GOLD MEDAL FURNITURE MANUFACTURING CO., LTD..... } PETITIONER;

AND

GOLD MEDAL CAMP FURNITURE MANUFACTURING CO. ..... } RESPONDENT.

1927
Oct. 14-17.
Nov. 29.

Trade-marks—Registration—User in Canada

Held, that the applicant for the registration of a trade-mark in Canada must be the first user of the same in Canada. (*Impex Electrical Ltd.* v. *Weinbaum* (1927) 44 R.P.C. 410, referred to.)

PETITION to have the trade-mark of the respondent herein expunged.

The action was tried before the Honourable Mr. Justice Audette at Toronto.

R. S. Smart, K.C., and *R. R. McMurtry* for petitioner.

A. W. Langmuir and *Wm. Mockridge* for respondent.

The facts are stated in the reasons for judgment.

1927

GOLD MEDAL FURNITURE MFG. CO., LTD. v. GOLD MEDAL CAMP FURNITURE MFG. CO.

AUDETTE J., now (November 29, 1927), delivered judgment (1).

This is an action whereby the petitioner seeks to expunge from the Canadian Register of Trade-Marks the objecting party's

specific trade-mark to be applied to the sale of beds, chairs, cots, litters, stands, stools, tables, folding bath tubs and folding houses, and which consists of the arbitrary name GOLD MEDAL.

This trade-mark was registered in Canada on the 14th August, 1919, upon the usual declaration, as required by sec. 13 of the Trade-Mark and Design Act,

that the said specific trade-mark was not in use to his knowledge by any other person, firm or corporation than the said Gold Medal Camp Furniture Manufacturing Company at the time of its adoption thereof.

Both parties carry on business in a class of merchandise of this particular description; the petitioner in Canada, and the objecting party at Racine, in the state of Wisconsin, U.S.

At the time the objecting party subscribed to the above mentioned declaration it was wrong, as is now established by conclusive evidence, in stating that it was the first to make use of this trade-mark. To maintain the purity of the Register it is evident that this statement should not remain unchallenged.

Moreover, it is well to mention as significant, although not as a matter determining the question at bar, that prior to the objecting party registering their Gold Medal trade-mark in 1919, the petitioner in 1907 had already registered as their specific trade-mark the words "Gold Medal" as applying to the sale of mattresses.

The question as to whether or not a trade-mark consisting of the words "Gold Medal" is good or bad in view of its suggestive character, is one I need not decide as it has not been raised by either party.

Now it is the use of a trade-mark, not its invention, that creates a right to it.

The test in all cases of conflict as to priority of adoption is, which claimant was first to so use the marks as to fix on the market a conviction that the goods so marked had their origin with him.

(1) An appeal has been taken to the Supreme Court of Canada.

Paul on Trade-Marks, 148, and 153, sec. 92. See also *Candee, Swan and Co.* v. *Deere and Co.* (1).

The applicant for the registration of a trade-mark in Canada must be the first user of the same in Canada. *Vess Jones* v. *Horton* (2). The law upon this question is well settled.

The recent observation of Tomlin J. upon this subject in re *Impex Electrical Ltd.* v. *Weinbaum* (3) is quite apposite and reads as follows:

. . . foreign markets are wholly irrelevant, unless it be shown by evidence that in fact goods have been sold in this country with a foreign mark on them, and that the mark so used has thereby become identified with the manufacturers of the goods. If a manufacturer having a mark abroad has made goods and imported them into this country with the foreign mark on them, the foreign mark may acquire in this country this characteristic, that it is distinctive of the goods of the manufacturer abroad. If that be shown, it is not afterwards open to somebody else to register in this country that mark, either as an importer of the goods of the manufacturer or for any other purpose. The reason of that is not that the mark is a foreign mark registered in a foreign country, but that it is something which has been used in the market of this country in such a way as to be identified with a manufacturer who manufactures in a foreign country. That, I venture to think, is the basis of the decision in the *Apollinaris* case. It seems to me to be the basis of the decision in the case before Mr. Justice Clauson of *Lacteosote Limited* v. *Alberman,* and it seems to me to be consonant with good sense.

It has been abundantly established by conclusive evidence that the petitioner, as far back as 1890 and 1891 under the circumstances disclosed at trial, were first to use in Canada, and have continuously ever since so used, the words "Gold Medal" upon their goods and articles of merchandise, that is upon goods and merchandise of the same class and description as those for which registration was granted to the objecting party, and I am, therefore forced to the conclusion that they are thereby entitled to the mark as against all others in this country.

Having so found, it becomes unnecessary to say any more or to pass upon secondary questions raised at trial.

Therefore there will be judgment ordering the expunging from the entry in the Canadian Trade-Mark Register of the Specific Trade-Mark "Gold Medal," under No. 128, Folio 29460, in accordance with the Trade-Mark and Design Act. The whole with costs against the objecting party. *Judgment accordingly.*

(1) (1870) 54 Ill. Rep. 439. (2) (1922) 21 Ex. C.R. 330.
(3) (1927) 44 R.P.C. 405, at p. 410.