

1945
 *Nov. 1
 *Dec. 21

BATTLE PHARMACEUTICALS..... APPELLANT;

AND

THE BRITISH DRUG HOUSES, LIM-
 ITED } RESPONDENT.

ON APPEAL FROM THE EXCHEQUER COURT OF CANADA

Trade Mark—Whether registered word mark “Multivims” should be expunged from register as being “similar” to previously registered word mark “Multivite”—The Unfair Competition Act, 1932 (Dom., 22-23 Geo. V, c. 38), ss. 2 (k) (o), 26, 52—Governing principle in determining question of similarity—Nature of evidence with regard to likelihood of confusion.

This Court affirmed the holding of Thorson J., [1944] Ex. C.R. 239, that appellant's registration of the word mark “Multivims” for use in association with wares described as “A multiple vitamin and mineral tablet” should be expunged from the register of trade marks kept under *The Unfair Competition Act, 1932* (Dom., 22-23, Geo. V, c. 38), on the ground that, within the meaning of s. 26 of said Act, said word mark was “similar” to the word mark “Multivite” previously registered by respondent for use in association with wares described as “A Preparation for Medicinal use of the Vitamins A, D, C and ‘B’ Complex”, and was used “in connection with similar wares”.

The question as to similarity must be determined as a matter of first impression. Any confusion would be in the person who only knows the one word, and has, perhaps, an imperfect recollection of it. Little assistance, therefore, is to be obtained from a meticulous comparison of the two words, letter by letter and syllable by syllable, pronounced with aimed clarity. The court must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description, but also of the shop assistant ministering to his wants (*Aristoc Ltd. v. Rysta Ltd.*, [1945] A.C. 68, at 86).

A witness may not state his opinion as to the effect the use of a mark would have, or be likely to have, on the mind of someone else, as that is the very point to be determined; but he may testify as to the effect the use of the mark in dispute would have on his own mind, which is one of the circumstances to be considered by the court.

APPEAL from the judgment of Thorson J., President of the Exchequer Court of Canada (1), ordering that the appellant's registration of the word mark “Multivims” on May 7, 1943, for use in association with wares described as

*PRESENT:—Kerwin, Taschereau, Rand, Kellock and Estey JJ.

(1) [1944] Ex. C.R. 239; [1944] 4 D.L.R. 577; 4 Fox Pat. C. 93.

"A multiple vitamin and mineral tablet be expunged from the Register of Trade Marks maintained under *The Unfair Competition Act, 1932* (Dom. 22-23 Geo. V, c. 38), on the ground that, within the meaning of s. 26 of the said Act, the said word mark was "similar" to the word mark "Multivite" registered by the respondent on March 26, 1936, for use in association with wares described as "A Preparation for Medicinal use of the Vitamins A, D, C and 'B' Complex", and that the two marks were used "in connection with similar wares."

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Rutledge C. Greig for the appellant.

Christopher Robinson for the respondent.

The judgment of the Court was delivered by

KERWIN J.—This is an appeal from a judgment of the Exchequer Court rendered on an application to it under section 52 of *The Unfair Competition Act, 1932*, by the respondent, The British Drug Houses, Limited, for an order striking from the register of trade marks an entry therein of May 7th, 1943, recording the trade mark "Multivims" as a word mark applied to a multiple vitamin and mineral tablet. That trade mark was recorded in the name of the appellant, Battle Pharmaceuticals. The respondent had, on March 26th, 1936, been recorded in the register as the owner of "Multivite" as a word mark applied to a preparation for medicinal use of the vitamins A, D, C and B complex.

The basis of the application is that the 1943 entry on the register did not accurately express or define the rights of the present appellant existing as of the date of the application to the Exchequer Court by the respondent. Those rights depend upon the question whether the word mark "Multivims" was registrable under section 26 of the Act, by the applicable provisions of which such word mark was registrable if it "(f) is not similar to * * * some other word mark already registered for use in connection with similar wares."

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It is not denied that the two word marks are used in connection with similar wares, but the appellant disputes the conclusion of the Exchequer Court that the word mark "Multivims" is "similar" to the word mark "Multivite". By clause (o) of section 2:—

"Word mark" means a trade mark consisting only of a series of letters and/or numerals and depending 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 as a series.

By section 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 onus is upon the applicant in these proceedings, the present respondent. *Proctor & Gamble Co. of Canada Ltd. v. LeHave Creamery Co. Ltd.* (1). The question must be determined by any judge upon whom the responsibility is cast as a matter of first impression and decisions upon disputes as to other trade marks are of no assistance except in so far as some principle is enunciated. Such a decision is that of the House of Lords in *Aristoc Ltd. v. Rysta Ltd.* (2). That case arose out of an application to the Registrar of Trade Marks for registration of a trade mark under the *Imperial Trade Marks Act*, chapter 22 of 1938. The Assistant Comptroller, acting for the Registrar, had issued his decision authorizing the application to proceed. Farwell J. discharged that order and directed the Registrar not to proceed with the registration. The Court of Appeal, with Lord Justice Luxmoore dissenting, reversed the order of Farwell J., holding that the registration should be allowed. The House of Lords unanimously reversed the order of the Court of Appeal and restored the order of Farwell J. Several questions were discussed before the Assistant Comptroller and the various courts but we are concerned only with the one arising under section 12 of the Act as to whether the trade mark sought to be registered so nearly resembled a trade mark already on the register as to be

(1) [1943] S.C.R. 433, at 438.

(2) [1945] A.C. 68.

likely to deceive or cause confusion. Although under that section the onus is on the applicant for registration, in view of the definition of "similar" in paragraph (k) of section 2 of our Act, the inquiry to be made on an application under section 52 thereof is in essence the same as that under section 12 of the Imperial Act.

The principle adopted by the House of Lords on that point is the same as has governed this Court in proceedings under section 52 of *The Unfair Competition Act* and it is found in a passage in the dissenting judgment of Lord Justice Luxmoore in the Court of Appeal, which was accepted in the House of Lords by all the peers as a fair statement of the duty cast upon the court. The passage referred to appears in the speech of Viscount Maugham at page 86 of the report:—

The answer to the question whether the sound of one word resembles too nearly the sound of another so as to bring the former within the limits of s. 12 of the Trade Marks Act, 1938, must nearly always depend on first impression, for obviously a person who is familiar with both words will neither be deceived nor confused. It is the person who only knows the one word, and has perhaps an imperfect recollection of it, who is likely to be deceived or confused. Little assistance, therefore, is to be obtained from a meticulous comparison of the two words, letter by letter and syllable by syllable, pronounced with the clarity to be expected from a teacher of elocution. The court must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description, but also of the shop assistant ministering to that person's wants.

Applying that principle to the case at bar, we are satisfied that the President of the Exchquer Court came to the right conclusion. The sound of the two words is such as would be likely to cause users of the wares to confuse the two, that is "to infer that the same person assumed responsibility for their character or quality". We agree that a witness may not state his opinion as to the effect the use of a mark would have, or would be likely to have, on the mind of someone else because, as stated in the *Proctor and Gamble* case (1), that is the very point to be determined in the proceedings, but that he may testify as to the effect the use of the mark in dispute would have on his own mind. That is one of the circumstances to be considered by the court.

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The only other argument advanced on behalf of the appellant was that users of the wares of the parties to which the registered trade marks applied would be more careful than usual because of the fact that they would be purchasing articles intended for medicinal purposes. However, all such articles are not sold on a doctor's prescription, and in connection with sales without such a prescription the confusion already adverted to is likely to occur.

The appeal is dismissed with costs.

Appeal dismissed with costs.

Solicitor for the appellant: *Rutledge C. Greig.*

Solicitors for the respondent: *Smart & Biggar.*
