

1932

Sept. 6.
Oct. 31.

BETWEEN :

CANADIAN GOODRICH CO. LTD.....PETITIONER;

AND

BLANCHE F. HALL.....RESPONDENT.

*Trade-mark "Zipper"—Calculated to deceive—Class of goods—
Expunging.*

The petitioner, owner of the specific trade-mark "Zipper" to be used in connection with the manufacture and sale of footwear, by its petition, asks that the trade-mark of the respondent, consisting of the same word "Zipper" as applied to the sale of corsets or corsets and brassieres combined, be expunged.

Held, on the facts, that there was no likelihood of confusion in the mind of the public, that the registration of the respondent's mark was not calculated to deceive the public into purchasing the goods of the respondent believing them to be those of the petitioner, and the petition herein was refused.

2. That the petitioner, having chosen to limit its mark to footwear, cannot now ask that the respondent's mark be expunged, on the ground that it (petitioner) may at some future time make or vend corsets, or corsets combined with brassieres, wherein the sliding fasteners are employed.

PETITION to expunge the word "Zipper" used by the respondent in connection with the sale of corsets and combination garments.

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

R. S. Smart, K.C., and *M. B. Gordon* for petitioner.

J. T. Richard for respondent.

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

THE PRESIDENT, now (September 6, 1932), delivered the following judgment.

This is a petition to expunge from the register a specific trade-mark, registered in July, 1929, by Blanche F. Hall, and consisting of the word *Zipper* "to be used in connection with the sale of corsets and combination garments, namely a corset and brassiere connected together."

The petitioner, in February, 1924, registered the word *Zipper* as a specific trade-mark "to be applied to the sale of footwear," and it is set forth in the petition herein that it introduced upon the Canadian market a line of over-

shoes equipped with separable fasteners of the well known slide-controlled type, and that it was the first to apply the word *Zipper* to overshoes so equipped; it is alleged also that the B. F. Goodrich Company, a United States Corporation, which controls the petitioner corporation, had earlier introduced upon the United States market, overshoes equipped with the same kind of fasteners. The petitioner's registered mark *Zipper* was not however to be confined to footwear equipped with sliding fasteners; the mark was to be applied to footwear produced by the petitioner whatever the fastening means, and no reference whatever is to be found in the application for registration, or in the certificate of registration, indicating that the mark was to be associated with footwear equipped with sliding fasteners. The plain fact is that others may manufacture footwear employing sliding fasteners, but they cannot use the petitioner's word mark *Zipper*. In October, 1927, and prior to the respondent's application for registration, the petitioner applied for the registration of the word *Zipper* as a general trade-mark, and it subsequently varied such application by limiting the application of the proposed general trade-mark to the sale of sliding fasteners, and articles containing sliding fasteners. That application for registration was later the subject matter of proceedings in the Exchequer Court of Canada with the result that the application was there refused, and on appeal to the Supreme Court of Canada, *Lightning Fastener Co. Ltd. v. Canadian Goodrich Co. Ltd.* (1), this was in substance affirmed. The petitioner is now only claiming that the respondent's mark should be expunged.

The petitioner claims that the respondent's mark should be expunged, first, on the ground that it was registered while the petitioner's prior application for the registration of the same word as a general trade-mark was pending, and that therefore the respondent's application for registration should not have been granted while the prior application of the petitioner was pending and the subject matter of proceedings in the courts. The petitioner also claims that it was the first to apply the word mark *Zipper* to overshoes equipped with sliding fasteners; that the word has become generally associated by the Canadian public with goods

1932
 CANADIAN
 GOODRICH
 Co. LTD.
 v.
 HALL.
 Maclean J.

1932
 CANADIAN
 GOODRICH
 Co. LTD.
 v.
 HALL.
 Maclean J.

manufactured by the petitioner when equipped with the sliding fastener and that if others are permitted to use the trade-mark *Zipper* for articles equipped with such fasteners the public will be misled and caused to believe that such articles bearing such mark were manufactured or sold by the petitioner; and that the respondent should not now have the benefit of the public popularity acquired by the petitioner's mark by marketing her corset and brassiere equipped with sliding fasteners, under the trade name *Zipper*. And the petitioner's counsel also advanced the theory of "natural extension," that is to say, that the use of the word *Zipper* should be available for use by the petitioner in the natural extension of its business in connection with any goods made by it other than footwear, for example, corsets, or a corset and brassiere connected together, in which sliding fasteners are employed.

The respondent was not a party to the proceedings in the Courts to which I have referred, concerning the petitioner's application for registration of the word *Zipper* as a general trade-mark, and I am not inclined to hold that the Commissioner was without authority to act upon the application of the respondent in the meanwhile. I do not know why he should refrain from disposing of the application, even though it turned out to be a nullity had the petitioner's application had a different reception in the Courts. In view of the decision rendered by the Supreme Court of Canada in the proceedings referred to, I do not think the first ground upon which the petitioner in this proceeding relies, is now a practical one.

Then the sole question for determination is whether or not the respondent is entitled to maintain her registration. This registered mark is not associated with sliding fasteners, or any particular form of fastening; it is a word mark to be applied to a finished article, a specific mark to be applied to the particular class of goods or manufacture mentioned in the application for registration, namely, corsets, and combination garments comprising a corset and brassiere connected together, without any mention whatever of sliding fasteners. It does however appear from the pleadings, that the respondent is the holder of a Canadian patent of invention relating to the same articles as are referred to in the respondent's trade-mark registration, and it would fur-

ther appear that in the case of the combination garments, the corset and brassiere are to be connected together by means of a sliding fastener. The patent is not in evidence and it is impossible to say whether the patentee is limited to that form of fastening, but at any rate, according to the pleadings, it is to such patented article that the respondent pleads she is entitled to apply her registered mark *Zipper*. I do not think I am justified in looking at the patent at all. The fact is, that the respondent has registered the word *Zipper* to be applied to corsets, etc., and there is no mention in either the application for registration or the certificate of registration of the use of sliding fasteners. A specific trade-mark means a trade-mark used in connection with the sale of a class of merchandise of a particular description. The petitioner has the same mark for footwear, but I cannot see that if the respondent has the same mark for a corset, or a corset and brassiere combined, that confusion will result, nor do I think the petitioner can be heard to say that the respondent is not entitled to her mark because the petitioner may some time in the future make and vend corsets, or corsets combined with brassieres, wherein sliding fasteners are employed. The petitioner chose to limit its mark to footwear, and to that it is to be reasonably restricted. Upon the evidence presently before me, and the statute, I see no ground for expunging the mark of the respondent.

The petition is therefore refused with costs to the respondent.

Judgment accordingly.

1932
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