

THE BOSTON RUBBER SHOE COM- } PLAINTIFF ;
PANY }

1900
Nov. 15.

AND

THE BOSTON RUBBER COMPANY } DEFENDANT.
OF MONTREAL (Limited)..... }

*Trade-mark--Infringement--Trade-Name--Statement of claim--Sufficiency
of--Demurrer.*

- In an action for infringement of a trade-mark, it is a sufficient allegation that the trade-mark used by the defendant is the registered trade-mark of the plaintiff to charge in the statement of claim that the registered trade-mark of the plaintiff and the mark used by the defendant are in their essential features the same.
2. It is not necessary in such statement of claim to allege that the imitation by the defendant of the plaintiff's trade-mark is a fraudulent imitation.
 3. It is not necessary to allege that the defendant used the mark with intent to deceive, and to induce a belief that the goods on which their mark was used were made by the plaintiff.

DEMURRER to the statement of claim in an action for infringement of a trade-mark.

The statement of claim filed by plaintiff was, in substance, as follows :

“The plaintiff is a company duly incorporated in the year 1853 or thereabouts to carry on the business of manufacturing and selling rubber boots and shoes, having its chief place of business at the cities of Boston and Malden, State of Massachusetts, in the United States of America.

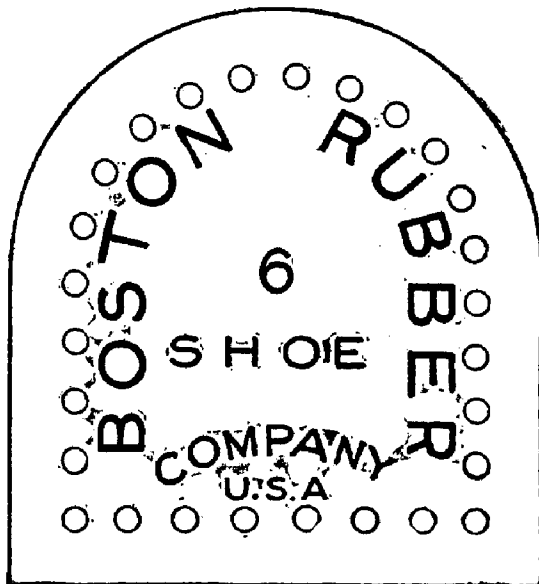
“The defendant is a company incorporated by letters-patent on or about the 27th day of November, 1896, under the laws of the Dominion of Canada to carry on a similar business to that of the plaintiff, and having its chief place of business in the City of Montreal, Canada.

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“ That ever since its incorporation the plaintiff has been and still is carrying on the said business of manufacturing rubber boots and shoes and selling the same to dealers and consumers in the United States of America and in the City of Montreal and elsewhere throughout the Dominion of Canada, as well as in almost every other civilized country of the world.

“ That ever since its incorporation the plaintiff has used as its trade-mark applied to and placed upon rubber boots and shoes so made and sold by it a mark the essential features of which consist of the words “ Boston Rubber Shoe Company ” generally arranged as follows ;



but sometimes with the words otherwise arranged and with the form of the diagram altered or omitted.

“ That the plaintiff is the owner of said mark, it or its predecessors in said business having been the first to use the same and having continuously down to the present time so used it.

“ That the plaintiff’s goods always were and are well and favourably known throughout Canada and other parts of the world by said trade mark and were

purchased and dealt in under the description indicated by said mark.

“That on or about the second day of October, 1897, the said trade-mark was duly registered by the plaintiff in the Department of Agriculture of the Dominion of Canada under the statutes of Canada respecting registration of trade-marks and a certificate therefor duly granted to the plaintiff, and said mark had also been therefore duly registered as a trade-mark in the United States of America under the laws in force there in that behalf.

“That on or about the 21st October, 1896, the Toronto Rubber Shoe Manufacturing Company (Limited) obtained the registration under the statute of Canada respecting trade-marks of a specific trade-mark consisting of the word “Boston,” and a certificate for such registration was duly granted to said last mentioned company and on or about the 20th September, 1897, by assignment duly made the plaintiff became and now is the assignee of all the right and title of said Toronto Rubber Shoe Manufacturing Company (Limited) to the said trade-mark.

“That in or prior to the year 1899 the defendant began and has ever since carried on the manufacture and sale in said City of Montreal and elsewhere in Canada of rubber boots and shoes of similar classes to those made and sold by the plaintiff and put thereupon and applied thereto as the defendant’s mark the following:



said mark being placed upon the same part of the boot

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or shoe made by the defendant as the plaintiff on its boots and shoes used to place its said trade-mark.

“ That said defendant has not obtained the registration of said mark under the statutes of Canada respecting trade-marks.

“ The said mark so used by the defendant is in its essential features the same as that of the first mentioned trade-mark of the plaintiff or in any event resembles the same and is an imitation thereof and is an infringement of the plaintiff's said trade-mark.

“ The said mark so used by the defendant so closely resembles in its essential features and mode of application upon similar classes of goods the said mark used by the plaintiff as to be calculated to mislead the public in Canada and elsewhere into believing that in purchasing the goods made by the defendant and so marked they are purchasing goods made by the plaintiff.

“ That said mark so used by defendant is also in its essential features the same as the trade-mark secondly above mentioned and of which the plaintiff is assignee as aforesaid or in any event resembles the same and is an imitation and infringement thereof.

“ The defendant has made and is still making large profits out of the sale in Canada of boots and shoes so marked by it as aforesaid which sales and profits have been brought about in whole or in part by reason of the purchasers of said boots and shoes being misled by said defendant's mark into purchasing the said goods made by the defendant believing them to be goods made by the plaintiff.

The plaintiff therefore prays :

“ That the defendant may be restrained by the order and injunction of this honourable court from continuing to use the said mark now in use by the defendant or any other mark similar thereto upon rubber

boots and shoes or any other goods made or sold by the defendant and from in any other way infringing the plaintiff's said registered marks or either of them.

“That the defendant may be restrained from making, selling or otherwise disposing of rubber boots and shoes made by the defendant with said mark now in use by the defendant as aforesaid or any other mark calculated to mislead the public into believing that in purchasing said goods they are purchasing goods made by the plaintiff.

“That the plaintiff may be paid by the defendant all damages that the plaintiff may have sustained or may hereafter sustain by reason of the infringement of the plaintiff's said marks or either of them by the defendant as aforesaid and may also be paid all profits that the defendant has made from sales by the defendant of rubber boots and shoes with said defendant's mark upon them to the public in the belief that they were buying goods made by the plaintiff, and all damages that the plaintiff may have otherwise sustained by the use of said mark by the defendant owing to its closely resembling said marks or either of them of the plaintiff.

“That a reference to ascertain such damages may be directed if thought necessary.

“That the plaintiff may have such further or other relief as may be considered just and may be paid the costs of this action.

To the statement of claim the defendant demurred in substance, as follows:

The defendant demurs to the plaintiff's statement of claim, and says that the same is bad in law on the ground that it is not alleged in said statement of claim that the mark alleged to have been put upon the rubber boots and shoes made and sold by the defendant is the registered trade-mark of plaintiff set forth in

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paragraph 4 of said statement or a fraudulent imitation thereof.

“ Because it is not alleged that defendant’s said mark is the trade-mark set forth in paragraph 8 of said statement or a fraudulent imitation thereof.

“ Because it is not alleged in said statement of claim that defendant’s said mark has been made or used by defendant with intent to deceive and to induce any person to believe that the goods on which the defendant’s mark was used were made by plaintiff.

“ Because it appears from the said statement of claim that the words of the defendant’s mark as set forth in paragraph 9 of said statement are essentially the corporate name of the company defendant ; and that the wording and arrangement thereof are entirely different from the wording and arrangement of plaintiff’s alleged trade-mark.

“ Because the registration of the word ‘ Boston ’ as alleged in paragraph 8 cannot prevent the use by the company defendant of its own corporate name or of the essential and prominent words of its said corporate name.

“ Because it does not in any way appear from the allegations of said statement of claim that the defendant has infringed any trade-mark of the company plaintiff.”

October 25th, 1900.

The demurrer now came on for argument.

A. McGoun, Q.C. for the defendant in support of demurrer :

It is not sufficient to allege that the defendant has infringed by imitating the plaintiff’s mark ; it should also be charged that the imitation was done fraudulently. Secondly, it is no infringement upon a trade-mark to merely use the name of a corporation upon

the goods manufactured by that corporation. That is all the defendant has done here. The words used by us, and of which the plaintiff complains, are in effect the corporate name of our company. This is no infringement. *Browne on Trade-Marks* (1); *Faber v. Faber* (2); *London and Provincial Law Assurance Society v. London and Provincial Joint Stock Life Assurance Co.* (3); *Colonial Life Assurance Co. v. Home and Colonial Assurance Co.* (4); *Sebastian on Trade-marks* (5); *Kerly on Trade-marks* (6).

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*R. V. Sinclair, contra :*

Plainly under the 3rd section of *The Trade-mark and Design Act* and under the authorities, an innocent infringement may be restrained. *Sebastian on Trade-marks* (7); *Kerly on Trade-marks* (8); The English courts have always granted relief without proof of fraudulent use. *Millington v. Fox* (9). The defendant has no authority for the proposition that fraudulent intention should be alleged.

Secondly, the defendant cannot escape the consequences of its infringement by saying that it merely uses its corporate name on its goods. Our trade-mark was known to the trade before it secured its corporate existence. (*Tussaud v. Tussaud* (10); *Plant Seed Co. v. Michel Plant and Seed Co* (11); *Celluloid Mfg. Co. v. Cellonite Mfg. Co.* (12); *Sebastian on Trade-marks* (13).

By its demurrer the defendant admits that the public have been deceived into purchasing its goods

(1) 2nd ed., secs. 196, 420.

(7) 4th ed. p. 124.

(2) 49 Barb. 357.

(8) p. 4.

(3) 17 L. J. Ch. 37.

(9) 3 My. and Cr. 338;

(4) 33 Beav. 548.

(10) 44 Ch. Div. 678.

(5) 4th ed., p. 256.

(11) 23 Mo. App. 579.

(6) P. 398.

(12) 32 Fed. Rep. 94.

(13) 4th Ed. p. 221 and foot note.

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for those of the plaintiff. *Johnston v. Orr-Ewing* (1);  
*Rose v. McLean Publishing Co.* (2).

*A. McGoun*, Q.C. replied, citing 26 *Am. and Eng. Encycl. of Law* p. 444; *Browne on Trade-marks*, sec. 386.

THE JUDGE OF THE EXCHEQUER COURT now (November 15th, 1900) delivered judgment :

By the demurrer to the statement of claim it is admitted, among other things, that the defendant company put upon rubber boots and shoes, a mark that is in its essential features the same as the plaintiff's registered trade-mark used by the latter upon rubber boots and shoes manufactured by them; that the mark is placed on the same part of the boot or shoe; that in any event it resembles the plaintiff's trade-mark and is an imitation and infringement thereof. It is also admitted that the mark so used by the defendant so closely resembles in its essential features and mode of application to similar classes of goods the plaintiff's registered trade-mark as to be calculated to mislead the public of Canada and elsewhere into believing that in purchasing goods made by the defendant and so marked they are purchasing goods made by the plaintiff.

The grounds of the demurrer are in substance as follows :

First, that the statement of claim is bad in that it is not alleged therein that the mark used by the defendant is the registered trade-mark of the plaintiff. As to this it seems to me that the allegation that the plaintiff's trade-mark (which is alleged to be registered) and the mark used by the defendant are in their essential features the same, is sufficient. It may

(1) 7 App. Cas. 219.

(2) 24 Ont. A. R. 240.



as a matter of fact be that they are not; but for the purposes of the demurrer it is admitted that they are.

Secondly, it is objected that the statement of claim is bad because it is not alleged therein that the imitation by the defendant of the plaintiff's trade-mark is a fraudulent imitation. That, it seems to me, is not necessary. Imitation involves knowledge; and if one by a mark attached to his goods knowingly imitates another's trade-mark, I do not see very well how he is to expect a court to find that the thing is done innocently. Of course a trader may happen, without knowledge of another's trade-mark, to adopt the same mark, but it cannot in such a case be said with propriety that the mark so adopted is an imitation. But even in such a case the true owner is entitled to protection.

I am also of opinion that the third ground of demurrer cannot be sustained. It is objected that the statement of claim is bad because it is not alleged that the defendant used the mark with intent to deceive, and to induce a belief that the goods on which his mark was used were made by the plaintiff. But that again is not necessary, for the fraud that entitles the owner of the trade-mark to redress need not consist in an intention to deceive on the part of the defendant, but may consist in an actual deception, or in the creation of a probability of deception independently of any fraudulent intention. (*Sebastian's Law of Trade-Marks* (1)).

Then it is also argued that the statement of claim is bad because it appears from it that the mark used by the defendant is its corporate name. That will no doubt be an important fact in the defendant's favour when the case comes to be heard upon the merits; but it will not, it seems to me, constitute a good defence to the action if the facts that are admitted by the

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(1) 4th Ed. 169.

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demurrer, as hereinbefore stated, are found to be the true facts of the case.

The demurrer is overruled. The defendant may, within twenty days, file a statement in defence, upon paying the plaintiff company its costs of the demurrer.

*Judgment accordingly.*

Solicitor for plaintiff: *R. V. Sinclair.*

Solicitors for defendant: *McGoun & England.*

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