

BETWEEN:

GRANVILLE S. DECATUR.....PETITIONER;

AND

FLEXIBLE SHAFT COMPANY LIM- } RESPONDENT.
ITED

1930
Jan. 14.
Jan. 28.

Trade-marks—Numerals—Expunging—Distinctiveness

Held, that the registered trade-marks "No. 360," "No. 361," "No. 90" and "No. 99," applied to the upper and lower blades of an animal clipping machine, and not in its original use intended as a trade-mark, and being without distinctiveness, are not properly trade-marks within the meaning of the Trade-Mark and Designs Act and should be expunged.

- 2. That there can be no distinctiveness, as a rule, in a numeral or numerals alone, although conceivably they might be so arranged, selected or used, that they would lose, partially at least, the characteristic of numerals, and acquire a distinctiveness qualifying them for registration as trade-marks.

PETITION by the Petitioner herein to have certain trade-marks referred to hereafter expunged.

The action was tried before the Honourable Mr. Justice Maclean, President of the Court, at Ottawa.

Eugene Lafleur, K.C., and *R. S. Smart, K.C.*, for petitioner.

Peter White, K.C., and *E. Bristol, K.C.*, for respondent.

The facts are stated in the Reasons for Judgment.

THE PRESIDENT, now (January 28, 1930), delivered judgment.

The petitioner asks that the trade-marks "No. 360," "No. 361," "No. 90," and "No. 99," registered in 1927 by the respondent company, Flexible Shaft Company Ltd., be expunged.

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The marks in question were registered in connection with with the sale of clipper plates (or blades) for use in animal clipping machines, manufactured or assembled by the respondent, in Canada, since 1920. The first two of the above mentioned marks are respectively applied to the upper and lower plates used in the most recent model of animal clipping machines produced by the respondent; the last two mentioned marks are respectively applied to the upper and lower plates of an earlier model of the same machines. These marks are stamped upon the plates as just stated, together with the full name of the respondent company in some instances, but with merely its initials in other instances. The plates bearing the first two mentioned marks, are sold to the public in small green and yellow tin boxes; plates bearing the other two marks are sold both in red and black tin boxes. The boxes all prominently designate their contents as either "Stewart Clipper Plate"; "Stewart Top Plate" or "Stewart Bottom Plate." The number of the plate also appears upon the box. Printed words upon the exterior of the boxes includes the following: "None genuine without our registered trade-mark Stewart on the box," "Always order this plate by its number"; and "Look for our name and number on every plate". It was not shown at the trial whether or not the word "Stewart" was a registered trade-mark. The name "Stewart", seems to be applied and used both in respect of the complete clipping machines, and the plates or blades separately. It does not appear that numeral marks of any kind are applied to the various parts of the complete clipping machine, other than the plates; but certain parts which are castings, have a pattern number, but that is not registered.

The respondent manufactures or assembles, and sells, several types of animal clipping and shearing machines. In a printed catalogue or price list, issued by the respondent for the season 1924 and 1925, and produced in evidence, the clipping and shearing machines are all referred to by the name of "Stewart," but with other descriptive matter, such as numbers, to designate the particular machine. In this catalogue the various parts of the clipping machines, and all other goods sold by the respondent, are designated by numbers; the exact marks here in question, and used

upon the several clipper plates as already explained. are also to be found in the catalogue indicating such clipper plates by the same numerals. The plates of the new model are referred to in the catalogue as "Stewart New Process Clipping Plates"; the catalogue also states: "Please specify our clipping plate numbers when ordering." The catalogue numbers are of course employed to facilitate or simplify the ordering of clipping machines or their parts, by customers, or users of the petitioners' clipping machines.

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The real point in controversy is, whether the registered marks which the petitioner seeks to expunge, were properly registered in 1927, as trade-marks. The Trade-Marks Act gives no definition of a trade-mark other than is to be found in sec. 5 which enacts:—

All marks, names, labels, brands, packages or other business devices which are adopted for use by any person in his trade . . . for the purpose of distinguishing any manufacture, product . . . manufactured, produced . . . or offered for sale by him, applied in any manner whatever either to such manufacture, product . . . shall, for the purposes of this Act be considered and known as trade-marks.

Sec. 11 (e) empowers the Minister to refuse to register a trade-mark "if the so called trade-mark does not contain the essentials necessary to constitute a trade-mark, properly speaking." A reference to further provisions of the Trade-Mark Act, would not be helpful.

In view of all the facts I have already stated, it seems to me, that the marks registered by the respondent are not properly speaking trade-marks; they were not originally adopted as trade-marks, nor were they so used at the time of registration, and I am not satisfied they are so being used to-day. The clipper plates are sold to the public generally as "Stewart Clipper Plates," and really that is the trade-name of the goods; in my opinion, that is the only way that the goods are distinguished as those of the respondent. Had the name or mark "Stewart" been registered in some form or other, in combination with a numeral or numerals, that might possibly have constituted proper subject matter for a registered trade-mark. There can be no distinctiveness, as a rule, in a numeral or numerals alone, although it is conceivable that numerals might be so arranged, selected or used, that they would lose, partially at least, the characteristic of numbers and acquire a distinctiveness qualifying them for registration as a trade-

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mark. Here, the numerals are used in the plain and ordinary way and without any suggestion of distinctiveness in any form; everything suggests and establishes that the marks were not adopted and used as trade-marks prior to the time of registration, nor do I believe they are so now looked upon by the public. They were used merely to number parts, as a trade convenience, a practice common to many manufacturers. Merely to number parts of a manufacture is not, in my opinion, the same as adopting a mark as a trade-mark to distinguish a manufacture or product. The prefix "No." to the numerals is in itself, I think, fatal to the respondent, because it indicates that they were adopted merely as a number and not as a trade-mark; the purpose is evident. The marks in issue were used by the respondent for seven years in Canada before the same were registered as trade-marks. It is a fair and safe deduction from the evidence that the marks were used during this period, not as trade-marks, but merely as numbers designating parts of complete clipper machines, so as to facilitate replacement orders of such parts. If that is so, then such marks were improperly registered as trade-marks, and this for the reason that when they were so registered they had not been adopted or used as trade-marks by the respondent.

I am impressed with the reasoning found in the American case, *Deering Harvester Co. v. Whitman & Barnes Mfg. Co.* (1), referred to by counsel for the petitioner. This was not an action for infringement of a statutory trade-mark. It was held in this case—the fact being much the same as here—that in machines such as reapers and mowers, which have many detachable parts, subject to be worn out or broken, the stamping or casting of letters and figures thereon, merely for the purpose of distinguishing them from each other, so that the user of the machine may more readily order them by letter or telegram for purposes of replacement or repair, creates no trade-mark rights in such letters or figures; nor is it sufficient to justify their appropriation as trade-marks that they are found only in association with the machines of the particular manufacturer.

From the reasons for judgment of the Court, delivered by Lurton J., the following might be usefully quoted:—

The claim that, inasmuch as these marks are found only in "association" with machines which do bear the trade name or mark or both,

of the Deering Harvester Company, they thereby serve to indicate that company as the common source of all articles having a like designation, is not sufficient to justify their appropriation as trade-marks. Any office which these marks perform as designations of origin is purely accidental. The fact that no two distinct parts in the same machine bear the same numerals is altogether persuasive of the fact that their purpose is not that of indicating the producer. Without explanation, such a multitude of different marks would convey no meaning. When explained, as they always have been and always must be, the explanation is that they are intended to designate size, shape, and place in the machine, and are to be used to distinguish one piece or part from another having a different function. This purpose does not tend, in any but the most remote way, to indicate the producer or maker. If each of such parts had some common symbol, in addition to the varying marks indicating place and size and shape, we would have marks capable of the double duty claimed for those actually used. The system of so defining the place, size, and shape of a part of a machine is not original with appellants. It is common to many other manufacturers. The purpose is to facilitate replacements. If they may also be appropriated as trade-marks, it will operate to practically monopolize all repairs and replacements by the original maker of the machines. The question is, therefore, one of wide general interest. If complainant's contention is well founded, it will injure the public, by stifling competition in the manufacture and sale of such repairs and replacements by confining their production to the original producer. The necessity for a common designation for such parts of such machines, by whomsoever the part is made, is most apparent, upon the showing made by the appellant.

Fitzpatrick, an officer of the respondent corporation, stated in evidence that the numerals were registered because they had come to be trade-marks by long user. This I construe as an admission that the marks were originally adopted and used for a purpose other than trade-marks. I do not comprehend, on the facts of this case, how they could become trade-marks by user, if that user had been for another purpose. The marks are now just what they were, say in 1921; they cannot now mean more or less than they did then; their registration did not change their real significance and purpose and the public could not attach to them any different meaning than they did prior to registration. If they were not trade-marks in 1921, they did not become trade-marks in 1927, merely by registration. The marks were really intended to express the quality, size and shape, of parts of a particular clipping machine made by the respondent; this does not, in my opinion, constitute "a trade-mark, properly speaking" and they were not, I think, entitled to registration.

There are practical difficulties in the way of recognizing bare and non-distinctive numerals as trade-marks. A de-

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fendant could always find fairly reasonable excuses for using the same numerals; it is difficult to give to mere numerals the effect of indicating origin or proprietorship; and, just as in this case, it is frequently difficult to establish that the numeral mark was originally designed as a trade-mark. Furthermore, it is difficult to impress the public with the idea that a numeral or numerals applied to any article can be, or was intended to be, a trade-mark.

The English case of *Ardath Tobacco Company Ltd. v. W. Sandorides Ltd.* (1) was cited on behalf of the respondent. There the plaintiff was suing to restrain the infringement of its registered trade-mark "999" by the use of "99" and the words "double nine," and it had several other triple numbers registered; it was suggested that the idea of the plaintiff's mark was the repetition of a digit, but it was held that the idea or distinctiveness of the mark was at the most triplication, and that there was no infringement, and a claim for passing off also failed. The question of the validity of the plaintiff's registration apparently was not in issue, there being no claim, so far as can be gathered from the reported case, for the rectification of the register. It must be borne in mind however, that under the provisions of the present English Trade-Marks Act, a numeral is registerable if it is distinctive, and upon evidence of its distinctiveness. In the case just referred to, something is to be said for the idea that the mark "999" was distinctive, but I should seriously doubt if the respondent's marks here in issue, would be held to be distinctive and registerable even under the provisions of the English Act. Sebastian in his work on Trade-Marks, Fifth Ed. (1911), p. 93, says: "There does not, however, appear to be any case in which the English courts have recognized a mere numeral or combination of numerals, standing alone, as sufficiently special and distinctive to constitute a trade-mark." That statement appeared before the "999" Case arose, but it is not necessarily inconsistent with the fact of the registration of "999," because if "999" is properly on the register, it could only be there because it was shown to possess distinctiveness.

It would appear that in the United States the use of a mere numeral or numerals as a registered trade-mark is per-

(1) (1924) 42 R.P.C. 50.

haps not definitely settled by the courts; the reported cases in this connection generally relate to unfair competition. There is however, considerable judicial authority in the United States in support of the view that bare numerals should not be registered as trade-marks.

I am of the opinion therefore, that the registered marks in question are not properly speaking trade-marks within the contemplation of the Trade-Marks Act, and were not such at the time of registration; they were therefore registered without sufficient cause and should be expunged. The costs of action will follow the event.

Judgment accordingly.

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