

HENRY GLASS & COMPANY.....PLAINTIFF;

VS.

1930
 Sept. 22, 23.
 Sept. 26.

THE HAMPTON MANUFACTURING }
 COMPANY LIMITED } DEFENDANT.

Trade-Marks—Specific Trade-Marks—Expunging—“Calculated to deceive.”

Plaintiff's trade-mark consisted of the words "Peter Pan" with a representation of Peter Pan, used in the sale of "woven piece goods," and defendant registered a trade-mark consisting also of a representation of Peter Pan, with the words "Genuine Peter Pan Garments," to be applied to "Ladies', Misses' and Children's Ready-to-Wear Garments."

Held, that while the Trade-Mark and Designs Act permits registration of a specific trade-mark, and without there being any provision for the classification of goods, nevertheless trade-marks resembling one another should not be registered for different classes of goods, if the result of the junior registration "be calculated to deceive or mislead the public"; and that, in consequence, defendant's trade-mark should be expunged, notwithstanding it was applied to garments only whilst plaintiff's was applied to piece goods.

ACTION by plaintiff herein to have the specific trade-mark of the defendant expunged.

The action was tried before the Honourable Mr. Justice Maclean, President of the Court, at Ottawa.

G. E. Mabee for plaintiff.

W. A. Merrill for defendant.

The facts are stated in the Reasons for Judgment.

THE PRESIDENT, now (September 26, 1930), delivered judgment.

The plaintiff is the registered owner of a specific trade-mark, consisting of the words "Peter Pan" together with "a representation of Peter Pan." The representation of Peter Pan is a youth, seated, with a palette in one hand and a brush in the other. This mark, which was registered in Canada in 1925, was intended to be used in connection with the sale of "woven piece goods." In practice the mark has been applied to a particular light cotton print fabric manufactured by the plaintiff in the United States, which is now being sold in quite substantial quantities in Canada, and which was also sold in Canada in substantial quantities prior to the registration of the defendant's mark. This particular class of woven fabric was and is being advertised in Canada in a substantial way under the trade name of Peter Pan, through the medium of journals circulating throughout Canada. When Peter Pan goods are sold by the plaintiff to persons proposing to manufacture the same into garments, it has been and is the practise of the plaintiff to supply such persons or concerns with an unregistered label bearing the words "Made of Genuine Peter Pan, Registered in the United States Patent Office. Guaranteed Fast Colors"; the label also contains the figure or representation of Peter Pan as shown in the application for registration, immediately above the words "Registered United States Patent Office." The labels thus supplied, are applied by the manufacturer to the garments made of the plaintiff's Peter Pan fabric. The defendant, prior to the registration of its trade-mark, which is the alleged infringing mark, manufactured and sold in Canada, garments made of Peter Pan fabric purchased of the plaintiff, and has at times used upon such garments the label I have just described. The plaintiff's trade-mark is not attacked in any way.

The defendant registered in Canada in January, 1927, as a specific trade-mark, to be applied, to "Ladies, Misses and Children's Ready-to-Wear Garments" the words Peter Pan associated with a representation of Peter Pan as exemplified in a copy of such specific trade-mark annexed to the application for registration. This copy of the mark annexed to the application bears the words "Genuine" and "Garment"; these words are separated, the former

1930

HENRY
GLASS &
Co.
v.
THE
HAMPTON
MFG. Co.,
LTD.

Maclean J.

1930
 HENRY
 GLASS &
 Co.
 v.
 THE
 HAMPTON
 MFG. Co.,
 LTD.
 Maclean J.

being above the words "Peter Pan" and the latter below the same. These words superimposed upon the representation of Peter Pan, to the casual reader appears as "Genuine Peter Pan Garment", and are part of the defendant's registered trade-mark. The defendant's representation of "Peter Pan" is said to be an adaptation of the Peter Pan statue in Kensington Gardens, London, and in my opinion, for the purposes of this case, is not to be distinguished from the plaintiff's adaptation of the same statue, particularly because of the fact that the words "Peter Pan" are associated with the figure or representation of Peter Pan. The defendant's representation of Peter Pan differs somewhat from the plaintiff's in that the youth appears to be in a standing position and playing upon a pipe, as he is represented in the famous statue in Kensington Gardens.

It has, I think, been sufficiently established by the evidence that the words "Peter Pan" accompanied by a representation of Peter Pan, when applied to a particular class of cotton print goods, denotes in Canada a certain fabric or class of cotton goods manufactured by the plaintiff. In fact these goods are sold only under the name of Peter Pan, the maker's name not appearing anywhere on the goods as sold. As already stated, the plaintiff has adopted the practise of supplying to purchasers of its Peter Pan goods and who intend to convert the same into women's or children's garments, with labels, to be attached to such garments for the purpose of representing that the same are "Made of Genuine Peter Pan"; the label, I should also say, bears the plaintiff's representation of Peter Pan, in other words, the label bears the plaintiff's full trade-mark, in order to indicate that the garment is made of the plaintiff's fabric Peter Pan. The defendant sells garments made of material, other than the plaintiff's Peter Pan, and thereto it affixes its trade-mark printed upon a small piece of cotton. There is nothing so far as I know which prevents the plaintiff supplying to garment manufacturers, using its product, the label which I have described, in fact such manufacturers could, I think, do so themselves without the plaintiff's authorization.

The Trade-Marks Act states that a trade-mark may be refused registration, if it "is calculated to deceive or mis-

lead the public." I think the defendant's mark attached to garments, is likely to be construed by the public as representing that such garments are made of the plaintiff's material, "Peter Pan," and which material or fabric has become known in Canada as Peter Pan, the plaintiff's manufacture. "Genuine Peter Pan Garment," the words prominently appearing in the defendant's registered mark, might easily, I should say, be understood by the public to represent that the garment is made of Peter Pan material, and this they would associate with the manufacture of the plaintiff. It may be said that the words "Genuine" and "Garment" should be read together, and apart from the words "Peter Pan." It is however, more easily open to the other reading, and I am inclined to the view that the public generally would read the words as "Genuine Peter Pan Garment." At least the words are very liable to be read in that way, and if so, the same is calculated to mislead the public. It was said, I think, that the defendant does not now employ the words "Genuine" and "Garment" in the use of its registered trade-mark. That, in my opinion, is no answer to the plaintiff's claim that the mark as now registered should be expunged; as it now stands registered the two words "Genuine" and "Garment" form part of the mark, and the defendant might revert to their use at any time upon the ground that they are a part of its registered mark. The elimination of these two words in the present use of the defendant's registered mark may minimize the danger of misleading the public, but I do not think it wholly removes the objection to the mark. I very strongly suspect that when the defendant first designed its mark and as later registered, it had then in mind the use only of the plaintiff's Peter Pan goods in the making of garments to which this mark was to be applied. The sketch of the mark accompanying the application for registration, in my opinion, strongly suggests this.

Evidence given by a representative of an independent business concern of Toronto, Nesbit, Auld & Co., wholesale distributors of women and children's ready-made garments, would indicate that the public do in fact associate the mere name, of "Peter Pan", when applied to ready-made cot-

1930

HENRY
GLASS &
Co.
v.
THE
HAMPTON
MFG. CO.,
LTD.

Maclean J.

1930
 HENRY
 GLASS &
 Co.
 v.
 THE
 HAMPTON
 MFG. Co.,
 LTD.
 Maclean J.

ton print garments, whether made by the defendant or by others, with the plaintiff's Peter Pan fabric. The plaintiff advertises very extensively that Peter Pan fabrics are "guaranteed fast colour fabrics", and the labels attached to garments made of Peter Pan material, as already explained, contain the words "Guaranteed Fast Colours". Nesbit, Auld & Co. sell in Canada in substantial quantities certain garments made of the plaintiff's Peter Pan. Persons in Canada have made demands upon them under the advertised guarantee, upon the ground that garments they had purchased and bearing the mark "Peter Pan"—but not made of the plaintiff's Peter Pan—had faded. Whether such garments were those of the defendant's make matters little, the point is, that such purchasers were misled into the belief that the garments were made of the plaintiff's Peter Pan goods. This evidence seems to furnish very strong proof of the fact that confusion is likely to arise in the mind of the public where the word mark "Peter Pan", with or without the representation of Peter Pan, is attached to ready-made garments not made of the plaintiff's Peter Pan goods.

But the defendant says: "our mark is not only different in get up from the plaintiff's, but is applied to garments only, whereas the plaintiff's is applied only to woven fabric." While the Act permits the registration of a specific trade-mark and without there being any provision for the classification of goods, still, I think, that the same mark, or marks resembling one another, should not be registered even for different classes of goods if the result of the junior registration "be calculated to deceive or mislead the public." That, I think, is the fact in this case, and that, I think, was not contemplated by the Act. In England, where goods are divided into classes for the purposes of registration, it has been judicially stated that too much stress must not be laid on the classification of goods in determining whether two sets of goods are of the same description. *The Australian Wine Importers Case* (1). On the other hand, there may be an intimate connection between two different sets or classes of goods, and the trade-mark used in connection with each of them may be so de-

signed and used as to mislead the public; in such a case one or the other should go. In this case, there is a very intimate connection between "Peter Pan" fabric, and "Peter Pan" garments.

The defendant contended also that the plaintiff acquiesced in the registration of its mark. I cannot make this deduction from the documentary evidence produced relative to this point, in fact, the inference I draw from this evidence is the very reverse. The defendant, in good faith, may have drawn the inference of acquiescence from the correspondence which passed between it and the plaintiff, but that inference rests on rather flimsy ground, and importance cannot, I think, be fairly attached to it. Acquiescence in a case of this kind, should be reasonably clear. It is improbable that the plaintiff would have agreed to the defendant using its mark, or anything resembling it, for use in the sale of garments not made from its Peter Pan goods. In any event the public interests are to be protected, and that, in my opinion, can only be done by expunging the defendant's mark. If this proceeding be regarded more in the nature of a passing off action than one of mere infringement, my conclusion would be the same. Jurisdiction in respect of a passing off case is, I think, given to the Court under the provision of Sec. 3, Chap. 23 Statutes of Canada, 1928.

The plaintiff is therefore, in my opinion, entitled to the relief claimed, reserving however, until the settlement of the minutes, the plaintiff's claims, 9c and 9d, as appearing in paragraph 9 of its statement of claim, to be then spoken to before me. In the circumstances of this case, I trust it will not be necessary to mention these two matters. Claim 9c should, I think, be disallowed if the defendant's mark may be removed from any goods unsold and in its possession. Without prejudice, I might now intimate that I do not think damages or an account of profits should be allowed, but if any, nothing but a mere nominal amount. The plaintiff will have its costs of action.

Judgment accordingly.

1930
 HENRY
 GLASS &
 Co.
 v.
 THE
 HAMPTON
 MFG. CO.,
 LTD.
 Maclean J.