

1917
March 21.
May 1.

IN THE MATTER OF A SPECIFIC TRADE-MARK CONSISTING OF THE WORD "HORLICK'S."

ON APPEAL FROM THE EXCHEQUER COURT OF CANADA.

Trade-Mark—Surname—Food Products.

A surname, and especially an uncommon surname, may be registered as a trade mark when it has long been used to designate the quality of goods sold and to distinguish the same from other goods.

APPEAL from the judgment of the Exchequer Court of Canada deciding that the word "Horlicks" could not be registered as a trade-mark to be used to designate goods sold by Horlick.

The appeal was heard *ex parte*, the Commissioner of Patents not appearing.

Harold Fisher and Smart for the appellants.

THE CHIEF JUSTICE.—This is an appeal from a judgment of the Exchequer Court on a petition by Horlick's Malted Milk Co. to register the surname "Horlick's" as a trade-mark to be used in connection with the sale of food products (ss. 5, 11 and 42 of the Act).

The application was disposed of in the Exchequer Court apparently on the assumption that the facts alleged in its support disclosed merely a case of passing off and that the goods had acquired a reputation on the market by reason of the superiority of their manufacture and nothing more.

PRESENT.—Sir Charles Fitzpatrick C.J. and Davies, Idington, Duff and Anglin JJ.

(REPORTER'S NOTE.—This case was not reported at the proper time as the judges' notes were mislaid).

The grounds on which the minister refused the application do not appear, but his right to refuse to register is limited by section 11 of the Act. Having carefully considered the different subsections of section 11 I assume that the minister exercised the powers conferred by subsection (e) of that section to the effect that the trade-mark for which registration was sought did not contain the essentials of a trade-mark properly speaking. I am not quite clear as to what that language means but in any event both before and after the statute the office of a trade-mark was and is to point out the origin or ownership of the article to which it is affixed. In the words of the English Act, 1905, section 9, a trade-mark is something adopted to distinguish the goods of the proprietor of the trade-mark from those of other persons. Our statute, section 5, enacts that all names adopted by a person in trade for the purpose of distinguishing an article manufactured and offered for sale by him shall for the purposes of the Act be considered as a trade-mark.

The evidence as I understand it, and I have read the affidavits with some attention, does not refer, as the judge below assumed, to the quality of the goods, but they establish that the word "Horlick's" has been used as a sign or symbol to indicate the origin or ownership of the goods to which it has been attached and, in the words of section 5, to distinguish the article manufactured and offered for sale. In these circumstances I fail to see how the application to register should be refused on the plain language of the sections of the Act. I do not think that *Teofani & Co. v. Teofani* (1), is applicable on the facts of this case. But in *Teofani's Case* (1), it was held "that a surname is not necessarily

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incapable of being a registrable trade-mark." It may be registered for instance where it is as in this instance an uncommon name and its use has been so extensive that in fact it has become distinctive. Here the affidavits shew that the trade-mark has been in actual use and that such user has been sufficient to render it distinctive; food products in packages bearing as a conspicuous identifying feature the word "Horlick" have been sold in the United States and in Great Britain and the Colonies for over forty years, the approximate number of packages sold each year amount to 7,500,000 and the annual cost of advertising has been almost \$500,000.

This case is distinguishable on the facts from the case of *In re R. J. Lea's Trade-Mark* (1), and our statute differs from the British Act; but the *Lea Case* (1) is very instructive.

I am of the opinion that the appeal should be allowed and the prayer of the petition granted.

DAVIES J.—I concur in the result.

IDINGTON J.—I think this appeal should be allowed. The use of names seems expressly provided for by section 5 of the Trade-mark and Designs Act, as one of the devices which may be adopted for use by any person in his trade, business, occupation or calling for the purpose of distinguishing any manufacture, etc.

Indeed it may by long use have become the most distinctive mark that the product of a man's manufacture can be recognized by.

(1) 29 Times L.R. 334.

The material before us indicates at least a *prima facie* right on the part of the petitioner to have this name registered as its trade-mark.

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The Minister may find some objection upon facts brought to his knowledge in any way which would entitle him, and might indeed render it his duty, under section 11 of the Act, to reject the application. We can only speak from what is before us.

The reference to English decisions is certainly not very helpful. There is such a wide difference between the frame and express language of the English Act and ours, that decisions under the former are often more apt to mislead than help or to put us on our guard.

In that Act in its latter form the use of names seems expressly to require the authority of the Board of Trade.

Under either Act, of course, the use of a name may so tend to mislead that the history of its use as well as possibility of it being a very common name in the country where the trade-mark is to be used must be looked at to avoid misleading.

The Weekly Notes and Law Times come to hand since this appeal was heard, contain notes of the decision of Mr. Justice Neville in *Re William Crawford & Sons* (1), where he held the application for registration should not proceed by reason of the name being a common one. He relied on the remarks of Lord Cozens Hardy M.R. in the *Teofani Case* (2).

All implied therein is very far from holding that the use of a name must be prohibited.

DUFF J.—I concur in the result.

(1) [1917] 1 Ch. 550; 116 L.T. 440.

(2) [1913] 2 Ch. 545.

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ANGLIN J.—We have not had the advantage of hearing counsel in support of the order made by the learned judge of the Exchequer Court refusing the petition of the applicants for registration of a "specific trade-mark." After giving to the consideration of the appeal the utmost possible care I am, with great respect, of the opinion that it should be allowed. The learned judge apparently misconceived the purport of the evidence adduced. Its object was and its effect is not to establish that the products of the applicants "have acquired a reputation on the market by reason of their excellence" or "by reason of the superiority of their manufacture," but to prove that the use in connection with the advertising, packing and sale of them of the word "Horlick's" has been so extensive, so conspicuous and of such duration and persistence that the word has become distinctive of those products. Having regard to the fact that the name itself is somewhat peculiar and uncommon and to the extent and nature of the user shewn, the objections usually made to the registration of the surname have not their customary force. The effect produced by the user made by the applicants of the word "Horlicks" is that it has become associated with them. It has become a name "adapted to distinguish the goods as the goods of one particular maker." The facts in evidence appear to bring this case within the recent decisions in the cases of "Cadbury" and "Muratti" (1) which seem to me more closely in point than the two authorities cited by the learned judge. Reference may also be made to the *Teofani Case* (2): "The so-called trade-mark contains the essentials of a trade-mark properly speaking." (R.S.C. ch. 71, sec. 11 (e); *Richards v. Butcher* (3).

(1) 32 Cut. P.C. pp. 9 and 77. (2) [1913] 2 Ch. 545, 567.

(3) [1891] 2 Ch. 522, 536.

I am of the opinion that upon a case such as that made in the record before us the English courts under the somewhat narrower terms of their statute would direct that an application for registration should proceed. Having regard to the broader provisions of our Act—that

all * names * * * adopted for use by any person in his trade (or) business * * for the purpose of distinguishing any manufacture, product or article * * manufactured, produced, compounded, packed, or offered for sale by him, applied in any manner whatever either to such manufacture, product or article or to any package * * box or other vessel or receptacle of any description whatever containing the same, shall for the purposes of this Act be considered and known as trade-marks.

I think we should really be doing a serious injustice to the applicants, not compensated by any advantages to the public, if we were not to allow the registration which they seek to be effected. *In re Daimler* (1).

Appeal allowed.

Solicitors for the appellant: *Murphy, Fisher & Sherwood.*

A trade-mark registered in Canada consists of an anchor in connection with the initials or full name of "John de Kuyper & Sons" to designate liquor sold by that firm. In the United States "Bostons" indicates goods sold by the Boston Rubber Shoe Co., and "Bucyrus" steel made in a town of that name.

Reporter.

(1) 33 Cut. P.C. 337.

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