

THE PROCTOR & GAMBLE COMPANY,

PLAINTIFF AND PETITIONER;

1928
June 20.
Aug. 21.

AND

PUGSLEY, DINGMAN AND COMPANY, LIMITED,
DEFENDANT AND OBJECTING PARTY.*Trade-Mark—Use—Registration—Rights conferred by registration—
Rectification of register.*

Plaintiff was the owner of a trade-mark *Camay* registered in the United States, for use in connection with the sale of toilet and bath soaps. Upon their applying for registration of the said mark in Canada the same was refused because of defendant's registration of the word *Cameo*. Though this mark was registered for use in connection with the sale of soap generally, it, in fact, was only applied to and used in connection with the sale of laundry soap. The application for registration stated that such mark was to be applied to "a certain soap." The present proceedings were to expunge defendant's mark or vary it by limiting it to laundry soap only, and for permission to register the word *Camay*.

Held that, on the facts, the defendant's registration and use of the mark *Cameo* should be limited to the sale of laundry soap alone; that said registration be varied accordingly; and that the plaintiff be permitted to register the mark *Camay* to be used in connection with the sale of toilet and bath soaps.

2. The Trade-Mark and Design Act was not intended to give new rights, but to place restrictions on the bringing of actions for infringement of trade-marks, and to facilitate evidence of title to the same by means of registration. The proprietor of a mark is not bound to register and does not lose his mark by failure to do so.

ACTIONS to expunge or vary the trade-mark *Cameo* of the defendant and to have the trade-mark *Camay* of the petitioner registered.

The actions were heard before the Honourable Mr. Justice Maclean, President of the Court, at Ottawa.

O. M. Biggar, K.C., for plaintiff.

R. C. H. Cassels, K.C., for defendant.

The facts are stated in the reasons for judgment.

THE PRESIDENT, now (August 21, 1928), delivered judgment.

These two proceedings were, by agreement, heard together. The former is an action to expunge the registration of the trade-mark "Cameo Soap" registered in the

1928

THE
PROCTOR &
GAMBLE Co.

v.

PUGSLEY
DINGMAN
& Co., LTD.

Maclean J.

name of the defendant company, or in the alternative, to vary it; the latter is a Petition of The Proctor & Gamble Company, the plaintiff in the first proceeding, for an order for the registration of the word "Camay" as a specific trade-mark, the application of the petitioner to register the same having been refused by the Commissioner of Patents.

I shall first consider the action to expunge the registered trade-mark of the defendant. On December 7, 1900, the Imperial Soap Company Limited, a corporation then carrying on business in the city of Toronto, registered in Canada a specific trade-mark, consisting of a square panel on which was engraved the words "Cameo Soap;" the mark had been previously acquired from the Grocers Good Manufacturing Company. In the application for registration it was stated that the mark was to be applied to the sale of a "certain soap," but there was no further description of that "certain soap." The certificate of registration stated that the registered mark was to be applied to the sale of "soap." The Imperial Soap Company commenced to apply this mark to a yellow laundry soap, which it manufactured and sold in Canada. In 1902 this company having ceased to do business assigned the mark to the defendant company, and the defendant company continued to use the mark exclusively in connection with the sale of the same brand of soap as did its predecessor. The registered specific trade-mark "CAMEO SOAP" expired on December 7, 1925, but on December 21 of the same year, the defendant company applied for the registration of the same words, as a specific trade-mark, to be used in connection with the sale of soap. The application stated that the defendant company believed the mark to be theirs on account of their having been the first to make use of the same. A certificate of registration issued on January 10, 1926. During the currency of the mark registered by the Imperial Soap Company Limited and until its expiration on December 7, 1925, the defendant company not only manufactured and sold a yellow bar laundry soap to which on one side of the bar they applied the word mark "CAMEO", but during the same period the defendant also continued to apply on the reverse side of the bar of soap the words "Imperial Soap Company Ltd," these latter

words the defendant continued to use on this particular brand of soap even after the registration applied for by it on December 21, 1925.

In August, 1926, the plaintiff company registered in the United States the word "CAMAY" as a trade-mark to be used in connection with the sale of toilet and bath soap. It immediately embarked upon an extensive advertising campaign in the United States, and it is claimed, that some advertising appearing there in printed publications also circulated in Canada. In May, 1927, the plaintiff made application in Canada to register the word "Camay" as a specific trade-mark to be used in connection with the sale of toilet and bath soaps. The application was to register the word "Camay" only, and nothing else. The application of the plaintiff company was refused by the Commissioner of Patents, on the ground that the word "Cameo" had been registered for soap since December 7, 1900, and was at present standing in the name of the defendant company, it having been renewed, it was said, in a communication to the solicitors of the applicant. The Commissioner apparently regarded the mark applied for by the defendant on December 21, 1925, as a renewal of the mark that expired on December 7, 1925. The Commissioner evidently considered the mark "Camay" to be the same as Camée, or at least sufficiently alike as to cause confusion. The French word Camée is the equivalent of the English word Cameo, and it is claimed that the word Camay is but the phonetic spelling of the French word.

In September or October, 1927, the defendant company commenced to manufacture a white toilet soap, of the same colour and shape as the plaintiff's "Camay" soap manufactured in the United States. It was in February, 1927, that the defendant company first considered the matter of manufacturing a toilet soap and using the word mark "Cameo" thereon. It is not clear when a definite decision was made to do this, but that is not important I think, as the vital point would be, when did it commence to use the mark in connection with the sale of toilet soap, and that was in September or October, 1927. It is quite clear that the defendant company knew of the plaintiff's Camay soap being placed on the United States market, and that an extensive advertising campaign was being carried on by

1928

THE
PROCTOR &
GAMBLE Co.

v.
PUGSLEY
DINGMAN
& Co., LTD.

Maclean J.

1928

THE
PROCTOR &
GAMBLE CO.
v.
PUGSLEY
DINGMAN
& Co., LTD.
Maclean J.

the plaintiff to establish this particular soap in that market.

Another phase of the case as developed should be stated, though I do not think it is of importance. In 1921 The T. Eaton Drug Company of Toronto, began the sale of a toilet soap and in connection with which they used the word Cameo as a trade-mark, but this mark was not registered. The box and wrapper in which this soap was sold bore the words "Cameo Toilet Soap." In 1927, this company abandoned the use of this mark as applied to toilet soap, but later registered the word Cameo as a trade-mark to be applied to toilet articles "other than soap." It was not contested that this abandonment was made by the T. Eaton Drug Company, and this is to be inferred from the registration made by it, and just mentioned. The defendant company states that it was unaware of the use of the mark Cameo Toilet Soap, by the T. Eaton Drug Company. This mark is not now in use by this company in connection with the sale of soap, in fact as I say it has been definitely abandoned, so therefore I cannot regard this incident as of present importance or relevance.

It was contended by Mr. Biggar, K.C., for the plaintiff that the defendant's registration should be expunged, or at least varied, so as to make its use applicable only to laundry soap; alternatively he claimed that the word mark Camay as applied for registration by the plaintiff would not be in conflict with the defendant's mark if it remained on the registry, and that both marks might properly be registered. He also urged that the continued use of the words "Imperial Soap Co., Ltd." by the defendant upon the laundry soap manufactured by it for twenty years and more, destroyed the registered mark. This last point may be considered first.

The essential feature of a trade-mark is that the mark should guarantee a particular manufacture, and the question here arises, whose manufacture was guaranteed by the mark? The original purchaser doubtless would know from whom he was buying and whose manufacture he was purchasing, but the user possibly would think he was using the manufacture of the Imperial Soap Company. This point arose quite casually upon the trial, and was not a point made by Mr. Biggar, K.C., in opening his case. I have no doubt the use of the words in question was an oversight and

will now be discontinued, but in any event I do not think it is a ground for removing entirely the mark from the registry. It is conceivable that under a certain state of facts, the point taken might prove quite formidable, but not here. A person in some way aggrieved might well complain of this irregularity, but the plaintiff is not I think such a person. I know of no authority upon which to sustain the point, and none was pointed out to me.

Now as to Mr. Biggar's first point, that the defendant's registration should be varied so as to make it apply only to laundry soap. We have the fact that the Imperial Soap Company applied the mark only to a laundry soap, and no doubt its predecessor did although there is no evidence on the point. I have no doubt when the Imperial Soap Company applied for the registration of its mark to be applied to "a certain soap" they meant soap of a particular brand or grade, and that was a common laundry soap. Something was intended by way of limitation in using the words "a certain soap." With the clear indication that the applicant did not intend to use the mark in connection with the sale of soap generally, an amended application should have been demanded at the time by the Commissioner of Patents. However, while this company continued in business it applied the mark only to laundry soap. The defendant did the same during the currency of the Imperial Soap Company registration. But that registration expired on December 7, 1925, and was never renewed. It could not be renewed because no renewal application was made within the period required by the Trade-Mark and Design Act. The defendant however secured a fresh registration of the mark in January, 1926, and there was no reason why it should not register a mark of which it could be said, that the defendant was the owner. It is clear that the defendant applied for this registration practically as a renewal of the one that had expired, and it at that time had in mind its use only in connection with the sale of laundry soap. The fact that it continued the use of the words "Imperial Soap Company Limited," is a pretty clear indication that it intended the use of the mark for the same soap that its assignor did, and that was laundry soap. In February, 1927, for the first time the defendant company, by its officers, discussed the propriety of using the mark in connec-

1928
 THE
 PROCTOR &
 GAMBLE Co.
 v.
 PUGSLEY
 DINGMAN
 & Co., LTD.
 Maclean J.

1928
 THE
 PROCTOR &
 GAMBLE Co.
 v.
 PUGSLEY
 DINGMAN
 & Co., LTD.
 Maclean J.

tion with a toilet soap. No effect can however be given to an indefinite intention to use a mark in the future, because it means nothing. The defendant only commenced to manufacture and sell toilet soap in September or October, 1927, and in this connection no previous date is of importance. When the plaintiff applied to register "Camay" for toilet and bath soap, on May 16, 1927, the defendant had not up to that date used its mark "Cameo Soap" on any soap excepting laundry soap. When it applied for registration of the same word mark on December 21, 1926, it was laundry soap it had in mind. It had no intention then to apply that mark to toilet soap though it was in fact selling toilet soaps under other names. The defendant therefore on May 16, 1927, had not the trade-mark Cameo in use for toilet or bath soaps. There can be no mark to register unless there has been one in use, or possibly, one that at the time of registration the applicant intended to use. So, on December 21, 1926, the defendant was not using the mark Cameo on anything but laundry soap, and it then had no intention of using it on any other kind of soap. Neither was the mark Cameo in use by the defendant on the date of the plaintiff's application on any soap, other than laundry soap. In this situation should the plaintiff have been refused registration of the mark Camay for toilet and bath soaps?

The Trade-Mark and Design Act was not intended to give new rights, but to place restrictions on the bringing of actions for infringement of trade-marks, and to facilitate evidence of title to trade-marks by means of registration. Essentially, the purpose of the Act was to provide a system of registration of trade-marks, but there must be a trade-mark before there can be a registration. The proprietor of a trade-mark is not bound to register and does not lose his mark by failure to register. I am not attempting in this case to go so far as to say that user is a prerequisite to registration, it is not necessary that I should. The Act contemplates a user of the trade-mark contemporaneously with, if not before registration. The defendant's mark is I think, what it would be had there been no registration at all. The means of enforcing its rights in the mark would be different. The Act could not have been intended to mean that one might register a specific trade-mark for

soap generally, and thus prevent another from registering the same mark for an absolutely different kind of soap, which the other did not at the time of registration sell nor intend to sell. It would seem strange that a registered specific trade-mark, covering a general and not a particular description of a class of merchandise, could be protected as to all articles within that class, no matter how diversified, and regardless of whether they were sold or not by the registrant. If so, then mere registration would seem to create a trade-mark, something I feel confident was never intended by the Act. That would seem to be contrary to the whole spirit of the Act. Clear of the question of the registration of a mark, in this case the defendant has only what he received from the Imperial Soap Company. The good will in a mark was assigned to the defendant and it can claim only what the assignor could claim. I am satisfied that all the Imperial Soap Company could claim or intended to claim was what I have already stated. Although the defendant made a fresh registration it is not on that account in a stronger position. It is in the same position exactly as if it had renewed the registration of the Imperial Soap Company before its expiration, or if there had never been a registration at all, which perhaps is the safest way of determining what is the scope of any trade-mark.

The defendant and its predecessors in title, the Imperial Soap Company and the Grocers Good Manufacturing Company so far as I know never used the mark for anything else than laundry soap. The defendant for many years, in its printed advertising matter, continuously used the mark to indicate to the trade as its manufacture a certain laundry soap. It produced, sold and advertised other laundry soaps, but to which it applied other word marks or trade names. It used other names for other soaps such as toilet soaps, whether they were registered trade-marks I know not and it is not of importance. When the defendant and its immediate predecessor, registered the mark "Cameo Soap" it was not believed contemplated to use the same in connection with the sale of any soap other than laundry soap. This I think can hardly be open to doubt and one must go back to the time of the registration to determine whether a trade-mark is properly on the register. The fact that both the Imperial Soap Company and the

1928

THE
PROCTOR &
GAMBLE Co.v.
PUGSLEY
DINGMAN
& Co., LTD.Maclean J.
—

1928
 THE
 PROCTOR &
 GAMBLE CO.
 v.
 PUGSLEY
 DINGMAN
 & Co., LTD.
 Maclean J.

defendant company registered the words "Cameo Soap" and not merely "Cameo" rather indicates that each intended one particular manufacture of soap to be known as "Cameo Soap." The defendant had therefore a specific trade-mark in "Cameo Soap" when used in connection with the sale of a laundry soap. If the registration included more, it did so improperly, and it should have been limited to what the defendant and its predecessors had used it for, namely as a mark to indicate a particular manufacture of soap. It was urged that laundry soap may be used as a toilet soap, but that is true of many other articles of commerce, and it does not follow that such soap is not primarily a laundry soap. I am of the opinion that the plaintiff's contention should prevail and that the register should be rectified so that the defendant's registration of January, 1927, should be made applicable only to laundry soap. I would refer to the following authorities which are in some degree applicable here though they are of course decisions made under a different statute. *Edward v. Dennis* (1); *Hargreaves v. Freeman* (2); *In re Hart* (3); and *Anglo-Swiss Condensed Milk Co. v. Pearks Gunston & Tee Ltd.* (4); and *Re Batt & Co.* (5).

That point being disposed of, and the rectification of the register becoming effective as of January 10, 1926, is there any objection to the registration of the word "Camay," which the plaintiff applied to register on May 16, 1927. I think not. I cannot see that there can arise any confusion over the use of the words "Cameo Soap" as a trade-mark in connection with the sale of a laundry soap by one person, and the use of the word "Camay" as a trade-mark for toilet and bath soaps. It may well be, as contended by Mr. Biggar, K.C., that the two marks are in no sense calculated to deceive or mislead the public if each were put into use by rival traders as in this case, in connection with the sale of the same kind of soap. It is not now necessary for me to make any decision upon this point. However, if applied to different grades of soaps, intended for different purposes or uses, I do not think it can fairly be contended that the use

(1) (1885) 30 Ch. Div. 454.

(2) (1891) 8 R.P.C. 237.

(3) (1902) 19 R.P.C. 569.

(4) (1903) 20 R.P.C. 509; (1904)
 21 R.P.C. 261.

(5) (1898) 2 Ch. Div. 432.

of both marks is calculated to mislead the public. I think therefore the petitioner in the second proceeding should be granted registration and I so order.

The plaintiff and the petitioner will have in each case its costs to be taxed.

1928
THE
PROCTOR &
GAMBLE Co.
v.
FUGSLEY
DINGMAN
& Co., LTD.
Maclea J.

Judgment accordingly.