

1937
Sept. 27.
Oct. 16

BETWEEN:

VIRGINIA DARE LIMITED.....APPELLANT;

AND

THE COMMISSIONER OF PATENTS..RESPONDENT.

*Trade-mark—Appeal from refusal of Registrar to register word mark—
 Unfair Competition Act, 22-23 Geo. V, c. 38, s. 26, ss. 1(b) and
 s. 29—“Virginia Dare.”*

Held: That although the words “Virginia Dare,” being the name of a person, may not be registered as a trade-mark by virtue of the Unfair Competition Act, 22-23 Geo V, c 38, s. 26, the Court, upon being satisfied that such mark has been so used as to become generally recognized by dealers in, or users of, the class of wares in association with which it has been used as indicating that the person using it assumes responsibility for their character or quality, will direct the registration of such words as a trade-mark, pursuant to s. 29 of the said Act.

APPEAL by Virginia Dare Limited from the refusal of the Registrar of Trade-Marks to register the word mark “Virginia Dare,” in connection with the sale of ladies’ wear.

The appeal was heard before the Honourable Mr. Justice Angers, at Ottawa.

R. M. Fowler for appellant.

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

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

ANGERS J., now (October 16, 1937) delivered the following judgment:

This is an appeal by Virginia Dare Limited, a company incorporated under the laws of the Province of Ontario, having its head office at the City of Toronto, from the refusal of the registrar to register the word mark "Virginia Dare" in connection with the sales of ladies' stockings, lingerie, gloves, dresses and ladies' wear generally. The application, dated the 3rd of May, 1935, states that the applicant has continuously used the words "Virginia Dare" as a word mark from at least the 16th of December, 1925, in Canada and not elsewhere, in connection with the sale of the wares above mentioned.

On February 24, 1936, the Commissioner wrote to the applicant, citing a communication from the Examiner in charge of the application, in which it is stated:

The words "Virginia Dare" form a personal name and attention is directed to section 26 (1) (b) of the Unfair Competition Act.

The communication from the Examiner further directed attention to the following trade-marks:

Trade-mark No. 28547/123 "Dorothy Dare" for dresses, waists cloaks and other articles of feminine apparel; registered by Pullan Manufacturing Company, Limited, of Toronto, Ontario, on June 18, 1921.

Trade-mark No. 20013/81 consisting of: (1) the name "Virginia" within a wreath at the top of which is the letter "V" in a shield; (2) the name "Virginia" with the photograph of a woman's head in a frame with the letter "V" in a shield at the top; registered for Women's Goodyear Welt Shoes by Perth Shoe Company, Limited, of Perth, Ontario, on July 31, 1914.

Trade-mark No. 49084/226, "Crepe Virginia" for garments and fabrics, men's, women's and children's outerwear and underwear; registered by Canadian Celanese Limited, of Montreal, on April 3, 1930.

I do not think that these trade-marks have any materiality in the present instance.

On February 26, 1936, the solicitors for the applicant wrote to the Commissioner; the second paragraph of their letter reads in part as follows:

We note also your reference to Section 21, 1(b) of the Unfair Competition Act referring to the fact the words may be a personal name. We do not know whether you are putting this in the form of

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an objection or simply calling it to our attention for consideration. In any event we know of no person by the name of Virginia Dare.

On March 3, 1936, the Commissioner replied submitting a communication from the Examiner from which I may quote the following observations:

The surname "Dare" is well known and as "Virginia" is also a well known Christian name, this section was brought to your attention, since if there is a person of this name such mark may not be registered. This section referred to does not restrict the personal name to a person domiciled in Canada, and it is consequently very probable that the name used is a personal name.

On March 5, 1936, the applicant's solicitors replied to the Commissioner stating (*inter alia*):

Virginia Dare was the first English child born on this continent. She was born on the 18th of August, 1587. We expect that she is since deceased and know of no person of this name.

In their letter, the applicant's solicitors sent to the Commissioner a solemn declaration dated the 5th of March, 1936, by the President of Virginia Dare Limited, containing, among others, the following statements:

2. So far as I know, Virginia Dare is not the name of any living person or persons.

3. I have been advised and understand that Virginia Dare was the name of the first white child born on this continent.

On March 18, 1936, the Commissioner wrote to the applicant's solicitors and included in his letter a communication from the Examiner reading in part as follows:

Applicants' letter of March 5, 1936, has been carefully considered and it is noted that "Virginia Dare" was the name of the first English child born on this continent. These words are consequently the name of a person.

Section 26 (1) (b) of the Unfair Competition Act is not limited either to names of persons in this country or to living persons, and it is thought that it is a bar to the registration of this word mark.

Registration is refused.

Alfred Stock, the President of Virginia Dare Limited, heard as witness for the appellant, said that the company had been in business for twelve years, dealing in ladies' wear, gloves, stockings, lingerie, etc.; that it had fourteen stores all located in the Province of Ontario and that, in addition, it made sales through the mail. The witness added that the name "Virginia Dare" indicated to the public that the products sold under that name were those of the appellant.

This line of evidence would have been irrelevant and immaterial on a mere appeal from the decision of the registrar; counsel for the appellant, however, expressed his intention to avail himself of the provisions of section 29

of the Act; counsel for the respondent declared that his client did not wish to prevent the appellant from obtaining permission to register its trade-mark under section 29 if it could prove to the satisfaction of the Court that its mark had been so used as to become generally recognized by dealers in or users of the class of wares in association with which it has been used as indicating that the person using it, namely, the appellant, assumes responsibility for their character or quality. In the circumstances, I thought that the evidence should be admitted.

Stock declared that, according to his information, Virginia Dare had been the first English child born in America.

A page of the *Time* of September 1, 1930, on which appears an article intituled "First Child," concerning Virginia Dare, was filed as exhibit 1 and a newspaper reproduction of a photograph of the monument in Fort Raleigh Park, Roanoke Island, commemorating the birth of Virginia Dare, was filed as exhibit 2.

Stock admitted that he had made no enquiry to find out if there were any person living bearing the name "Virginia Dare."

Three word marks, namely, "Rob-Roy," "Cleopatra" and "Bessborough" recorded respectively on December 15, 1936, June 16, 1937, and July 16, 1937, were filed as exhibits 3, 4 and 5, for the purpose of establishing that the Commissioner had allowed the registration of word marks consisting of a name or surname. I do not think that the registration of these trade-marks is material.

The evidence adduced on behalf of the respondent consists of four affidavits by Allan Edward Jacques, civil servant, employed by the Dominion Government in the Trade-Mark Branch of the Patent Office, who says that, in the course of his duties, he searched city directories and found: (a) in Polk's Baltimore City Directory for the year 1937, on page 294, the name "Virginia Dare, h. 1600 Eutaw Pl."; (b) in Polk's Baltimore City Directory for the year 1937, on page 294, the name "Virginia Dare, Clk., Reads Drug Store (Br.) r. 2404 Md. Ave."; (c) in the Providence City Directory for the year 1937, on page 973, the name "Virginia Dare, Women's Furngs., 228 Westminster"; (d) in Polk's (Boyd's), Philadelphia (Pennsylvania) City Directory, 1935-1936, Vol. CVII, on page 491, the name "Virginia A. Dare, r. 4695 Calumet (Falls)."

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The application of the appellant was refused by the registrar in virtue of paragraph (b) of subsection (1) of section 26 of the Unfair Competition Act.

The material provisions of subsection (1) of section 26 read as follows:

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

(a) * * * *

(b) is not the name of a person, firm or corporation;

It was submitted on behalf of appellant that the word "person" in paragraph (b) of subsection (1) of section 26 means a living person domiciled in Canada. I must say that I cannot agree with this proposition unreservedly.

Upon the record before him, the registrar was right in refusing to register the word mark "Virginia Dare."

In view, however, of the statement made by counsel for the appellant that, if the appeal from the refusal of the registrar could not be maintained, he wished to avail himself of the provisions of section 29 and ask the Court for a declaration that the trade-mark in question may be registered and in view of the assertion by counsel for the respondent that his client did not wish to take advantage of the lack of action or petition for the registration of the trade-mark under section 29, I will not dismiss the appeal but will give the appellant the opportunity of proceeding in virtue of said section.

If the appellant elects to proceed, it shall, within thirty days from the date hereof, give notice of its application for the registration of its trade-mark in accordance with the requirements of rule 35 of the General Rules and Orders of this Court; on the appellant's failure to proceed within said delay, the respondent may move for the dismissal of the appeal.

There will be no order as to costs for the present.

Judgment accordingly.

NOTE: The appellant herein filed a second petition, subsequent to the date of delivery of the judgment reported, praying registration of the trade-mark Virginia Dare, pursuant to the provisions of sec. 29 of the Unfair Competition Act, and on February 8th, 1938, the Honourable Mr. Justice Angers made an order granting the petition and directing the registration of the trade-mark.