

BETWEEN:

ROBERT C. WIAN ENTERPRISES, INC. . . APPLICANT;

AND

DAVID MADY, GEORGE MADY,
ALBERT MADY, NORMA MADY
and MICHAEL MADY trading under
the firm name or style of "BIG BOY
DRIVE-IN" and MADY'S BIG
BOY LIMITED

DEFENDANTS.

1963
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Feb. 4-8
1965
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Jan. 11
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Trade Marks—Registration—Expungement of registration—Validity of registration—Confusion of trade marks—Trade mark made known in Canada—User of trade mark not registered under Trade Marks Act by person other than plaintiff—Circulation of publications in the "ordinary course of commerce"—Trade mark made known by a person by advertising sponsored by someone else—Affidavit evidence that something is "well known in Canada"—Method of obtaining affidavit evidence that something is "well known in Canada"—Meaning of "well known in Canada"—Burden of proving no abandonment of trade mark—Requirement that registrant be satisfied he is entitled to use trade mark sought to be registered—Effect of lack of statement in application that applicant satisfied he is entitled to use trade mark sought to be registered—Trade Marks Act, S. of C. 1953, c. 49, ss. 2(n), (o) and (t), 5, 6(1) and (2), 16, 17(1), 18(1), 19, 29, 49, 56, 57 and 58(3).

The plaintiff (applicant) seeks the expungement of the registration of two trade marks registered by the defendants "Big Boy Drive-In" registered as No. 103,521, and "Big Boy" registered as No. 105,286, the entries in the Register in the case of both trade marks showing that they have been used in Canada since April 12, 1955. The trade mark "Big Boy Drive-In" relates to services, namely, "The dispensing of various types of food and specifically a hamburger" and the trade mark "Big Boy" relates to wares, namely, "Hamburgers".

The grounds upon which the plaintiff seeks to have the registrations expunged are that the registrations are invalid because on the date of first user, accepted by the parties as being April 12, 1955, each of the two trade marks was confusing with a trade mark that had been previously made known in Canada "by any other person" within the meaning of s. 16(1)(a) of the *Trade Marks Act*, and that the defendants were not satisfied that they were entitled to use their trade marks in Canada as required by s. 29, para. (i) of the *Trade Marks Act*.

Held: That in order to show that the trade marks under consideration were, prior to April 12, 1955, made known in Canada by some other person, the plaintiff must establish that, (a) the trade marks were, prior to April 12, 1955, used by the plaintiff in the United States in association with wares or services, (b) that such wares or services were, prior to April 12, 1955, advertised in association with the trade marks in (i) any printed publication circulated in Canada in the ordinary course of commerce among potential dealers in or users of such wares or services, or (ii) radio broadcasts, as defined in the *Radio Act*, ordinarily received in Canada by potential dealers in or users of such wares or services, and (c) that such trade marks had, prior to April 12,

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- 1955, "become well known in Canada" by reason of "such . . . advertising".
2. That to bring itself within the exception under s. 16 of the *Trade Marks Act*, the plaintiff must establish that each trade mark attached was "confusing" with a trade mark that had been made known in Canada in the manner set out in s. 5 of the Act at the date on which the applicant for registration of the trade mark "first so used it".
 3. That in addition to having established that the trade marks had been "made known in Canada" by the plaintiff itself prior to April 12, 1955, within the meaning of those words as defined by s. 5 of the Act, the plaintiff must also have discharged the burden imposed upon it by s. 17(1) of the Act, of showing that it had not abandoned the confusing trade marks at the date of advertisement of the defendant's applications and it must have established that the trade marks attached were "confusing" with the trade marks so made known within the meaning of that word as defined by s. 6 of the Act.
 4. That regardless of the effect of United States legislation in relation to the facts of this case, user by some person other than the plaintiff of trade marks that are not registered under the Canadian *Trade Marks Act* cannot be regarded as user by the plaintiff of these trade marks for the purposes of s. 5 of the Act by virtue of s. 49 thereof.
 5. That the provisions of s. 49 of the *Trade Marks Act* cannot, by any strain placed on their words, be interpreted as applying to user that is not in accordance with a registration under that section in respect of a trade mark that is registered under the Canadian Act.
 6. That s. 49 of the *Trade Marks Act* has no application to user of a trade mark registered under United States law by a person other than the registered owner pursuant to some United States legislative scheme for letting persons other than owners of trade marks use them for distinguishing their goods or wares.
 7. That the plaintiff's attack on the defendants' registrations by virtue of the wording of s. 16 of the *Trade Marks Act* fails because the plaintiff has failed to establish "user" of its United States trade marks by it in the United States.
 8. That circulation of publications in the "ordinary course of commerce" is accomplished by putting the publications into the hands of members of the public either as subscribers or as persons purchasing from newsstands or other outlets that exist for getting such publications into the hands of the public.
 9. That the affidavit of Robert C. Wian, sworn on August 25, 1961, is rejected on the ground that the evidence contained therein is based on information and belief and not on personal knowledge and so is not admissible as this is not an interlocutory motion for the purposes of Rule 168 of the General Rules and Orders of this Court, and, even if it were, the evidence would be inadmissible because the affidavit does not give the grounds of belief.
 10. That it is doubtful whether s. 5 of the *Trade Marks Act* can be read as providing that a trade mark is deemed to be made known in Canada "by a person" by virtue of advertising distributed or published in Canada when that advertising was sponsored by some other person.
 11. That a thing may be regarded as known in Canada if it is known only in some part of Canada but it is not "well known" in Canada unless knowledge of it pervades the country to a substantial extent. A trade mark cannot be regarded as "well known in Canada" when knowledge of it is restricted to a local area in Canada, but it must be "well known"

across Canada "among potential dealers in or users of" the wares or services with which it is associated.

12. That the plaintiff has adduced no evidence to discharge the burden imposed upon it by s. 17 of the *Trade Marks Act* to establish that it had not abandoned its trade marks at the date of the advertisement of the defendants' applications for registrations of their trade marks under the Canadian Act.
13. That it cannot be argued by the plaintiff that the defendants could not have been satisfied that they were entitled to use the trade marks in Canada in association with the wares or services described in the applications; as required by s. 29, para. (i) of the *Trade Marks Act*, when the plaintiff has failed to establish that the registrations were otherwise invalid.
14. That there is no provision in the *Trade Marks Act* under which the failure of the defendants to include in their applications for registration of their trade marks a statement that they were satisfied that they were entitled to use the trade marks in Canada in association with the wares or services described in the applications, is a basis for finding that the registrations are nullities.

Practice—Effect of United States formal judgment or Decree—Affidavits based on information and belief—Failure to state grounds of belief in affidavit based on information and belief—Value of affidavits obtained by suggestive questioning of deponents—Rule 168 of General Rules and Orders.

Held: That the formal judgment or "Decree" made by a United States court in an action in which the plaintiff in these proceedings was a party and in which it obtained judgment against a third party on the United States trade mark registrations in issue in this case, affidavit evidence of which judgment was filed by the plaintiff, can have no evidentiary value or binding effect as between the plaintiff and the defendants because not only has the doctrine of *res judicata* no application where the parties are not the same but the evidence in the United States case may well have been quite different from the evidence in this case.

2. That there is some question of the value of affidavits filed by the plaintiff to establish that its trade marks had become well known in Canada prior to April 12, 1955, by reason of radio broadcasts ordinarily received in Canada, where they have been obtained as a result of questioning that suggested to the deponents the crucial date of April 1, 1955 concerning which their evidence was required.
3. That evidence of individuals as to whether something was "well known in Canada" at a specific time, can be relevant to the question to be decided only if it be shown (a) by what scheme or survey the persons to give evidence were chosen, and (b) by what method such persons were questioned as to their knowledge of the question.
4. That it is of the utmost importance that the evidence submitted to establish that something was "well known in Canada" at a specific time, be considered in the light of the methods that were employed in selecting the deponents so that the Court can assess whether or not they are in any way representative of the body of opinion or knowledge that is being assessed. It is equally important that it be established that the deponents were not induced to give their testimony by leading questions or other improper practices.
5. That the application is dismissed.

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APPLICATION to strike out a trade mark.

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The action was tried by the Honourable Mr. Justice
Cattanach at Ottawa.

v.
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*Christopher Robinson, Q.C., Donald Sim, Q.C. and James
D. Kokonis* for the applicant.

David Watson for defendants.

The facts and questions of law raised are stated in the reasons for judgment.

CATTANACH J. now (January 11, 1965) delivered the following judgment:

Section 56 of the *Trade Marks Act*, c. 49 of the Statutes of Canada of 1953, confers on this Court jurisdiction, on the application of any person interested, to order that any entry in the register of trade marks kept under that Act be struck out on the ground that, at the date of such application, the entry does not accurately express or define the existing rights of the person appearing to be the registered owner of the mark. Section 57 provides that such an application shall be made either by the filing of an originating notice of motion, by counter-claim, or by statement of claim in an action claiming additional relief under the Act. This proceeding was originally instituted on November 26, 1959, by filing a statement of claim claiming other relief under the Act in addition to an order expunging certain trade mark registrations. That statement of claim was amended in accordance with an order of President Thorson dated April 20, 1961 to limit the relief claimed to the claim for an order expunging the trade mark registrations and, on May 4, 1961, he made an order that the Statement of Claim "be deemed to be an originating notice of motion". A "Statement of Defence and Reply to Originating Notice of Motion" was filed on May 9, 1961. While, therefore, these proceedings must be regarded as having been originated by an originating notice of motion, as the issues are defined by documents entitled Statement of Claim and Statement of Defence, and as the parties are described therein as "Plaintiff" and "Defendants" respectively, I shall so refer to them in these reasons for judgment.

The entries in the Register that the plaintiff seeks to have expunged are No. 103,521 and No. 105,286. No. 103,521

shows the defendants David Mady, George Mady, Albert Mady, Norma Mady and Michael Mady, trading as Big Boy Drive-In of 356 Ouellette Avenue, Windsor, Ontario as registrants of the trade mark "Big Boy Drive-In" in respect of services, namely, "The dispensing of various types of food and specifically a hamburger" and shows that it has been "Used in Canada since April 12, 1955". No. 105,286 shows the same defendants as registrants of the trade mark "Big Boy" in respect of wares, namely, "Hamburgers" and shows that the trade mark has also been "Used in Canada since April 12, 1955".

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The principal ground upon which the plaintiff seeks to have the registrations of these trade marks expunged is that the registrations are invalid, by virtue of s-s(1) of s. 18 of the *Trade Marks Act* because the above named defendants were not the persons entitled to secure their registration under s-s(1) of s. 16 of that Act, which reads as follows:

16. (1) Any applicant who has filed an application in accordance with section 29 for registration of a trade mark that is registrable and that he or his predecessor in title has used in Canada or made known in Canada in association with wares or services is entitled, subject to section 37, to secure its registration in respect of such wares or services, unless at the date on which he or his predecessor in title first so used it or made it known it was confusing with

- (a) a trade mark that had been previously used in Canada or made known in Canada by any other person;
- (b) a trade mark in respect of which an application for registration had been previously filed in Canada by any other person; or
- (c) a trade name that had been previously used in Canada by any other person.

The sole ground upon which the plaintiff contends that the aforesaid defendants were not entitled to have their trade marks registered under s-s(1) of s. 16 is that, upon the date of first user, which is accepted by both parties as being April 12, 1955, each of their trade marks was "confusing" with a trade mark "that had been previously . . . made known in Canada by any other person" within the meaning of those words in para. (a) of that subsection. To succeed, therefore, the plaintiff must have established

- (a) that each of the defendants' trade marks was, on April 12, 1955, "confusing" with some other trade mark within the statutory meaning given to that word by s-ss. (1) and (2) of s. 6 of the *Trade Marks Act*, and
- (b) that such other trade mark had, previous to April 12,

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1955, been "made known in Canada" by some other person within the statutory meaning given to that expression by s. 5 of the *Trade Marks Act*.

I propose to consider first what the plaintiff must have established to have shown that a trade mark was, previous to April 12, 1955, made known in Canada by some other person. Sections 5 and 17(1) of the *Trade Marks Act* read as follows:

5. A trade mark is deemed to be made known in Canada by a person only if it is used by such person in a country of the Union, other than Canada, in association with wares or services and

- (a) such wares are distributed in association with it in Canada, or
- (b) such wares or services are advertised in association with it in
 - (i) any printed publication circulated in Canada in the ordinary course of commerce among potential dealers in or users of such wares or services, or
 - (ii) radio broadcasts, as defined in the *Radio Act*, ordinarily received in Canada by potential dealers in or users of such wares or services,

and it has become well known in Canada by reason of such distribution or advertising.

17. (1) No application for registration of a trade mark that has been advertised in accordance with section 36 shall be refused and no registration of a trade mark shall be expunged or amended or held invalid on the ground of any previous use or making known of a confusing trade mark or trade name by a person other than the applicant for such registration or his predecessor in title, except at the instance of such other person or his successor in title, and the burden lies on such other person or his successor to establish that he had not abandoned such confusing trade mark or trade name at the date of advertisement of the applicant's application.

It is admitted by the defendants that the United States of America, the country in which the plaintiff claims to have established user of a trade mark is "a country of the Union" within the meaning of those words in s. 5 and the plaintiff does not make any claim to have brought itself under para.

(a) of s. 5. Furthermore, having regard to s. 17, s-s(1), the plaintiff cannot rely on a "making known of a confusing trade mark" by any person other than itself. The plaintiff must therefore have established, on this branch of the case,

- (a) that a trade mark was, previous to April 12, 1955, used by the plaintiff in the United States in association with wares or services,
- (b) that such wares or services were, previous to April 12, 1955, advertised in association with that trade mark in
 - (i) any printed publication circulated in Canada in the ordinary course of commerce among potential dealers in or users of such wares or services, or

- (ii) radio broadcasts, as defined in the *Radio Act*, ordinarily received in Canada by potential dealers in or users of such wares or services, and
- (c) that such trade mark had, previous to April 12, 1955, "become well known in Canada" by reason of "such . . . advertising".

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If the plaintiff has not established all such facts, this attack on the registrations fails because s. 5 says that a trade mark is deemed to be made known in Canada by a person "only if" all three conditions have been satisfied and the plaintiff must, to bring itself within the exception under s. 16, establish that each trade mark attacked was "confusing" with a trade mark that had been so made known in Canada at the date on which the applicant for registration of the trade mark attacked "first so used it".

In addition to having established that a trade mark had been "made known in Canada" by the plaintiff itself previous to April 12, 1955, within the meaning of those words as defined by s. 5, the plaintiff must also have discharged the burden imposed upon it by s-s. (1) of s. 17, *supra*, of showing that it had not abandoned the confusing trade mark at the date of advertisement of the defendants' application and it must, as already indicated, have established that the trade marks attacked were "confusing" with the trade mark so made known within the meaning of that word as defined by s. 6 of the *Trade Marks Act* which reads in part:

6. (1) For the purposes of this Act a trade mark or trade name is confusing with another trade mark or trade name if the use of such first mentioned trade mark or trade name would cause confusion with such last mentioned trade mark or trade name in the manner and circumstances described in this section.

(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.

If the plaintiff has failed to bring itself within that part of s. 16 on which it relies, read with ss. 5, 6 and 17, the plaintiff relies, in the alternative, on another attack on the registrations, which, in that event, will also have to be considered.

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Having outlined in a general way some of the obstacles that the plaintiff must have overcome in order to succeed in its main attack on the defendant's registrations, I now propose to consider whether it has succeeded in doing so.

I shall first consider whether the plaintiff has established that trade marks, which it says were confusing with the defendants' trade marks, were, previous to April 12, 1955, "used" by the plaintiff in the United States in association with wares or services.

The trade marks on which the plaintiff relies as having been made known by it in Canada within the statutory meaning of those words in s. 5 are two trade marks in respect of which it has United States registrations. The first is United States registration No. 561, 430 registered January 30, 1950, being the word "Bob's" and the figure of a stout boy dressed in checkered overalls and holding up a hamburger from which a bite has been taken. It is registered for "Hamburger sandwiches". The second is United States registration No. 574,742 consisting of the words "Big Boy" registered on August 11, 1952. It is also registered for "Hamburger Sandwiches".

There is no evidence that either of these trade marks has been "used" by the plaintiff in the United States in respect of wares or services. An affidavit of the president of the plaintiff company shows that the plaintiff "adopted" these trade marks (he misdescribes No. 561,430 as including the words "Big Boy" rather than the word "Bob's") and says that the plaintiff licenses and "has continuously since its adoption of the trade marks . . . licensed restaurant owners in the United States to use the Plaintiff's trade marks" but nowhere does this affidavit, or any of the other affidavits constituting the material on which the proceedings were heard pursuant to s-s(3) of s. 58 of the *Trade Marks Act*, show any user of these trade marks by the plaintiff in the United States or elsewhere.

What the plaintiff does rely on as user by it of the trade marks in the United States is user of the trade marks, or one of them, by the operators of certain "drive-in" restaurants in the State of Michigan by a person other than the

plaintiff.¹ The plaintiff's case, on this alternative, is that such user was pursuant to a "Franchise Agreement" between the plaintiff and Fred Elias, Louis Elias and John Elias, co-partners doing business under the firm name and style of "Dixie Drive-In", that such user was in compliance with certain provisions in the United States law permitting user of a trade mark by some person other than the owner of the trade mark, that United States law conferred on such user the quality of being the same as user by the owner of the trade mark and that such user therefore acquired the character of user by the owner of the trade mark for the purposes of the Canadian *Trade Marks Act* by virtue of the "Registered User" provisions to be found in s. 49 of that Act.

Much of the evidence suggests that the Michigan restaurants in question were operated by an incorporated company and not by the partnership "Dixie Drive-in". (See affidavit of Gabriel W. Kassaf and the cross-examination thereon). I do not find it possible on the evidence to find that the restaurants in question were operated by the partnership known as "Dixie Drive-in". For that reason, if that trade mark has not been registered by the plaintiff must fail. There are, moreover, other grounds for reaching the same conclusion.

The second ground for this conclusion is that, on the facts of this case, no user of a trade mark by a person other than the plaintiff can be regarded, for the purpose of s. 5 of the Canadian statute, as user by the plaintiff of that trade mark, if that trade mark has not been registered by the plaintiff under Canadian legislation.

To appreciate the plaintiff's argument, it is necessary to review certain provisions in the Canadian statute. Section 2(t) defines "trade mark" to mean, for present purposes, a mark that is used "by a person" for the purpose of distinguishing, or so as to distinguish, wares or services

¹ One argument of the defendants with which I do not propose to deal, because of the way in which I propose to dispose of the case, should be mentioned at this point. That argument is that neither the user or advertising relied on by the plaintiff is related to the plaintiff's trade mark "Big Boy" because it was, in fact, user and advertising of the trade mark "Elias Brothers Big Boy".

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manufactured, sold, . . . or performed "by him" from those manufactured, sold, . . . or performed "by others". This, indeed, as I understand it, is the public policy justification for trade mark law—the public are entitled to be protected from being deceived as to the source of the goods or services that it buys or obtains. So we find that s. 19 provides that registration of a trade mark, with certain immaterial exceptions, confers on the owner "the exclusive right" to its use throughout Canada. This character of a trade mark as being distinctive only of the goods of the owner of the trade mark so that it is a means whereby the public can have assurance that goods that they purchase are the goods of the person with whom they have dealt in the past, and in whom they have acquired confidence, is subject to a major exception engrafted on Canadian trade mark law for the first time in 1953 by s. 49 of the present statute. This section provides for registration of a person other than the owner of a registered trade mark as a "registered user", who thereupon becomes entitled to use the trade mark in accordance with the terms of the registration, which user is called "permitted user", and "permitted user" has, by virtue of s-s. (3) of s. 49, "the same effect for all the purposes of this Act as a use thereof by the registered owner". Registration of a registered user is accomplished pursuant to the joint application of the registered owner and the proposed registered user, who must show the Registrar, among other things, the relationship existing between them, the degree of control by the owner of the trade mark over the permitted user, the conditions or restrictions proposed with respect to the permitted user and the Registrar is authorized to approve a person as a registered user "if he is satisfied that . . . the use of the trade mark . . . by the proposed registered user would not be contrary to the public interest". It is not necessary for me to consider any of the many problems that may arise as to the precise character of the duty so imposed on the Registrar. Having regard to the inherent nature of trade marks as being a device to protect the public from deception, I am confident that the Registrar will feel bound to ensure that no proposed user is registered in favour of any person until he is satisfied that the "terms of his registration" are such that the public will not be deceived either as to the quality of the goods or services in respect

of which the permitted user is to be employed or as to the person with whom they are dealing, or as to the source of the goods or services that they are acquiring. I consider that it is important to have explored the nature of the legislative scheme contained in s. 49, at least to this extent, because of its relevance to the testing of the plaintiff's argument concerning the applicability of the United States legislation.

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I am of opinion that, regardless of the effect of the United States legislation in relation to the facts of this case, user by some person other than the plaintiff of trade marks that are not registered under the Canadian Act cannot be regarded as user by the plaintiff of these trade marks for the purposes of s. 5 of the Canadian Act by virtue of s. 49 thereof, the only provision to which my attention has been drawn in this connection.

The first three s-ss. of s. 49 of the *Trade Marks Act* read:

49. (1) A person other than the owner of a registered trade mark may be registered as a registered user thereof for all or any of the wares or services for which it is registered.

(2) The use of a registered trade mark by a registered user thereof in accordance with the terms of his registration as such in association with wares or services manufactured, sold, leased, hired or performed by him, or the use of a proposed trade mark as provided in subsection (2) of section 39 by a person approved as a registered user thereof, is in this section referred to as the "permitted use" of the trade mark.

(3) The permitted use of a trade mark has the same effect for all purposes of this Act as a use thereof by the registered owner.

By definition in s. 2(o) "registered trade mark" means a trade mark that is on the "register" and "register", by definition in s. 2(n) means the register kept under s. 26 of the Canadian Act. Subsection (1) of s. 49 therefore provides for registration of a person as "registered user" of a trade mark that is on the register kept under the Canadian *Trade Marks Act*. Subsection (2) of s. 49 says that the use of such a trade mark by a "registered user" in accordance with the terms of his registration is referred to in that section as "permitted user" and s-s(3) then provides that "permitted user" has the same effect "for all purposes of this Act"—i.e., the Canadian *Trade Marks Act*—as use by the registered owner. These carefully worked out provisions cannot, by any strain placed on their words, be interpreted as applying to user that is not in accordance with a registration under s. 49 in respect of a trade mark that is registered under the Canadian law. Section 49 has

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no application to user of a trade mark registered under United States law by a person other than the registered owner pursuant to some United States legislative scheme for letting persons other than owners of trade marks use them for distinguishing their goods or wares.

In the circumstances, I doubt that there is any need for me to refer to the United States law. There are, however, certain comments that I may usefully make. The provision in the United States law upon which the plaintiff relies for having use by a third person under a "Franchise Agreement" treated as use by the plaintiff for the purpose of s. 5 of the Canadian *Trade Marks Act* is s. 5 of the *United States Trademark Act*, 1946, United States Public Law 489, 79th Congress, Chapter 540, which reads as follows:

Where a registered mark or a mark sought to be registered is or may be used legitimately by related companies, such use shall inure to the benefit of the registrant or applicant for registration, and such use shall not affect the validity of such mark or of its registration, provided such mark is not used in such manner as to deceive the public.

None of the evidence concerning the United States law provides any assistance as to the effect of this statutory provision that, where a registered mark may be used legitimately by related companies, such use "shall inure to the benefit of the registrant", which are the words upon which the plaintiff is presumably relying. These words may well have a clear meaning in relation to the remainder of the United States law. I am certainly not prepared, without some evidence as to the effect of this part of United States law, to assume that they mean that such use shall be deemed to be user by the registrant, not merely as a drafting device within the context of the United States trade mark law, but as a matter of the exercise of any sovereign power that the United States Congress may have to deem something done within its territorial limits, to be for universal purposes, something that it is not.

In any event, I am not satisfied upon the evidence—both as to the facts of the case and as to the foreign law—that this is a case of "related companies" within the above United States statutory provision. That provision must apparently be read with s. 45 of the *United States Trademark Act*, 1946, which reads as follows:

The term "related company" means any person who legitimately controls or is controlled by the registrant or applicant for registration in respect to the nature and quality of the goods or services in connection with which the mark is used.

There are three affidavits by United States lawyers, a large part of which I must disregard because such part expresses opinions as to the application of the United States law to the facts of this case—as the respective lawyers understand them—or deposes to facts on information and belief. As I understand the situation, these affidavits are admissible in so far as the deponents expound, as experts, the law of the United States, and in so far as they may state facts within the personal knowledge of the deponents. It is my function to make findings as to the facts of this case, to make findings as to the applicable United States law (which is a question of fact in these proceedings) and to apply the United States law to the facts. Furthermore, I should comment on the use made in these affidavits of a formal judgment or “Decree” made by a United States Court in an action in which the plaintiff in these proceedings was a party and in which it obtained a judgment against a third party on these same United States trade mark registrations. Such a judgment cannot, of course, have any evidentiary value or binding effect as between the plaintiff and the defendants. Not only has the doctrine of *res judicata* no application where the parties are not the same but the evidence in that case may well have been quite different from the evidence here. In any event, there is some indication that it is a consent “Decree”. Taking into account the considerations to which I have referred, I cannot, on the evidence, reach the conclusion that the plaintiff controls the operators of the Elias Drive-Ins “in respect of the nature and quality of the goods” in connection with which the United States trade marks are used under the Franchise Agreement. Not only is the provision in that agreement as to the character of the hamburgers to be sold under the agreement of the most superficial and unrestrictive character, but there is no provision for supervision or control and the evidence indicates that actual control concerning “nature and quality of the goods” is, practically speaking, non-existent.

For all the above reasons, I hold that the plaintiff has failed to establish “user” of its United States trade marks by it in the United States. That being so, its attack on the defendants’ Canadian registrations by virtue of the wording of s. 16 fails, for such user of its alleged “confusing” trade

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marks is one of the conditions precedent to the success of such attack. It may, nevertheless, be well to consider whether the plaintiff has succeeded in establishing the facts required to overcome the second hurdle in the way of its success on this attack. For that purpose, it is necessary to assume that the plaintiff did establish that the two trade marks of which it is the registrant under the United States law were "used" by the plaintiff in the United States previous to April 12, 1955, in association with hamburger sandwiches or indeed in respect of other goods or services, and, on that assumption, consider whether such wares or services were advertised previous to April 12, 1955, as required by s. 5 of the Canadian *Trade Marks Act*, in association with those trade marks in

- (a) any printed publication circulated in Canada in the ordinary course of commerce among potential dealers in or users of such wares or services, or
- (b) radio broadcasts, as defined in the *Radio Act*, ordinarily received in Canada by potential dealers in or users of such wares or services.

As far as printed publications circulated in Canada in the ordinary course of commerce among potential dealers in or users of the plaintiff's wares or services are concerned, the evidence is meagre indeed. I reject any consideration of menus, napkins, bags, comic books and the like, which got into the hands of Canadians who patronized United States restaurants, on the ground that such articles were not publications circulated in Canada in the ordinary course of commerce. (In my view circulation of publications in the "ordinary course of commerce" is accomplished by putting the publications into the hands of members of the public either as subscribers or as persons purchasing from newsstands or other "outlets" that exist for getting such publications into the hands of the public.) I reject the evidence of circulation in Canada to be found in the affidavit of Robert C. Wian, sworn on August 25, 1961, on the ground that such evidence is based on information and belief and not on personal knowledge and so is not admissible as this is not an interlocutory motion for the purposes of Rule 168 of the General Rules and Orders of this Court. (It would not be admissible even on such a motion because the

affidavit does not give the grounds of belief.) I reject the evidence in Dick Johnson's affidavit of the distribution in Hamilton, Ontario of 300 copies of the November 1953 issue of the magazine "Cooking for Profit" because that was a distribution by United Gas & Fuel Company of Hamilton, Ontario, which fact, in my view, in the absence of further evidence, indicates that this was not a "circulation in the ordinary course of commerce", and because there is no evidence that this was a distribution among potential dealers in or users of hamburger sandwiches. Finally, I reject the evidence of the average Sunday circulation of the "Los Angeles Examiner" in Canada during the last nine months of 1952 because William Merritt's affidavit, by giving the source of his information, makes it clear that this information is not of his own knowledge and because there is no evidence that any of such publications contained any reference to the plaintiff's trade marks in relation to its wares. (I am left to surmise as to whether the "Sunday Pictorial Review of the Los Angeles Examiner" for June 8, 1952, referred to in Robert C. Wian's affidavit, is one of the publications referred to in Merritt's affidavit. In any event, evidence as to averages does not establish that this particular Sunday issue ever reached Canada.) There is, in my view, no satisfactory evidence that there was any advertisement of the plaintiff's wares in any publication that comes within s. 5(b)(i) of the *Trade Marks Act*.

With reference to radio and television broadcasts (it is common ground that television is included in radio as defined in the *Radio Act*), the defendants have not really challenged the plaintiff's claim that there was, in Detroit, some radio advertising of "Big Boy", or of trade marks of which the words "Big Boy" formed a part, in connection with hamburger sandwiches and other food products, that was received in Windsor previous to April 1, 1955. The evidence of what such advertising amounted to is, however, far from satisfactory. It seems clear from an examination of paras. 2 and 3 and the final sentence of para. 4 of the affidavit of Robert Baldrice, and the exhibits referred to in such parts of his affidavit, that none of the information contained therein is based on his personal knowledge and it must therefore be rejected as evidence. The second sentence of the fourth paragraph becomes meaningless in

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the absence of the first sentence therein. The last paragraph of his affidavit does not seem to add anything material. The first two sentences of that paragraph do not indicate that the advertising of Elias Brothers referred to therein has anything to do with "Big Boy" products and the last paragraph does little more than state the deponent's "belief" that what someone else says is "accurate". William H. Morgan's affidavit is also of dubious value as evidence in these proceedings. He states that "according to the records available to me", Elias Drive-Ins and Restaurants sponsored certain radio spot announcements during relevant periods and gives details of the announcements showing, among other things, a number of references to the "Big Boy" trade mark in relation to hamburgers and other food items. Apparently based on the same source of information, rather than his own knowledge, his affidavit also states that there was a similiar sponsorship of eight "TV" spot advertisements "from January, 1955 to December 24, 1955". On cross-examination, he swore that all eight "TV" advertisements took place in December 1955 and that prior to December 1955 "It was radio and strictly radio". On re-examination, he said that his own "personal knowledge" was restricted to the fact that "we paid this amount in December of '55 for eight TV spots". Subsequently, he re-attended for further cross-examination and, on further re-examination, put in documents purporting to be copies of records kept by "advertising agents" of which his personal knowledge, as it appeared from his evidence, was, to say the least, somewhat dubious. Having regard to the importance to the plaintiff's case of establishing that the advertising in question took place before April 12, 1955, and to the fact that no admissible evidence was led as part of the plaintiff's original case of the fact that such broadcasts did take place before that date, I am not inclined to place much credence on the evidence put in at this stage through a witness who appears to have had no personal knowledge of the crucial fact. I conclude, therefore, that there was, previous to April 12, 1955, radio advertising, by an operator of restaurants in Detroit and other Michigan places, of hamburgers and other kinds of food in association with the trade name "Big Boy" but that it has not been established that there was similar advertising on television before that time.

One thing is clear and that is that the plaintiff has never suggested that it, the plaintiff, had sponsored any such advertising by either radio or television that is ordinarily received in Canada, but rather it was sponsored by the Michigan interests. There is considerable doubt in my mind that s. 5 can be read as providing that a trade mark is deemed to be made known in Canada "by a person" by virtue of advertising distributed or published in Canada when that advertising was sponsored by some other person. If this is the result, there does not seem to be much point in the requirement, in s-s (1) of s. 17, that the attack on the registration must be made by the person by whom the mark had been made known. I need not, having regard to the fact that my conclusion with regard to the application of s. 5 is supported by several other grounds, come to any final conclusion on that question.

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I come now to the third and final question with regard to the application of s. 5, namely: Has the plaintiff established that the plaintiff's trade mark "Big Boy" became "well known in Canada", previous to April 12, 1955, by reason of "such . . . advertising"—that is, such radio advertising.

In this connection, the plaintiff filed 54 affidavits by persons residing in Windsor. Of these, after cross-examination of the deponents, counsel for the plaintiff indicated that he did not rely on 17. Reference to these cross-examinations makes it clear that the deponents in these 17 affidavits swore to the truth of the contents of the affidavits without any regard to the particular words in the affidavits. Indeed, the affidavits seem to have been drafted by a lawyer having regard to his view of what evidence would support the plaintiff's case and it would seem that they were then put in the hands of a layman who distributed them to others in the hope that persons might be found who would subscribe to them, which hope was, strangely enough, realized. This sorry performance, taken with the answers given on the cross-examination of many deponents on whose affidavits the plaintiff does rely, is calculated to create a very strong anxiety concerning the reliability of evidence of this kind. It is not that there would appear to be any intent on the part of the deponents to mislead (all of those to whom I refer have quite candidly contradicted, under oral examination, the statements contained in their affidavits, until it

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was brought home to them that they were so contradicting themselves when they tended to try to go back to the statements in their affidavits) it is rather the willingness of so many members of the public to put their names, even under oath, to documents stating that which some person wants them to say without any regard to the relationship of the words used in the documents to their actual knowledge of the facts. In any event, deduction of this group of 17 affidavits from the total of 54 leaves 37 affidavits that the plaintiff relies upon on this branch of the case. The affidavits of 15 other deponents state that the deponents knew of "Big Boy" hamburgers in the United States prior to April 1, 1955, this date having been chosen, apparently, by the plaintiff's agents as being just before April 12, 1955, but attribute their knowledge exclusively to information received during personal visits to the United States or to some means other than advertising of the kind contemplated by s. 5. These 15 affidavits may also be deducted from the total to which consideration must be given in considering whether there is evidence to support the plaintiff's contention on this third question that arises under s. 5. If anything, they should be considered as weighing against the plaintiff on that question because they tend to show that, if the plaintiff's trade mark "Big Boy" was well known in Canada prior to April 12, 1955, it was so known, in a large part at least, by reason of persons living in Canada having seen the plaintiff's trade mark while in the United States rather than by reason of advertising that reached them in Canada. (This is borne out by an affidavit filed by the plaintiff showing that 1,000 Canadians each month patronized the Michigan Big Boy Drive-Ins.) I am left, therefore, with 22 affidavits that have to be considered. These affidavits bear dates during the latter part of 1961 and may be noted briefly as follows:

1. DORIS AKERMAN: states that "long before April 1955" she watched in Windsor television programmes from Detroit on which Elias Brothers advertised Big Boy Hamburgers and that "as of April 1, 1955", the trade mark "Big Boy" was well known to her to refer to hamburgers available in Elias Brothers Drive-In restaurants in Detroit. This deponent is an employee or agent of a Market Research concern and conducted

the survey as a result of which the other thirty-six deponents whose affidavits were relied upon were prevailed upon to sign affidavits. She obviously had an interest in the effectiveness of the evidence that she gathered. I do not think much weight can be put on this deponent's evidence.

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2. ALBERT ALOFS: states that "prior to April 1st, 1955", Big Boy hamburgers were well known to him to be sold in the United States by Elias Bros. in Detroit and that such familiarity arose by seeing, in Canada, television advertisements associated with the Elias operation "prior to April 1st, 1955". On cross-examination, on September 25, 1961, this deponent says he saw advertisements on television in relation to Big Boy "about three or four or five or six years ago" and at another point in his cross-examination, speaking of when he saw such advertisements, he says ". . . I wouldn't bet any money on it. I would say that I saw it before '55" and, later on, he said, "It's a hard thing for me to say. I believe I saw it before 1955 myself. If there is any proof that I am wrong—then I'm wrong". Still later in his cross-examination he said, "For the exact date, no, I'm not certain" and "I think in my own mind that I saw it before that date". This deponent does not persuade me that he remembers Big Boy television advertising before April 1, 1955.

3. DONALD ANDERSON: After referring to certain programmes on "T.V. from 1949 to 1952", on which a person ate a hamburger from Elias Brothers, and another programme of no specified date advertising Elias Brothers, this deponent says that he can remember when the Big Boy store appeared in Windsor and he thought at the time that it must have some connection with the United States Big Boy and that he had heard of Big Boy hamburgers either on radio or television "before the Windsor Big Boy opened". On cross-examination this deponent was unable to be more precise concerning the time when he heard Big Boy programmes than "from 1956 to 1958 or perhaps later" or "perhaps earlier". This deponent's evidence is of little, if any, support for the plaintiff's case.

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4. MARIE BARSONA: states that "prior to April 1955" she heard Big Boy hamburgers advertised over the radio by Elias Brothers of Detroit and "as of April 1955" Big Boy hamburgers therefore indicated to her hamburgers available at Elias Brothers Stores in Detroit. On cross-examination, this deponent seems sure that she knew of the Detroit Big Boy before 1955 by reason of having been in Detroit but could not be at all sure that she had heard radio advertising of it before that time although, on re-examination, her confidence in that recollection seems to have revived. This deponent's recollection of the time of the broadcasts is too vague to assist the plaintiff.
5. FRANK BENDER, SR.: states that he remembers hearing Elias Brothers Big Boy Hamburgers advertised on television over a spot news programme in 1954 and 1955 and that as a result of seeing this advertised on television he stopped on two occasions at their stores in Detroit, the first occasion being in the summer of 1954 or 1955. On cross-examination, this deponent did not seem to be too sure whether what he heard was radio or television and it does not seem to have been too clear in his mind whether it was during the summer of 1954 or 1955. This evidence does not help to establish that the plaintiff's trade marks were well known in Canada by reason of radio advertising before April 12, 1955.
6. THOMAS L. BRADLEY: deposes that he saw television advertising of Big Boy hamburgers, that he can remember the Mady Big Boy store opening in Windsor and that he had heard of Big Boy hamburgers through radio or television "before that time" but, on cross-examination in December 1961, he stated that he first heard such television advertising "about four years ago" and that he does not think that he heard it on radio. This evidence does not support the plaintiff's case.
7. GORDON CARRUTHERS: deposes that he can remember hearing television advertising of Big Boy hamburgers in 1952, 1953, 1954 and perhaps 1955. He also says that he thinks the same advertising was done over radio stations at the same time. This witness's evidence stood up under cross-examination.

- 8. VIOLET COOPER: deposes that Big Boy hamburgers were well known to her prior to April 1, 1955 "from having seen and visited Elias Brothers Drive-Ins selling Big Boy Hamburgers in the Detroit area". Her only reference to broadcasts is her evidence on re-examination, after having been cross-examined on her affidavit, when she stated that she heard it on broadcasts but cannot remember whether she might have gathered any knowledge regarding Big Boy from the radio before she visited it in 1954. This deponent's evidence is of no value to the plaintiff's case.
- 9. MRS. KATHERINE DELANEY: deposed that, prior to April 1, 1955, she was familiar with Big Boy hamburgers on sale in the Detroit area and that this familiarity arose from watching television advertising received by her in Windsor prior to April 1, 1955. On cross-examination, this lady was not too sure when she heard the advertising on radio and on "TV" but she thought it was in 1955 and on re-examination she indicated that she first heard it on radio in 1955 but she did not know the date. This evidence does not establish that radio advertising was heard in Canada before April 12, 1955.
- 10. PAUL FIELDS: deposes that he became aware of the name Big Boy hamburgers through purchasing them, on visits to Detroit, prior to April 1, 1955. While there are no references in his affidavit to radio or television advertising, there are references to television advertising in his cross-examination and re-examination but he does not know whether he saw it before 1955. His evidence does not bear on the point in issue.
- 11. NICHOLAS IFTINIUK: deposes that the name Big Boy hamburgers was familiar to him in the Detroit area prior to April 1, 1955 and that he was aware of Big Boy hamburgers and Big Boy Drive-In restaurants in the Detroit area for several years prior to April 1, 1955 by reason of having seen and patronized Big Boy Drive-In restaurants selling Big Boy hamburgers in this area. On cross-examination, he contradicted the statement that he patronized the restaurant. While there is no reference in this affidavit to this deponent having heard or seen any advertising and there was no

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such reference in his cross-examination, on re-examination, after confirming that the name "Big Boy Hamburgers" was familiar to him in the Detroit area prior to April 1, 1955, he was asked "And how were you aware of the existence of Big Boy Hamburgers in the Detroit area?" and he replied, "I think by advertising over the radio". This last answer is a statement, albeit by way of an afterthought, that a person in Windsor heard radio advertising of Big Boy prior to April 1, 1955.

12. HORACE D. JACOBS: deposes that, prior to April 1, 1955, Big Boy hamburgers were well known to him as referring to hamburgers available at Big Boy Drive-In restaurants in the Detroit area and that such knowledge arose as a result of watching television advertising received by him in Windsor prior to April 1, 1955. On cross-examination he said that his first viewing of the television advertising might have been anywhere from 1954 to 1956. Nevertheless, on re-examination, he indicated that there was nothing in his affidavit he would want to retract. I doubt that such evidence can have much, if any, weight in establishing that Big Boy had become well known in Canada by reason of television programmes seen before April 12, 1955.
13. OLGA KANUIK: deposes that she was a waitress, that, prior to April 1, 1955, she was familiar with the fact that Big Boy hamburgers were on sale in the Detroit area and that this familiarity arose through radio advertising heard in Windsor prior to April 1, 1955. On cross-examination, this deponent denied that she was a waitress, stated that she had told the person doing the survey that she first heard the name Big Boy "in the States", and had told her that she "had heard advertising on the television and radio". On cross-examination and re-examination, it became very clear that this deponent had not known and had never pretended to know, whether she first heard this advertising in 1954, 1955 or 1956. Her evidence is of no value except that she, and a sister, both say, according to her, that they first heard of Big Boy "in the States".
14. LILLIAN KOTT: deposes that "prior to April 1, 1955, she was familiar with the name Big Boy hamburgers in

the Detroit area and that she learned about them through television and radio advertising from Detroit stations received in Windsor prior to April 1, 1955" and also from seeing Big Boy Drive-In restaurants in the United States when on trips to Detroit. On cross-examination, she denied having seen advertisements of Elias Brothers Big Boy restaurants on television, she was not sure about having seen Big Boy hamburgers advertised on television but she was sure that she had heard advertisements of Big Boy Drive-Ins on radio; however, she could not be sure of the date—it could be from 1954 to 1956. On re-examination, she became persuaded that she should stick to the date in her affidavit but her recollection is obviously not very clear.

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15. DENISE MARCOUX: deposes to having eaten Big Boy hamburgers in Detroit, to having heard of them on radio or television, but on cross-examination, it became quite clear that she could not be sure that she heard such advertising any earlier than 1956, which is not surprising when it is noted that, in November, 1961, she was only 20. Her evidence does not have any relevance to the state of affairs before April 12, 1955.
16. EDITH MARENLITTE: deposes that she remembers hearing Big Boy hamburgers advertised on the radio for years before the Big Boy store opened in Windsor. On cross-examination, the witness was very vague about the years she heard the advertising but seems to think it was in the neighbourhood of "'56 or '57, something like that". Her evidence is of no value on the question I am considering.
17. ALCIDE MENARD: deposes that the trade mark Big Boy as applied to hamburgers available at Elias Big Boy Drive-Ins in the Detroit area was well known to him prior to April 1, 1955 and that he became familiar with Big Boy hamburgers through watching advertising by Elias Stores on television programmes received by him in Windsor prior to April 1, 1955. On cross-examination, this witness was not sure of the time that he saw the television programmes and agreed that the words "prior to April 1, 1955" should be deleted from the second part of his affidavit. On re-examination, it became

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clear that this witness had got to know about the Detroit Big Boys back as far as November, 1953 through visiting Detroit.

18. DANNY PANCHUK: deposes that the name Big Boy hamburgers was well known to him as referring to hamburgers on sale in the Detroit area prior to April 1, 1955 and that his familiarity with the name Big Boy hamburgers arose from seeing the Big Boy stores advertising Big Boy hamburgers in Detroit prior to 1955 and also television advertising received by him in Canada prior to 1955. On cross-examination, this witness makes it quite clear that he could not remember when he heard either television or radio advertising of Big Boy. He said that it might be 1955, 1956 or 1957. He just did not know.
19. NORMAN S. PICKERING: deposes that he remembers hearing Big Boy hamburgers advertised over a radio station between the fall of 1954 and the spring of the year 1955 and that he can remember the year because he was working in Blenheim in a garage at the time and the radio was on all day. This witness's evidence is substantially unchanged by cross-examination.
20. VIRGINIA ROBINSON: deposes that she was, prior to April 1, 1955, aware of the existence of Big Boy hamburgers in the Detroit area and that she became aware of the existence of Big Boy hamburgers in that area through listening to and seeing in Windsor radio and television advertising sponsored by the Elias Company and broadcast on Detroit stations. On cross-examination, this deponent says that the reference to television advertising should be deleted from her affidavit and she agreed that she could not say definitely in what year she first heard it on radio. On re-examination, she decided that she could remember having heard the radio advertising in 1954 because that was the year her mother was sick.
21. LEO SOULLIERE: deposes that he became familiar with Big Boy hamburgers which were available in stores in the Detroit area before April 1, 1955 by watching television advertising by Detroit Big Boy stores in Windsor. On cross-examination, he agreed that the

woman who had first interviewed him had suggested the date in 1955 that went into his affidavit and on being asked if he was sure of the exact date he replied, "Not positive, no. I doubt if you would". However, he did remember a specific occasion when he ate a Big Boy hamburger at a drive-in in Detroit in March of 1954 and he thought that he did see it on television before that time, because that was what made him stop at one of the drive-ins.

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22. FRANCES SZARAN: deposed that Big Boy hamburgers meant to her hamburgers available at drive-ins in the Detroit area and that she became familiar with the name Big Boy hamburgers prior to April, 1955 by hearing them advertised on the radio on a Detroit station which she listened to in Windsor. Her evidence was not weakened on cross-examination.

On the crucial question as to whether the plaintiff's trade mark "Big Boy" had become well known in Canada, prior to April 12, 1955, by reason of radio broadcasts ordinarily received in Canada, all but eight of these affidavits are, in my view, of no evidentiary value. The remaining eight are those of Doris Akerman, Gordon Carruthers, Nicholas Iftiniuk, Lilliam Kott, Norman S. Pickering, Virginia Robinson, Leo Soulliere and Frances Szaran. Of these eight affidavits, all but those of Gordon Carruthers, Norman S. Pickering and Frances Szaran are, for the reasons that I have indicated, of dubious value. In addition, there is some question in my mind as to whether any attention can be paid to them having regard to the fact that, except for that of Doris Akerman, they were obtained as a result of questioning that suggested to the deponents the crucial date of April 1, 1955 concerning which their evidence was required. See *re Edward Hack*¹ per Morton J., at pages 108 *et seq.* For this reason, it does seem to me that this evidence is hardly worthy of having any weight attached to it. Furthermore, it should be noted, there was no pretence of complying with the minimum requirement for establishing what is necessary if this type of evidence is to be employed. In my view, the evidence of individuals on this kind of question—that is, whether something was "well known in

¹ (1941) 58 R.P.C. 91.

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Canada” at a specific time—can only be relevant to the question to be decided if it be shown

- (a) by what scheme or survey the persons to give evidence were chosen, and
- (b) by what method such persons were questioned as to their knowledge of the question.

It is of the utmost importance that the evidence of the respective deponents be considered in the light of the methods that were employed in selecting them so that the Court can assess whether or not they are in any way representative of the body of opinion or knowledge that is being assessed. It is equally important that it be established that the deponents were not induced to give their testimony by leading questions or other improper practices. See *Registrar of Trade Marks v. G. A. Hardie & Co. Ltd.*¹ per Kellock J. at page 501.

For the above reasons, I find that the plaintiff has failed to establish that its trade marks were “well known in Canada” prior to April 12, 1955 by reason of radio advertising.

Furthermore, I think I should say that there was really no attempt, in my view, to show that the plaintiff’s trade marks were “well known in Canada”. All that was attempted was to show that they were well known in Windsor, Ontario and surrounding territory. It was argued that, if they were well known in any part of Canada, they were “well known in Canada” within s. 5 of the *Trade Marks Act*. I cannot accept this view. A thing may be regarded as known in Canada if it is known only in some part of Canada but, in my view, it is not “well known” in Canada unless knowledge of it pervades the country to a substantial extent. When s. 5 speaks of a trade mark that is “well known in Canada by reason of . . . advertising”, it suggests to me such well known trade marks as “Coca-Cola”, “Esso”, Chevrolet” and “Frigidaire”, names that are seen in magazine advertising in homes in every part of the country, or are heard or seen on radio or on television in every part of the country. I do not think a trade mark can be regarded as “well known in

¹ [1949] S.C.R. 483.

Canada" when knowledge of it is restricted to a local area in Canada. In my view it must be "well known" across Canada "among potential dealers in or users of" the wares or services with which it is associated. In this connection I have to refer to *Registrar of Trade Marks v. G. A. Hardie & Co. Ltd.*¹ per Kellock J. at p. 500. The question there was whether it had been proved that a trade mark had been so used by any person "as to have become generally recognized by dealers in and/or users of the class of wares in association with which it had been used" so as to be registrable under s. 29 of the *Unfair Competition Act*, 1932, and Kellock J. said that the affidavits relied upon were quite insufficient to establish the "general" recognition required. He added "There must be hundreds of other laundries and there are many other hospitals throughout the country, none of which are so much as mentioned in the evidence."

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A final reason why, in my view, the plaintiff's principal attack on the defendants' Canadian registrations must fail is that it has adduced no evidence to discharge the burden imposed upon it by s. 17 of the *Trade Marks Act* to establish that it had not abandoned its trade marks at the date of the advertisement of the defendants' applications for registration of their trade marks under the Canadian Act.

In the circumstances, I need not consider whether the trade marks of the defendants' were confusing with the plaintiff's trade marks.

The plaintiff's alternative attack on the defendants' registrations is based on the requirement in para. (i) in s. 29, of the *Trade Marks Act* that an application for registration must contain "a statement that the applicant is satisfied that he is entitled to use the trade mark in Canada in association with the wares or services described in the application". There is no suggestion that the defendants' applications did not contain this statement. The argument is based on the assumption that the defendants were not in fact "satisfied" that they were entitled to use their trade marks in Canada and, that being so, their applications were not "in accordance with section 29" as required by s-s (1) of s. 16.

¹ [1949] S.C.R. 483.

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In the first place, I am of the view that this contention is not open to the plaintiff on the pleadings. There is no allegation in the Statement of Claim that the defendants were not "satisfied" as to their entitlement to use the trade marks they are registering and no evidence was led by either the plaintiff or the defendants directly related to that question.

Secondly, I cannot accept the submission that the defendants could not have been satisfied that they were entitled to use the trade marks in Canada in association with the wares or services described in the applications.¹ Indeed, I have difficulty in conceiving how this alternative contention can succeed when the plaintiff has failed to establish that the registrations are otherwise invalid. How can the defendants have been so obviously not entitled that the Court must infer that they were not "satisfied" that they were entitled when the plaintiff has been unable to show that they were not entitled?

Finally, with regard to this alternative contention, I am unable to find that there is any provision, in the very carefully worked out code of provisions in the *Trade Marks Act*, under which this is a basis for finding that a registration is a nullity.

This contention, in my view, also fails.

The application is dismissed with costs.

Judgment accordingly.

¹ Of course the defendants could not use the trade mark to pass their goods off as the goods of the plaintiff, but there is no reason why they could not so use the trade mark as not to be guilty of that tort.
