim the respondent does not rely upon the registration of his various marks but upon their use prior to the date when the appellants commenced to use their mark. The respondent has shown that, in addition to the manufacture and sale of pickles and vinegar between the years 1931 and 1935, thereafter between the years 1935 to 1939 inclusive, it put up and sold extensively olives, jams, apple butter, fruit juices, preserved cherries and sauce for use with meat. The respondent did in fact discontinue the production of some of these products during the war, but there is no evidence to justify the finding that it has abandoned the use of its design mark upon any of them. The basis of a passing-off action being a false representation by the defendant, it must be proved in each case as a fact that such a representation has been made: the point to be decided is whether, having regard to all the circumstances of the case, the use by the defendant in connection with the goods of the mark, name, or get-up in question impliedly represents such goods to be those of

the plaintiff (*Spalding v. Gamage* (1), Lord Parker at p. 284). It is not necessary to prove any actual deception or actual resulting damage, it being sufficient to prove that the practice complained of is of such a nature that it is likely in the ordinary course of business to deceive the public. It was shown by the respondent that the labels used by it upon a variety of products for some years prior to 1944 exhibited a representation of a rose red in colour, in conjunction with the words "Rose Brand". The appellants displayed prominently upon their labels the word "Rosie" in conjunction with the figure of a red rose on goods which are, in my view, of a different kind than those manufactured by the respondent. If anyone has been misled there was no evidence to that effect, the only witness called being the wife of the Toronto representative of the respondent who expressed her opinion that if she saw canned chicken products with the words "Rosie Brand" and the picture of a rose she would think they were the goods of the respondent. Why she should think this rather than that they were products of other manufacturers using the same or closely similar brands, she did not explain. The evidence wholly fails to satisfy me that the use by the appellants of the word "Rosie" alone, or in conjunction with the figure of a rose, is likely in the ordinary course of business to deceive the public and result in a passing-off.

I would allow the appeal with costs and dismiss the action with costs.

Appeal allowed and action dismissed with costs throughout.

Solicitors for the appellants: *Carreau & Quain.*

Solicitors for the respondent: *Smart & Biggar.*

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