

CASES
DETERMINED BY THE
EXCHEQUER COURT OF CANADA
AT FIRST INSTANCE
AND
IN THE EXERCISE OF ITS APPELLATE
JURISDICTION

1943
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Sept. 27, 28
Oct. 4, 5.
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1946
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Dec. 17
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BETWEEN :

J. H. MUNRO LIMITED,..... PLAINTIFF,

AND

NEAMAN FUR COMPANY LIMITED, . . . DEFENDANT.

Trade Marks—“Gold Medal Furs”—Trade Mark and Design Act, R.S.C. 1927, c. 201, ss. 5, 11 (e), 13, 20, Rule X—The Unfair Competition Act, 1932, ss. 4 (4), 19, 23 (1), 26 (1) (c), 29.—Invalid registration a defence in an infringement action—Misrepresentation in application for registration—Non-use of trade mark before registration—Essentials necessary to constitute trade mark—Distinctiveness an essential requirement—Laudatory or commendatory epithets not distinctive—Acquisition of secondary and distinguishing meaning subsequent to registration.

The plaintiff, a dealer in manufactured furs particularly real Alaska seal fur coats, had the words “Gold Medal Furs” registered as a specific trade mark. In an action for infringement against the defendant who made and sold electric seal fur coats carrying a label containing the words “Gold Medal Seal” the defendant attacked the validity of the registration of the plaintiff’s alleged trade mark.

Held: That the plaintiff’s alleged trade mark “Gold Medal Furs” lacked the necessary quality of distinctiveness and did not, therefore, contain the essentials necessary to constitute a trade mark, properly speaking within the meaning of section 11 of the Trade Mark and Design Act and was not validly registered.

2. That if the words “Gold Medal Furs” were not *per se* apt and appropriate for trade mark use at the time of their registration because of their lack of distinctiveness and, therefore, not properly registrable, then any subsequent acquisition of a secondary and distinguishing meaning denoting only the plaintiff’s furs could not for the purpose of supporting an action for infringement give validity to a registration that was invalid when it was made.

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ACTION for infringement of a specific trade mark.

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The action was tried before The Honourable Mr. Justice Thorson, President of the Court, at Vancouver and Winnipeg.

A. E. Bull K.C., E. A. Burnett and H. G. Harvey Smith for plaintiff.

H. A. Bergman K.C. and A. E. Cantor for defendant.

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

THE PRESIDENT now (Dec. 17, 1946) delivered the following judgment:

The plaintiff seeks an injunction and damages for alleged infringement by the defendant of the alleged trade mark "Gold Medal Furs", registered in the plaintiff's name on May 28, 1932, in The Trade Mark Register No. 252, Folio 54386, under the Trade Mark and Design Act, as a specific trade mark to be used in connection with the sale of furs.

Prior to the incorporation of the plaintiff, J. H. Munro, now its president, had been in the fur business since 1913, first at Revelstoke in British Columbia, then at Westminster and later at Vancouver. He was in the raw fur business until 1923 when he started to deal in manufactured furs. In 1925 he exhibited some furs at the British Empire Exhibition at Wembley, England, and there received a certificate and bronze medal in recognition of his participation. Before he left Wembley he sent an exhibit of furs to the New Zealand and South Seas Exhibition, 1925-6, at Dunedin, New Zealand. There he received a diploma of merit, first class, for general excellence of display, a diploma of first order of merit and gold medal for manufactured fur goods, a diploma of second order of merit and silver medal for dressed fur skins and a diploma of second order of merit and silver medal for fur novelty goods.

At the trial J. H. Munro said that after 1926 he commenced using the words "Gold Medal" in connection with his furs on circular letters, letter heads and newspaper

advertising. About August, 1929, after he had moved to Westminster, he began the use of a label on his fur coats, a sample of which was filed as exhibit 10. This was sewed on the inside of the coats but was not used on any other furs. Its outstanding feature consists of the words "The Munro Fur Store" in red on a blue strip diagonally across it. Above this strip on the left there is a design, said to be a reproduction of the front of the gold medal won at Dunedin, and under it in small print the words "J. H. Munro, Prop." In the upper right corner the words "Canada's Gold Medal Furrier" appear and in the lower right corner the address "Vancouver, B. C." is printed.

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On April 17, 1931, the plaintiff was incorporated under the Companies' Act of British Columbia and took over the business formerly carried on by J. H. Munro, he becoming its president and his wife its secretary treasurer. On April 21, 1932, the plaintiff requested the Commissioner of Patents to register in its name a specific trade mark consisting of the words "Gold Medal Furs" to be used in connection with the sale of furs and the registration was made on May 28, 1932.

The plaintiff continued to use exactly the same label as J. H. Munro had done except for the change of address to "Vancouver, B.C.", after it had moved from New Westminster. It used the words "Gold Medal Furs" in some of its advertising and circulars and in a pamphlet which it distributed, but its greatest use of them was in its slogan "Gold Medal Furs are Better Furs" which it used on its letter heads and in its pamphlet and stressed particularly in its radio broadcasting. But on its letter heads, advertisements, circulars, pamphlet and sales slips, the plaintiff's name or the words "Munro Fur Store" were usually followed by the words "Canada's Gold Medal Furriers". There were also references to "Gold Medal Brand Fur" and to "Gold Medal Quality". Until 1936 or 1937 when it was stolen the gold medal won by the plaintiff was displayed in its store window. The words "Gold Medal Furs" by themselves were never used on any furs by label or otherwise either before or after the registration either by the plaintiff or by J. H. Munro.

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 J. H. MUNRO as Alaska seal, which sold at from \$200 to \$400 each, or an average of \$280, and developed a considerable business in them.
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Thorson P. The facts with regard to the alleged infringement by the defendant are as follows. It is a manufacturing furrier in Winnipeg. Between July, 1938, and December, 1941, it manufactured for and sold to The T. Eaton Company Limited, who were large merchandisers of fur coats, 1463 fur coats on which was sewn a label, a sample of which was filed as Exhibit 3. This carries the words "Gold Medal Seal" in gold letters on a black background; under them in small but legible print the words (Dyed Rabbit) in red appear and above them there are representations of what might be taken for a row of gold medals. The coats were of dyed rabbit fur, known as electric seal. They were sold to The T. Eaton Company Limited at \$60 each and by it to the public at \$98.50 each.

The plaintiff claimed that there had been an infringement of his trade mark by the sale of these coats under the label "Gold Medal Seal" and that his sale of Alaska seal coats had been adversely affected thereby. He brought action against The T. Eaton Company Limited in the Supreme Court of British Columbia and was awarded damages against them. He then brought the present action. The first action contained a claim for passing off but this one contains no such claim.

Many interesting questions were raised by counsel in the course of their careful arguments, but a number of them need not be dealt with in view of the conclusion that the plaintiff's alleged trade mark should not have been registered.

The words "Gold Medal Furs" were registered on May 28, 1932, as a specific trade mark, under the Trade Mark and Design Act, R.S.C. 1927, chap. 201. On September 1, 1932, The Unfair Competition Act, 1932, Statutes of Canada 1932, chap. 38, came into force, by section 23 (1) of which it was provided:

23. (1) The register now existing under the *Trade Mark and Design Act* shall form part of the register maintained pursuant to this Act, and, subject as hereinafter provided, all entries therein shall hereafter be

governed by the provisions of this Act, but shall not, if properly made under the law in force at the time they were made, be subject to be expunged or amended only because they might not properly have been made hereunder.

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It is a condition precedent to the bringing of proceedings for infringement of a trade mark that it should be registered. Section 4 (4) of The Unfair Competition Act, 1932, provides:

4. (4) No person shall institute any proceedings in any court to prevent the infringement of any trade mark unless such trade mark is recorded in the register maintained pursuant to this Act.

and section 20 of The Trade Mark and Design Act made a similar provision. But it is open to the defendant in such proceedings to attack the validity of the registration and if he does so successfully the infringement action must be dismissed. This result appears clear from section 19 of the new Act and, while there was no corresponding express provision in the old Act, the law was the same. It was held in *Partlo v. Todd* (1) that a defendant in an action for infringement of a trade mark could question the validity of the registration of the mark. There the plaintiff had sued for infringement of his registered trade mark "Gold Leaf" as applied to flour, but it was held in effect that the term was common to the trade and, therefore, not registrable as a trade mark. Consequently, notwithstanding its registration, the plaintiff had no right to its exclusive use. The authority of this decision is not affected by any changes in the law since the Trade Mark and Design Act, 1879: *Provident Chemical Works v. Canada Chemical Co.* (2). The defendant may, therefore, notwithstanding the registration of the words "Gold Medal Furs" as a specific trade mark, go behind such registration and question its validity. This must be determined by the law in force at the time it was made.

Counsel for the defendant made two attacks on the registration; one, that there was a misrepresentation in the application for it, and the other, that the words "Gold Medal" could not properly be the subject of a trade mark registration.

(1) (1888) 17 S.C.R. 196.

(2) (1902) 4 O.L.R. 545.

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The application for the registration contains the following:

J. H. Munro Limited . . . hereby requests you to register in the name of the Company a specific trade mark to be used in connection with the sale of furs which the Company verily believes is the Company's on account of having been the first to make use of the same.

The said Company hereby declares that the said Specific trade mark was not in use to its knowledge by any other person than the company at the time of the Company's adoption thereof. The said specific trade mark consists of the name or words "Gold Medal Furs".

It is said that if the mark was ever used its first use was by J. H. Munro and not by the plaintiff and that the statement "which the Company verily believes is the Company's on account of having been the first to make use of the same" was, therefore, untrue. That, technically, cannot be denied. But it is said in answer that this does not matter since such a statement was not required by section 13 of the Trade Mark and Design Act which sets out how a registration may be effected. The reply to that is that the statement was in accordance with the form of application prescribed under the authority of the Act. It is, of course, true that if a person seeks to take advantage of a statutory right, he must comply with the requirements of the statute but, while the untrue statement is not lightly to be dismissed, I doubt whether by itself it would be a sufficient ground for declaring the registration invalid. Then it is said that the plaintiff never used the words "Gold Medal Furs" as a trade mark at all. Section 5 of the Trade Mark and Design Act setting out what shall be deemed to be trade marks provides as follows:

5. All marks, names, labels, brands, packages or other business devices, which are adopted for use by any person in his trade, business, occupation or calling, for the purpose of distinguishing any manufacture, product or article of any description 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, parcel, case, box or other vessel or receptacle of any description whatsoever containing the same, shall, for the purposes of this Act, be considered and known as trade marks.

A trade mark is used to distinguish the goods of the proprietor of the mark from those of other persons and it is clearly indicated by section 5 that the manner of its use must be by application of it either to the goods themselves or to their container. If the use of the words "Canada's Gold Medal Furrier" on the plaintiff's label can be said

to be a use of the specific trade mark "Gold Medal Furs" then, of course, there was a use of it within the meaning of section 5, but I am unable to think that these words were used as a trade mark: they were, in my opinion, merely descriptive either of J. H. Munro, or of the plaintiff, or of The Munro Fur Store, and were not used for the purpose of distinguishing the plaintiff's goods. The use of the words "Gold Medal Furs" in the plaintiff's advertising, circulars, pamphlets and radio broadcasting was clearly not a use within the meaning of the section. Of that there can, I think, be no doubt. I am, therefore, of the opinion that the defendant's attacks on the plaintiff's application were well founded. Not only was the plaintiff not the first person to use the alleged specific trade mark, but also the words had not been used by the plaintiff as a trade mark at all. If use of a trade mark was a prerequisite to its valid registration under the Trade Mark and Design Act, as, in my opinion, the weight of authority indicates, although there is some conflict of opinion on the subject, the plaintiff's registration of the words "Gold Medal Furs" as a trade mark was invalid on the ground that they had never been used as such.

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While the registration was invalid on this ground, the other reason for attacking it, namely, that the words "Gold Medal Furs" were not properly the subject of a trade mark registration is a stronger one. Section 11 (e) of the Trade Mark and Design Act provides:

11. The Minister may refuse to register any trade mark . . .
 (e) if the so-called trade mark does not contain the essentials necessary to constitute a trade mark, properly speaking.

While section 11 permits the Minister to refuse to register a trade mark in certain specified cases, I think it is clear that in such cases he ought to refuse the registration, and that if it is made it is invalid. It may, therefore, be implied from section 11 (e) that it is necessary to the validity of the registration of a trade mark that it should contain "the essentials necessary to constitute a trade mark, properly speaking". What are these essentials? In *Fisher v. British Columbia Packers Limited* (1) it was held that distinctiveness is an essential requirement of a trade mark. Resort was there had to the definitions of a trade mark and a word

(1) (1945) Ex. C.R. 128 at 132.

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mark in The Unfair Competition Act, 1932, to support this view. Then, in *Food Machinery Corporation v. Registrar of Trade Marks* (1) the requirements for registrability of a trade mark were discussed and it was stated that, while distinctiveness is an essential requirement it is not the only one for it is also necessary that there should be no prohibition against the registration such as those expressed or implied in section 26 (1). Under the Trade Mark and Design Act there is no provision corresponding to section 26 of The Unfair Competition Act, 1932, and the Act does not define or explain the essentials necessary to constitute a trade mark, but there can be no doubt that distinctiveness is one of them. While this is not stated in the definition of what shall be considered and known as trade marks contained in section 5 of the Act, already cited, it is clearly implied. The marks, etc., there referred to, are those that are adopted for use to distinguish the proprietor's goods. Trade marks are used in association with goods for the purpose of distinguishing them as the goods of the proprietor of the mark from those of other persons. If such purpose is to be accomplished the trade mark must have the quality of distinctiveness. Indeed, it was settled by the Judicial Committee of the Privy Council in *Standard Ideal Company v. Standard Sanitary Manufacturing Company* (2) that "distinctiveness is the very essence of a trade mark."

If, therefore, the words "Gold Medal Furs" did not possess the requisite distinctiveness at the time of their registration on May 28, 1932, they should not have been registered and the registration was invalid. It is not a question whether the words "Gold Medal" are clearly descriptive of character or quality within the prohibition of section 26 (1) (c) of The Unfair Competition Act, 1932, for it does not here apply, but whether at the time of the registration of the words "Gold Medal Furs" they had the distinctiveness that is one of "the essentials necessary to constitute a trade mark". I have come to the conclusion that they did not. The cases indicate, I think, that words of this sort are not apt or appropriate for trade mark use. In *Standard Ideal Company v. Standard Sanitary Manufacturing Company* (*supra*) Lord MacNaghten, delivering

(1) (1946) Ex. C.R. 266 at 270.

(2) (1911) A.C. 78 at 85.

the judgment of the Judicial Committee, said, at page 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.

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In *Joseph Crosfields' & Sons Ltd's Application* (1), known as the *Perfection Case*, the Court held that even under the wide discretion given to the Board of Trade and the Court under section 9 (5) of the Trade Marks Act, 1905, the word "Perfection" ought not to be registered as a trade mark. It was not a distinctive mark and even with its long user by the applicants it was not adapted to distinguish their goods from those of other persons. In that case Lord Moulton dealt with the subject of distinctive and descriptive terms. It was a fallacy to assume that there is a natural and innate antagonism between distinctive and descriptive as applied to words and that if a word is descriptive it cannot be distinctive. There are many words which are originally descriptive and not distinctive that may by long user become distinctive, for distinctiveness is a quality that may be acquired. But it was also held that there are some descriptive words, such as ordinary laudatory epithets, that can never acquire distinctiveness, no matter what length of user may be proved, and the word "Perfection" was considered to be a word of such a nature. In *Henry Thorne and Co. Limited v. Sandow Limited* (2) it was held that the plaintiff's trade mark "Health" as applied to cocoa, notwithstanding its registration, was intended to convey the idea that the cocoa was health giving or that

(1) (1909) 26 R.P.C. 837.

(2) (1912) 106 L.T.R. 926.

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the taking of it would promote health, that it was, therefore, merely a laudatory or commendatory epithet and not distinctive, and that it should be removed from the register. Then in one of the latest cases on the subject, *Canadian Shredded Wheat Co., Ltd. v. Kellogg Co. of Canada Ltd. et al* (1), Lord Russell of Killowen, in delivering the judgment of the Judicial Committee of the Privy Council, after saying that the required meaning of distinctiveness of a trade mark "must carry with it the feature that the goods distinguished are the goods manufactured by a particular person, and by no other", laid down the following test of distinctiveness:

A word, or words, to be really distinctive of a person's goods, must, generally speaking, be incapable of application to the goods of any one else.

It is this singleness of applicability only to the goods of the proprietor of the trade mark that is required if it is to have the essential quality of distinctiveness that is so necessary if the purpose of using a trade mark is to be accomplished. In my view, the words "Gold Medal" *per se*, as applied to goods such as furs, do not meet such a stiff requirement.

There are two Canadian cases, other than those brought by the plaintiff, in which the words "Gold Medal" are referred to. In *Dominion Flour Mills Co. v. Morris* (2) the trial judge dismissed the plaintiffs' action seeking to restrain the defendants from passing off their flour as the plaintiffs' by the sale of it in bags impressed with the unregistered trade mark "Gold Medal" which had been used by the plaintiffs for many years and the Divisional Court of Ontario affirmed his judgment. The evidence showed that "Gold Medal" as applied to flour was a synonym for excellence and came to mean an excellent blended flour from a mixture of Ontario and Manitoba wheat and that the words were in common use for flour throughout Ontario. It was held that the onus was on the plaintiffs to show that the defendants had been attempting to sell their flour as the plaintiffs' and that the term "Gold Medal" had acquired, through its use by the plaintiffs, a secondary meaning denoting their flour only, and that they had not satisfied such onus. While the decision was made with regard to the use of the words "Gold Medal"

(1) (1938) 1 All E.R. 619 at 631.

(2) (1912) 25 O.L.R. 561.

as applied to flour and the fact that such use was common in the province, I think it may fairly be inferred that, in the opinion of the Court, the words "Gold Medal" *per se*, without proof of a secondary meaning, were not distinctive. At page 562, Boyd C. said:

The words "Gold Medal" are ordinary words capable of a well understood meaning, and are applicable to articles which have gained a prize at some exhibition or competition.

The other case is *Gold Medal Furniture Mfg. Co., Ltd. v. Gold Medal Camp Furniture Mfg. Co.* (1). There the petitioner sought to expunge the objecting party's specific trade mark "Gold Medal", to be used in connection with the sale of certain specified goods, which had been registered on its application in which its president had stated that it belonged to the applicant "on account of its having been the first to make use of the same". It was held that this statement was untrue, that the petitioner was the first to use the words in Canada upon goods of the same class as those for which registration had been granted to the objecting party, and that the entry of the objecting party's mark should be expunged. The judgment of this Court was affirmed by the Supreme Court of Canada. The reservations made are, I think, significant. In this Court Audette J. said, at page 66:

The question as to whether or not a trade mark consisting of the words "Gold Medal" is good or bad in view of its suggestive character, is one I need not decide as it has not been raised by either party.

It would not be unfair to deduce that there was at least some doubt in his mind as to the aptness of the words for trade mark use. And in the Supreme Court of Canada in written reasons for judgment of Lamont J., in which Anglin C. J. C., and Mignault, Rinfret and Smith JJ. all concurred, the following statement is made:

In affirming the judgment of the Exchequer Court expunging the appellant's entry from the register we do not wish to be understood as impliedly holding that the words "Gold Medal" contain the essentials necessary to constitute a valid trade mark. Both parties carefully abstained from raising that question either in the court below or before us, and the trial judge expressly stated that he was not passing upon it.

If there had been no doubt in the mind of the Court that the words "Gold Medal" were distinctive there would have been no need for such a reservation.

(1) (1928) Ex CR 65;
(1928) S.C.R. 575

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In the present case, the question is squarely raised. In my judgment, the words "Gold Medal Furs" are common English words, connoting the winning of a gold medal or suggesting furs of such high quality as to merit the award of such a medal. The words "Gold Medal" as applied to furs are synonymous of first class quality and clearly suggestive of such a high degree of excellence as to be of gold medal winning quality or of the highest order of merit. In that sense they are in the nature of laudatory or commendatory epithets. The words draw attention to the superior quality of the furs, and do not serve the purpose of distinguishing them as those of the plaintiff and of no one else. They do not meet the requirement of distinctiveness referred to in the cases and are not apt or appropriate for trade mark use. Under the circumstances I have come to the conclusion that the plaintiff's alleged trade mark "Gold Medal Furs" lacked the necessary quality of distinctiveness and did not, therefore, contain the essentials necessary to constitute a trade mark, properly speaking, within the meaning of section 11 of the Trade Mark and Design Act and was not validly registered. I am strengthened in this conclusion by the decision of the New York Court of Appeals in *Taylor v. Gillies et al* (1). There the plaintiff's action seeking to restrain the defendants from using the words "gold medal" as applicable to their manufacture of saleratus on the ground that the plaintiff had an exclusive right to such use as a trade mark was dismissed. It was held that an exclusive right cannot be acquired to the use of the words "gold medal" as a trade mark upon the wrappers of a manufactured article. At page 333, the Court said:

Gold medal is equivalent to prize medal of the highest class. Such is its constant sense as applied to merchandise. It is an affirmation in respect to fact and to quality, comprehending, first, the idea of its having been awarded for excellence in some public competition; and, second, the idea of the affirmation of the possession of the actual excellence thus attested. Taking this to be the just sense of the words, they are not capable of being a trade mark. They do not indicate origin or ownership. Indeed, they cannot do so as long as other gold medals can be awarded in other competitions; for, in respect to any such article, the right of such person to whom a gold medal had been or should be awarded would be equal to announce the fact that his product had been so distinguished.

In the present case, there is evidence that J. H. Munro was not the only person in Canada to win a gold medal for his furs but that there were several others who had done so, and the words "Gold Medal" would be as applicable to their furs as to those of the plaintiff. They would thus not comply with the test of distinctiveness laid down in the *Shredded Wheat* case (*supra*). Neither J. H. Munro nor the plaintiff, in the absence of proof that the words "Gold Medal" had acquired a secondary and distinctive meaning denoting only his or its furs, had any right to appropriate for exclusive use common English words which any winner of a gold medal for his products would be entitled to use.

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In the conclusion I have reached I have been unable to agree with the decision of the Supreme Court of British Columbia in the action which the plaintiff brought successfully against The T. Eaton Company Limited, *J. H. Munro Limited v. The T. Eaton Company Limited et al* (1). I think it may be inferred from the reasons of Farris C. J. S. C. that he had himself a doubt as to the registrability of the words "Gold Medal" *per se*; after referring to *Dominion Flour Mills Co. v. Morris* (*supra*) and *Gold Medal Camp Furniture Mfg. Co., Ltd. v. Gold Medal Furniture Mfg. Co.* (*supra*) and stating that in both cases the Courts had found it unnecessary to determine whether such words are descriptive or not, he stated, at page 201:

Neither is it necessary to do so in this case. I find that there is nothing in the evidence to indicate that prior to use by the plaintiff and its predecessor in business, Munro, the words "Gold Medal" were used in connection with furs and that in British Columbia, at least, the extensive usage by the plaintiff and predecessor in business, Munro, of the words "Gold Medal" was such that if the words are descriptive they acquired a secondary meaning so as to distinguish the goods of the plaintiff, and I find, therefore, that the use of the words "Gold Medal", whether descriptive or not, is not bad in the trade mark registered by the plaintiff, and that the trade mark was properly registered.

On the case before me I am unable to reach a similar conclusion either on the facts or in law. While I do not go so far as to say that the words "Gold Medal" cannot ever by user of them in association with goods acquire a secondary meaning so as to distinguish such goods as those of the user from the goods of other persons and thus acquire the quality of distinctiveness necessary for their use as a trade

(1) (1943) 2 W.W.R. 195.

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mark, which the words *per se* do not possess, I think it is clear that the establishment of such secondary and distinguishing meaning imposes a very heavy onus on the user and requires very convincing evidence. The extreme difficulty of proving that common or descriptive words have acquired such a meaning was strongly emphasized by the House of Lords in *Cellular Clothing Company v. Maxton & Murray* (1). In the *Perfection Case* (*supra*) it was settled that ordinary laudatory epithets can never acquire such meaning, no matter what the extent of their user may have been, but it was also recognized that in the case of other descriptive words there might be varying degrees of difficulty in the proof of acquired distinctiveness. At page 858, Fletcher Moulton L. J. said:

The extent to which the Court will require the proof of this acquired distinctiveness to go will depend on the nature of the case. If the objections to the word itself are not very strong it will act on less proof of acquired distinctiveness than it would require in the case of a word which in itself was open to grave objection. I do not think, for instance, that any amount of evidence of user would induce a Court to permit the registration of ordinary laudatory epithets, such as "best", "perfect", etc. On the other hand, in the case of a peculiar collocation of words it might be satisfied with reasonable proof of acquired distinctiveness even though the words taken separately might be descriptive words in common use.

And while it was indicated in *Dominion Flour Mills Co. v. Morris* (*supra*) that the words "Gold Medal" as applied to goods could acquire a secondary and distinguishing meaning, it was made clear that convincing evidence of the acquisition of such meaning was required. At page 563, Boyd C. said:

It lies upon the plaintiffs to prove that these merely descriptive words (implying success at some exhibition) have acquired a technical and superinduced meaning distinct from the natural one and applicable only to this particular flour. That is the proposition to be established, and it must be so by convincing evidence.

Under the circumstances, it is clear that in the present case the onus on the plaintiff of establishing a secondary and distinguishing meaning for the words "Gold Medal Furs" so as to denote only its furs is a very heavy one. The evidence before me, whatever it may have been in the case against The T. Eaton Company Limited, falls very

(1) (1899) A.C. 326.

far short of establishing any such meaning and, if the case depended thereon, I would have no hesitation in finding that the plaintiff had failed to satisfy the onus resting upon it.

Moreover, if the words "Gold Medal Furs" were not *per se* apt and appropriate for trade mark use at the time of their registration because of their lack of distinctiveness and, therefore, not properly registrable, then any subsequent acquisition of a secondary and distinguishing meaning denoting only the plaintiff's furs could not for the purpose of supporting an action for infringement give validity to a registration that was invalid when it was made. In so far as the conclusion reached by Farris C. J. in the British Columbia case depends upon a different view I am respectfully unable to agree with him. If the plaintiff must rely upon a secondary and distinguishing meaning of the words "Gold Medal Furs" as denoting only its furs in order to support the registration of its alleged trade mark, it must show not only that the words had acquired such meaning at the time of the registration, but also that the application for it had been made under the provisions applicable thereto. This the plaintiff cannot do. Rule X under the authority of the Trade Mark and Design Act provides as follows:

X. 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.

No application was made under this rule. Indeed, at the time of the registration, the plaintiff could not have complied with its requirements, for there is no proof at all that at such time the words had acquired any secondary or distinguishing meaning, and I do not see how they could have done so. Nor was any application made under section 29 of The Unfair Competition Act, 1932, which makes provision for the registration of a trade mark, even although it is not registrable under any other provision of the Act, on proof to the satisfaction of the Court that it has been used in association with goods so as to distinguish such goods as those of the user of the mark and there are numerous

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cases where word marks which would be refused registration under section 26 (1) (c) as containing descriptive words have been registered pursuant to a declaration of the Court that it is satisfied that proof has been made of the acquisition by user of the necessary secondary and distinguishing meaning. If the plaintiff had made an application under section 29 on the same evidence as that given in the present case the Court would not have been justified, in my opinion, in making the declaration contemplated by the section.

Under the circumstances, I must hold that the registration of the plaintiff's alleged trade mark "Gold Medal Furs" was invalid and cannot support the plaintiff's action with the result that it must be dismissed with costs.

Judgment accordingly.