LEVER BROTHERS, LIMITED.....PLAINTIFF;

VS.

BENJAMIN L. WILSON.....DEFENDANT.

1932

Feb. 24.
March 30.

Trade-marks—Infringement—Expunging—Calculated to deceive—Person aggrieved

The plaintiff is the owner of two trade-marks, one consisting of the word "Sunlight", to be applied to the sale of soaps and other laundry goods, and the other consisting of a rectangular box-lid label bearing the word "Sunlight", with scroll devices and other designs, to be used in the sale of candles, common soaps and other laundry and toilet preparations.

The defendant is the owner of the trade-mark consisting of the word "Sunbrite" used in the sale of Javel Water in bottles, the label thereon consisting of the word "Sunbrite" and the words "Javel Water" in certain colours and set in a certain design as described in the reasons below.

1932

LEVER BROS., LTD. v. WILSON.

The plaintiff contends that the defendant's mark is calculated to deceive the public and should be expunged. The defendant denies this and by counter-claim asks that the trade-mark of plaintiff be expunged, except in so far as applied to cake soap.

Held, that the trade-mark of the defendant does not so resemble the plaintiff's trade-mark in appearance, sound, or otherwise, as to be calculated to deceive or mislead the public into purchasing the goods of the defendant believing them to be those of the plaintiff. That moreover, the plaintiff's product and that of the defendant are not of the same class, the one being a cake soap, and the other a liquid, and that the action of the plaintiff should be dismissed.

2. Held further that the grievance of the applicant to expunge must be substantial; a fanciful or sentimental grievance is not sufficient; that the defendant is not a person aggrieved within the meaning of the Trade Mark and Design Act, and that the counter-claim of the defendant to expunge the plaintiff's trade-mark cannot be maintained.

3. That the plaintiff not having incurred any additional costs as a result of the defendant's counter-claim, which was brought up by plaintiff's unfounded action, the plaintiff should pay to the defendant the costs of the action, and there should be no costs against him upon the dismissal of his counter-claim.

Note: The question as to the party on whom falls the burden of proving that a mark is calculated to deceive and the application of Rules 34 and 39 discussed.

ACTION by plaintiff herein to have trade-mark of defendant expunged and counter-claim by defendant to have plaintiff's trade-mark expunged except as applied to cake soap.

The action was tried before the Honourable Mr. Justice Angers at Toronto.

R. S. Cassels, K.C., for plaintiff.

Ericksen Brown, K.C., and *J. P. E. Brown* for defendant.

The facts material to the understanding of the case, together with the points of law raised, are stated in the Reasons for Judgment.

ANGERS J., now (March 30, 1932), delivered the following judgment.

This is an action to expunge from the Trade Mark Register No. 237 a specific trade-mark registered on the 12th day of January, 1931, by the defendant, and consisting of the word "Sunbrite," to be applied to the sale of Javel Water, a washing, bleaching and disinfecting solution composed principally of sodium hypochlorite, on the ground that the said trade-mark is so similar to the plaintiff's

1932

LEVER BROS., LTD. v. WILSON.

Angers J.

registered trade-mark "Sunlight" as to be calculated to deceive the public.

The action is brought under the provisions of section 45 of the Trade Mark and Design Act (R.S.C., 1927, ch. 201). The plaintiff is an incorporated company having its head office in the city of Toronto. The defendant carries on business at the city of Toronto under the firm name of Atlas Chemical Company.

In its statement of claim plaintiff sets out that it is the owner of two specific trade-marks, to wit:

1. A specific trade-mark consisting of the word "Sunlight" to be applied to the sale of soaps, detergents, starch, blue and other laundry goods, also fancy soaps, perfumery and other toilet preparations, the same having been registered on the 28 day of March, 1889, by Lever Brothers of Warrington, County of Lancaster, England, and subsequently assigned by Lever Brothers to Lever Brothers Limited, of Port Sunlight, Birkenhead, County of Chester, England, on the 17th day of July, 1894, and further assigned on the 12th day of December, 1899, by Lever Brothers Limited to the plaintiff, the registration of the said trade-mark having been renewed by the latter for a period of 25 years from the 28th day of March, 1914;

2. A specific trade-mark to be applied to the sale of all kinds of candles, common soap, detergents, matches, starch, blue and other preparations for laundry purposes, also perfumed soap, perfumery and other toilet preparations, consisting of a rectangular box-lid label bearing, essentially, the word "Sunlight" together with scroll devices, floral spray and the representation of a maid carrying a masket of clothes in her right hand and holding in her left a prop supporting a clothes line on which an article of clothing is suspended, the same having been registered on the 30th day of August, 1894, by Lever Brothers Limited, of Port Sunlight, England, and subsequently assigned by Lever Brothers Limited to the plaintiff on the 12th day of December, 1899, the registration of the said trade-mark having been renewed by the plaintiff for a period of 25 years from the 30th day of August, 1919.

The defendant's trade-mark, to be applied as aforesaid to the sale of Javel Water, is described as consisting of

a rectangle on a yellow background outlined in dark blue; immediately at the top thereof is inscribed in big blue block letters the word: "Sunbrite"; below this in smaller similar letters appear the words: "Javel Water"; stretching horizontally from side to side there is a blue clothes line, with a white washing attached thereto, swaying as with a breeze; below this in the left hand corner is portrayed a house, with predominating blue colouring, save for its front windows and chimney and smoke emanating therefrom, which are shown in a yellowish white tinge; the house is fringed in the background by a dark blue shadow in the solid formation of foliage and trees; the house stands within a valley at the base of two hills which slope from either side of the rectangle towards its centre; the hills, which rise from the lower side of the rectangle are coloured with a blue-yellow check; in front of the house, and in the valley directly at the base of the two hills there is depicted the picture of a young woman outlined in blue, with white dress and white flowing apron;

1932

LEVER BROS., LTD. v. WILSON.

Angers J.

in outstretched arms, she is carrying a blue clothes basket, heaped with white contents; immediately to her right, creeping from behind the valley, there is described an arc outlined in blue, in the formation of the sun; radiating upwards from this arc and spreading across the top of the rectangle are clearly seen white fine rays of the sun; these dilate, become heavier as they ascend and finally burst into a mass of white, which forms a background for the above-mentioned firstly described word: "Sunbrite"; at the head of the rectangle.

In his statement in defence, the defendant avers that he commenced the manufacture and sale of Javel Water under the label and get-up now used by him in February, 1925, and that he has since continued the manufacture and sale of this article in Canada; that no objection was taken by plaintiff until May, 1929, following which date there ensued correspondence between the plaintiff and the defandant and their solicitors; that no action was taken by plaintiff for infringement or otherwise, although defendant categorically stated that he would not discontinue the use of his label "Sunbrite"; that defendant applied for and obtained his trade-mark under date of the 12th January, 1931, covering the label adopted by him in February, 1925.

The defendant denies the plaintiff's right of action on the grounds:

(*a*) that the defendant's trade-mark is not calculated to deceive the public and is not so similar to the plaintiff's trade-mark as to be objectionable;

(*b*) that the plaintiff, by neglecting to assert its rights before the civil courts and allowing the defendant to carry on business, was guilty of laches and is not entitled to the relief claimed.

The defendant alleges specifically that Javel Water is not soap and that no words in the plaintiff's trade-marks include the article sold by defendant.

In addition to praying for the dismissal of the action, the defendant asks that the plaintiff's trade-marks be cancelled and expunged, except in connection with cake soap. In support of his so-called counter-claim, the defendant submits:

(*a*) that the plaintiff has not manufactured nor sold in Canada any of the articles mentioned in its trade-marks, save only soap in the form of a cake;

(*b*) that the plaintiff is not entitled to retain the exclusive right to the word "Sunlight" except in connection with cake soap;

1932

LEVER BROS., LTD. v. WILSON.

Angers J.

(c) that it is in the interests of the public and of the defendant that so much of the plaintiff's trade-marks as are expressed to be applicable to any articles other than cake soap should be expunged from the trade-mark register.

The evidence discloses the following facts.

Lever Brothers (the partnership) commenced to sell "Sunlight" soap in Canada in 1889. The Canadian Company, i.e., the plaintiff, was incorporated in 1899. From that date it has continuously sold "Sunlight" soap in Canada. "Sunlight" soap is a yellow laundry bar soap and is sold in three different packages (exhibits A, B and 7). Several thousand tons are sold every year all over Canada. Approximately sixty per cent is sold in the form of exhibit A, fifteen per cent in the form of exhibit B (sold only in Toronto and Halifax) and twenty-five per cent in the form of exhibit 7 (a carton containing four bars sold exclusively in the West, i.e., Manitoba and Saskatchewan).

I may note here that only the label on the carton filed as exhibit 7 contains all the data of plaintiff's second trade-mark (exhibit No. 3). The labels on the cartons filed as exhibits A and B do not contain the representation of the "maid carrying a basket of clothes in her right hand and holding in her left a prop supporting a clothes line on which an article of clothing is suspended."

Soap is sold largely in grocery stores, in some drug stores, in departmental stores and in chain stores; seventy to eighty per cent is sold in grocery stores or grocery departments of departmental stores.

Millar, Secretary and Director of the plaintiff company, says he bought a bottle of "Sunbrite" Javel Water in an A. & P. shop, which is a grocery store, and another bottle in a Stop & Shop store (presumably also a grocery store). In both places, "Sunbrite" Javel Water was displayed within a shelf or two of the soap department.

The witness goes on to say that the word "Sunlight" is not applied by the plaintiff to any product other than soap, at least in Canada; the plaintiff is not producing and has never produced any Javel Water in Canada; witness cannot tell if plaintiff ever produced Javel Water elsewhere; plaintiff puts out and sells other products, including Rinso

1932

LEVER BROS., LTD. v. WILSON.

Angers J.

(a soap powder), Life Buoy soap (a fancy soap), Lux in the form of toilet soap and flakes and Panshine (a cleanser).

Plaintiff first found out that the defendant was putting out "Sunbrite" Javel Water some three or four years ago. There was some correspondence at that time between plaintiff and defendant. In May, 1929, the plaintiff objected to the sale of Javel Water under the name "Sunbrite" and the defendant refused to discontinue selling his product. No proceedings were taken by the plaintiff against the defendant apart from the action now pending.

Millar admits that his company did not lose any business by reason of the defendant selling his "Sunbrite" Javel Water; he adds that he cannot say what the future may bring forth, which is a wise and prudent statement. Another point in Millar's deposition which is of some interest is that a soap always contains fat of some description, that with water it will emulsify the oil that may be found in the fabric and remove it, that it is not a bleach, that, on the other hand, Javel Water contains no fat and has a breaching effect.

Examined on his own behalf, the defendant states that Javel Water is used for cleaning crockery, sinks, drain boards, enamelled ware, wash basins, wooden utensils, drain pipes, garbage cans and other articles, for washing hardwood floors and destroying odours; it is a disinfectant. Javel Water is composed of ninety-seven and a half per cent of water and two and a half per cent of sodium chloride. It is essentially a bleach. Javel Water has been on the market for a very long time. The defendant has been selling his Javel Water with the "Sunbrite" label since 1925; for two years previous he had sold it under the name of "Chloro."

There is no question of infringement nor of passing-off in the present case. The question arising is whether the trade-mark of the defendant is identical with the trade-marks of plaintiff or so resembles them that it may be considered as calculated to deceive or mislead the public. If the answer is in the affirmative, the defendant's trade-mark must be expunged from the register; if in the negative, the action must be dismissed. In the latter alternative, there will remain for the Court to pass on the defendant's

counter-claim to have the plaintiff's trade-marks expunged, except in connection with cake soap.

There is really no dispute as to the material facts and the summary I have made of the pleadings and of the evidence will dispense me with having to deal with them any further.

Counsel for plaintiff first submitted that the *onus* is on the defendant to establish that there is no likelihood of confusion arising. Assuming that the plaintiff's contention is well founded, though expressing no opinion on this point which I deem unnecessary, I am still faced with the duty of weighing the evidence laid before me, both literal and verbal, on its merits. I may note however that the cases cited by counsel for plaintiff in respect of onus are cases in which the trade-mark had not yet been issued and in which, according to defendant's counsel's statement, discretion was still open (*Melchers & DeKuyper* (1); In the matter of *McDowell's Application for a Trade-Mark* (2); *Eno & Dunn* (3)). Has the registration of a trade-mark the effect of shifting the onus, as submitted by counsel for defendant? It is quite possible I am inclined to think so; but again I may repeat that I see no necessity to express an opinion on this point.

The second proposition which counsel for plaintiff submitted to the Court is that the trade-mark of the defendant so resembles its own that it is calculated to deceive or mislead the public. That is the only point in the case, at least as far as plaintiff's action is concerned.

Article 11 of the Act says:

> 11. The Minister may refuse to register any trade-mark. . . .
>
> (*a*) . . . .
>
> (*b*) if the trade-mark . . . is identical with or resembles a trade-mark . . . already registered;
>
> (*c*) if it appears that the trade-mark . . . is calculated to deceive or mislead the public.

It is quite obvious that the trade-marks of the parties herein are not identical. The plaintiff, in fact, does not invoke identity, but, in his statement of claim, he merely alleges that " the name ' Sunbrite ' is so similar to the plaintiff's registered trade-mark ' Sunlight ' as to be calculated to deceive the public."

(1) (1898) 6 Ex. C.R., 82. (2) (1927) 44 R.P.C., 335.
(3) (1890) L.R., 15 A.C., 252.

1932

LEVER BROS., LTD. v. WILSON.

Angers J.

It is argued on behalf of the plaintiff that there is similarity both in appearance and in sound and that this similarity is sufficient to deceive or mislead the public. Counsel for plaintiff, at the hearing, did not pretend that there was any likelihood of deception as to the article itself—it is difficult indeed to conceive that a customer wanting to buy a cake of soap would go away satisfied if handed a bottle of Javel Water—but he submitted that there might be confusion as to the origin of the product. The witness Millar, heard on behalf of the plaintiff, adopted the same view. I must say that I cannot agree with this contention. It seems to me that a glance at the two labels will suffice to convince anyone that there is no likelihood, not to say possibility, of confusion. The whole get-up is different: the nature of the goods, the colour of the labels, their appearance, the lettering, the subject matter and its disposition vary. The only point of similitude in the trade-marks consists of the word "Sun" which in both cases constitutes the first syllable of the two names. One cannot claim the ownership of a common word of the English language and monopolize it. There remain the suffixes which added to the word "Sun" differentiate the marks. The suffixes "light" and "brite" are not similar in appearance, although they may sound somewhat alike, particularly when carelessly pronounced. The similarity however is not such as to create confusion, especially in a case where the general appearance of the articles differs widely.

Distinctiveness, of course, is of the essence of a trade-mark, the object whereof is to distinguish the goods of a trader from those of other traders, but I fail to see, after a careful examination of the labels, how a purchaser, however incautious and unwary he may be, can be led to believe that the soap of the plaintiff and the Javel Water of the defendant are the products of the same manufacturer.

Apart from the other dissimilarities already alluded to, I may note that plaintiff's label bears the name "Lever Brothers Limited" and that there appears on defendant's label the following indication: "Manufactured by Atlas Chemical Company, Toronto, Ont., Canada." It has been held that little importance may be attributed to matter printed on the back or the sides of a container. I do not think however that it ought to be entirely disregarded.

1932

LEVER BROS., LTD. v. WILSON.

Angers J.

The above mentioned inscription on the defendant's label, although not forming part of the trade-mark proper, is printed on the right side of the label itself—not on a separate label, as is sometimes the case—and it indicates clearly the origin of the article. I may state, although it is not essential in an action of this kind to establish the intention to deceive, that it is clearly manifest that the defendant never entertained such an intention.

Summing up, I may repeat that, in my opinion the trade-mark of the defendant does not so resemble the plaintiff's trade-mark in appearance, sound or otherwise, as to be calculated to deceive or mislead the public. On this ground alone the action must fail.

I may add as a further reason for the dismissal of the action that I do not consider that the product of the plaintiff and that of the defendant are of the same class, if perhaps they are in the same line of business. One is a cake soap; the other a liquid. The first is a cleanser; the second a bleach. True it is that to some extent Javel Water may be used for laundry purposes, as defendant's product almost exclusively is, but, this is not sufficient to bring plaintiff's soap and defendant's Javel Water into one and the same class.

In view of the reasons hereinabove set forth, for which I consider that the action cannot be maintained, I deem it unnecessary to deal with the question of laches on the part of plaintiff raised by the defendant and allegedly resulting from the plaintiff's neglect to object to the use by defendant of his mark during a period of over four years.

I will now proceed to examine the defendant's demand, contained in his statement of defence, that the plaintiff's trade-marks be cancelled and expunged from the register, save and except in connection with and limited to the cake soap manufactured and sold by plaintiff under the name of "Sunlight Soap."

I shall first consider the question of procedure. Counsel for plaintiff submits that the defendant should have proceeded by way of statement of claim under Rule 34 and that an application to expunge can only be made by way of defence in an action for infringement; counsel for plaintiff relies on Rule 39. In the Matter of the Petition of *The C.*

1931

LEVER BROS., LTD. v. WILSON.

Angers J.

Turnbull Co. Limited for an order permitting it to register certain trade-marks (1) a petition was presented asking for an order to be allowed to register certain trade-marks and in the petition was added a demand to expunge other trade-marks alleged to stand in the way of the petitioner; a motion was presented on behalf of the party whose trade-marks were sought to be expunged praying for the dismissal of the aforesaid petition in so far as the demand to expunge was concerned. The Honourable Mr. Justice Audette, availing himself of Rules 299 and 300, dismissed the motion and gave leave to the petitioner to join in his petition to register its trade-marks a demand to expunge. I find in the learned Judge's reasons for judgment the following:

> There is no doubt rule 34 should be so amended as to allow the two questions to be tried together; because if I were to make an order to-day allowing the application it would result in the petitioner having to take a petition for registration and another action, by statement of claim to expunge; that would set up a multiplicity of actions which is against the very spirit of modern law.

The case now under advisement is somewhat different, inasmuch as the demand to expunge is contained in the defence. The only Rules applicable are Rules 34 and 39. The latter does not extend to actions to expunge. I would hesitate to dismiss the defendant's demand to expunge on a mere question of procedure; I quite agree with the Honourable Mr. Justice Audette that the multiplicity of actions should be avoided and are against the spirit of modern law. On the other hand, I would feel myself bound by the text of Rules 34 and 39.

I will not rest my decision on this point however. I have reached the conclusion that the defendant's demand to expunge cannot be maintained for the reason that the defendant is not a person aggrieved in the eyes of the law. I cannot see how the defendant is liable to suffer damage if plaintiff's mark remains on the register as it now stands.

The grievance of the applicant to expunge must be substantial; a fanciful or a mere sentimental grievance is not sufficient: In re *Wright, Crossley & Co.'s trade-mark* (2); In re *Ellis & Co.'s trade-mark* (3).

Had I come to the conclusion that the defendant was aggrieved by the registration of plaintiff's trade-marks, I

(1) (1932) Ex. C.R. 6. (2) (1898) 15 R.P.C. 131.
(3) (1904) 21 R.P.C. 617.

1932

LEVER BROS., LTD. v. WILSON.

Angers J.

would have hesitated in granting his demand to have them expunged from the register on the ground that there had been abandonment on the part of plaintiff of his trade-marks save and except in connection with cake soap.

Mere disuse of a trade-mark does not amount to abandonment. The intention to abandon has to be clearly established. Such intent may derive from the circumstances of the case. I do not think that the proof nor the circumstances in the present case warrant the expunging of plaintiff's trade-marks. See *Madame Irene* v. *Schweinburg* (1); *Western Clock Coy.* v. *Oris Watch Co. Ltd.* (2).

There will be judgment dismissing plaintiff's action, with costs in favour of the defendant.

There will also be judgment dismissing defendant's demand to expunge, but without costs. Under Section 45 of the Trade Mark and Design Act, the question of costs is left to the discretion of the Court. Plaintiff has not incurred any additional costs as a result of defendant's demand, which was brought about by plaintiff's unfounded action, and I think that in equity the defendant ought not to be called upon to pay costs.

Judgment accordingly.