

1920

Nov. 19.

IN THE MATTER OF GRAY DORT MOTORS,
LIMITED,

AND

IN THE MATTER OF A SPECIFIC TRADE-MARK CONSISTING OF A ROUND CIRCLE IN THE CENTRE OF WHICH ARE THE WORDS "GRAY DORT", THE BORDER OF THE SAID TRADE-MARK BEARING THE WORDS "OWN A" AT THE TOP, AND WORDS "YOU WILL LIKE IT," AT THE BOTTOM.

Trade-Mark—Company's name—Secondary meaning—Advertisement.

Petitioners were incorporated in October, 1915. Since then they have done a large business in motor cars, and have used a trade-mark consisting of a round circle in the centre of which are the words "Gray Dort", the border of the said Trade-Mark bearing the words "Own a" at the top, and the words "You will like it," at the bottom.

Held; That, had the petitioners used as their trade-mark the words "Gray Dort" alone, their five years user would have entitled them to have had the same registered as a trade-mark, and, in view of that, the fact of their using additional words as above mentioned, in connection therewith, should not have the effect of vitiating their right to register, and that the trade-mark as described and used should be registered. H. G. Burford & Company's trade-mark "Burford" (1919) Ch. D. 28, referred to.

PETITION of the Gray Dort Motors, Limited, praying for an order of this Court directing the registration of the words "Gray Dort" in the middle of a circle on the border of which are the words "own a" at the top, and "You will like it," at the bottom, as a trade-mark to be used in the sale of their motors.

The petition was first heard by the Honourable Sir Walter Cassels at the city of Ottawa on the 14th day of May, 1920, and enlarged sine die to allow petitioners to submit authorities. The matter was again spoken to on the 11th November, 1920.

M. G. Powell, for petitioners.

No one appearing for the Minister of Trade and Commerce.

The facts are stated in the reasons for judgment.

THE PRESIDENT OF THE COURT, now (November 19, 1920) delivered judgment.

The petitioners, Gray Dort Motors, Limited, are a Canadian corporation having their head office in the city of Chatham. They were incorporated on the 25th October, 1915. They ask for registration of a specific trade-mark consisting of a "round circle" in the centre of which are the words "Gray Dort,"—the border of the said trade-mark bearing the words "Own a" at the top, and the words "You will like it" at the bottom.

The advertisement required before the application is made states that notice is given that a petition of "Gray Dort Motors, Limited," etc., that a certain trade-mark described in said petition consisting of a circle in the centre of which are the words "Gray Dort," the border of the said trade mark bearing the words "Own a" at the top, and the words "You will like it," at the bottom, be registered.

A large number of affidavits have been filed showing that a large business has been built up, and that this specific trade-mark, including the words above the circle, have been attached to every motor sold.

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For a considerable time I had doubts whether a trade mark, such as I have described, contained the essentials of a trade mark, having regard to the fact of these words "Own a," and "You will like it," being included as part of the trade-mark.

The Privy Council, in the case of the *Standard Ideal Co. v. The Standard Manufacturing Co.*, (1) have practically stated that under the subsequent sections of the Trade-Mark Act, there must be the essentials of a trade-mark, and that our decisions followed the line of decisions in England.

In the case of *Perry Davis & Son v. Lancaster Harbord* (2), the application was made for the registration of the words "Pain Killer." It is true the cases differ to a certain extent, but on one point their Lordships agree that what was used as the trade-mark was not the words "Pain Killer" alone, but "Perry Davis' Vegetable Pain Killer." Lord Halsbury, for instance, at page 320 states as follows:

"Now, finding this difficulty in his way, the learned counsel contended that the word 'pain-killer' alone, dissociated from everything else, was what had been used. As a matter of fact I find against him on that, as each Court in turn has found against him. The evidence negatives it. It appears to me that which was registered as a trade-mark was used as a trade-mark together with the words 'Perry-Davis, and 'vegetable,' the one set of words forming, to my mind, just as much part of the trade-mark as the other."

Lord Herschell says at page 322:

"Now, how has the appellant in this case marked, identified or distinguished his goods? Not merely by putting upon them the words 'Pain Killer,' but by

(1) 1911, A.C. 78.

(2) 15 A.C. 316.

putting on them the words 'Perry Davis' Vegetable Pain Killer.' It seems to me impossible to say that he has used the words 'Pain Killer' as his trade-mark."

And Lord Macnaghten's words are to the same effect (at page 322): "It seems to me also, upon the evidence, to be perfectly clear that the appellant did not use the words 'Pain Killer' separately and alone as his trade-mark."

In this particular case on the face of the petition and by the advertisement, the words "Gray Dort" have not been used alone, but always with the words "Own a" at the top, and underneath it "You will like it." The reason I mention it is that on the argument before me, Mr. Powell contended that if the applicant be not entitled to a trade mark as prayed, that at all events they should be entitled to register the words "Gray Dort."

There is no question about it, that on the trade-mark as shown by the petition, and in the affidavits, the words "Gray Dort" form the prominent feature of the trade-mark and one which would strike the eye. Had the applicants used as their trade-mark the words "Gray Dort" alone, I think on the evidence of five years user they would have been entitled to registration.

The decision in the Court of Appeal in the case of H. G. Burford's & Company's application, (1) might be referred to. That was an application for registration of the word "Burford." In that case the trade-mark had been used for only 3½ years, but notwithstanding that, the court of appeal overruled the decision of Sargant J., who had refused to allow the registration.

(1) (1919) 2 Ch. D. 28.

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A considerable amount of stress is laid upon the fact that a large amount of capital is necessary to be expended in the construction of works to turn out automobiles, and in this respect it differs from articles of a small kind.

I have come to the conclusion that on the evidence before me the petitioners have brought themselves within the decision I have just quoted if the trade-mark was "Gray Dort" alone. After some doubt I have come to the conclusion that their trade-mark should not be vitiated by the use of the words above and below the scroll. For a considerable time I thought taking the whole trade-mark as claimed it was merely an advertisement.

I have come to the conclusion, not without doubt, that the fact that they have above the circle "Own a," and below "You will like it" should not have the effect of vitiating their right.

Also, as I have said on more than one occasion, the owner of a trade-mark cannot bring an action unless his trade-mark is registered. The registration does not make it a valid trade-mark if contested in the courts. It merely has the effect of shifting the onus.

I think that an order should go directing the registration of the trade-mark as applied for.

Judgment accordingly.