

BETWEEN :

GENERAL MOTORS CORPORATION... APPLICANT,

1947

AND

June 18 & 19

NORMAN WILLIAM BELLOWS..... RESPONDENT;

1948

Jan. 22

AND BETWEEN :

NORMAN WILLIAM BELLOWS..... APPLICANT,

AND

GENERAL MOTORS CORPORATION.. RESPONDENT.

(No. 2)

Trade Mark—The Trade Mark and Design Act, R.S.C. 1927, c. 201—The Unfair Competition Act, 1932, 22-23 Geo. V., c. 38, ss. 52 (1) 29, 26 (1) (c), 23 (1)—Exchequer Court Rule 35—"Frigidaire"—Motion to expunge—Mark lacking distinctiveness—Acquisition of a secondary meaning subsequent to registration does not give validity to an invalid registration—Prior registration no bar to application under s. 29 of Unfair Competition Act.

Held: That the word "Frigidaire" is not *per se* a distinctive word and at the time of registration was merely a descriptive word lacking that distinctiveness which is necessary to constitute a trade mark properly speaking and should not have been registered under the general provisions of the Trade Mark and Design Act, R.S.C. 1927, c. 201, s. 11.

2. That the acquisition of a secondary meaning subsequent to registration cannot give validity to a registration which is invalid when it was made. *J. H. Munro Limited v. Neaman Fur Company Limited* (1947) Ex. C.R. 1.

3. That previous registration of a mark does not constitute a bar to an application under s. 29 (1) of The Unfair Competition Act which gives the Court jurisdiction to make the declaration therein mentioned in any action or proceeding.

1947
 GENERAL
 MOTORS
 CORPORATION
 v.
 BELLOWS
 CAMERON J.

4. That Rule 35 of the General Rules and Orders of the Exchequer Court requiring advertising in the Canada Gazette of notice of filing petitions for registration refers only to proceedings for registration by way of petition.
5. That the word "Frozenaire" has acquired a secondary and distinctive meaning and is entitled to the declaration provided for in s. 29 (1) of the Unfair Competition Act.

MOTION by Norman William Bellows for an order expunging the trade mark "Frigidaire" from Register of Trade Marks and MOTION by General Motors Corporation for a declaration under s. 29 of the Unfair Competition Act.

The motions were heard before the Honourable Mr. Justice Cameron at Ottawa.

Christopher Robinson for General Motors Corporation;

Dr. Harold S. Fox, K.C. and *Gordon Henderson* for Norman William Bellows.

The facts and questions of law raised are stated in the reasons for judgment.

CAMERON J. now (January 22, 1948) delivered the following judgment:

In these consolidated proceedings General Motors Corporation, the owner of the word mark "FRIGIDAIRE," moved to expunge the registration of the word mark "FROZENAIRE," registered by Norman William Bellows, on the ground that the two marks were confusingly similar. On August 20, 1947, I gave judgment dismissing that motion. At the request of counsel for both parties, I adjourned *sine die* the cross motion to expunge the trade mark "FRIGIDAIRE," registered by General Motors Corporation. An appeal has now been taken by General Motors Corporation from the judgment of August 30, 1947, (1) and at the request of counsel I shall now deal with the cross motion.

The Frigidaire Corporation applied for registration of the word "FRIGIDAIRE" in Canada under The Trade Mark and Design Act on September 18, 1929, as a specific trade mark to be applied to the sale of refrigeration apparatus. It had continuously used the word since September 21, 1918. The application was granted on January 24, 1933.

Under date of November 30, 1936, Frigidaire Corporation assigned all its interests in the trade mark registered in Canada to General Motors Corporation.

1947
 GENERAL
 MOTORS
 CORPORATION
 v.
 BELLOWES
 Cameron J.

General Motors Corporation will hereinafter, in this motion, be referred to as the respondent and Norman William Bellows as the applicant. The latter is the owner of the trade mark "FROZENAIRE," registered in Canada on April 23, 1940, for use on electric refrigerators and refrigeration.

The application to expunge the registration of the trade mark "FRIGIDAIRE" is made under section 52 (1) of the Unfair Competition Act, 1932, which is as follows:

52. (1) The Exchequer Court of Canada shall have jurisdiction, on the application of the Registrar or of any person interested, to order that any entry in the register be struck out or amended on the ground that at the date of such application the entry as it appears on the register does not accurately express or define the existing rights of the person appearing to be the registered owner of the mark.

The registration of the trade mark "FRIGIDAIRE" is attacked on two grounds: (1) the trade mark "FRIGIDAIRE" is, and always has been, clearly descriptive of the character or quality of the wares in association with which the trade mark has been used and registered; (2) the trade mark "FRIGIDAIRE" is not a symbol adapted to distinguish wares.

Briefly, it is alleged that the word "FRIGIDAIRE" is descriptive of the wares in connection with which it is used, that it lacks distinctiveness and therefore should not have been registered. For the respondent two submissions are advanced: (1) that the word "FRIGIDAIRE" *per se* was distinctive at the time of its registration; and (2) alternatively, if it were not then distinctive as of the date of the motion to expunge, it had since acquired a secondary and distinctive meaning and the respondent was therefore entitled to retain its registration. If the first submission is valid, the second one needs no consideration.

The first question is not whether at the time of its registration the word "FRIGIDAIRE" came within the prohibition of section 26 (1) (c) of the Unfair Competition Act, 1932; but whether it then had the distinctiveness that under the Trade Mark and Design Act was "one of the essentials necessary to constitute a trade mark properly speaking". (Section 11 (e)). By section 23 (1) of the

1947
 GENERAL
 MOTORS
 CORPORATION
 v.
 BELLOWS
 CAMERON J.

Unfair Competition Act it is provided that a registration properly made under the Trade Mark and Design Act shall not be subject to be expunged or amended only because it might not properly have been registered under the Unfair Competition Act.

The Trade Mark and Design Act does not define what are "the essentials necessary to constitute a trade mark properly speaking", but it was settled by the Judicial Committee of the Privy Council in *Standard Ideal Company v. Standard Sanitary Manufacturing Company* (1) that "distinctiveness is the very essence of a trade mark". Lord MacNaghten, in delivering the judgment of the Privy Council, said at p. 84 of the word "Standard" which had been registered as a trade mark under the Trade Mark and Design Act, 1879:

Now the word "standard" is a common English word. It seems to be used not unfrequently by manufacturers and merchants in connection with the goods they put upon the market. So used it has no very precise or definite meaning. But obviously it is intended to convey the notion that the goods in connection with which it is used are of high class or superior quality or acknowledged merit. Without attempting to define "the essentials necessary to constitute a trade mark properly speaking" it seems to their Lordships perfectly clear that a common English word having reference to the character and quality of the goods in connection with which it is used and having no reference to anything else cannot be an apt or appropriate instrument for distinguishing the goods of one trader from those of another. Distinctiveness is the very essence of a trade mark. The plaintiff company was therefore not entitled to register the word "standard" as a trade mark. The result is, in accordance with the decision of the Supreme Court in *Partlo v. Todd* (17 Can. S.C.R. 196), that the word though registered is not a valid trade mark. The action so far as it is based on alleged infringement of trade mark must fail.

It is to be noted that "FRIGIDAIRE" was registered in Canada under the general provisions of the Trade Mark and Design Act. It was not registered under the special provisions of Rule X under that Act, which read as follows:

A Trade Mark consisting either of a surname, a geographical name or adjective, or a word having a direct reference to the character or quality of the goods in connection with which it is used, may be registered as a Specific Trade Mark upon the filing of the prescribed application and payment of the prescribed fee, and upon furnishing the Commissioner with satisfactory evidence, either by statutory declaration or by affidavit, that the mark in question has, through long continued and extensive use thereof in Canada acquired a secondary meaning, and become adapted to distinguish the goods of the applicant.

"FRIGIDAIRE" is the combination of two words—"frigid" and "aire". "Frigid" is an ordinary English word

that has been in common use for a great many years to denote cool or cooled. "Air" (or "aire", which is merely an old form of "air") has also been in everyday use in the English language for a very long time. It is suggested by the respondent that "FRIGIDAIRE" is an invented word. As pointed out by Astbury J. in the application by *Yalding Manufacturing Company Ltd.* (1), it is frequently a difficult matter to determine whether or not a word is an invented word, as it is a matter on which different minds may reach different conclusions. He pointed out that there were several well-decided matters to which regard must be had in questions of this sort. At p. 289 he said:

In the first place, it is made quite clear in the *Solio Case* in the House of Lords that, if a word is an invented word within the meaning of the Act, it is none the less registrable because it may have reference to the character or quality of the goods to which it is proposed to be applied. The second rule, to which I wish to refer, is that the mere fact that a new word, or a word which has not been included in the dictionaries, is produced is not sufficient to make it an invented word within the meaning of the Statute. Lord Halsbury said in the *Solio Case*:—"I can quite understand suggesting other words—compound words or foreign words—as to which it would be impossible to say that they were invented words, although, perhaps, never seen before, or that they did not indicate the character or quality of the goods, although as words of the English tongue they had never been seen before. Suppose a person were to attempt to register as a single English word "Cheapandgood," or even, without taking so gross an example, using a word so slightly differing from an ordinary and recognized word as to be neither an invented word nor, avoiding the prohibited choice of a word, indicating character or quality. Lord Herschell said:—"I do not think the combination of two English words is an invented word, even although the combination may not have been in use before, nor do I think that a mere variation of the orthography or termination of a word would be sufficient to constitute an invented word, if to the eye or ear the same idea would be conveyed as by the word in its ordinary form." Lord Macnaghten said:—"The word must be really an invented word; nothing short of invention will do. On the other hand, nothing more seems to be required. If it is an invented word—if it is "new and freshly coined" (to adapt an old and familiar quotation), it seems to me that it is no objection that it may be traced to a foreign source, or that it may contain a covert and skilful allusion to the character or quality of the goods." And Lord Shand said:—"There must be invention, and not the appearance of invention only. It is not possible to define the extent of invention required, but the words I think should be clearly and substantially different from any word in ordinary and common use. The employment of a word in such use, with a diminutive or a short and meaningless syllable added to it, or a mere combination of two known words, would not be an "invented" word; and a word would not be "invented" which, with some trifling addition or very

1947
GENERAL
MOTORS
CORPORATION
v.
BELLOWS
Cameron J.

1947
 GENERAL
 MOTORS
 CORPORATION
 v.
 BELLOWS
 Cameron J.

trifling variation, still leaves the word one which is well known or in ordinary use, and which would be quite understood as intended to convey the meaning of such a word.

Those passages show clearly that the mere fact that a word is previously unknown, or that it has not got into any technical Dictionary, is not sufficient to make it an invented word within the meaning of the Act.

Reference may also be made to *Farbenfabriken Vormals Fried. Bayer and Co.'s Application* (1) where, in the Court of Appeal, Smith L.J. said at p. 92:

Suppose a trader to go to a dictionary, and to find a word wholly unused, and to propose to register the word, would that be an invented word within the section? I say it would not, because the word so found would not be a word coined for the first time; and it therefore might be capable of having reference to the character or quality of goods. Suppose the trader therein to find two words equally unused, and to join them together, will that suffice? I think not; and for the same reason, namely, that the two which were joined together not being words coined for the first time, might, when joined, have reference to the character and quality of goods, whereas I think that the essence of an invented word within the meaning of the section is that it is a word which of necessity is incapable of having any reference to goods, inasmuch as it is incapable of conveying anything.

On the principles established in these cases, "FRIGIDAIRE" is clearly not an invented word, but a combination of two well-known English words long in use. To the eye and ear the same idea is conveyed by the composite word "FRIGIDAIRE" as by its two component parts—"frigid" and "aire(e)".

The respondent manufactures refrigerators and refrigeration apparatus, articles which by their nature are intended to produce frigid or cooled air to preserve perishable articles placed within the apparatus. I think that the word "FRIGIDAIRE", used in connection with such goods, was used originally to describe and did, in fact, describe that character or quality of the respondent's goods and the purpose to which such goods were to be applied. It was, therefore, not a registrable mark under the general provision of the Act.

I find, therefore, that the word "FRIGIDAIRE" was not *per se* a distinctive word; that, on the contrary, it was at the time of registration merely a descriptive word, lacking that distinctiveness which is necessary to constitute a trade mark properly speaking, and that it should not have been registered under the general provisions of the Act.

It is of interest to note that the respondent's predecessor in title had applied for registration of the mark in the United States under the Act of 1905, but the application was refused, it is said on the ground that the word was descriptive. Subsequently it was registered under the Act of 1920 which forbids registration of any mark that could have been registered under the Act of 1905.

1947
 GENERAL
 MOTORS
 CORPORATION
 v.
 BELLOWS
 Cameron J.

As I understand the argument of counsel for the respondent on the second point, it is not suggested that at the time of the application for registration in Canada the word "FRIGIDAIRE" had then, through use, acquired a secondary meaning. But it was argued that, as the proceedings here are taken under section 52 (1) of the Unfair Competition Act, 1932 (*supra*) consideration must be given to the rights of the respondent as of the date of the applicant's motion to expunge—March 10, 1947. The respondent contends that as of that date the trade mark "FRIGIDAIRE" had acquired a secondary meaning as indicating that the respondent assumed responsibility for the character or quality of the class of wares in association with which it was used or for their place of origin. It is pointed out that section 52 (1) of the Unfair Competition Act, 1932, is materially different from section 45 of the Trade Mark and Design Act under which consideration had to be given to the date of the entry in the register. It is contended, and I think rightly so, that under section 52 (1) consideration has to be given to the rights of the registered owner as existing at the time of the application to expunge. For example, a trade mark validly registered can now be attacked on the ground that it has expired by effluxion of time and has not been renewed; or that the registrant has not used its mark and has no intention of using the mark in connection with the goods for which it has been registered. The problem here is whether an invalid registration can become valid by reason of the acquisition of a secondary meaning after registration, thus becoming distinctive, and retain its registration.

For the applicant it is urged that the matter is concluded by the judgment of the President of this Court in *J. H. Munro Limited v. Neaman Fur Company Limited* (1). That was an infringement action in which the defendant

1947
 GENERAL
 MOTORS
 CORPORATION
 v.
 BELLOWS
 Cameron J.

attacked the validity of the plaintiff's registration. No application was there made under section 52 (1) to expunge the plaintiff's mark. The finding in that case was limited to infringement proceedings.

I have not found it easy to determine the precise meaning of the phrase in section 52 (1), "on the ground that at the date of such application the entry as it appears on the register does not accurately express or define the existing rights of the person appearing to be the registered owner of the mark".

By the Act, registration of the trade mark confers certain important rights on the registered owner. But that those rights are not absolute and unchallengeable is indicated by the provisions of section 52 (1) and by the use of the words, "at the date of the application", and "the existing rights". The rights conferred by registration may be entirely lost, in which case the word may be expunged; or they may be reduced and the register amended, all in the light of the evidence adduced at the hearing to establish that the mark should not have been registered in that it lacked registrability, or that by reason of circumstances which have occurred since registration, the registration should be expunged or amended. The section does not, in my view, confer any rights on the registered owner. It merely indicates that the registration may be attacked if, for example, it be established that at the time of the application the registered owner had no right to retain all or any of the benefits conferred on him by the entry in the register and under the Act itself. The section varied the law as declared in the case of *The Bayer Company v. American Druggists Syndicate* (1), in which it was held that the authority to expunge (under the then section 42 of the Trade Mark and Design Act) "any entry made without sufficient cause" meant "without sufficient cause at the time of registration".

I cannot find anything in the Act which would indicate that a registered trade mark which was invalid at the time of registration by reason of lack of distinctiveness could be held to have been validly registered by reason of the acquisition of a secondary and distinctive meaning after the date of registration. If it originally lacked registrability, it did

not become registrable until a secondary and distinctive meaning had been acquired and a successful application had been made under section 29 (1) of the Unfair Competition Act, 1932, or under the former Rule X of the Trade Mark and Design Act.

1947
GENERAL
MOTORS
CORPORATION
v.
BELLOWS
Cameron J.

Nor have I been referred to any case which would support such a conclusion. I was referred to the application by *J. & P. Coats Limited* for the registration of its mark "Sheen", (1), in which Lord Justice Romer said at p. 384:

There are words which have a direct relation to the character and quality of goods which nevertheless may lose their primary meaning and acquire in a particular trade a secondary meaning as indicating to people interested, whether as trader or as the public in the trade, the goods of a particular manufacturer. When that does occur and the evidence shows that the word has obtained a secondary meaning, then, in my opinion, the word is registrable as a trade mark. It does not mean, of course, that it necessarily should be registered.

Registration was allowed in that case but it is to be noted that it was an application to register, not an expungement proceeding.

It would seem also that under the English Trade Marks Acts wider latitude is given in cases such as this by reason of part of section 9, as follows:

For the purposes of this section "distinctive" shall mean adapted to distinguish the goods of the proprietor of the trade mark from those of other persons.

In determining whether a trade mark is so adapted, the tribunal may, in the case of a trade mark in actual use, take into consideration the extent to which such user has rendered such trade mark in fact distinctive for the goods with respect to which it is registered or proposed to be registered.

In my opinion, no evidence that a secondary meaning had been acquired subsequent to registration can affect the question as to whether or not the mark, at the time of registration, was distinctive. If the registration was invalid, it remains invalid. The entry as it appears on the register speaks as of the date of registration. It says nothing as to the existing rights of the registered owner at any later date unless, of course, there has been a previous amendment to the register. Insofar, therefore, as the question of registrability arises, the inquiry must be directed to the time of the application for registration. In my view, therefore, there is no reason to distinguish this case from

1947
 GENERAL
 MOTORS
 CORPORATION
 v.
 BELLOWS
 Cameron J.

that of *J. H. Munro Limited v. Neaman Fur Company Limited* (*supra*) on the ground that the latter case was one of infringement and the present one is under section 52 (1).

The application to expunge the trade mark "FRIGIDAIRE"—No. 262-56218—will therefore be granted, with costs to be taxed.

There is a further motion by General Motors Corporation which I must now consider. On June 12, 1947, it served notice of motion in these consolidated proceedings that if, upon the return of the notice of motion to expunge the registration of the word mark "FRIGIDAIRE", the Court was of opinion that the said word mark was not registrable under any provisions of the Unfair Competition Act, it would apply to the Court for a declaration under section 29 of the said Act that the said word mark "FRIGIDAIRE" has been so used by it and its predecessor in title as to become generally recognized by dealers in and/or users of the class of wares in association with which the said mark has been used, as indicating that the said General Motors Corporation assumes responsibility for their character or quality throughout Canada, and that the said or a fresh registration should extend to the whole of Canada aforesaid, subject to the condition defined by subsection (3) of the said section 29.

Section 29 of the Unfair Competition Act, 1932, is as follows:

29. (1) Notwithstanding that a trade mark is not registrable under any other provision of this Act it may be registered if, in any action or proceeding in the Exchequer Court of Canada, the court by its judgment declares that it has been proved to its satisfaction that the mark has been so used by any person as to have become generally recognized by dealers in and/or users of the class of wares in association with which it has been used, as indicating that such person assumes responsibility for their character or quality, for the conditions under which or the class of person by whom they have been produced or for their place of origin.

(2) Any such declaration shall define the class of wares with respect to which proof has been adduced as aforesaid and shall specify whether, having regard to the evidence adduced, the registration should extend to the whole of Canada or should be limited to a defined territorial area in Canada.

(3) No declaration under this section shall authorize the registration pursuant thereto of any mark identical with or similar to a mark already registered for use in association with similar wares by any person who was not a party to the action or proceeding in which the declaration was made.

Objection to the motion is taken by Norman William Bellows, owner of the trade mark "FROZENAIRE" who, in order to avoid confusion, will in this motion be referred to as the respondent, and General Motors Corporation will be referred to as the applicant. It is alleged by counsel for the respondent that the existing registration of the mark "FRIGIDAIRE" is a bar to the success of this application, and I am referred to *Canadian Shredded Wheat Company Ltd. v. Kellogg Company of Canada Ltd.* (1) in which it was held, *inter alia*, that the existence upon the register of the petitioner's mark was a bar to the petition; and that the declaration provided for in section 29 (1) of The Unfair Competition Act is not to be made in the case of a registered mark.

It is suggested that that case may be distinguished from the present one inasmuch as the applicant there requested the cancellation of its previously registered mark, only when the new application under section 29 (1) was granted; in the present case the application is made in the alternative and only to be considered as, if and when, the former registered mark has been expunged.

With respect, I have reached a different conclusion than that of the late President in the *Shredded Wheat Case* (*supra*). Section 29 (1) provides that when a trade mark lacks registrability, registration may be effected if the Court makes the declaration therein mentioned. The Court does not direct registration of the trade mark, but merely makes a declaratory order of registrability. The applicant must thereafter apply for registration under the provisions of section 33. I think that there can be no question that, in a proper case, the owner of a registered trade mark which has been expunged from the register on the ground that his mark was invalidly registered, could thereafter make a successful application under section 29. The mere fact that his mark had at one time been registered would not be a bar to later proceedings under that section. It provides that the declaration may be made in "*any action or proceeding in the Court,*" and applies to any trade mark which, under any other provision of the Act, lacks registrability. There is nothing in the section itself which in clear terms bars such an application as the present one. Nor

1947
 GENERAL
 MOTORS
 CORPORATION
 v.
 BELLOWS
 —
 Cameron J.
 —

1947
 GENERAL
 MOTORS
 CORPORATION
 v.
 BELLOWS
 Cameron J.

am I aware of any principle under which the owner of a trade mark already registered should be barred from making an application under section 29.

In essence, section 29 (1) provides that if a mark lacks registrability the Court may, in the circumstances therein mentioned, declare registrability *in any action or proceeding in the Exchequer Court*. The words, "in any action or proceeding," seem to me to be broad enough to cover not only cases where a petition is launched to secure a declaration of registrability of an unregistered mark, but also cases where in an action or proceeding the validity of a registered mark is challenged. Section 29 is in aid of the user of a mark which lacks registrability under the other sections of the Act but which, by user, is shown to have acquired a secondary and distinctive meaning. I see no necessity of confining its provisions to a mark which is unregistered. The owner of a mark which is registered, but which lacks registrability, should be in no worse position than the owner of a mark which is unregistered. He should not be penalized by the mere fact that he had registered his mark. And if the user of an unregistered mark can "in any action or proceeding" ask the Court for a declaration of registrability, the owner of a registered mark should have the same right.

In any event, in this case at least, the application is contingent on the Court having found that the mark "FRIGIDAIRE" should be expunged. An order to that effect has already been made in these consolidated proceedings, so that when the applicant proceeds under section 33, it will not then have its mark on the register.

I find, therefore, that the applicant is not barred from making its application under section 29 (1) by the fact that it had previously registered its mark under the general provisions of The Trade Mark and Design Act.

An objection is also taken by the respondent on the ground that there has been no compliance with Rule 35 of the Exchequer Court Rules, which is as follows:

Notice of filing Petition for Registration in Canada Gazette

In the case of any proceeding for the registration of any copyright, trade mark or industrial design, a notice of the filing of the *petition*, giving the object of the application and stating that any person desiring to oppose it must, within fourteen days after the last insertion of the notice in the *Canada Gazette*, file a statement of his objections with the Registrar of the Court and serve a copy thereof upon the petitioner, shall

be published in four successive issues of the *Canada Gazette*. The notice of the filing of the petition in the case of any proceeding for the registration of any copyright, trade mark or industrial design, may be in the terms of Form 8 in the Appendix to these Rules.

In the case of any proceeding to have any entry in any register of copyrights, trade marks or industrial designs, expunged, varied or rectified, it shall not be necessary to publish any notice of the filing of the *petition*.

1947
 GENERAL
 MOTORS
 CORPORATION
 v.
 BELLOWS
 Cameron J.

In the instant case no notice was inserted in the *Canada Gazette*. But in my view, Rule 35 refers only to proceedings for registration by way of petition. Form 8 in the appendix of the Rules, and which is referred to in Rule 35, would also so indicate. But section 29 (1) gives jurisdiction to the Court to make the declaration therein mentioned in *any* action or proceeding. Here the proceedings are not by way of petition. This objection cannot, therefore, be sustained.

There is substantial evidence, which I accept, that the word "FRIGIDAIRE" has acquired a secondary meaning and, as used at the time of the application, was generally recognized by dealers in refrigeration apparatus as indicating that the applicant assumed responsibility for their character or quality and for their place of origin. In support of this contention the applicant filed three affidavits by officials of three competing firms. D. Robertson of Brantford, Ontario, states that for eighteen years he was in the employ of Universal Cooler Company of Canada, Ltd., as its president, which company, throughout the whole period of eighteen years, distributed refrigerators and refrigerating apparatus throughout Canada in competition with those bearing the trade mark "FRIGIDAIRE." He states:

The said mark has always been known to me as indicating apparatus associated with General Motors Corporation, or its predecessor, Frigidaire Corporation, and I have been familiar with the advertisements of the said refrigerators and refrigerating apparatus under the said mark. I have never myself considered, and have never heard it suggested by anyone concerned in the business of distributing refrigerators and refrigerating apparatus, or by purchasers of the said wares, that the word "FRIGIDAIRE" was descriptive of refrigerating apparatus generally.

Ernest Lowden, of Toronto, from 1918 to 1925 was associated with the Frigidaire Corporation in Canada as a salesman and in 1925 became its manager for Canada, continuing in that position until the year 1932. From 1932 to 1944 he was Manager of the Appliance Division of Canadian Westinghouse Limited, from which position he

1947
 GENERAL
 MOTORS
 CORPORATION
 v.
 BELLOWS
 Cameron J.
 ———

retired in 1944. He is not now associated in any way with the Frigidaire Corporation or General Motors Corporation, or any other company engaged in selling electric refrigeration. He gives evidence to the same effect as that given by Mr. Robertson.

Harold B. Shipley, of Toronto, was for eight years in the employ of Canadian Ice Machine Company Ltd. as Managing Director and President, and during all that time his company was in competition with the applicant in the sale of refrigerators and refrigerating apparatus. His evidence is to the same effect as that given by Mr. Robertson.

It is also clear from the evidence of Lewis Clyde Shannon, the Manager of the Canadian and Export Department of the Frigidaire Division, General Motors Corporation of Dayton, Ohio, that for many years the sales by the applicant in Canada of wares bearing the mark "FRIGIDAIRE" have been very extensive. He states that between the years 1926 and 1936 the total dollar value of the apparatus distributed in Canada, and bearing the said mark, was in excess of \$20,000,000, and that since 1936 the dollar value of like wares was in excess of \$24,000,000. It is also established that, as of December 31, 1946, such wares were distributed throughout all of Canada by a total of 1,270 dealers. Between the years 1926 and 1942, the total dollar value of sales in Canada exceeded \$35,000,000, and more than \$720,000 was expended in Canada alone on advertisement of the wares in publications. During the same period, the sales in the United States were many times as great as in Canada, and a substantial part of the total expenditure of more than \$40,000,000 for like advertising of similar wares, under the same mark in the United States, was paid to periodicals in the United States which had a substantial circulation in Canada.

For the respondent it is contended, however, that the said word has at no time acquired a secondary meaning, but the only evidence in support of that is in the affidavit of the respondent himself in which he states, "that the applicant's registration No. 262-56218, registered by the applicant or its predecessor in business, is, and always has been, unregistrable under the Unfair Competition Act on the grounds of its lack of distinctiveness."

It is also alleged by the respondent that the mark "FRIGIDAIRE" is now in the public domain, and is used by members of the public as a word descriptive of refrigerators and refrigerating equipment generally. In support of this latter contention, the respondent exhibits a series of advertisements clipped at random from the daily press, showing the use by members of the public of the word "FRIG", or "FRIGIDAIRE". These are exhibits G1 to G6 to the respondent's affidavit of January 14, 1947. Exhibits G1 and G2 show the word "FRIG" in advertisements, but in my opinion this may well be an abbreviation of the word "REFRIGERATOR" rather than a short form of the word "FRIGIDAIRE". Exhibits G3, G4 and G6 are advertisements of articles for sale, and refer respectively to "Westinghouse Frigidaire", "Leonard Frigidaire", and one "Crosley Shelvidor Frigidaire". These three advertisements are apparently advertisements of persons *not* in the trade. Exhibit G5 is under the heading "Motors", and states, "Frigidaire and Washing Motors repaired, stock on hand; keys made."

1947
 GENERAL
 MOTORS
 CORPORATION
 v.
 BELLWOS
 ———
 Cameron J
 ———

The test to be applied in determining whether a mark has become *publici juris* is referred to in Kerly, Sixth Edition, p. 423, in which he quotes from the judgment of Mellish, L.J. in *Ford v. Foster* (1), as follows:

"There is no doubt, I think," said Mellish, L.J., in *Ford v. Foster*, (1872) L.R. 7 Ch. 628, "that a word which was originally a trade mark, to the exclusive use of which a particular trader, or his successors in trade, may have been entitled, may subsequently become *publici juris*, as in the case which has been cited of *Harvey's Sauce*, (*Lazenby v. White* (1871), 41 L. J. Ch. 354, n.). I think the test must be whether the use of it by other persons is still calculated to deceive the public, whether it may still have the effect of inducing the public to buy goods not made by the original owner of the trade mark as if they were his goods. If the mark has come to be so public and in such universal use *that nobody can be deceived by it*, and can be induced from the use of it to believe that he is buying the goods of the original trader, it appears to me, however hard to some extent it may appear on the trader, yet practically, as the right to a trade mark is simply a right to prevent the trader from being cheated by other persons' goods being sold as his goods through the fraudulent use of his trade mark, the right to the trade mark must be gone."

At p. 424 Kerly states:

Where common user is alleged of a trade mark that has been long used and registered, in order to establish this, the use by other persons should be substantial. Thus where it was alleged that a cat and barrel were common to the trade in gin at the date of the plaintiff's registration in 1879, it was held not to be sufficient to have proved nothing more than

(1) (1872) L.R. 7 Ch. 628.

1947
 GENERAL
 MOTORS
 CORPORATION
 v.
 BELLOWES
 Cameron J.

“a very sporadic use of the labels with a cat and barrel on them.” It was found that there had been in the case of none of the users of such labels, other than the plaintiffs, any trade that would associate their goods with a cat and barrel. *Boord & Son v. Thom and Cameron, Ltd.* (1907), 24 R. P. C. 697, at p. 721, Court of Session.

The instances of user of the word “FRIGIDAIRE” as shown by exhibits G3, G4 and G6 are, in my opinion, merely sporadic, and not in any case by any person in the trade. In none of these cases was the word used as a label or mark. There is evidence, which I accept, that the applicant has been alert in protecting its mark, and in preventing others in the trade from adopting marks which might be considered confusingly similar.

I prefer the evidence adduced by the applicant and in my view there can be no doubt that the word “FRIGIDAIRE” has acquired a secondary and distinctive meaning, and is entitled to the declaration provided for in section 29 (1) of the Act.

There will therefore be a declaration, pursuant to the provisions of section 29 (1) of The Unfair Competition Act, 1932, that it has been proven to the satisfaction of this Court that the trade mark “FRIGIDAIRE” has been so used by General Motors Corporation, and its predecessor in title, as to have become generally recognized by dealers in and/or users of the class of wares in association with which it has been used (that is to say, refrigeration apparatus, namely, refrigerators, including electric refrigerators, electrical refrigerating machinery, ice-making machinery, refrigerating cabinets, air conditioning systems, apparatus and devices for cooling foods by refrigeration of all kinds, parts of the above goods and accessories thereto), as indicating that General Motors Corporation assumes responsibility for their character or quality or for their place of origin; and having regard to the evidence adduced that the registration thereof should extend to the whole of Canada—the whole subject to the provisions of section 29 (3) of the said Act.

The motion of the applicant is granted, with costs to be taxed.

Judgment accordingly.