

BETWEEN:

YAMASKA GARMENTS, LIMITED APPELLANT,

AND

THE REGISTRAR OF TRADE
MARKS AND
RELIANCE MANUFACTURING
COMPANY

RESPONDENTS.

1945
Sep. 12
Oct. 10

Trade-Marks—The Unfair Competition Act, 1932, Sec. 2, pars. (k) and (l)—Similar wares—Similar marks—Evidence as to likelihood of confusion—Wholesalers and retailers—Words common to the trade—Test of similarity of marks—Method of applying test.

Appeal from refusal of the Registrar to register the appellant's word mark "The Big Y Line" on the grounds that it was confusingly similar to the word mark of objecting company, namely "Big Yank". The appellant had used its word mark only in Canada and only since 1936. The objecting company's word mark had been used for 25 years principally in the United States and Canada, and was registered in Canada on the 12th February 1934. It was admitted that the wares of both companies were similar and the contemporaneous use of both marks in the same area in association with wares of the same kind was not in dispute.

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Held: That the evidence of a witness that in his opinion the marks were not similar and that they did not create confusion was inadmissible. *British Drug Houses Limited v. Battle Pharmaceuticals* (1944) Ex. C.R. 239 followed.

2. That evidence from the public and dealers who deal with the public is more important as to confusion, than the evidence of wholesalers who deal only with the retail dealers. *Havana Cigar & Tobacco Factories Ltd., v. Oddenino* (1923) 40 R.P.C. 229.
3. That where there is no evidence of confusion either actual or probable, the test should be made not by placing the marks side by side but by asking whether, under the relevant surrounding circumstances, the appellant's mark as used is similar (as defined by the Act) to the registered mark of the objecting company as it would be remembered by persons possessed of an average memory with its usual imperfections. *Coca-Cola v. Pepsi Cola* (1942) 2 D.L.R. 657 applied and followed.
4. That a word mark under Section 2 (o) depends for its distinctiveness upon the idea or sound suggested by the sequence of the letters and/or numerals and their separation into groups. The ideas or sounds suggested by the sequence of the letters and their separation into groups of these two marks are not similar.
5. That the appellant's trade-mark "The Big Y Line" was not similar within the meaning of the Unfair Competition Act 1932 to the registered word mark "Big Yank" and the Registrar's decision refusing to register it, was set aside.

APPEAL by appellant from the refusal of the Registrar of Trade Marks to register the appellant's word mark "The Big Y Line".

The appeal was heard before the Honourable Mr. Justice O'Connor at Ottawa.

C. C. Gibson, K.C., for appellant.

W. P. J. O'Meara, K.C., for Registrar.

Christopher Robinson for Reliance Manufacturing Company.

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

O'CONNOR J. now (October 6, 1945) delivered the following judgment:

This is an appeal from the refusal of the Registrar to register the appellant's word mark "The Big Y Line" on the grounds that it is confusingly similar to the word mark of Reliance Manufacturing Company of Chicago, namely "Big Yank". Notice under Section 38 of the Unfair Competition Act was given by the Registrar to the Reliance Manufacturing Company and this company objected to the

appellant's registration. Notice of appeal was filed and served but the objecting company failed to appear and a certificate of default was registered against it.

Counsel for the objecting company appeared at the trial and moved to add the objecting company as a respondent and advised the court that he would not offer any evidence. His motion was not opposed by counsel for the appellant and the objecting company was added as a party respondent.

The appellant has used its work mark "The Big Y Line", only in Canada, and only since 1936 and during that time has sold approximately two million garments in Canada.

The objecting company's word mark "Big Yank" has been used for 25 years, principally in the United States and Canada and was registered in Canada on the 12th day of February 1934. Its sales in Canada amount to more than \$15,000.00 annually.

Counsel for the Registrar pointed out that if the Registrar was in doubt as to the registration the provision of Section 38, "he *shall* by registered letter request the owners, etc.", was mandatory and that there was in this case a reasonable and logical basis for doubt and that the Registrar was quite justified in his opinion that the reasons for the objections were not frivolous. Counsel for the appellant agreed that this was so.

Similarity of wares, namely men's and boys' work and dress shirts, underwear, pyjamas, overalls, and jackets, is admitted and the contemporaneous use of both marks in the same area in association with wares of the same kind is not in dispute.

The question for determination is whether the word marks are similar as defined by the Act.

2. (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.

The appellant filed affidavits from a number of wholesalers doing business in Canada from Montreal to Winnipeg stating that they had been aware of the sale of garments

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by the appellant under the mark "The Big Y Line" and by the objecting company under its mark "Big Yank" for periods ranging from six to nine years and that they had both bought and sold the garments of each company under the respective marks of each and that at no time had any confusion arisen in the trade or on behalf of the buying public as a result thereof.

The deponents went further and gave their opinion that the marks were not similar and that they did not create confusion. This was objected to by counsel for the objecting company as being inadmissible and his objection is sound and well taken. Counsel for the appellant agreed that this portion was inadmissible. Those portions of the affidavits are inadmissible. This had been laid down in *The British Drug Houses Limited v. Battle Pharmaceuticals* (1) following *The North Cheshire and Manchester Brewery Company Limited v. The Manchester Brewery Co. Ltd.* (2).

Counsel for the Registrar pointed out that the affidavits used by the appellants were all from wholesalers and that the retailers dealing directly with the public would be in a much better position to report on any confusion or on the absence of it, on the part of the public. The point is well taken and there is no doubt that the public and dealers who deal with the public are more important, in this connection, than wholesalers who deal only with the retail dealers. See *Havana Cigar & Tobacco Factories Ltd. v. Oddenino* (3) per Russel J. *John Jaques & Son Ltd. v. Chess* (4).

That is a matter of degree however, and in this case no evidence of confusion actual or probable was submitted and I hold the affidavits are sufficient.

The appellant filed an affidavit showing that in addition to the appellant's application for registration of the word mark "The Big Y Line" there were 19 registrations and applications containing the word or letters "Big". Of these only one appears to be still pending. The following are a few: "Big Horn", "The Big 4", "Big Chief", "Big 3", "Big B Brand", "Big Bob", "Big Jack", "Big Swede". The majority of these apply to similar wares to those manufactured by both the appellant and the objecting company,

(1) [1944] Ex. C.R. 239

(3) [1923] 40 R.P.C. 229.

(2) [1899] A.C. 83

(4) [1939] 56 R.P.C. 415 at 426.

namely overalls, shorts, pants, work clothing, etc. Clearly the word "Big" is common to this trade. The proper comparison must be made with that fact in mind.

Where there is no evidence of confusion either actual or probable, the test and the manner in which the test should be made are described by Lord Russell of Killowen in *Coca-Cola Company v. Pepsi-Cola Company* (1) at page 661:

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.

When tested in this manner the marks are not similar.

Under section 2 (o) a word mark depends for its distinctiveness upon the idea or sound suggested by the sequence of the letters and/or numerals and their separation into groups, independently of the form of the letters or numerals severally or in series.

The ideas or sounds suggested by the sequence of the letters and their separation into groups, of these two marks are not similar.

I have fully considered all the submissions put forward by Counsel for the objecting company based on his careful and exhaustive review of the authorities, but I am of the opinion that the word mark used by the appellant and the registered mark of the objecting company are not word marks so resembling each other or so clearly suggesting the idea conveyed by each other that the contemporaneous use of both in the same area in association with wares of the same kind would be likely to cause dealers 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.

The word mark in my opinion is registrable; the Registrar's decision refusing to register it is accordingly set aside.

There will be no costs against the Registrar. The appellant to have the costs of the appeal as against the objecting company but which, under the circumstances, will be limited to a counsel fee which I fix at \$50.00.

Judgment accordingly.

(1) [1942] 2 D.L.R. 657

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