

BETWEEN

THE GORHAM MANUFACTURING } PLAINTIFFS;  
COMPANY..... }

1904  
Mar. 7.

AND

P. W. ELLIS & CO.....DEFENDANTS.

*Trade-mark—Infringement—Sterling silver “hall-mark”—Right to register goods bearing mark on Canadian market.*

If by the laws of any country the makers of certain goods are required to put thereon certain prescribed marks to denote the standard or character of such goods, and goods bearing the prescribed marks are exported to Canada and put upon the market here, it is not possible thereafter, and while such goods are to be found in the Canadian market, for any one to acquire in Canada a right to the exclusive use of such prescribed marks to be applied to the same class of goods, or to the exclusive use of any mark so closely resembling the prescribed marks as to be calculated to deceive or mislead the public.

*Quaere:* Whether any one would, in such a case, be precluded from acquiring a right in Canada to the exclusive use of such a trade-mark, where there was no importation into Canada of goods bearing the prescribed foreign marks?

2. The plaintiffs brought an action for the infringement of their registered specific trade-mark to be applied to goods manufactured by them from sterling silver which, it was thought, so resembled the Birmingham Hall-mark, or a hall-mark, as to be calculated to deceive or mislead the public, and it appeared that during the time that the plaintiffs' goods, bearing such mark, were upon the Canadian market, goods bearing the Birmingham Hall-mark were also upon the market here.

*Held,* that the plaintiff could not, under the circumstances, acquire the exclusive right to the use as a trade-mark of the mark that he had been so using.

**ACTION** for an injunction to restrain the infringement of the plaintiffs' trade-mark, and to expunge that of the defendants.

1904  
 THE  
 GORHAM  
 MANUFACTURING Co.  
 v.  
 ELLIS & Co.  
 Argument  
 of Counsel.

The facts of the case are stated in the reasons for judgment.

January 18th, 19th, 20th and 28th, 1904.

The case was heard at Toronto.

*A. B. Aylesworth, K.C.*, for the plaintiffs, contended that there was no doubt upon the evidence that the defendants registered their trade-mark with knowledge of the prior registration of that of the plaintiffs. As to the resemblance between the marks, that is for the court to decide in finding an infringement. *Bourne v. Swan* (1). The marks are so small here that it would need a glass to assist the eye to distinguish them. It is the average man, and not the expert, that the law contemplates as being deceived. *Sebastian on Trade-marks* (2).

It is not necessary to establish that defendants fraudulently imitated the plaintiffs' mark. An innocent imitation is an infringement. The whole question is: Is the defendants' mark calculated to deceive the public into buying their goods for those of the plaintiffs? *Millington v. Fox* (3); *Singer Machine Manufacturers v. Wilson* (4).

The question of the origin of the mark, and the length of time it has been used by the plaintiffs has nothing to do with the merits of the case between the parties. We are entitled to it by reason of prior registration. *Cope v. Evans* (5); *Somerville v. Schembri* (6). The burden is on the alleged infringer to show his right where he has taken part of a registered trade-mark. *Ford v. Foster* (7).

The matter of the Birmingham Hall-mark has nothing to do with the issue of infringement between these

(1) 51 W. R. 213.

(2) 4th ed. p. 127.

(3) 3 Myl. & Cr. 338.

(4) L. R. 3 A. C. 376.

(5) L. R. 18 Eq. 138.

(6) L. R. 12 A. C. 453.

(7) L. R. 7 Ch. 611.

parties. The statute 18 Geo. III, c. 52 is limited in its operation to England; and a manufacturer in the United States using the Birmingham Hall-mark on silverware would not be liable to an action. Canada is a foreign country in the same sense. *Greeley on Patents and Trade-marks* (1); *Sebastian on Trade-marks* (2). The statute regulating the use of hall-marks in England is of purely local concern. It is to protect the English public only. *Paul on Trade-marks* (3). The plaintiffs are entitled to an injunction, a rectification of the register of trade-marks and damages.

*G. T. Blackstock, K.C.* for the defendants, argued that the plaintiffs were not entitled to ask for a rectification of the register in an action for infringement. The sole question here is the proprietorship of the mark in dispute.

It is not the public that would be deceived in such a case as this, but the retail dealers, who are really specialists, and not likely to be deceived. If any dealer makes a minute inspection, as he undoubtedly would in buying silverware, he would use a glass and so see the difference between the two marks. The maple leaf in the mark of the defendants affords a ready means of distinguishing it from that of the plaintiffs.

The plaintiffs have adopted as their trade-mark an imitation of the Birmingham Hall-mark, which was first used on  $\frac{900}{1000}$  silverware. It was used on goods sold in Canada long before the plaintiffs obtained registration of their mark. This operates as a denial of the plaintiffs' right to register. *Partlo v. Todd* (4); *J. B. Bush Mfg. Co. v. Hanson* (5).

1904  
 THE  
 GORHAM  
 MANUFACTURING Co.  
 v.  
 ELLIS & Co.  
 Argument  
 of Counsel.

(1) Secs. 150, 151,

(3) Sec. 89.

(2) 4th ed. p. 82.

(4) 17 S. C. R. 196.

(5) 2. Ex. C. R. 557.

1904  
 THE  
 GORHAM  
 MANUFACTURING Co.  
 v.  
 ELLIS & Co. Co. (1).  
 Argument  
 of Counsel.

There is no case here of passing off our goods as those of the plaintiffs, or of appropriating their business. There is clearly no infringement upon the whole case; *Provident Chemical Works v. Canada Chemical Mfg. Co.* (1).  
*A. B. Aylesworth, K.C.*, in reply, cited *Davis v. Kennedy* (2).

THE JUDGE OF THE EXCHEQUER COURT now (March 7th, 1904) delivered judgment.

The action is brought by the plaintiff company against the company defendant for relief against an alleged infringement by the latter of the former's registered trade-mark.

The plaintiffs were, in May, 1863, by an Act of the General Assembly of the State of Rhode Island, constituted a corporation for manufacturing goods made of gold, silver and other metallic substances and for the transaction of other business connected therewith. As silversmiths they succeeded to a business that is said to have been commenced in 1813, and which they have continued to carry on at Providence, in the State of Rhode Island. They employ in this business, one of the witnesses stated, from seventeen hundred to two thousand persons, and the value of the annual output is between four and six million dollars. Their trade is principally in the United States of America, but they find a market for some of their goods in South America, Germany and other countries. A statement is produced (Exhibit A. 16) showing the volume of their business in Canada for the years 1884 to 1903, both inclusive. In 1884 their sales in Canada amounted in value to \$4,844, and in 1900 to \$20,260. Since the latter year their business in Canada has been done through "The Gorham Company, Limited,"

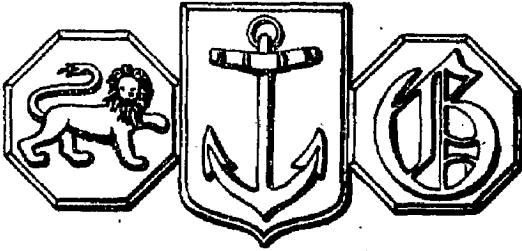
(1) 4 O. L. R. 545.

(2) 13 Gr. 523.

incorporated in February, 1901 under *The Companies Act* of Canada, the sales in Canada in the year 1903 amounting to \$23,088. For some forty years the plaintiffs have in the course of their business impressed or stamped on silverware manufactured by them the following, among other marks:

1904  
 THE  
 GORHAM  
 MANUFACTURING Co.  
 v.  
 ELLIS & Co.

Reasons  
 for  
 Judgment.



This mark, which one or more of their witnesses spoke of as the "house mark", had been previously used in a similar way by the plaintiffs' predecessors in the business for a period of ten or twelve years. In their application to register their trade-mark in the United States Patent Office, to which reference will be made, they state that the trade-mark had been continuously used by them since about January 1st, 1853. As they did not come into existence as a corporation until 1863 that is not literally correct; but identifying them with their predecessors there would appear by the evidence given in this case to have been a user of the mark since about that time. Prior to 1868 the silverware on which the mark mentioned was placed contained nine hundred parts of pure silver out of one thousand parts, that is, it was of the same standard as United States coin. Since then they have manufactured no silver that was not equal in fineness to sterling silver, in which nine hundred and twenty-five parts out of one thousand are pure silver. On silverware of that quality they have placed the mark mentioned and the word "sterling." Some silver of a

1904  
 THE  
 GORHAM  
 MANUFACTURING Co.  
 v.  
 ELLIS & Co.  
 ———  
 Reasons  
 for  
 Judgment.  
 ———

higher quality has been manufactured by them, and on this has been impressed in addition to the "house mark" the representation of an eagle. Not only has the plaintiffs' mark been impressed or placed upon the silver goods manufactured by them, but it has been made a prominent feature in their advertisements. In the United States they have advertised widely and at great expense, and in Canada they have been advertising their goods for about three years. With reference to the sale in Canada of silver goods manufactured by the plaintiffs, the evidence of Mr. Henry Birks, of Montreal, goes to show that as early as 1857, or shortly thereafter, such goods were on the market at Montreal; and assuming, as I think from the evidence as a whole one ought to assume, that such goods bore the plaintiffs' mark, that would go to show a use in Canada of this mark as early as the year last mentioned, or within a year or two thereafter.

In 1895 the plaintiffs sought to protect in some measure their mark by registering in the Copyright Office at Washington "a photograph, the title or description of which was in the following words, to wit: Lion, Anchor, & Co." For reasons that are given by one of the witnesses, but which there is no occasion to repeat, no attempt was made to register the mark as a trade-mark until the year 1899. On the 19th of December of that year, the mark was registered in the United States Patent Office, as a trade-mark to be applied to silverware; and on the 10th of April, 1892, they obtained in Canada registration of the mark as a specific trade-mark to be applied to the sale of articles formed in part or wholly of silver. Underneath the central panel of the drawing, accompanying the statement and declaration by which the application for registration in the United States was made, is the word "sterling" in plain Latin text, as mentioned in

the statement, but it is added therein that this word may be omitted. In the Canadian certificate of registration the plaintiffs' trade-mark is stated to consist "of the representation of three raised panels placed "side by side." The central panel has the conventional shape of a heraldic shield on which is the representation of an anchor. The panel on the left of the central panel has on it the representation of a lion, and the panel on the right of the central panel has the capital letter "G" in old English, as per the annexed pattern and application." An illustration of this pattern has already been given.

And this description of the trade-mark is to be found in the application mentioned :

"The said Specific Trade-mark consists of the representation of three raised panels. These have generally been arranged as shewn in the accompanying facsimile, in which the central panel has the conventional shape of a heraldic shield on which is the representation of anchor. The panels on each side of the central panel are inclosed by a series of straight lines, the points of inter-sections of the lines being within a circle. The panel on the left of the central panel has on it the representation of a lion, and the panel on the right of the central panel has the capital letter "G" in old English. When the trade-mark is required to be very small, the representations of the anchor, the capital letter "G" and the lion may be omitted without altering the character of the trade-mark, the essential feature of which is the representation of three raised panels placed side by side."

The defendant company have a factory and warehouse at Toronto where they carry on the business of manufacturing gold and silver goods and watch cases. The business was commenced in 1877 by Mr. P. W.

1904

THE  
GORHAM  
MANUFACTURING Co.  
v.  
ELLIS & Co.

Reasons  
for  
Judgment.

1904  
 THE  
 GORHAM  
 MANUFACTURING Co.  
 v.  
 ELLIS & Co.  
 ———  
 Reasons  
 for  
 Judgment.  
 ———

Ellis in partnership with his brother and another person. In 1901 the company was incorporated. Their present business, judged by Canadian standards, is a large one. The value of the sterling silverware annually manufactured by them is between one hundred and fifty thousand and two hundred thousand dollars. Prior to the year 1885 they used on sterling silver goods manufactured by them a mark showing a lion and a crown. The same mark, with the addition of a quality mark, was used by them on goods made of gold. In the year last mentioned they registered a specific trade-mark to be applied to the sale of gold, silver and other jewellery which consisted of the representation of a maple leaf with the letter "E" superimposed thereon. Up to, and including the year 1899, they put on sterling silverware manufactured by them the word "sterling" and the trade-mark mentioned, and sometimes the figures  $\frac{925}{1000}$ . In 1900 they made another change, and adopted a mark for silverware that was afterwards (on the 13th day of May, 1902) registered as a specific trade-mark to be applied to the sale of sterling silver jewellery, flat and hollow ware, medals and other sterling silver goods, and which consisted of three panels bearing an anchor, a maple leaf with the letter "E" thereon, and a lion. The following is a reproduction of the sketch or pattern submitted with the defendants' application :



This mark was, it appears, first used by the defendants on some silver stampings imported from Birmingham during the summer of 1900, and which when



finished at Toronto, were offered to the trade about the first of August of that year.

It will have been observed that the plaintiffs' trademark was registered in Canada on the 10th of April, 1902, and the defendants' on the 13th of May of the same year. Prior to such registrations there had been some correspondence between the parties on the questions now in issue between them, which shows what the controversy was and how it originated. On the 19th of February, 1902 the plaintiffs' solicitors at Providence, Rhode Island, wrote to the defendants as follows:

"PROVIDENCE, R.I., Feb. 19, 1902.

"MESSRS. P. W. ELLIS & Co.,

"Toronto, Canada.

"GENTLEMEN,—We have, at the request of the  
 "Gorham Manufacturing Company, examined  
 "samples of, and the printed representations of,  
 "your Richmond pattern sterling table ware, and  
 "have compared the same with the different pieces  
 "of the 'Lancaster' pattern of the Gorham Manu-  
 "facturing Company. We find that your patterns  
 "are exact copies of the original Gorham design,  
 "the 'Lancaster'. The imitations are so exactly  
 "like the original that it is evident the dies must  
 "have been made from the original Gorham  
 "pattern.

"Not only have you exactly copied the designs  
 "in every detail, but you have so nearly imitated  
 "the Gorham Manufacturing Company's trade-  
 "mark, by the use of the representation of the  
 "anchor and the lion, that the purchaser, giving  
 "such attention as an ordinary purchaser usually  
 "gives, will be deceived and purchase your goods  
 "believing they are purchasing the well-known

1904  
 THE  
 GORHAM  
 MANUFACTURING CO.  
 v.  
 ELLIS & Co.  
 Reasons  
 for  
 Judgment.

1904  
 THE  
 GORHAM  
 MANUFACTURING Co.  
 v.  
 ELLIS & Co.  
 ———  
 Reasons  
 for  
 Judgment.  
 ———

“ standard quality of goods manufactured by the  
 “ Gorham Manufacturing Company.

“ Under the law preventing unfair competition in  
 “ trade, you are liable for damages to the Gorham  
 “ Manufacturing Company.

“ We are instructed by the Gorham Manufac-  
 “ tory Company to proceed against you unless you  
 “ cease manufacturing and selling the goods.

“ Please consider this matter carefully and let  
 “ us know at as early a day as possible what  
 “ action you propose to take in this matter, and  
 “ oblige,

“ Very truly yours,

“ (Sgd.) JOSEPH A. MILLER & CO.”

“ B.S.W.

On the 25th of February, 1902, the defendants' soli-  
 citors made the following reply to the plaintiffs' com-  
 munication :

“ TORONTO, Feb. 25th, 1902.

“ JOS. A. MILLER & Co.,

“ Solicitors of Patents, &c.,

“ 435 Butler Exchange,

“ Providence, R.I.

“ DEAR SIRS,—Your letter of Feb. 19th to  
 “ Messrs. P. W. Ellis & Co. of this city has been  
 “ handed to us. We have gone over the matter  
 “ with our clients, and we beg to state that in the  
 “ first place the patterns to which you refer are  
 “ similar to what the Gorham Manufacturing  
 “ Company manufacture under the designation of  
 “ ‘Lancaster’. The designs are by no means ori-  
 “ ginal, and in fact the same design is and has been  
 “ for a very long time for sale in this market in  
 “ plated ware ; and likewise, we observe from publi-  
 “ cations, is apparently for sale in the United States

“ in plated ware. There is indeed so far as we  
 “ can see nothing original in the design, the bead-  
 “ ing around the edge being a very old and familiar  
 “ pattern, the roses being obviously simply a copy  
 “ from the natural flower. In any case there is  
 “ and can be no property by your clients in such  
 “ a design. Further the design is not registered  
 “ under our Act.

1904  
 ~~~~~  
 THE  
 GORHAM  
 MANUFACTURING Co.  
 v.  
 ELLIS & Co.

Reasons  
 for  
 Judgment.

“ With reference to what you say as to imitation  
 “ of the Gorham Company's trade-mark, we beg  
 “ to say that our clients have so far from imitating  
 “ the Gorham Company's trade-mark distinctly  
 “ placed their own trade-mark, namely a maple  
 “ leaf with the letter 'E', their own registered  
 “ trade-mark, on their goods; and so far as the use  
 “ of the Anchor and Lion is concerned there  
 “ is nothing whatever original in that. On the  
 “ contrary that combination is one of the English  
 “ Hall-marks, placed particularly upon hall-marked  
 “ goods coming from Birmingham, and has been  
 “ coming into this country in that way for a very  
 “ large number of years. So far from attempting  
 “ to deceive the public into the belief that their  
 “ goods are those of your clients, our clients are  
 “ exceedingly anxious and desirous of having their  
 “ goods sold as their own goods. They are quite  
 “ well satisfied with their own reputation for  
 “ sterling goods, and quite satisfied to sell their  
 “ goods under their own name as evidenced by  
 “ the fact that they have given their goods a dif-  
 “ ferent name, also placed their own trade-mark  
 “ plainly upon it, and the goods are invariably  
 “ sold by them as under their own name and  
 “ being, as they are, their own manufacture.

“ We beg, therefore, to state to you that our  
 “ clients do not propose to alter their method of

1904  
 ~~~~~  
 THE  
 GORHAM  
 MANUFACTURING Co.  
 v.  
 ELLIS & Co.

Reasons  
 for  
 Judgment.

“conducting their business and if your clients see  
 “fit to take any action in the matter, we will  
 “accept service of any process you may see fit to  
 “issue.

“Yours very truly,

“BEATTY, BLACKSTOCK,  
 NESBITT, FASKEN & RIDDELL.”

“(Sgd.) ROBERT MCKAY.”

The plaintiffs, having first registered their trade-mark in Canada, instituted the present proceedings against the defendants for the infringement of such trade-mark. The statement of claim was filed on the 24th of October, 1902, and the statement in defence on the 22nd November following.

The defences are in substance: (1) That the trade-mark in question is not the plaintiffs'; and that they are not entitled to the exclusive use thereof; and (2) that the defendants have not infringed such trade-mark.

Before taking up the first of these grounds of defence, it may be convenient to state that the defendants have shown that they did not adopt the trade-mark that they have been using since the year 1900 for the purpose of unfair competition in trade, or with any view of obtaining any advantage from the reputation that the plaintiffs' goods had acquired either in the United States or in Canada. They did not export their goods to the United States, and in Canada there would at least be nothing to gain by imitating the plaintiffs' trade-mark, as the volume of the defendants' business in Canada is much greater than the plaintiffs'. The resemblance between the two trade-marks results from the fact that both resemble to a greater or less extent the hall-marks that are, in Great Britain, applied to goods manufactured from

sterling silver, and more especially the marks that are used at the Birmingham Assay Office. The defendants and other Canadian manufacturers of silverware have very generally been accustomed to put on such ware certain marks that more or less resemble the British hall-marks; and it is in general admitted that some advantage was thought to be derived from such a use of such marks. Mr. Harry Ryrie, of Toronto, one of the witnesses examined for the defendants, stated that without any intention on the part of the manufacturers to deceive anyone they have very generally been putting on their silverware marks resembling such hall marks. And Mr. John Wanless, Jr., a retail dealer in silverware in Toronto, who was examined on the part of the plaintiffs, testified that at one time the word "sterling" was a better mark, but that unfortunately it is not to-day in as good repute as it was, because the "sterling" mark has been abused, especially in the United States, where it had often been stamped on goods only perhaps 500 fine. So that dealers are beginning to fall back more or less on the marks that are used by companies of recognized reputation; and that within late years the tendency was in that direction.

Mr. P. W. Ellis, on cross-examination, denied that the defendants had used such marks with the intention of giving their customers the impression that the goods were hall-marked, but to meet a demand by the public for something to shew that such goods were of real silver and not an imitation.

The defendants suggest that at the time when the plaintiffs' predecessors in business first used the mark now in question, it was equally to their advantage to adopt a mark resembling a British hall-mark, especially as they were applying it to goods that were not as fine as sterling; and that their adoption of the mark

1904  
 THE  
 GORHAM  
 MANUFACTURING Co.  
 v.  
 ELLIS & Co.

Reasons  
 for  
 Judgment.

1904  
 THE  
 GORHAM  
 MANUFACTURING Co.  
 v.  
 ELLIS & Co.  
 ———  
 Reasons  
 for  
 Judgment.  
 ———

is to be accounted for in that way. The plaintiffs have a different explanation. Of the three symbols used in their mark, the letter "G" stands, it is said, for "Gorham"; the representation of an "anchor" is to be found in the official seal of the State of Rhode Island, and was, it is suggested, adapted therefrom; and the use of the figure of a "lion" is not explained. It is not necessary to come to any conclusion as to which of the two suggestions or explanations is the more probable. What has to be considered here is not the reasons or motives that led the plaintiffs' predecessors in business to adopt the mark in question, but the mark itself.

By reference to the description of the plaintiffs' trade-mark given in the extract that has been taken from their application in Canada therefor, it will be seen that it is stated that when the trade-mark is required to be small the representation of the anchor, the capital letter "G" and the lion may be omitted without altering the character of the trade-mark, the essential feature of which is the representation of three raised panels placed side by side. Now it does not appear to me to be possible to omit from this mark the letter "G" and the representations of the anchor and of the lion without altering its character as a trade-mark; and there is, I think, no evidence that in the use of it such an omission has ever been made or attempted. But assuming the features mentioned to be omitted, there would be left nothing but the representation of three raised panels placed side by side, which is said to be the essential feature of the trade-mark. And here I agree with Mr. Aylesworth that what is claimed is not three raised panels, but the representation of three raised panels; and that while the stamp, by which in practice the mark is placed on silver ware makes in the silver what are in fact sunken

panels or shields, the effect produced may, at least to some eyes, appear to be a representation of raised panels or shields. But such a mark is none the less a representation as well of what it consists of, namely, sunken panels or shields. So that there is not in that respect anything distinctive in the use of a mark applied to silver in that way. And such stamps or punches have been used for that purpose, and with that or a like effect for so long a time and so commonly, and in such a variety of forms, that it is impossible, it seems to me, to sustain the plaintiffs' claim to an exclusive right to use as a trade-mark to be applied to silver ware the representation of three panels or shields placed side by side, whether to the eye such panels or shields have the appearance of being raised or sunken. But even if it were thought that such a claim could be sustained, it would be necessary to so limit it as not to interfere with the long established and general use by others of marks which made in the same way have a like or similar effect. So limiting the plaintiffs' trade-mark the defendants have not, I think, infringed it. Assuming for the moment that the latter have a right to stamp or impress upon silver goods made by them the three devices or symbols used by them, there is no objection to the manner in which that is done. They, in common with others, have a right to use for that purpose a stamp or punch, and it is no objection to such use that the sunken shield or panel which the stamp produces and on which such devices or symbols are shown, should to the eye of some persons appear to be raised panels or shields. Apart from the representation of a lion and of an anchor, and the letter "G" shown in the plaintiffs' trade-mark on the representation of the three panels, there would be no question of infringement here. It is only when one takes the trade-mark as a whole, as it has been used, that the

1904

THE  
GORHAM  
MANUFACTURING CO.  
v.  
ELLIS & CO.

Reasons  
for  
Judgment.

1904  
 THE  
 GORHAM  
 MANUFACTURING Co.  
 v.  
 ELLIS & Co.  
 ———  
 Reasons  
 for  
 Judgment.  
 ———

question of infringement really arises. And when one does that he must of necessity, I think, take these symbols as they have been used and described as necessary or essential features or characteristics of the trade-mark. It might perhaps be sufficient to take the plaintiffs' own definition of the essential feature of their trade-mark, and so to dispose of the case; but I am inclined to go further, and, notwithstanding what they themselves have set up in their application to register the trade-mark, to give them the benefit of the mark they have used, and of which they registered a facsimile, if their right to the exclusive use thereof can be sustained.

Coming then to that question, the objections, urged against the plaintiffs' claim to a right to the exclusive use in Canada of the trade-mark represented by the facsimile registered by them, are:—(1) That they could not in Canada acquire a title to such trade-mark, and a right to its exclusive use, because it so closely resembled the British hall-marks, and more particularly the Birmingham hall-mark, on silver goods imported into Canada, as to be calculated to deceive or mislead the public; and (2) That two of the three symbols used, namely, the representations of a lion and of an anchor were in common and general use by silversmiths in Canada, as marks to be applied to silverware.

A reference to the statutes respecting the marking of gold and silver plate in Great Britain and Ireland will be found in *Sebastian's Law of Trade-Marks*, (1). Of the statutes applying to England, the present enquiry is principally concerned with those that have reference to the Birmingham Assay Office, of which Mr. Carslake, the solicitor of that office, has made mention. The earliest of these

(1) Appendix H. pp. 614-625.



is 13 Geo. III, c. 52 (1772) referred to at page 616 of *Sebastian*. As a result of these statutes there are to be found on silverware or plate made in England four or five marks, which consist of the following representations, symbols or letters:—(1) The standard mark which for sterling silver (that is silver 11 oz. 2 dwt. fine) is a lion passant, and for silver 11 oz. 10 dwt. fine, Britannia; (2) the date mark, that is, a letter to denote the year, which is changed annually; (3) the maker's mark, which consist of the initials of his name, or of the name of the firm; (4) the duty mark (disused since 1890, 53-54 Vict. c. 8) which was the sovereign's head; and (5) the Assay Town Mark, which for London is a leopard's head; and where the silver is of the higher fineness mentioned, a lion's head erased; for Exeter, a castle; Chester, a dagger and three sheaves; Newcastle, three castles; Sheffield, a crown; Birmingham, an anchor. In *Redman's Illustrated Handbook of Hall-Marks, Date Letters, &c.*, (Exhibit B-47), at page 185, is given a list of the date letters used at the Assay Office, Birmingham, from the year 1773 to the year 1899. It would appear from the evidence of Mr. Westwood, the assay master at Birmingham, that while the list is, in respect of the letters used, in general correct, it cannot be implicitly relied upon with respect to any particular date, as the compiler has at least in one instance given a "j" that was not used. For example we find a capital "G" in old English given for the year 1831-1832, when in fact that letter in that form was used the year previous, 1830-1831. But that is of no importance here, as nothing turns upon the year in which the letter mentioned was used, or in the view that I take of the case of the particular letter used. The use of this letter was, however, referred to frequently in the evidence and in argument, for the reason that omitting other

1904

THE

GORHAM  
MANUFACTURING Co.v.  
ELLIS & Co.Reasons  
for  
Judgment.

1904  
 THE  
 GORHAM  
 MANUFACTURING Co.  
 v.  
 ELLIS & Co.  
 Reasons  
 for  
 Judgment.

marks, there will be found in the Birmingham Hall-mark of the year 1830-1831 and in the plaintiffs' trade-mark, representations of a lion passant, an anchor, and the capital letter "G" in old English. A reproduction of the plaintiffs' registered trade-mark has been given. The following is an illustration of the Birmingham Hall-mark for the year mentioned :—



In the Birmingham Hall-mark the lion faces to the left; in the plaintiffs' trade-mark it faces to the right. In the latter the form of the panels or shields has in use been uniform; in the former such panels or shields have, it appears, from time to time varied in form, and there are some differences between the form of the panels or shields used by the plaintiffs and those used at the Birmingham Assay Office. With regard to the capital letter "G", in old English, in the plaintiffs' trade-mark it would not, I think, be fair to limit the comparison to the use of that letter in old English in the hall-mark for the year 1830-1831, because in other years a different date letter has been used, and there is no evidence of the importation into Canada of any silver goods made at or near Birmingham in that year, or bearing that date letter. With reference to the use in the plaintiffs' trade-mark of this letter, I do not think more ought to be urged against the mark than that it contains a letter which, while it may stand for the word "Gorham", may also in the connection in which it is used be taken by many persons to be the date letter of a hall-mark. I do not put the objection on any higher ground than that. Then, as has been seen, there are to be found on English silverware other

marks besides the hall-mark, such as the maker's mark or initials, and on plate made prior to the year 1890 the duty mark. In some cases it would appear that on silver goods manufactured by the plaintiffs other marks are placed; but this is not so uniform or so well understood as the use on English silverware of the maker's mark and the duty mark. So that it cannot, I think, be doubted, that anyone who was acquainted with the Birmingham Hall-marks, and with the plaintiffs' trade-mark, and who examined the same carefully, could distinguish the one from the other, and would not be liable to be deceived. But on the other hand there are others, and probably a considerable number of persons, who might, I think, mistake the plaintiffs' mark for the Birmingham Hall-mark, or for a hall-mark. Conceding that there are differences by which the two marks as they are respectively used on silverware may be distinguished, there is, it seems to me, such a resemblance between them that the plaintiffs' mark is liable to be mistaken for the Birmingham Hall-mark, or for a hall-mark, and is calculated to deceive and mislead the public.

It is argued, however, that the statutes under which silverware made in England is hall-marked are not in force in Canada, and with that I agree. If they were in force here there would be little or no room for argument. It is because the statutes referred to are not in force in Canada that the plaintiffs are enabled to use their mark here. But to use it, or to be allowed to use it, or even to have a right to use it, are different things from having an exclusive right to its use. While the statutes under which hall-marks are placed on British silverware are not in force in Canada, goods bearing such marks are exported to Canada and put upon the market here, and that constitutes a use of such marks in Canada. The marks are, it is true, not trade-marks,

1904  
 THE  
 GORHAM  
 MANUFACTURING Co.  
 v.  
 ELLIS & Co.  
 Reasons  
 for  
 Judgment.

1904  
 THE  
 GORHAM  
 MANUFACTURING Co.  
 v.  
 ELLIS & Co.

Reasons  
 for  
 Judgment.

but they are marks used in trade to denote the standard or quality of the goods to which they are applied. As all makers of that class of goods have to use such marks, the use becomes general, and is not, as in the case of a trade-mark, confined in its use to one maker only, or to a limited number of makers. In that way such marks come to stand for the reputation for commercial honesty, not of one manufacturer only, but of the trade in general and of the country in which the goods are produced. And wherever such goods in the course of trade go, it is a matter of public interest that the public should be protected from imitations of such marks, or the use of marks that so closely resemble them as to be calculated to deceive or mislead.

In this connection it was also contended that in matters relating to trade-marks in Canada, the United Kingdom of Great Britain and Ireland is to be considered as a foreign country. And without expressing any opinion as to that one way or the other, I concede the contention for the purposes of the argument in this case. But that does not, I think, make any difference. If by the laws of France, or of the United States of America, or of any other foreign country, the makers of certain goods were required to put thereon certain prescribed marks to denote the standard or character of such goods, and goods bearing the prescribed marks were exported to Canada and put upon the market here, it would not thereafter, and while such goods were to be found in the Canadian market, be possible, I think, for any one to acquire in Canada a right to the exclusive use of such prescribed marks to be applied to the same class of goods, or to the exclusive use of any mark so closely resembling the prescribed marks as to be calculated to deceive or mislead the public. And the fact that such marks were not trade-marks, but marks used to comply with statutes

of the country of origin would not in that respect in any way alter the case. Whether anyone would in such a case be precluded from acquiring a right in Canada to the exclusive use of such a trade-mark where there was no importation into Canada of goods bearing the prescribed foreign marks, is a question on which no opinion is expressed as it does not arise in this case. In the determination of the question at present in issue it is not necessary to go beyond the proposition as stated.

The Birmingham Hall-mark goes back to the year 1773, and has been continuously in use since that date. The plaintiffs have in the United States used their trade-mark since about the year 1853. With regard to the use of the latter mark in Canada, or in one or more of the Provinces now forming part of Canada, the evidence of Mr. Henry Birks, of Montreal, shows, as has been seen, that as early as the year 1857, or within a few years thereafter (I do not know that he intended as to that to fix the exact date) the Gorham goods were being imported by Savage & Lyman, of Montreal. With regard to the importation of English silverware, Mr. Birks, being asked if he knew where the greater part of it had since the year 1857 (when he went into Savage & Lyman's employment) come from, answered that during the last several years the purchases of his firm had been, by all odds, the largest from Birmingham; but whether he wished it to be understood that he knew of such importations as early as 1857 is not clear. With reference to the same question the evidence of Mr. Thomas H. Lee, of Toronto, who was a clerk with Mr. J. G. Joseph, of Toronto, in 1853, and afterwards, in 1857, a partner in the firm of J. G. Joseph & Co., shows that in the year 1859, when Mr. Joseph died, the firm had a large business in silverware with a branch at Birmingham. It is fair, I think, to assume

1904

THE  
GORHAM  
MANUFACTURING Co.  
v.  
ELLIS & Co.

Reasons  
for  
Judgment.

1904  
 THE  
 GORHAM  
 MANUFACTURING Co.  
 v.  
 ELLIS & Co.  
 ———  
 Reasons  
 for  
 Judgment.  
 ———

that such a business could not be created in a day, and that such importations had been going on for a number of years previously. Of later importations of English silverware, the larger portions of which came, it appears, from Birmingham, there is ample evidence; but the evidence of such importations prior to 1857 or 1859 leaves, I think, something to be desired. No one, I suppose, doubts that such importations took place, and, as it is perhaps difficult after the lapse of so many years to get direct evidence thereof, one ought not to be too exacting; or if there is any real doubt about the matter the case is one perhaps in which leave might be given to adduce further evidence. The burden of proof, however, is in this respect upon the defendants, and it is for them to discharge that burden. Taking the evidence as a whole, I think this may with fairness be said, and I find, that during the time the Gorham goods have been on the Canadian market English silverware hall-marked at the Birmingham Assay Office has also been upon the same market. During that period, probably for a period considerably longer, Canadian silversmiths have very generally used as a silver mark the representation of a lion. Other marks, such as a representation of the sovereign's head, or a crown, have also been used. Of some fifty impressions appearing on a plate prepared by Mr. John Leslie, of Montreal, silversmith, to show the marks put on goods manufactured at Montreal by R. Hendry, R. Hendry & Co. and Hendry & Leslie, for different persons and firms who were customers of theirs, all show a lion, and all but one the sovereign's head. In two instances there is a crown, in two a beaver, and in one three castles. In ten cases, what would correspond with a date letter is shown; in some thirty instances the initials of the name of the customer or dealer appear;

and in thirteen of such impressions the names of the dealers are shown in full.

With regard to the use in Canada of the representation of an anchor as a silver mark, such use has not been general, but has been limited to a few silversmiths. Nor is there any evidence that it has been so used in Canada for more than thirty or thirty-five years. Mr. Benjamin Pearsall's testimony shows that as long ago as that he used, at Toronto, as a silver mark the representation of a lion passant, an anchor and a crown. Now whatever may be said or thought of the use by silversmiths in Canada of marks so closely resembling English marks as those that have been mentioned, this at least is clear, that there is no greater objection to their use of them than to the plaintiffs' use thereof in Canada. The lion passant has for centuries been, with silversmiths, a mark for sterling silverware; and in the absence of any statutory regulation of its use in Canada there is, it seems to me, no objection to its honest use in Canada on goods of the requisite standard of quality. But no one silversmith can appropriate the mark to himself. To the use in Canada of a letter as part of a trade-mark to be applied to silver there is no objection, if it is made clear that the letter is not a date letter. If that is not shown its use suggests that the goods are hall-marked, and the suggestion is not true. Where, however, as in the defendants' trade-mark, the letter is placed upon something so distinctively Canadian as a maple leaf no one can be deceived, and the use of the letter is, I think, free from objection. But here again no one can acquire a right to the exclusive use as a silver mark of any such letter by itself. To the use on silverware made in Canada of any Town Assay Mark, such as an anchor, there is the objection that it suggests not only that the goods are hall-marked; but also that they were so marked at a particular place,

1904

THE

GORHAM  
MANUFACTURING Co.

v.

ELLIS &amp; Co.

Reasons  
for  
Judgment.

1904  
 THE  
 GORHAM  
 MANUFACTURING Co.  
 v.  
 ELLIS & Co.  
 ———  
 Reasons  
 for  
 Judgment.  
 ———

and both suggestions are false. But it would not be possible for any silversmith who saw fit in Canada to use such a mark, even if its use were not objectionable, to gain a right to its exclusive use. And when a combination of all these marks is used on goods that are not in fact hall-marked, the danger of mistake and deception is increased, and the use thereof becomes more objectionable. No one can, I think, in Canada, acquire title to such a combination as a trade-mark to be applied to silverware. If I am right as to that, the plaintiffs' action fails, and there is no occasion to determine the question as to whether or not the defendants' present trade-mark is an infringement of the plaintiffs'.

There has been no application by the defendants to expunge the plaintiffs' trade-mark from the register of trade-marks. The objection to the plaintiffs' right to the exclusive use of the trade mark in question and of the title thereto is taken by the defendants, as it may be, as a defence to the action of infringement. There is no question in that respect as to the rectification of the register. But the plaintiffs, as part of the relief claimed, ask for an order directing the cancellation of the defendants' trade-mark in the register of trade-marks, and to expunge the same from such register. The ground upon which that relief is asked is that the defendants' registered trade-mark is an infringement of the plaintiffs', and so resembles the same as to be likely or calculated to deceive and mislead the public. But that ground, as we have seen, fails. It is possible,—however I express no opinion—but it is possible that the plaintiffs are otherwise aggrieved in that respect by the registration of the defendants' trade-mark, and that on other grounds they would be entitled to relief. I, therefore, reserve to them the right to apply for a rectification of the register of trade-



marks by expunging therefrom in whole, or in part, the defendants' trade-mark. With that reservation there will be judgment for the defendants and the costs will follow the event.

1904

THE

GORHAM  
MANUFACTURING Co.

v.

ELLIS & Co.

*Judgment accordingly.*

Solicitors for plaintiffs: *Barwick, Aylesworth, Wright & Moss.*

Reasons  
for  
Judgment.

Solicitors for defendants: *Beatty, Blackstock, Nesbitt, Fasken & Riddell.*