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 June 18 & 19
 August 30

BETWEEN :

GENERAL MOTORS CORPORATION APPLICANT

AND

NORMAN WILLIAM BELLOWS... RESPONDENT

AND

NORMAN WILLIAM BELLOWS... APPLICANT

AND

GENERAL MOTORS CORPORATION RESPONDENT

Trade Marks—"Frigidaire"—"Frozenaire"—The Unfair Competition Act, 1932, secs. 2 (k), (1) 26 (1) (f), and 52—Word marks not likely to cause confusion—Delay in instituting proceedings to expunge not cause for dismissal of motion when no proof that respondent has been put under any unfair disadvantage.

Held: That the words "Frigidaire" and "Frozenaire" used in connection with refrigerators and like wares do not so clearly resemble each other as to be likely to cause confusion nor do they so closely suggest the idea conveyed by each other that confusion is likely to arise.

2. That in the absence of evidence that the delay or neglect of applicant in instituting proceedings to expunge has put the respondent under any unfair disadvantage such delay is not sufficient cause for dismissal of applicant's motion.

MOTION by applicant for an order expunging respondent's trade mark from Register of Trade Marks.

The motion was argued before the Hon. Mr. Justice Cameron at Ottawa.

Christopher Robinson for Applicant-Respondent.

Dr. Harold G. Fox K.C. and *Gordon Henderson* for Respondent-Applicant.

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

CAMERON J. now (August 30, 1947) delivered the following judgment.

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By notice of Motion dated December, 1946, General Motors Corporation asks for an order under section 52 of the Unfair Competition Act, 1932, expunging from the Register of Trade Marks the registration of the trade mark "FROZENAIRE", registered on April 23, 1940, under No. N.S. 68-17883 by the respondent Norman William Bellows, and recorded on the 18th day of October, 1943, for use on electric refrigerators and refrigeration. This application will hereinafter be referred to as the original motion.

By notice of Motion filed March 10, 1947, Norman William Bellows asks for a similar order expunging the registration of the trade mark "FRIGIDAIRE" the property of General Motors Corporation, registered on the 24th of January, 1933. This application will hereinafter be referred to as the second motion.

By order dated May 15, 1947, all proceedings in the two motions were consolidated.

I shall first consider the original motion. In brief, it is alleged that the trade mark "FRIGIDAIRE" was registered prior to the trade mark "FROZENAIRE", and that the words so nearly resemble each other, or so clearly convey the same idea, that confusion is likely to arise, as they are used in connection with similar wares; and that therefore the word "FROZENAIRE" was not properly registrable under section 26 (1) (f) of the Unfair Competition Act, 1932, which is as follows:

(1) Subject as otherwise provided in this Act, a word mark shall be registrable if it

(f) is not similar to, or to a possible translation into English or French of, some other word mark already registered for use in connection with similar wares.

"Similar" is defined in section 2 (k) of the Act as follows:

(k) "Similar", in relation to trade marks, trade names or distinguishing guises, describes marks, names or guises so resembling each other or so clearly suggesting the idea conveyed by each other that the contemporaneous use of both in the same area in association with wares of the same kind would be likely to cause dealers in and/or users of such wares to infer that the same person assumed responsibility for their character or quality, for the conditions under which or the class of persons by whom they were produced, or for their place of origin.

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There is no question that the two words are used in connection with similar wares as defined in section 2 (1) of the Act. The word "FROZENAIRE" is registered for use on electric refrigerators and refrigeration. The word "FRIGIDAIRE" is registered for use in connection with the sale of refrigeration apparatus, namely refrigerators, including electric refrigerators, electrical refrigerating machinery, ice-making machinery, refrigerating cabinets, air-conditioning systems, apparatus and devices for cooling foods by refrigeration of all kinds, part of the above goods and accessories thereto.

It is also fully established that the trade mark "FRIGIDAIRE" was in use and registered long before the word "FROZENAIRE" was adopted by the Respondent. "FRIGIDAIRE" was registered as a trade mark in the United States Patent Office on November 23, 1920, and has been continuously used in the business of the Frigidaire Corporation since September 21, 1918. Under date of September 18, 1929, Frigidaire Corporation applied for its registration in Canada as a special trade mark and the application was granted on January 24, 1933. On November 30, 1936, Frigidaire Corporation assigned all its interest in the trade mark "FRIGIDAIRE", registered in Canada as aforesaid, to General Motors Corporation, together with the goodwill of the business carried on in Canada in association with the wares for which it had been so registered.

The original motion of General Motors Corporation is supported by the affidavit of Lewis Clyde Shannon, Manager of the Canadian and Export Department of the Frigidaire Division, General Motors Corporation. This affidavit shows that subsequent to 1942, owing to war regulations and scarcity of materials, the manufacture and sale of apparatus to which the mark "FRIGIDAIRE" would otherwise have been applied had been greatly restricted. It establishes that between the years 1926 and 1942 the dollar value of sales of wares bearing the mark "FRIGIDAIRE" in Canada alone exceeded thirty-five million dollars, and that more than seven hundred and twenty thousand dollars was expended in Canada alone by the applicant and its predecessors in title on the advertising of the said wares in publications; that during the same

period the sales in the United States of similar wares bearing the same mark were many times as great as in Canada and a substantial part of a total expenditure of forty million dollars for like advertising of similar wares under the same mark in the United States was paid to the periodicals having a substantial circulation in Canada; that about seventy-five per cent of this thirty-five million dollars worth of wares sold in Canada, as above described, represents sales of refrigerators for use in homes, small shops and the like, distributed through retail dealers of whom there were in 1940 about 550 in Canada; and about seventy-five per cent of the advertising expenditures was addressed to members of the public to encourage them to purchase refrigerators bearing the mark "FRIGIDAIRE" in preference to competing units.

This evidence is quite uncontradicted.

There seems no question also that both have been used contemporaneously in the same area, that is, throughout Canada.

The respondent, by his affidavit, shows that since 1931 he has carried on at St. Catharines, Ontario, the business of manufacturing and selling refrigerators and refrigerating apparatus, both of a domestic and a commercial nature. Until 1937, the business was carried on under the name of Norman W. Bellows and Company. From the year 1937, until the present, he has carried on the wholesale part of his business under the name of "Frozenaire Cooler Company", retaining the name of Norman W. Bellows and Company for the retail part of his business. The name "Frozenaire Cooler" was adopted for use in 1937 and at the same time he adopted for use as a trade mark the word "FROZENAIRE" as a symbol to distinguish his wares. Since 1937, he has continuously used the said trade mark "FROZENAIRE" as a symbol to distinguish his goods and has also used the name "Frozenaire Cooler Company" as aforesaid. All the refrigerators and refrigeration apparatus sold by him since 1937 have borne on them a plate or transfer with the name "FROZENAIRE" and all letterheads, bills, invoices and other commercial documents used in the conduct of the wholesale business have used the words "Frozenaire Cooler Company". On April 2, 1940, he applied for registration of the trade mark

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“FROZENAIRE” and stated therein that he had adopted and continuously used the said word since June 2, 1939. The application, as I have mentioned above, was granted as of April 23, 1940.

On this motion, therefore, there remains only the one question for determination, that is whether the two marks, “FRIGIDAIRE” and “FROZENAIRE” so resemble each other, or so clearly suggest the idea conveyed by each other, that their contemporaneous use in the same area would be likely to cause dealers in and/or users of the wares, in respect of which the marks have been registered, to infer that the same person assumed responsibility for their character and quality.

I am of the opinion that the onus here is upon the applicant, General Motors Corporation. See *Battle Pharmaceuticals v. The British Drug Houses, Limited* (1); and *Proctor & Gamble Co. of Canada Ltd. v. LeHave Creamery Co. Ltd.* (2). The respondent has used the word “FROZENAIRE” in substantially the manner complained of for more than five years immediately before the commencement of these proceedings, and therefore the presumption established by section 10 (c) of the Unfair Competition Act, 1932, does not arise. The evidence indicates that the respondent first used the mark “FROZENAIRE” on June 2, 1939, and has used it continuously since that time. Proceedings were commenced on December 19, 1946.

In cases such as this it must be kept in mind that the question must be determined as a matter of first impression and that decisions on disputes as to other trade marks are of no assistance except insofar as some principle is enunciated. See *Battle Pharmaceuticals v. The British Drug Houses, Limited supra*. The President of this Court laid down the proper approach to problems of this type in the same case in this Court (3), when he stated:

It is not a correct approach to solution of the problem to lay the two marks side by side and make a careful comparison of them with a view to observing the differences between them. They should not be subjected to careful analysis; the Court should rather seek to put itself in the position of a person who has only a general and not a precise recollection of the earlier mark and then sees the later mark by itself; if such a person would be likely to think that the goods on which the

(1) (1945) S.C.R. 50 at 52.

(3) (1944) Ex. C.R. 239 at 248.

(2) (1943) S.C.R. 433 at 438.

later mark appears are put out by the same people as the goods sold under the mark of which he has only such a recollection, the Court may properly conclude that the marks are similar. The reasons for this guiding rule are sound. Similar marks are not identical marks and similarity of marks implies some difference between them, for without any difference they would be identical. A careful analysis of the marks with a view to ascertaining differences fails to observe this important distinction. Moreover, it is the likely effect of the use of the later mark on the minds of ordinary dealers or users generally that must be considered and people as a rule have only a general recollection of a particular thing, rather than a precise memory of it.

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Reference may also be made to *Aristoc, Ltd. v. Rysta, Ltd.* (1) where, at page 86, Viscount Maugham stated:

The answer to the question whether the sound of one word resembles too nearly the sound of another so as to bring the former within the limits of s. 12 of the Trade Marks Act, 1938, must nearly always depend on first impression, for obviously a person who is familiar with both words will neither be deceived nor confused. It is the person who only knows the one word, and has perhaps an imperfect recollection of it, who is likely to be deceived or confused. Little assistance, therefore, is to be obtained from a meticulous comparison of the two words, letter by letter and syllable by syllable, pronounced with the clarity to be expected from a teacher of elocution. The court must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description, but also of the shop assistant ministering to that person's wants.

There is little in the evidence to assist me in reaching a conclusion on this point. The only evidence for the applicant is that of Mr. Shannon, previously referred to. In paragraph 6 of his affidavit of December 9, 1946, he says:

That in my personal opinion there is no doubt whatever that the use of the word "FROZENAIRE" for refrigerators and refrigerating apparatus would inevitably lead to confusion between the goods so marked and those bearing the mark "FRIGIDAIRE".

For the respondent, the only evidence is that contained in his affidavit of January 14, 1947, in which, in paragraph 8 he states:

With respect to paragraph 6 of the said affidavit I deny that the use of the word "FROZENAIRE" for refrigerators and refrigerating apparatus would lead to confusion between the goods so marked and those bearing the mark "FRIGIDAIRE", but on the contrary state that in my personal opinion there is no possibility of confusion between the words "FROZENAIRE" and "FRIGIDAIRE". In my opinion there is not sufficient resemblance between the two words as would deceive purchasers into buying the goods marked with the word "FROZENAIRE" when they intended to buy goods marked with the word "FRIGIDAIRE".

(1) (1945) A.C. 68.

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Neither of these statements is helpful. It is well settled that in cases such as this a witness may not state his opinion as to the effect the use of a mark would have or be likely to have on the mind of someone else, because that is the very point to be determined; but that he may testify as to the effect the use of the mark would have on his own mind. See *Battle Pharmaceuticals v. The British Drug Houses, Limited* (1), and Kerly on Trade Marks, 6th Ed., 293. Both Mr. Shannon and Mr. Bellows have long experience in the trade and neither of them, personally, is likely to be deceived by any similarity between the marks. Their special knowledge of the trade and the fact that the former is an official of the applicant, and the latter is the respondent, prevents me from attaching any weight to such evidence in solving the problem. I must, therefore, act upon my view of the matter, guided by the principles above mentioned and with the admission that no confusion has in fact arisen.

"FRIGIDAIRE" is a combination of two well known English words in common use—"frigid" and "air". The addition of the letter "e" to the word "air" is, I think, of no importance. The meaning of the word "frigid" as here used is, I think, "cold". "Frozenaire" is also a combination of two well known English words in common use—"frozen" meaning cooled—and "air". To fall within the definition of "similar" as related to trade marks, they must so resemble each other, or so clearly suggest the idea conveyed by each other, as to be likely to cause confusion. I do not think that they so clearly resemble each other as to be likely to cause confusion. "Air" is common to both but "frigid" and "frozen" are quite distinct and different and bear little if any resemblance to each other whether written or spoken. In my view the difference is substantial.

In considering whether marks are similar, consideration ought to be given to the nature of the words themselves, and a distinction drawn between a fancy or invented word and an ordinary word in everyday use. In the case of a purely invented word, the scope of protection is very much wider than that of an ordinary word. Reference may be made to *Imperial Tobacco Co. of Great Britain and Ireland Ltd. v. De Pasquali & Co.* (2). In that case

(1) (1945) S.C.R. 53.

(2) (1918) 35 R.P.C. 185.

the Plaintiff was the owner of two marks, "Regimental Cigarettes" and "Regimental", and brought an action for infringement and passing off against the defendant who was using the mark "Pasquali's The Regiment". In giving judgment, dismissing the action for infringement and passing off, Astbury J. stated, at p. 195:

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It is true that "The Regiment" as a descriptive reference to goods differs little from "Regimental," but it is not the same, and in judging whether one word mark infringes another by mere colourable difference it is of first importance to have regard to the nature of the word said to have been infringed. A distinctive invented or fancy word has a much wider scope for colourable imitation than a word primarily descriptive, especially if the latter be one in common English use, and just as it is the policy of the present Trade Mark law in this country, except in the rare cases falling within Section 9 (5) of the Act of 1905, to prevent applicants for registration from monopolising ordinary English words which other people may, or reasonably might, desire to use to convey a meaning reasonably flowing therefrom, so I think the Courts should be careful to prevent any undue extension in this direction, by holding that an ordinary and common word is an infringement by way of colourable imitation of another word equally common and ordinary, which has been allowed in the past to find its way upon the Register; and this is especially so when the user complained of on the part of the Defendant is not, as in my judgment it has not been proved to be in this case, calculated to pass off his goods as and for those of the Plaintiff.

I have also been referred to *Office Cleaning Services, Ltd., v. Westminster Window and General Cleaners, Ltd.* (1). The plaintiff carried on business as "Office Cleaning Services" and the defendant, after using the name of "Westminster Office Cleaning", changed it to "Office Cleaning Association". Giving judgment in the House of Lords, Lord Simonds said, at p. 42:

In the present case there are certain considerations to which I think it worthwhile to call particular attention.

Foremost I put the fact that the Appellants chose to adopt as part of their title the words "Office Cleaning" which are English words in common use, apt and more apt than any other words to describe the service that they render. This is a trade name, not a trade mark, case, but I would remind your Lordships of the close analogy between the two classes of case found by *Farwell, J., in Aerators Limited v. Tollitt* ((1902) 2 Chancery 319) and by *Parker, J. in the Vacuum Cleaner case (ubi supra)*. So it is that, just as in the case of a trade mark the use of descriptive words is jealously safeguarded, so in the case of trade names the Courts will not readily assume that the use by a trader as part of his trade name of descriptive words already used by another trader as part of his trade name is likely to cause confusion and will easily accept small differences as adequate to avoid it. It is otherwise where a fancy word has been chosen as part of the name. Then it is that fancy word which is discriminatory and upon which the attention is fixed, and if

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another trader takes that word as part of his trade name with only a slight variation or addition, he may well be said to invite confusion. For why else did he adopt it?

Where, as here, there is no proper evidence of confusion, actual or probable, before the Court, the test and the manner in which the test should be made are laid down by Lord Russell of Killowen in *Coca-Cola Company v. Pepsi-Cola Company* (1) where, at pages 660-1 he states:

In these circumstances the question for determination must be answered by the Court, unaided by outside evidence, after a comparison of the defendant's mark as used with the plaintiff's registered mark, not placing them side by side, but by asking itself whether, having due regard to relevant surrounding circumstances, the defendant's mark as used is similar (as defined by the Act) to the plaintiff's registered mark as it would be remembered by persons possessed of an average memory with its usual imperfections.

In matters of this sort consideration should also be given to the nature of the wares and the circumstances under which the articles are sold and the class of purchasers. Here the wares are doubtless of considerable value and ordinary users or purchasers would, I think, give careful consideration to the matter before making a purchase involving such an outlay. It is not a matter where the purchase would be made hastily or without consideration as in the case of an article of little value or importance. As to dealers in the wares, I would think it beyond question that each would have a sufficient knowledge of his business and the trade that no confusion could possibly arise in their minds.

Testing the matter in the manner above laid down, and taking into consideration the circumstances and conditions disclosed by the evidence and for the reasons stated, I am of the opinion that the words "FRIGIDAIRE" and "FROZENAIRE" do not so clearly resemble each other as to be likely to cause confusion.

Nor can I find that the words so closely suggest the idea conveyed by each other that confusion is likely to arise. It is true, I think, that each suggests the idea of "cool air" or "cooled air". But the applicant is not entitled to a monopoly of all words which suggest the idea of "cooled air" or "cold air". He must establish that the word complained of conveys not only the same idea but also that it is likely to cause dealers in and/or users of the wares

to infer that the same persons assumed responsibility for their character or quality. And I think that the difference between the words "FRIGIDAIRE" and "FROZEN-AIRE", as pointed out above, and for the reasons hereinbefore stated, is sufficient to prevent any likelihood of such confusion arising.

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I am supported in this view of the matter by the fact that the respondent has been using the word "FROZEN-AIRE" for at least eight years and possibly longer and that no confusion of any sort whatever has arisen during that time. The applicant, of course, need not prove that confusion has arisen but merely that confusion is likely to occur. But the fact that such confusion has not occurred over a period of many years is a circumstance to be taken into consideration and is of some importance in determining whether confusion is likely to occur. Reference may be made to the judgment of Davis J. in *Coca-Cola Company v. Pepsi-Cola Company* (1) where, at page 30, he stated:

Where a defendant's trade is of some standing, the absence of any instance of actual confusion may be considered as some evidence that interference is unnecessary.

There has also been some delay on the part of the applicant in taking proceedings to expunge the word "FROZEN-AIRE", and almost three years elapsed between the time when, through its solicitors, the applicant demanded that the respondent discontinue the use of the word "FROZEN-AIRE" and these proceedings were begun. There is no evidence before me as to the volume of the respondent's business or whether it has increased or decreased since 1943; nor is there any evidence that the delay or neglect of the applicant to institute proceedings has put the respondent under any unfair disadvantage. And my conclusion on this point is, that in the absence of such evidence, I would not be justified in holding that the applicant's delay in instituting proceedings was fatal to its case. See *Addley Bourne v. Swan and Edgar, Ltd.* (2) at pp. 114-115.

For the reasons which I have stated, the applicant's motion is dismissed. The respondent is entitled to the costs of the original motion after taxation.

(1) (1940) S.C.R. 17.

(2) (1903) 20 R.P.C. 105.

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In the second motion, it was agreed by counsel for both parties that, in the event of the original motion being dismissed, the second motion would stand adjourned *sine die*, without judgment being rendered, but that in the event of the applicant in the original motion entering an appeal from the judgment in that motion, an application could be made to deliver judgment in the second motion, and I so direct. The same direction will go in regard to the other motion of the applicant, General Motors Corporation, dated June 12, 1947.

Judgment accordingly.