

1923
March 24.

THE HURLBUT COMPANY, LIMITED.. PLAINTIFF;

VS.

THE HURLBURT SHOE COMPANY DEFENDANT.

Trade-mark—Person's own name—Fraudulent intention.

Held that, in the absence of any fraudulent intention to pass off his goods for those of another, any person may use his own name for the purposes of his trade, and no one bearing a similar name can arrogate to himself the exclusive use thereof.

ACTION by plaintiff to expunge defendant's trade-mark from the Canadian Register of Trade-Marks.

March 14th and 15th, 1923.

Case now heard before The Honourable Mr. Justice Audette, at Toronto.

F. B. Fetherstonhaugh K.C. and *H. G. Fox* for plaintiff.

M. A. Macdonald and *Frank Denton* for defendant.

The facts are stated in the reasons for judgment.

AUDETTE J., now (24th March, 1923), delivered judgment.

The plaintiff, by his statement of claim, seeks to obtain an order to expunge from the Canadian Register of Trade-Marks a specific trade-mark

to be applied to the sale of footwear, and which consists of the representation of a musket and a bow and arrow surmounted by the name "Hurlbut's" and underneath the said representation is the word "Shoe."

This trade-mark was registered by the defendant company, of Barrie, Ontario, on the 5th September, 1919.

On the 2nd August, 1913, the plaintiff company, of Preston, Ontario, registered as a specific trade-mark

to be applied to the sale of boots, shoes, slippers, bootees, moccasins, shoe-packs, and footwear generally of all kinds excepting hosiery, and which consists of a representation of the Hurlbut arms, comprising a shield quarterly argent and sable, in the sinister chief and dexter base each a lion rampant, and over all a bend gule charged with three annulets, below the shield being the word "Hurlbut" and surrounding it the words "Genuine-Welt."

Subsequently thereto, namely on the 11th November, 1921, the plaintiff company registered a second specific trade-mark to be applied to the sale of footwear and which consists of the word "Hurlbut."

REPORTER'S NOTE: Appeal has been taken to the Supreme Court of Canada.

The defendant company, by its amended statement in defence, asks, *inter alia*, that an order should be made to expunge, cancel and annul the plaintiff's specific trade-mark to be applied to the sale of footwear, consisting of the word "Hurlbut." Furthermore, by par. 9 thereof, it takes a very reasonable position in the matter, namely:—

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9. As to the allegation contained in paragraph 11 of the said statement of claim this defendant has no desire to cause any confusion between the trade-marks and trade-names of the parties hereto and has offered to the plaintiff in writing to add to defendant's trade-mark and trade literature some language or expressions of a reasonable character for the purpose of further distinguishing the defendant company from the plaintiff company, and the defendant is still ready and willing so to do, though not admitting any legal or moral obligation or any practical necessity therefor.

An offer to the same effect or purpose was made by the defendant to the plaintiff before the institution of the present action on the 11th January, 1922, as shown by letter E 9, but refused.

The controversy arises from the fact that the parties hereto have taken trade-marks for two surnames, which being different only but for the letter "r," names involving the difference only of a single letter and when carelessly pronounced having practically no phonetic variance, the name used as plaintiff's mark is spelled Hurlbut, that of the defendant Hurlburt. In plaintiff's mark, however, the name is coupled with distinctive features, words and ornaments. Notwithstanding this latter difference, it is apparent that the two names are very much alike and resemble one another and that the consumer, the public, might very well take one for the other as identical even when not side by side.

Moreover, these specific trade-marks are used in connection with the sale of the same class of merchandise which would be an additional reason for confusion.

Therefore the case is complicated by this very fact that the most conspicuous part of each trade-mark—that part which appeals to the eye—is the name of the respective parties.

It cannot be denied that any person has the undoubted right to use his own name for the purpose of his trade and that no one bearing a similar name has a right to arrogate to himself the exclusive use of the same.

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However, that rule must be qualified under numerous judicial decisions, to the effect that where such person makes use of his own name for the purpose of fraud, and satisfactory evidence of fraudulent intention has been produced, such unfair conduct will be restrained, even though the free use of the man's own name may be thereby hindered. *Holloway v. Holloway* (1); *Burgess v. Burgess* (2); Sebastian, *Law of Trade-Marks*, 5th ed. 39-40; Smart, *Law of Trade-Marks*, 112; 27 Hals. 749; Kerly, 4th ed. 593; *Saunders v. Sun Life Ass'ce Co.* (3); *Brinsmead v. Brinsmead* (4).

There is not a tittle of evidence of fraud in the present case. Indeed, I, was especially impressed by the genteel demeanour of both parties when in the witness box and by the manly and upright manner in which their respective testimony was given.

Under the circumstances, while I find that the parties are each entitled to use their own name to distinguish their goods,—in the interest of the public, I will accept the offer made by the defendant and vary its trade-mark, by substituting for the word "Hurlburt" the name of its company,—that is "The Hurlburt Shoe Company," which certainly I hope, will decrease to a degree of nullity the reasons for confusing both names and the merchandise of their respective firm. By so doing, the public, the consumer will obviously be protected, and power and jurisdiction to do so is specifically given to this court under section 42 of The Trade-Mark and Design Act.

Therefore, there will be judgment dismissing the action, with costs, and furthermore ordering to vary the registration of the defendant's specific trade-mark No. 106, Folio 25055, of the 5th September, 1919, by striking out therefrom the word "Hurlburt's" and substituting therefor the words "The Hurlburt Shoe Company."

Judgment accordingly.

Solicitors for plaintiff: *Fetherstonhaugh & Co.*

Solicitors for defendant: *Denton, Macdonald & Denton.*

(1) [1850] 13 Beav. 209.

(2) [1853] 3 Deg. M. & G. 896.

(3) [1894] 1 Ch. D. 537.

(4) [1913] 30 R.P.C. 493.