

CASES

DETERMINED BY THE

EXCHEQUER COURT OF CANADA.

BETWEEN

A

THE NEW YORK HERALD COM- } PLAINTIFFS;
PANY }

1908

June 13.

AND

THE OTTAWA CITIZEN PRINTING } DEFENDANTS.
COMPANY, LIMITED, *et al.*..... }

Trade-mark—Infringement—Specific marks—Title of comic sections of newspapers—Sale of newspapers containing titles without previous copyright—Effect of, on right to register titles as specific trade-marks.

In an action for the infringement of two specific trade-marks, consisting of the words "Buster Brown" and "Buster Brown and Tige" as applied to the sale of comic sections of newspapers, etc., it appeared that the plaintiff had not registered such words, or titles, as trade-marks in Canada until the year 1907, although from 1902 onwards they had been selling in this country comic sections of a newspaper, published in New York, with the words "Buster Brown" and "Buster Brown and Tige" applied to the same without having sought and obtained the protection of copyright therefor under the Dominion Copyright Act.

Held, that, upon the facts, even if the said words, or titles, were the subject of valid trade-marks (*quoad hoc dubitante*), the plaintiffs had abandoned to the Canadian public any exclusive right they may originally have had to use the same as trade-marks.

ACTION for the infringement of trade-mark.

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

May 4th, 1908.

The case was now argued.

R. V. Sinclair, K.C. and *D. H. McLean* for the plaintiffs;

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 of Counsel.

J. S. Ewart, K.C. and *F. M. Burbidge* for the defendants.

For the plaintiffs it was contended that under their trade-marks registered in Canada they had an absolute right to restrain the defendants from publishing comic sections of their newspaper setting forth the adventures of "Buster Brown" and "Buster Brown and Tige."

The plaintiffs had been manufacturing and selling comic supplements with the trade-marks "Buster Brown" and "Buster Brown and Tige" applied to them since 1902 in the United States, and in July, 1907, they had registered the trade-marks in Canada. About the time of the registration of the trade-marks in Canada, the defendants had begun to sell and continued to sell comic sections of the "Saturday Evening Citizen" in Canada with the trade-marks of the plaintiffs applied to them.

The above names had been adopted for use by the plaintiffs for the purpose of distinguishing a series of comic sections manufactured and sold by them from similar productions made and sold by others, and so they were the subject of valid trade-mark. (*Partlo v. Todd* (1); *McAndrew v. Bassett* (2); *Borthwick v. Evening Post* (3); *Canada Publishing Company v. Gage* (4); *Carey v. Goss* (5); *Rose v. McLean Publishing Company* (6); *Scrutton on Copyright* (7); *New York Herald Company v. The Star Co.* (8); *Dixon Crucible Company v. Guggenheim* (9).

For the defendants it was argued that the title of a literary production cannot be the subject of a valid trade-mark under the Canadian statute. It is not a "business

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

(2) 4 DeG. J. & S. 380.

(3) L. R. 37 Ch. D. 449.

(4) 11 S. C. R. 306.

(5) 11 Ont. R. 619.

(6) 24 Ont. A. R. 240.

(7) 3rd. ed. p. 109.

(8) 146 Fed. Rep. 204 and 146 Fed. Rep. 1023.

(9) 2 Brewst. (Pa.) 321.

device" within the meaning of R. S. 1906, c. 71, sec. 5. It could not be registered under the English Acts, see *Licensed Victuallers Company v. Bingham* (1); *Bradbury v. Beeton* (2); *Dicks v. Yates* (3); *Schove v. Schiminické* (4). None of the English authorities show that an injunction against the use of a literary title has ever been issued upon the ground of it being a trade-mark; but they proceed upon the common law right to prevent deception. The case here presented is under the statute, as the court has no jurisdiction to enforce the common law right.

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Secondly, the plaintiffs could not register the names in question as a trade-mark because they were in general use long before they pretend to have adopted them. Nor did they ever acquire any title to their exclusive use. (*Leather Cloth Company v. American Leather Cloth Company* (5); *Gage v. Canada Publishing Company* (6); *National Starch Company v. Munn's Patent* (7).

Thirdly, the neglect to copyright the comic sections with the titles in question attached causes the publications as a whole to become *publici juris*. They were brought into Canada and sold without the protection of copyright, and anyone could reprint them for sale if he saw fit. (*Clemens v. Belford* (8); *Singer Mfg. Company v. Wilson* (9); *Singer Mfg. Company v. Loog* (10); *Jollie v. Jaques* (11).

CASSELS, J., now (June 13th, 1908) delivered judgment.

The plaintiffs in this action sue the defendants for an alleged wrong on the part of the defendants in infringing the trade-marks of the plaintiffs.

- (1) 38 Ch. D. 139.
 (2) 39 L. J. Ch. 57.
 (3) 18 Ch. D. 76.
 (4) 33 Ch. D. 546.
 (5) 11 H. L. C. 546.

- (6) 6 Ont. R. 80.
 (7) [1894] A. C. 275.
 (8) 14 Fed. Rep. 728.
 (9) 3 App. Cas. 376.
 (10) 18 Ch. D. 395; 8 App. Cas. 15.

(11) 1 Blatch. 618.

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There is little dispute as to the facts in question.

On the 6th July, 1907, the plaintiffs registered in the proper office and obtained the certificate of registration required by the statute of a specific trade-mark consisting of the words "Buster Brown" to be applied to the sale of comic sections of newspapers, etc.

On the 15th July, 1907, the plaintiffs registered in the proper office and obtained a certificate of registration required by the statute of a specific trade-mark consisting of the words "Buster Brown and Tige" to be applied to the sale of comic sections of newspapers, etc.

"Buster Brown" is not an ordinary youth generated as other lads, but was conceived in the office of the plaintiffs in New York in the year 1902.

He was a progressive youth of a saintly countenance and apparently born with such a superabundance of mischievous tendencies as required at a very early age the addition to his ménage of a dog called "Tige" who could assist him in his pranks.

From 1902 onwards The New York *Herald* in their Sunday edition, as part of the comic section of their paper, published a serial illustrated story of Buster Brown and his dog Tige.

These comic sections were received over a considerable portion of the world by the manly youth with great eagerness, and while they may have had a tendency to make the lives of parents blessed with boys slightly more unhappy, they became a lucrative source of revenue to the *Herald*.

If the trade-marks in question are the valid subject matter for a trade-mark, I think the plaintiffs entitled to them. I do not think the prior use of the name as detailed by the witness Epstein during the slight lapse of James Crossley from inebriety to sobriety sufficient to invalidate the trade-marks.

Neither can I agree with Mr. Ewart's contention that Buster Brown must be considered as a real personage. If it had been George Washington or Napoleon, or any other distinguished person, of course anyone would have had the right to publish new tales of pranks when these distinguished personages were youths. But Buster Brown is of an entirely different conception.

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I have read over the cases cited and the argument, and a great number of other cases.

It has to be borne in mind that this action must be determined by the sole question whether or not the trade-marks are valid and whether the defendants have infringed.

No question of fraud at common law, or of passing off, have been raised, nor would it be within my jurisdiction to try such cases.

In considering the various authorities cited it must be noticed that the greater number are not in reality based on the trade-mark, although language has been used in some apt to mislead.

Many of them are cases in which the newspaper in question was the property of partners and the title passed as part of the assets of the business, but not because the ordinary English words distinguishing the title were capable of being trade-marks.

Other cases depend on fraud, the misleading of purchasers and obtaining the benefit of the business of the plaintiffs.

The case of *The New York Herald Company v. The Star Co.* (1); affirmed by the Circuit Court of Appeals (2); is apparently a strong case in favour of the plaintiffs. I have a high regard for the opinion of these judges, but do not see my way to come to the same conclusion in this case.

(1) 146 Fed. Rep. 204.

(2) 146 Fed. Rep. 1023.

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The motion in that case was an interlocutory, one and the reasons given are scant.

Filed with me as part of his argument by counsel for the plaintiffs is a judgment of Mr. Justice Dowling of the Supreme Court of New York County in a case of *Outcault vs. Cupples* of date 21st June, 1907. I would gather from this judgment that in addition to the registered trade-marks in the United States the serial picture story has been copyrighted in the United States also. No copyright has been asked for or obtained in Canada.

From 1902 onwards the *Herald* has been selling their paper in Canada without the protection of the copyright statutes and without complying with the requirements of the statutes. The result is that apart from questions of fraud (with which I have nothing to do) anyone in Canada could republish the sheets of the *Herald* including the names of Buster Brown and Tige.

In a very early case *Jollie vs. Jaques* (1); decided by Mr. Justice Nelson, it was held that where in an action on copyright the plaintiff failed to make out title to his copyright the question whether the court will interfere to permit the use of the title of the work upon principles relating to the good-will of trades cannot be entertained, as the court has no jurisdiction of such a question.

“The title or name is an appendage to the book or piece of music for which the copyright is taken out, and if the latter fails to be protected the title goes with it, as certainly as the principal carries with it the incident.” (2).

See also *Kerly on Trade-marks*, (3); and case cited of *Clemens vs. Belford*, (4); *Sabastian on Trade-marks*, (5). There are numerous cases such as the reproduction of Webster's Dictionary after copyright had expired, where it was held that the defendant having the right to publish the dictionary the right to the name followed.

(1) 1 Blatch. 618.

(2) 1 Blatch at p. 627.

(3) 2nd Ed. p. 487.

(4) 14 Fed. Rep. 728.

(5) 4th Ed. p. 297.

“But there is no exclusive right to a trade name on a publication which has been dedicated to the public without copyright, or on which copyright has expired.”

Hesseltine on Trade-marks, (1).

I would have thought it extremely doubtful, having regard to the terms of the Canadian statute as to trade-marks, that these words “Buster Brown” and “Buster Brown and Tige” were the subject-matter of a trade-mark. But under the facts of the case they become public property so far as this court is concerned.

I think the action must be dismissed with costs, to be paid by the plaintiffs to the defendants.

*Judgment accordingly**

Solicitor for plaintiffs: *D. H. McLean*.

Solicitors for defendants: *Ewart, Osler, Burbidge & McLaren*.

(1) Ed. 1906 p. 205.

*Affirmed on appeal to the Supreme Court of Canada.

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