

THE BOSTON RUBBER SHOE COM- } APPELLANTS;
 PANY (PLAINTIFFS)..... }

1902
 *Feb. 25,
 *May 15.

AND

THE BOSTON RUBBER COMPANY } RESPONDENTS.
 OF MONTREAL (DEFENDANTS).... }

ON APPEAL FROM THE EXCHEQUER COURT OF CANADA.

*Trade-mark—Infringement—Use of Corporate name—Fraud and deceit—
 Evidence.*

The plaintiffs, incorporated in the United States of America, have done business there and in Canada manufacturing and dealing in india rubber boots and shoes under the name of "The Boston Rubber Shoe Company" having a trade line of their manufactures marked with the impression of their corporate name, used as a trade-mark, known as "Bostons," which had acquired a favourable reputation. This trade-mark was registered in Canada, in 1897. The defendants were incorporated in Canada, in 1896, by the name of "The Boston Rubber Company of Montreal," and manufactured and dealt in similar goods to those manufactured and sold by the plaintiffs, on one grade of which was impressed the defendants' corporate name, these goods being referred to in their price lists, catalogues and advertisements as "Bostons," and the company's name frequently mentioned therein as the "Boston Rubber Company" without the addition "Montreal." In an action to restrain defendants from the use of such mark or any similar mark on the goods in question, as an infringement on the plaintiffs' registered trade-mark,

Held. reversing the judgment appealed from, (7 Ex. C. R. 187), that under the circumstances, defendants' use of their corporate name in the manner described was a fraudulent infringement of plaintiffs' registered trade-mark calculated to deceive the public and so to obtain sales of their own goods as if they were plaintiffs' manufactures, and, consequently, that the plaintiffs were entitled to an injunction restraining the defendants from using their corporate name as a mark on their goods manufactured in Canada.

* PRESENT :—Sir Henry Strong C.J. and Sedgewick, Girouard, Davies and Mills JJ.

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APPEAL from the judgment of the Exchequer Court of Canada (1), dismissing with costs the plaintiffs' action for damages and an injunction to restrain the defendants from infringing the plaintiffs' trade-mark registered in Canada.

The plaintiffs were incorporated in the State of Massachusetts in the year 1853, for the purpose of manufacturing and selling rubber boots and shoes, and ever since have carried on that business throughout the United States of America and Canada, using a trade-mark upon their rubber boots and shoes the essential features of which consist, as alleged, of the words "Boston Rubber Shoe Company." In October, 1897, the plaintiffs registered said trade-mark in Canada as a specific trade-mark for rubber boots and shoes. The statement of claim alleged further that on the 21st October, 1896, the Toronto Rubber Shoe Manufacturing Company registered in Canada, as a specific trade-mark for rubber boots and shoes, the word "Boston," and transferred the same to the plaintiffs by assignment dated the 20th September, 1897; that the defendants in 1899 manufactured and sold in Canada, rubber boots and shoes similar to those made and sold by plaintiffs and applied thereto a mark as follows, "The Boston Rubber Co., Montreal, Ltd." placing the same on the same part of the boot or shoe made by the defendants as the plaintiffs on their boots and shoes were accustomed to place their said trade-mark; that the defendants have not registered the said mark in Canada; that the mark so used by the defendants is, in its essential features, the same as the plaintiffs' said trade-marks, or so closely resembles the same as to be calculated to mislead the public in Canada and elsewhere into believing that in purchasing goods made by the

(1) 7 Ex. C. R. 187.

defendants and so marked they were purchasing goods made by the plaintiffs, and that defendants made large profits by reason of purchasers being misled by said mark into purchasing said goods believing them to have been manufactured by plaintiffs.

The defendant pleaded that the plaintiffs' trade-marks were registered in Canada after the defendants had begun to use the mark complained of and denied that defendants' profits have been made by reason of purchasers being misled into purchasing its goods believing them to be plaintiffs' goods. The defendants further pleaded that defendants' mark is composed in effect of defendants' corporate name, that the user thereof was not fraudulent, and that, prior to the incorporation of defendants, a company was in existence in the United States for the manufacture of rubber boots and shoes called "The Boston Rubber Co.", that the plaintiffs endeavoured by suits in the courts of the United States to prevent the use by The Boston Rubber Company of their corporate name in connection with the manufacture of rubber boots and shoes, but failed, and that the Boston Rubber Company continued to imprint their name on rubber boots and shoes prior to registration by plaintiffs of its trade-mark in Canada, that the promoters of the defendant company purchased the plant of The Boston Rubber Company and adopted the mark complained of as the dies purchased by The Boston Rubber Company bore the name of that company.

The defendants having demurred to the plaintiffs' statement of claim the demurrer was overruled (1).

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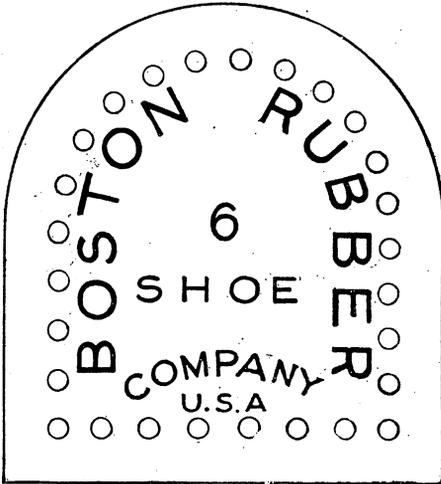
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The marks of the plaintiff company were impressed upon its goods, generally arranged as follows :



Those impressed by the defendant upon the goods in question of its manufacture were generally as follows :



The marks being placed on the same part of its boots and shoes and those impressed upon the plaintiff's manufacture.

The questions at issue in the present appeal are stated in the judgment reported.

Sinclair for the appellants. It is not necessary to prove fraudulent adoption or adaptation. The injury to the owner of a trade-mark is just as great when the infringement is innocent as when it is intentional. "*Singer*" *Machine Manufacturers v. Wilson* (1), *Millington v. Fox* (2), *Kerly on Trade Marks*, (1 ed.), pp. 4, 14, 316, 349; *Sebastian on Trade Marks*, (4 ed.), p. 124; 26 *Am. & Eng. Encl. of Law*, p. 444.

The fact that the plaintiffs' trade-mark was not registered in Canada until after the incorporation of the defendant company is not a reason for denying the relief sought. The plaintiffs had a perfectly good trade-mark in Canada for years before the defendants were incorporated. Section 19 of the Trade-Mark Act, R. S. C., cap. 63, only imposes a condition precedent to the right to sue, the plaintiffs' trade-mark in Canada and the United States existed long prior to the date of the incorporation of the defendant company, although by reason of the Trade Mark Act it had to be registered before the plaintiffs could sue in respect of infringement. *Barlow and Jones v. Jabez Johnson & Co.* (3), at pages 405 and 411. Damages can be recovered for infringements occurring prior to registration, *Smith v. Fair* (4), per Proudfoot J. at page 736. The fact that the defendants use the word "Boston" or "Bostons" in its advertisements and catalogues, that word being the essential portion of the plaintiffs' registered mark as applied to their product, and omit from their books and catalogues the words "of" and "Montreal" in many instances shows that even if the original choice of name was not made for the purpose of gaining the benefit of the plaintiffs' reputation, the subsequent

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(1) 3 App. Cas. 376.

(2) 3 My. & Cr. 338.

(3) 7 Cutl. P. Cas. 395.

(4) 14 O. R., 729.

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use made of it by the defendants contains those garnishings of fraud referred to in the judgment of Lord Esher in *Turton v. Turton* (1), at page 134, which will enable the Court to conclude that the defendants are endeavouring to pass off their goods as the goods of the plaintiffs. The defendants' mark is so like that of the plaintiffs that purchasers cannot tell when purchasing which company has made the goods. The intentional dropping of the words "of" and "Montreal" is evidence that the defendants are acting in bad faith and fraudulently marking their goods so as to deceive purchasers. See the remarks of Bradley J. in *Celluloid Mfg. Co. v. Cellonite Mfg. Co.* (2); *Burgess v. Burgess* (3); *Hendriks v. Montagu* (4); *Manchester Brewery Co. v. North Cheshire and Manchester Brewery Co.* (5); Kerly on Trade-Marks, (1 ed.) pp. 320, 380, 389, 423; (2 ed.) pp. 466, *et seq.* It is not necessary to prove that the defendants have sold or attempted to sell their goods as those of the plaintiffs otherwise than by shewing the sale of such goods under the name by which plaintiffs' goods are known in the market. *Reddaway v. Banham* (6); *Wotherpoon v. Currie* (7); *Massam v. Thorley's Cattle Food Co.* (8); *Warner v. Warner* (9).

When there is, as in this case, an appropriation of a material or substantial part of a trade-mark the appropriator is bound to use such precautions as to avoid the probability of error and deception and the onus is on him to shew that the purchasers of goods will not be deceived. *Orr Ewing & Co. v. Johnston & Co.* (10); Brown on Trade-Marks, (2 ed.), sec. 387. See also the

(1) 42 Ch. D. 128.
 (2) 32 Fed. Rep. 94.
 (3) 3 De G.M. & G. 896.
 (4) 17 Ch. D., 638.
 (5) [1898] 1 Ch. 539.

(6) [1896] A. C., 199.
 (7) L. R. 5 H. L. 503.
 (8) 14 Ch. D. 748.
 (9) 5 Times L. R., 327, 359.
 (10) 13 Ch. D. 434.

remarks of Lord Esher M. R. in *Pinto v. Badman* (1). As to the right in Canada to assign a trade-mark in gross, see *Smith v. Fair* (2); Sebastain on Trade-marks, (4 ed.), p. 15 note; *Hohner v. Gratz* (3). Under the Trade-Mark Act, R. S. C., cap. 68, s. 3, the proprietor of a registered trade-mark is entitled to the exclusive right to use the same to designate articles manufactured and sold by him.

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If the court should be of the opinion that the original choice of name by the defendants was innocent the plaintiffs are entitled to damages from the 21st September, 1900, when the defendants were notified of the infringement.

As to proof of fraud being no longer necessary in order to enable the court to restrain a person from trading under his own name, see Kerly on Trade-Marks, (2 ed.) pp. 500-514; *Valentine Meat Juice Co. v. Valentine Extract Co.* (4); *J. & J. Cash. Ld. v. Cash* (5).

When the plaintiffs' goods are known by a name suggested by his trade-mark the defendants may be restrained from using a mark calculated to cause the same name to be applied to their goods. Kerly (2 ed.) pp. 240-253, p. 379.

As to restraining infringement caused by defendants' catalogues, price lists and advertisements, see Kerly (2 ed.) pp. 39, 369; "*Singer*" *Machine Manufacturers v. Wilson* (6); *Jay v. Ladler* (7).

As to form of injunction in such cases, see Kerly on Trade-Marks (2 ed.) pp. 751, 754 and 756.

It is not a question whether the use of the defendants' mark is necessarily deceptive but whether there is not a strong probability of its causing deception.

(1) 8 Cutl. P. Cas. 181.

(2) 14 O. R. 729.

(3) 50 Fed. Rep., 369.

(4) 17 Cutl. P. Cas. 673.

(5) 18 Cutl. P. Cas. 213.

(6) 3 App. Cas. 376, at p. 392.

(7) 6 Cutl. P. Cas. 136.

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Cf. Cotton L.J. in *The Upper Assam Tea Co. v. Herbert & Co.* (1); Kerly (2 ed.) pp. 373-374.

Where the plaintiff's trade-mark is geographical the defendant not carrying on business at the same place may be restrained; *The Whitestable Oyster Fishery Co. v. The Hayling Fisheries, Ld.* (2); Am. & Eng. Encl. vol. 26 p. 331; *Montgomery v. Thompson* (3).

As to restraining the use of a portion of a registered trade-mark, see *Crawford v. Shuttock* (4); *Carey v. Goss* (5).

Béique K.C. and *McGouin K.C.* for the respondents. It was not until October, 1897, that the appellants registered their trade-mark in Canada, and even in the United States they registered only in April, 1897, more than five months after the incorporation of the Canadian Company. Plaintiffs' action is based entirely on the provisions of our statute by section 3 of which trade-marks are defined, registration permitted, and it is declared that *thereafter* the person registering shall have the exclusive right to the use of the name. However this might affect the persons, it cannot affect the vested rights of the respondents to continue to use the name they had been using from the time of incorporation. Sebastian (3 ed.) p. 27; *Burgess v. Burgess*. (6). Marks in use before registration come under the same rule as old marks under the English statute. It is essential that the mark should be claimed and registered precisely in the form in which it has been used. Sebastian (3 ed.) p. 103; note (l) to section 64 of the P. A., 1883, cited at page 366.

The decisions in *The Boston Rubber Shoe Co. v. The Boston Rubber Co.* (7); *Converse v. Hood* (8); and *Converse v. The Boston Rubber Co.* (8); were that

(1) 7 Cutl. P. Cas. 183.

(2) 17 Cutl. P. Cas. 461.

(3) [1891] A. C. 217.

(4) 13 Gr. 149.

(5) 11 O. R. 619.

(6) 3 De G., M. & G. 896.

(7) 149 Mass. 436.

(8) 149 Mass. 471.

the Boston Rubber Shoe Company could not deprive the Boston Rubber Company of the right to manufacture boots and shoes and even to stamp them with their name. This was pleaded, and copies of the documents forming the record in that case are produced.

As to the trade-mark on the word "Boston" registered by the Toronto Rubber Shoe Manufacturing Company and purchased by the plaintiffs, it is to be observed, first, that the word was in use both by the plaintiffs and by the company from which the defendants bought their plant for many years before said registration.

It is certainly hypercritical to observe that in the price lists and catalogues the full name has not been always repeated. It is impossible that a single manufacturer should be allowed to arrogate to himself the exclusive use of a name which he shares in common with many other persons, and from this circumstance the rule is deduced that while against persons bearing a different name a manufacturer's right in his trade-mark is absolute and exclusive, as against persons bearing the same name, no such exclusive right can be set up. *Burgess v. Burgess*, (1).

The court below has followed the French courts in *Erard v. Erard* (2), which followed an earlier holding, *Salignac v. Levannier* (3) affirming the *arrêt* of the Court of Appeal in *Lagorée v. Perrin* (4). See also *Erard v. Erard* (5), and *Partlo v. Todd* (6).

The respondents have done precisely what the court ordered in these cases, they have put the name "Montreal" in clear large type and the abbreviation "Ltd." in the middle of the mark adopted by them, thus making the distinctive features the most prominent part of their

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(1) 3 De G. M. & G. 896.

(2) Dal. 73, 1, 231.

(3) Dal. 54, 1, 252.

(4) Dal. 54, 2, 86.

(5) Dal. 80 1, 80.

(6) 17 Can. S. C. R. 196.

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mark. On this point, the absence of fraudulent intention, the judgment of the court below is emphatic, and there is nothing in the record that can weaken this holding.

For all these reasons the judgment of the court below must be affirmed, that it should be declared that the defendants have acted throughout with perfect honesty and in absolute good faith, and the appellants should pay the costs of the demurrer as well as the costs already adjudged and the costs of this appeal.

The judgment of the court was delivered by :

DAVIES, J.—The plaintiffs (appellants) brought their action in the Exchequer Court seeking to restrain the respondents (defendants)

from continuing to use the Trade Mark of the plaintiffs (the essential feature of which were alleged to consist of the words “Boston Rubber Shoe Company,”) “or any other mark similar thereto upon rubber boots and shoes or any other goods made or sold by the defendants and from in any other way infringing the plaintiffs’ registered marks or either of them.”

They also claimed damages and “such further or other relief as might be considered just.”

As regards the plaintiff company, the learned judge states the facts of follows:—

The plaintiff company was, in 1853, incorporated under the laws of the Commonwealth of Massachusetts, by the name of “The Malden Manufacturing Company” for the purpose of manufacturing cotton, silk, linen, flax or india-rubber goods at the Town of Malden. In 1855 its name was, by an Act of the Commonwealth, changed to “The Boston Rubber Shoe Company.” Since that time it has continued to do business by that name, and its business has prospered. In rubber boots and shoes it manufactures two grades or lines of goods; the one that which is spoken of as “The Boston Rubber Shoe line,” and the other “The Bay State line.” The former are known to the trade, and have been since as early as 1865 at least, as “Bostons.” The other grade is known as “Bay State.” The company’s annual output of rubbers is about twelve million pairs. Mr. Sawyer puts it at from ten

to fifteen millions. Of this quantity about half are "Bostons" and half "Bay State." These goods are sold in the United States, in Europe and in Canada. But the sale in Canada is not, I infer from the evidence, large.

In the year 1896, one Charles L. Higgins purchased from another company in the United States of America, called The Boston Rubber Company, all its calendars, blocks, dies, patterns, moulds and all furniture and tools specifically adapted for the manufacture of rubber boots and shoes.

This Boston Rubber Company had, at one time, included, in the goods they manufactured, rubber boots and shoes, but after some litigation with the plaintiffs connected with their right to use the name (but not, so far as it appears, in consequence of such litigation) had gone out of the business of manufacturing boots and shoes and sold their blocks, dies, &c., to Higgins.

In 1896, Higgins applied for and obtained for himself and others incorporation under "The Companies Act," (R. S. C. c. 119), by the name of The Boston Rubber Company of Montreal, Limited. This company manufactures, amongst other goods, two grades of rubber boots and shoes at their works in St. Jerome, in the Province of Quebec. On the better grade are impressed the words "The Boston Rubber Company, Montreal, Limited," and these goods in the company's catalogues, price lists and advertisements are referred to as "The Boston." In the illustrated catalogue Exhibit No. 15, will be found the following:—

Our Neptune brand is everything we claim for it—a high grade second, not so good as the Boston, but a clean, well made, stylish rubber that will give excellent satisfaction for the money ; and in the same catalogue, as well as in the price list (Exhibit No. 16), the words "Boston Rubber Company" without any addition of the word "Montreal", frequently occur.

The learned judge found as a fact, and the evidence fully justifies the finding, that

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although the sales of the plaintiffs' goods in Canada do not appear to be, or so far as the evidence goes, to have been considerable, the term "Boston" or "Bostons" has come in some way to have a commercial value as attached to rubber boots and shoes and this value has been given to it by the plaintiffs' enterprise and business.

He further says with respect to the use of that term or terms that it seemed to him reasonably certain that

the plaintiff company was the first to make use of the term in that connection, and that any value it had acquired in that connection, any secondary meaning that it has come to have as denoting excellence in rubber boots and shoes, has been derived from its use in the plaintiffs' business;

and further

that the defendant company as honest manufacturers and traders ought to discontinue its use except so far as it forms part of the corporate name of the company.

Having reached these conclusions of fact and expressing these opinions however, the learned judge went on to say

that this action was not brought to restrain the use of the word "Boston" or "Bostons" in the company's catalogues, price lists and advertisements, but to restrain it from using upon goods of its own manufacture what, in substance, is its corporate name, the only difference being the omission of the preposition "of" before Montreal.

The learned judge accepted the explanation of Mr. Higgins as to the circumstances under which the corporate name of the defendants was adopted and acquitted him and the company of any intentional or fraudulent adaptation of any part of the plaintiffs' corporate name. He further says that there is no evidence of any attempt by the defendant company to sell their goods as those of the plaintiffs, and that the question he had to determine was whether the company might or might not impress their corporate name upon goods of their own manufacture. He answered it in the affirmative in the absence of any fraud or bad faith.

It seems to me, with great respect, very difficult on the evidence in this case to find that fraud and bad faith were absent; and if I were compelled to find specifically on the point I would strongly incline to the opinion that the particular corporate name which Mr. Higgins selected for his company was selected by him because of the special value which had attached to the term "Boston" in connection with rubber boots and shoes by the enterprise, energy and business of the plaintiffs. I can hardly conceive of any legitimate use of the word "Boston" in the corporate name of a Canadian company established to do a manufacturing business in the Province of Quebec. The object of using the name by stamping it upon each of the products of their manufacture and offering them for sale so stamped may not have been to deceive purchasers into the belief that they were buying the goods of the Boston Shoe Co., but that such would have been the result, I entertain no reasonable doubt. If so, it would bring the case directly within the rule laid down by Lord Kingsdown in *Leather Cloth Co. v. American Leather Cloth Co.* (1), quoted approvingly by Lord Herschell in *Reddaway v. Banham* (2), viz.:

The fundamental rule is that one man has no right to put off his goods for sale as the goods of a rival trader, and he cannot therefore (in the language of Lord Langdale in the case of *Perry v. Truefitt* (3)), be allowed to use names, marks, letters, or other indicia by which he may induce purchasers to believe that the goods which he is selling are the manufacture of another person,

and entitles the person aggrieved to an injunction to restrain its use.

The term "Boston" or "Bostons" attached by the plaintiff company to their rubber boots and shoes was an "invented or fancy word" and not a descriptive one, and had come in time as found by the learned

(1) 11 H. L. Cas. 523, at p. 538. (2) [1896] A. C. 199.

(3) 6 Beav. 66.

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judge, to have a well understood meaning in the trade and to apply to a special class of rubber boots and shoes' which the plaintiffs manufactured and sold. Comparing the name and diagram stamped by the defendant company on their boots and shoes with the name and diagram stamped by the plaintiff company on theirs, I can have no doubt that an ordinary purchaser would be deceived. The deception would be caused by the use of the term "Boston," and that this would be so would seem to have been well known to the defendants from the fact that the boots and shoes so stamped by them are referred to in the company's catalogues, price lists and advertisements as "Bostons."

The distinction between an "invented or fancy word" as a Trade Mark and a really descriptive one is of great importance in determining, where that is necessary, the presence or absence of fraud. But with all respect to the learned judge I doubt very much that it is necessary to find "fraud or fraudulent intent" on the defendants' part in order to grant relief.

The general rule that a single manufacturer will not be allowed to arrogate to himself the exclusive use of a name which he shares in common with many others, has of course been qualified in *Holloway v. Holloway* (1), by the statement that the free use even of a man's own name will be hindered and restrained if it is shewn that the person using it is doing so for the purpose of fraud. But I doubt much that such general rule, even without the qualification, could be invoked by the defendant company in a case such as this.

The whole question of the use of a name which had acquired a special meaning with respect to a special class of goods was exhaustively reviewed by the House of Lords in the late case of *The Cellular Clothing Company, Limited v. Maxton & Murray* (2), where nearly

(1) 13 Beav. 209.

(2) [1899], A. C. 326.

all the leading cases on the subject are referred to. The distinction between an invented or a fancy name and a *bonâ fide* descriptive one is pointed out and it was there held that the word "cellular" was an ordinary English word which appropriately described the cloth of which the goods sold by the respondents were manufactured, and that the term had not been proved to have acquired a secondary or special meaning so as to denote only the goods of the appellants.

In the case now under consideration by us, the term "Boston" or "Bostons" was a fancy word used with respect to a special class of goods manufactured by the plaintiffs in or near the City of Boston, and has come to have a special meaning in the trade as denoting only such goods. In giving judgment in the case just cited the Lord Chancellor says, on page 334, referring to the necessity for fraudulent intention being proved:—

The only observation that I wish to make upon that part of the argument is that it seemed to be assumed that a fraudulent intention is necessary on the part of the person who was using a name in selling his goods in such a way as to lead people to believe that they were the goods of another person. That seems to me to be inconsistent with a decision given something like sixty years ago, by Lord Cottenham, who goes out of his way to say very emphatically that that is not at all necessary in order to constitute a right to claim protection against the unlawful use of words or things—I say things because it is to be observed that not only words but things, such as the nature of the wrapper, the mode in which the goods are made up, and so on, may go to make up a false representation; but it is not necessary to establish fraudulent intention in order to claim the intervention of the court. Lord Cottenham says in that case, *Millington v. Fox*; "I see no reason to believe that there has, in this case, been a fraudulent use of the plaintiffs' marks. It is positively denied by the answer, and there is no evidence to show that the defendants were even aware of the existence of the plaintiffs as a company manufacturing steel; for although there is no evidence to show that the terms 'Crowley' and 'Crowley Millington' were merely technical terms, yet there is sufficient to show that they were very generally used, in conversation at least, as descriptive of particular qualities of steel. In short, it does

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not appear to me that there was any fraudulent intention in the use of the marks. That circumstance, however, does not deprive the plaintiffs of their right to the exclusive use of those names; and therefore, I stated that the case is so made out as to entitle the plaintiffs to have the injunction made perpetual." That, my Lords, I believe to be the law. It was the law then, and it has not been qualified or altered by the fact that the Trade Marks Act has since been passed, which gives a feasible and perfectly facile mode of remedy in cases in which Trade Marks apply.

And again, on page 336 :—

There has not been any question, nor can there be any question as to what the state of the law is. It is laid down in *Burgess's Case* (1), the Anchovy Sauce case, with great precision. The simple proposition is this : That one man is not entitled to sell his goods under such circumstances, by the name, or the packet, or the mode of making up the article, or in such a way as to induce the public to believe that they are the manufacture of some one else. The proposition that has to be made out is that something amounting to this has been done by the defendant, and if that proposition is made out the right to relief exists.

And in the same case Lord Shand says, page 338 :—

There is a vital distinction in cases of this class between invented or fancy words or names, or the names of individuals such as "Crowley" or "Crowley Millington" attached by a manufacturer to his goods and stamped on the articles manufactured, and words or names which are simply descriptive of the article manufactured, or sold. The idea of an invented or fancy word used as a name is that it has no relation, and at least no direct relation, to the character or quality of the goods which are to be sold under that name. There is no room whatever for what may be called a secondary meaning in regard to such words, as the Lord Advocate pointed out in the course of his argument. The word used and attached to the manufacture, being an invented or fancy name and not descriptive, it follows that, if any other person proceeds to use that name in the sale of his goods, it is almost, if not altogether impossible to avoid the inference that he is seeking to pass his goods off as the goods of the other manufacturer. A person invents or applies the term "Eureka" as the name of a shirt in his sales. If you buy a "Eureka" shirt, that seems at once to mean that you are buying a shirt made by the particular maker who is selling shirts under that fancy name. The public come to adopt the word "Eureka" as applicable to the manufacture of the particular person who began to use it and as denoting the article he is

(1) 3 DeG. M. & G. 896.

selling, and if another person employs the word in the sale of the same or a similar article, it seems to follow that he is acting in direct violation of the law that no one, in selling his goods, shall make such representations as will enable him to pass them off as the goods of another, so as to get the benefit of that other's reputation.

A totally different principle must apply in the case of goods which are sold under a merely descriptive name.

He too states the question to be put as follows; page 340:—

It is true the question in issue in cases of this class may generally be broadly stated as: Did the defendants by their representations seek to induce purchasers to acquire their goods under the false belief that these goods were of the plaintiff's manufacture?

I have no hesitation myself, in the case now before us, in answering the question put in that form in the affirmative. The word "Boston" which they used and put in their corporate name and stamped on the rubber boots and shoes they offered for sale and advertised in their circulars and advertisements, amounted to an emphatic representation under cover of which they sought to induce purchasers to acquire their goods under the false belief that they were the plaintiffs' and I agree with the learned Judge of the Exchequer Court that

as honest manufacturers and traders they ought to discontinue its use except so far as it forms part of their corporate name.

I differ with him, however, as to their right under cover of their corporate name to stamp this invented or fancy word on the goods they offer for sale, unless it is so done as clearly to distinguish the goods from those of the plaintiffs, and also as to the power and duty of the Court to compel them to desist from their dishonesty. Lord Davey in the *Cellular Clothing Case* (1), from which I have been quoting, speaking of the logical foundation of this branch of the law, says at page 343:—

Shortly summed up, it is that a man shall not by misrepresentation pass off his own goods as those of his neighbour.

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But there are two observations which must be made ; one is that a man who takes upon himself to prove that words, which are merely descriptive or expressive of the quality of the goods, have acquired the secondary sense to which I have referred, assumes a much greater burden—and indeed a burden which it is not impossible, but at the same time extremely difficult, to discharge—a much greater burden than that of a man who undertakes to prove the same thing of a word not significant and not descriptive but what has been com- pendiously called a “fancy” word.

The same doctrine is to be found in a leading case in the House of Lords known as *The Camel Hair Belting Case, Reddaway v. Banham* (1), where it was held that the defendant should be restrained from using the words “Camel Hair” as descriptive of or in connection with belting made or sold by him and not manufactured by the plaintiff, without clearly distinguishing such belting from the plaintiff’s. Lord Herschell in his judgment, at page 209, says :—

Where the Trade Mark is a word or device never in use before, and meaningless, except as indicating by whom the goods in connection with which it is used were made, there could be no conceivable legitimate use of it by another person. His only object in employing it in connection with goods of his manufacture must be to deceive. In circumstances such as these, the mere proof that the Trade Mark of one manufacturer has been thus appropriated by another would be enough to bring the case within the rule, as laid down by Lord Kings- down, and to entitle the person aggrieved to an injunction to restrain its use.

And again, as to the right of a man to use his own name, he says, page 211 :—

The authority replied on was the case of *Burgess v. Burgess* (2). When the judgments in that case are examined, it seems to me clear that no such point was decided. Turner, L. J., commences by saying: “No man can have any right to represent his goods as the goods of another person ; but in applications of this kind it must be made out that the defendant is selling his own goods as the goods of another.” He then points out that where a person is selling goods under a particular name and a person not having that name is using it, it may be presumed that he so uses it to represent the goods sold by himself as

(1) [1896] A. C. 199.

(2) 3 DeG. M. & G. 896.

the goods of the person whose name he uses ; but where the defendant sells goods under his own name, and it happens that the plaintiff has the same name, it does not follow that the defendant is selling his goods as the goods of the plaintiff. He adds : " It is a question of evidence in each case whether there is false representation or not." This I think, clearly recognizes that a man may so use even his own name in connection with the sale of goods as to make a false representation. In *Massam v. Thorley's Cattle Food Company* (1), James, L. J., said : "*Burgess v. Burgess* (2), has been very much misunderstood if it has been understood to decide that anybody can always use his own name as a description of an article whatever may be the consequences of it or whatever may be the motive for doing it or whatever may be the result of it." After quoting from the judgment of Turner, L. J. the passages to which I have just alluded,³ he said : "That I take to be an accurate statement of the law, and to have been adopted by the House of Lords in *Wotherspoon v. Currie* (3), in which the House of Lords differed from the view which I had taken."

Now it seems to me beyond doubt that Mr. Higgins could not, either himself personally or in association or partnership with the others who applied for and obtained letters patent of incorporation under the defendants' name, have used the plaintiff company's trade-mark, on rubber boots and shoes he might manufacture and offer for sale, without subjecting himself and themselves to the risk of an injunction. Nor am I able to see how he can, by obtaining for himself and his associates letters corporate under the statute, do under cover of the corporate name what he otherwise would be prevented from doing. The defendant company has the right to use its corporate name for all lawful and legitimate purposes. It has not the right to use it however, by stamping it upon goods it has manufactured and offered for sale, if by so doing it causes the purchasing public to believe that the goods are those of the plaintiff company. The stamping of their corporate name, which embraces the plaintiffs' trade-mark, upon the rubber boots and shoes manu-

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(1) 14 Ch. D. 748.

(2) 3 DeG. M. & G. 896.

(3) L. R. 5 H. L. 508.

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factured by them would almost certainly lead purchasers to believe that the defendant company was a branch of the plaintiff company carrying on business in Montreal.

I think the prayer of the plaintiffs in the statement of claim sufficiently broad to cover the infringement charged of the plaintiffs' registered trade-mark in the advertisements, circulars and price lists issued by the defendants, calling attention to their goods as "Boston" or "Bostons" and that the defendants should be restrained from the use of such words either by stamping them upon their goods or advertising them in circulars, price lists or otherwise.

I do not think the damages alleged to have been sustained thus far sufficient to justify the expense of a reference.

The appeal should be allowed with costs here and below. Judgment should be entered in the Exchequer Court for the plaintiffs for an injunction restraining the defendants from using the words "Boston" or "Bostons" as descriptive of or in connection with rubber boots or shoes manufactured by them, or rubber boots or shoes (not being of the plaintiffs' manufacture) sold or offered for sale by them, either by stamping upon such rubber boots and shoes, or by circular, or advertisement or otherwise, without clearly distinguishing such rubber boots and shoes from the shoes of the plaintiffs.

Appeal allowed with costs.

Solicitor for the appellants: *R. V. Sinclair.*

Solicitors for the respondents: *McGoun & England.*