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10, 1951

No. 47 of 1948.

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In the Privy Council.

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| <p>ON APPEAL</p> <p><i>FROM THE COURT OF APPEAL FOR JAMAICA.</i></p> | <p>UNIVERSITY OF LONDON W.C.1.</p> <p>15 JUL 1953</p> <p>INSTITUTE OF ADVANCED LEGAL STUDIES</p> |
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BETWEEN

CECIL DE CORDOVA
 G. J. DE CORDOVA
 CECIL DE CORDOVA & CO. LIMITED (Defendants) *Appellants*

AND

10 VICK CHEMICAL COMPANY (Plaintiffs) - - *Respondents*

AND

IN THE MATTER of an Application by CECIL DE CORDOVA & Co.
 LIMITED

AND

IN THE MATTER of the Registered Trade Marks Nos. 1852
 and 3707 of VICK CHEMICAL COMPANY LIMITED

AND

IN THE MATTER of the Trade Marks Law (Chap. 272).

Case for the Appellants

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THE PROCEEDINGS.

RECORD.

1. This is a consolidated appeal by leave of the Supreme Court of Judicature of Jamaica from an Order of the Court of Appeal in Jamaica (Hearne C.J. and Carberry and MacGregor P.JJ.) dated the 12th January 1948 which reversed an Order of Savary J. dated the 14th January 1947.

p. 95.
p. 74.

2. The Appellants Cecil de Cordova, G. J. de Cordova and Cecil de Cordova & Co. Ltd. were Defendants in an action for the infringement of two Trade Marks registered in the name of the Respondents and the Appellants Cecil de Cordova & Co. Limited were the Applicants in a motion to rectify the Register of Trade Marks by expunging the said Trade Marks, which has been treated as a Counterclaim to the action.

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LEGAL STUDIES,
 25, RUSSELL SQUARE,
 LONDON,
 W.C.1.

3. The Respondents are an American Corporation, carrying on business as manufacturing chemists. In the year 1923 they commenced to market in Jamaica a medicament which consisted of a salve or ointment which could be rubbed into the body and at the same time partly vaporise, the released vapour being beneficial when inhaled. To this medicament was given the name "Vicks VapoRub," the word "Vicks" indicating the name of the Respondents and the word "VapoRub" being, as the Appellants contend, a mere misspelling of the words "Vapor" (being the word "Vapour" as spelt in the U.S.A.) and "Rub."

4. The Respondents are the Registered Proprietors in Jamaica of 10 two Trade Marks as follows :—

(i) No. 1852, dated 7th April 1924, consisting of a label mark containing the word "Vicks" in large script above the word "VapoRub" in substantially smaller script and the word "salve," a triangular device bearing the words "Vick Chemical Company" and additional matter, in Class 3 in respect of "A Medicinal Salve for external use, liver pills, headache tablets, and a liniment for the treatment of sprains, swelling and lameness, rheumatism, neuralgia, burns, sore throat, soreness of the chest, bruises and cuts, or lameness requiring a liniment of this kind, chemical, medical 20 and pharmaceutical preparations."

(ii) No. 3707, dated 13th October 1941, consisting of the word "VapoRub" in Class 3, in respect of "Chemical Substances prepared for use in Medicine and Pharmacy."

The Respondents in their Application for the registration of each of the said Trade Marks stated that they did not claim registration of such Trade Mark under the special provisions of paragraph 5 of Section 9 of the Trade Marks Law, 1911, and of paragraph 5 of Section 8 of the Trade Mark Law Chapter 272 respectively, and neither of the said Trade Marks was registered under such special provisions. 30

5. The third-named Appellants carry on business as general merchants and commission agents having on the 28th December 1943 acquired the business previously carried on in partnership by the first- and second-named Appellants. The Appellants have at all material times acted as agents and distributors in Jamaica for E. Griffiths Hughes Ltd., an English Company, who carry on a large, reputable and long established business as manufacturers of pharmaceutical products sold in the United Kingdom and for export.

6. On the 1st March 1944 the Respondents instituted proceedings against the Appellants on the grounds that the latter had advertised, 40 invoiced and sold a preparation, manufactured by E. Griffiths Hughes Ltd., and described as "Karsote Brand Vapour Rub" or "Karsote Vapour Rub" claiming damages or an account of profits and injunctions to restrain the Appellants :—

(i) from infringing the Respondents' Trade Marks Nos. 1852 and 3707 ;

(ii) from selling goods not of the manufacture of the Respondents under the name "Vapour Rub" or any other name so closely resembling "VapoRub," the name and mark of the Respondents' goods, as to be calculated to deceive; and

(iii) from passing off goods not of the Respondents' manufacture for the goods of the Respondents.

7. On the 11th October 1945 the Appellants instituted proceedings by Notice of Motion claiming an Order to rectify the Register of Trade Marks:—

- 10 (i) by the removal therefrom of Trade Mark No. 3707; and
 (ii) by expunging from the Register part of Trade Mark No. 1852, namely the word "VapoRub" or by adding to the entry relating to Trade Mark No. 1852 a disclaimer of any right on the part of the Respondents to the exclusive use of the word "VapoRub";

or such other order for rectification as to the Court should seem fit.

The grounds of objection appear from the Notice of Motion and evidence by affidavit was filed on the Motion by the Appellants and the Respondents. p. 10.

20 8. The Respondents' Action and the Appellants' Motion were heard concurrently before Savary J. on the 3rd, 4th, 5th, 6th and 7th June and the 4th, 5th, 29th, 30th and 31st July 1946. On the 14th February 1947 Savary J. gave judgment and ordered:— p. 74.

- (i) that the Respondents' Action be dismissed;
 (ii) that Trade Mark No. 3707 be expunged from the Register of Trade Marks;
 (iii) that no order be made on the Motion in relation to the words "Vicks VapoRub" contained in Trade Mark No. 1852;
 30 (iv) that the Respondents enter a disclaimer on the Register in respect of Trade Mark No. 1852 to the effect that no claim is made on behalf of "Vicks VapoRub" as a liver pill or headache powder; and
 (v) that the Respondents pay to the Appellants four-fifths of their taxed costs.

9. On the 12th March 1947 the Respondents gave Notice of Appeal in the Action and Motion. The grounds of the Appeal appear from the Notice. The Appellants did not appeal and do not now appeal from the refusal of Savary J. to make an Order on the Motion in relation to the words "VapoRub" contained in Trade Mark No. 1852. pp. 75, 81.

40 10. The Appeals on the Action and Motion were heard concurrently by the Court of Appeal before Hearne C.J. and Carberry and MacGregor P.JJ. who gave judgment on the 12th January 1948, ordering that the Judgment of Savary J. be set aside save as to his Order relating to Trade p. 95.

Mark No. 1852 and that his Order that Trade Mark No. 3707 be expunged from the Register of Trade Marks be rescinded and that the Respondents be granted injunctions as prayed for in the Writ and be paid by the Appellants the sum of £67 4s. 3d. as loss of profits and their costs of the Action and Motion in the High Court and the Court of Appeal.

p. 97.
p. 101.
p. 102.

11. The Appellants applied by Notice for leave to Appeal to His Majesty in Council in respect of both the Action and Motion and such application was heard by Savary, Carberry and MacGregor JJ. in the Court of Appeal on the 11th and 12th March 1948. On the 9th April 1948 the Court of Appeal gave reasons for granting leave to appeal and made an order consolidating the Appeals. Final leave to appeal was granted on the 5th July 1948. 10

COMMERCIAL EXPLOITATION OF RESPONDENTS' PRODUCT.

p. 35.

12. In 1876 one Richardson, a pharmacist in the United States, first marketed a medicated ointment or salve, which became partly vaporised when rubbed into the body, under the name "Vicks Croup and Pneumonia Cure." In or about 1911 he began to describe the product as "Vicks VapoRub Salve." The word "Salve" appears to have been omitted about the year 1929. Richardson's successors, the Respondents, obtained registration in the United States of the word "Vaporub" in 1915 and of label marks containing the words "Vicks VapoRub" and "Vick VapoRub" in 1932 and 1936 respectively. 20

pp. 106-128.

Exhibits 18-41.

13. The Respondents first marketed their products in Jamaica in 1923. The product was sold in a jar, carrying a label, wrapped in a carton containing a leaflet. Advertising was carried out in the local press and through the distribution of display materials and samples and sales increased until they had reached 4,200 dozen at the date of the Writ herein.

p. 49.

14. Other similar preparations have from time to time been marketed in Jamaica, some of the preparations being described as vapour rubs while others were sold under somewhat different descriptions or under a Trade Mark without a descriptive name. 30

In 1933, Benjamin Manufacturing Co. Limited, of Jamaica, marketed a Vapour Rub; in 1937 Cupal Limited, an English Company, marketed "Cupal Iodised Chest Vapour Rub" and later in the same year Ayrton Saunders & Co. Limited, another English Company, marketed "Ayrton Brand Vapour Rub." Representations were made to these Companies by the Respondents with the result that in the first two cases the names of the preparations were changed to "Vaporox" and "Rayglo Chest Balm" respectively and in the third case the preparation appears to have been taken off the market in Jamaica. 40

In 1941 "Karsote Brand Vapour Rub" was first invoiced by E. Griffiths Hughes Limited to the Appellants and sales thereof were first made in Jamaica in 1942, 90 dozen bottles being sold in that year and 1,536 bottles in the following year.

In 1942 a Vapour Rub marketed by H. & J. Kirby & Co. Limited, another English Company, was first marketed in Jamaica.

In addition, "Thermogene Medicated Rub," "Miller's Vaporising Salve" and "Buckley's White Stainless Rub," all products competing with that of the Respondents, came on the Jamaican market some years before the date of the Writ herein.

Further, a number of competing products sold under trade marks such as "Mentholatum," "Musterole" "Evapotex," "Mentho Vapo," and "Turpo" came on to the Jamaican market at various times from 1920 onwards. Several of these preparations were manufactured in the U.S.A. or Canada, countries in which the Respondents had secured registration for the Trade Mark "VapoRub."

15. The Respondents first marketed their product in England in 1910 under the description "Vicks VapoRub." The word "VapoRub" was registered in England in 1920. In 1924, to obtain exemption from Medicine Stamp Duty, the Respondents changed the description of their product to "Vick Brand Vapour Rub" under which description it has been sold ever since.

16. Other brands of vapour rub came into the English market since 1924, competing with "Vick Brand," and in 1938 E. Griffiths Hughes Ltd. first marketed "Karsote Brand" in England. Official recognition was given to the name "vapour rub" as the description of a particular preparation in the 1934 edition of the British Pharmaceutical Codex where under the monograph relating to Menthol the following statement appears:—

"Vapour rubs are preparations of menthol with other volatile substances in a base of soft paraffin and are applied to the chest for local action and on account of their value when inhaled."

The evidence establishes that the British Pharmaceutical Codex was used in Jamaica and was regarded as a work of the highest authority. In addition, a formula for "Chest Vapour Rub" first appeared in Pharmaceutical Formulæ, published by the proprietors of the "Chemist and Druggist."

VALIDITY OF TRADE MARK NO. 3707.

17. The Respondents applied on the 13th October 1941 for the registration of "Vaporub" in Class 3 in respect of "Chemical substances prepared for use in medicine and pharmacy." The Application was made on Form T/M No. 2 upon which appear the words "Applicant does not claim the registration of this Trade Mark under the special provisions of paragraph 5 of Section 8 of the Trade Marks Law Chapter 272 in regard to names, signatures or words." It was conceded at the trial that the Trade Mark did not comply with the provisions of paragraphs 1 or 2 of Section 8 of the Law. The application accordingly fell to be considered under paragraphs 3 and 4 of Section 8 of the Law.

18. To be registrable under the provisions of paragraph 3 of Section 8 of the Law a Trade Mark must contain or consist of an invented word or invented words.

p. 63. The Appellants contended and Savary J. held that "VapoRub" is not an invented word, but was a combination of the words "Vapour" and "Rub," "Vapour" being spelt in the American fashion "Vapor," the combination having no different meaning from the two words "Vapour" and "Rub." Savary J., was on this finding upheld by the Court of Appeal and the Appellants humbly submit that this finding was correct and that the Trade Mark was not registrable under paragraph 3 of Section 8 of the Law.

p. 89.

19. To be registrable under the provisions of paragraph 4 of Section 8 of the Law a Trade Mark must contain or consist of a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary significance a geographical name or a surname. The Appellants contended that "VapoRub" or "Vapour Rub" directly refer to the character of the goods and on this point they have concurrent findings of fact in their favour in the Courts below. The Appellants refer to the following evidence of the Respondents' witnesses.

pp. 64, 89.

p. 31. Francis, a druggist, in cross-examination, said: "Don't say VapoRub is apt description—Yes, it is apt description. You rub it and it volatilises."

p. 33. Haughton, a druggist, in cross-examination, said: "I would say VapoRub is a true description of the article—answers purpose completely." In re-examination, he said: "If a man told me he had seen a thing called VapoRub in U.S.A. I would think it was a salve for rubbing."

p. 37. Dunning, Vice-President of Respondents, in cross-examination, said: "In 'Vicks VapoRub Ointment' I would say ointment is generic name, VapoRub describes the type of ointment and Vicks is manufacturer."

p. 41. Henriques, Doctor, in cross-examination, said: "I would understand Vapour Rub to mean something you rub which produces Vapour for inhalation. Rubbing would stimulate skin. I would say Vapour Rub is compressed form of conveying meaning describing character and quality of ointment."

p. 43. Levy, Doctor, in cross-examination, said: "VapoRub is a description of product, but I would say it could be better described as 'Vapourising medicament.' If told it was a salve I would say VapoRub would well describe it."

p. 44. McCulloch, Doctor, in examination-in-chief, said: "Vapour Rub is something you rub that vaporises." In cross-examination, he said: "Vapour Rub Salve is a complete description of article like Vicks VapoRub."

p. 53. The Appellants also refer to the evidence of Thomas, Teacher of Chemistry, called on their behalf who stated: "I would say description 'Vapour Rub' is apt description for both preparations" (Vicks and Karsote).

The Appellants submit that the evidence establishes that the Trade Mark "VapoRub" has a direct reference to the character of the goods and is not registrable under the provisions of paragraph 4 of Section 8 of the Law.

20. The Appellants submit that upon the evidence and the findings of the Courts below the Trade Mark was not and is not properly registrable upon any of the grounds open to the Respondents under their application of the 13th October 1941. At the trial, however, the Respondents contended that notwithstanding their express disclaimer of registration under paragraph 5 of Section 8 of the Law, they were entitled to pray that paragraph in aid. To be registrable under the provisions of paragraph 5 of Section 8, a Trade Mark must contain or consist of any other (i.e. other than as specified in the four preceding paragraphs) distinctive mark, but a
10 name, signature, or word or words, other than such as fall within the description in the above paragraphs (1), (2), (3) and (4), shall not, except by order of the Court, be deemed a distinctive mark. The Respondents had not obtained an order of the Court that the Trade Mark was to be deemed distinctive, but contended at the trial that the Court should then assume the duty of deciding the question as if it were an original application under this subsection and if the Court so found it should act on the *nunc pro tunc* rule, and make an order accordingly.

21. The Appellants submit that the obtaining of an order of the Court as required by paragraph 5 is a condition precedent, imposed by the
20 Law, to the acceptance by the Registrar of Trade Marks of an application for registration of a Trade Mark made under this paragraph. If, as in the present case, an applicant expressly disclaims his intention to invoke the procedure under paragraph 5, he cannot at a later date be permitted to change his mind and treat his application as though it has not been made upon Form T/M No. 2, but upon the Form appropriate to an application under paragraph 5 and to ask for an order under the *nunc pro tunc* rule. In the words of Cozens-Hardy, M.R. in *Teofani & Co. v. Teofani* [1913] 2 Ch. 545 at p. 551 "Teofani & Co. were desirous of registering the name
30 'Teofani' under the Trade Marks Act, but it is quite clear that they could not proceed at all unless they obtained what I venture to call a passport from the Board of Trade, or from the Court." (The Master of the Rolls was then considering Section 9 (5) of the English Trade Marks Act 1905, which was substantially identical with paragraph 5 of Section 8 of the Law, save that an order could be obtained from either the Court or the Board of Trade.)

22. Savary J. decided at the trial in favour of the Appellants on this point. He said: "My conclusion from the language of the Section and the
40 observations in the cases cited is that as no order of the Court was obtained prior to the registration of the word 'Vaporub' in 1941 I cannot now deal with the question of what order the Court would have made on the application if there had been an application before it on the basis of distinctiveness. My view is that an order of the Court is a condition precedent to registration under subsection (5) and that it is not competent for the Court in this case to deal with the matter as if an order had been obtained or at this stage to make an order and consider the sole issue of distinctiveness. The result of my opinion is that the word 'VapoRub' was at the commencement of this action not properly on the Register as it could not be registered under subsections (3) or (4) of Section 8 and it is not competent for the Court to consider whether it could have been put on the Register under subsection (5).
pp. 66, 67.

If my view on the latter point is correct the Plaintiffs would not be precluded from making an application now, if so advised, to have the word 'VapoRub' put on the Register. It seems to me that the Plaintiffs deliberately put themselves in this difficulty by the form of their application and no blame can be attached to the Registrar of Trade Marks." The Appellants humbly submit that this finding of Savary J. is correct.

pp. 90, 91.

p. 91.

23. The Court of Appeal, however, overruled the decision of Savary J. on this point. They agreed that upon an application to the Registrar for registration of a particular mark under paragraph 5 of Section 8, an order of the Court is a condition precedent, but it appeared to them that if the mark is already on the Register and an application to expunge it is made, the Court may in the exercise of its discretion refuse to do so. In coming to this decision, the Court of Appeal took into consideration a number of authorities which, it would appear, were not cited before Savary J. Of the authorities referred to in their Judgment, the only one which in the Appellants' respectful submission is directly relevant is *W. N. Sharpe Ltd. v. Solomon Bros. Ltd.* (31 R.P.C. 441). In that case, the Trade Mark "Classic" had been registered in respect of Christmas cards and similar goods without a preliminary order of the Board of Trade or the Court that it was to be deemed to be distinctive. Upon a Motion before the Court to expunge the Trade Mark from the Register, Warrington J. held that it was a mark in respect of which such an order should be made under the provisions of Section 9 (5) of the English Trade Marks Act 1905. The learned Judge went on as follows (at page 451): "On the whole I find that user has been such as to render the word in fact distinctive of the Plaintiffs' goods. The result is that the mark in question is one to which it would be right to make an Order that it be deemed to be a distinctive mark.

"Then it is said that having been registered without such an Order having first been obtained, it ought to be expunged from the Register, leaving the Plaintiffs to begin again *de novo*. Section 35 under which the application is made authorises the Court in any proceedings under the Section to decide any question that it may be necessary or expedient to decide in connection with the rectification of the Register. I decide that the mark is to be deemed to be distinctive. Except that this preliminary point, with which nobody except the Applicants and the Comptroller are concerned, had not been decided, the proceedings resulting in registration were in every respect regular, and I see no reason for putting the parties to fresh expense and trouble. In fact, the same course was adopted by the Court of Appeal in *Teofani's* case. There the mark had been registered under an Order of the Board of Trade made upon evidence which the Court thought insufficient. The Court itself, however, upon further evidence thought the mark ought to be deemed distinctive and allowed it to remain on the Register."

24. The Appellants humbly submit that Warrington J. misdirected himself in *Sharpe's* case and that his Judgment was incorrect. The learned Judge failed to take into account the fact that the Applicants in that case, as in the present, had disclaimed registration under the special provisions of subsection 5, and accordingly he was, in the respectful submission of the Appellants, in error in stating that the proceedings were

in every respect regular. The learned Judge was further in error in holding that the same course had been adopted in *Teofani's* case (1913 2 Ch. 545) in which case the application had been made under the special provisions of subsection 5 and a preliminary order of the Board of Trade had been obtained.

25. In the present case the Court of Appeal decided as follows: p. 91.
 “ We have come to the conclusion that as the word ‘ VapoRub ’ could
 by itself have been registered in 1924 on the ground that it was inherently
 distinctive or adapted to distinguish and as in 1941 it had in addition
 10 become distinctive of the Appellants’ (i.e. the present Respondents) goods
 ‘ VapoRub ’ should not have been expunged from the Register, although
 the application for registration in the latter year had not been made
 under Section 8 (5) but under Section 8 (3).” The Court of Appeal
 accordingly rescinded the Order of Savary J. that Trade Mark 3707 be
 expunged from the Register. For the reasons above stated, the Appellants
 humbly submit that, even if the Trade Mark had been adapted to dis-
 tinguish or distinctive in fact, the Court of Appeal had no power to treat
 the application as though it had been made under Section 8 (5) and make
 an order that it was to be deemed to be distinctive. The Appellants
 20 further submit that the finding of the Court of Appeal that the word
 “ VapoRub ” had *become* distinctive of the Respondents’ goods in 1941
 is inconsistent with their finding that the word *was* inherently distinctive
 or adapted to distinguish in 1924.

26. The Appellants submit, however, that the Trade Mark was not
 inherently distinctive or adapted to distinguish nor had it in fact become
 distinctive by the date of registration in 1941. As to the inherent
 character of the Trade Mark the Appellants contend that it had a direct
 reference to the character of the goods and rely upon their contentions
 contained in paragraph 19 hereof.

30 27. The Appellants further contend that it was not established
 on the evidence that the word “ VapoRub ” had in fact become distinctive
 of the Respondents’ goods by the date of registration, the 13th October
 1941, which, in the Appellants’ submission, is the relevant date to consider.
 Any association that may have existed in the minds of the purchasing
 public in 1941 between the words “ Vicks ” and “ VapoRub ” was the
 association that will in time arise between the name by which a particular
 product is described and the sole manufacturer of such product. Such an
 association does not necessarily, and, as the Appellants submit, did not in
 the present case, displace the descriptive character of the name and lead
 40 the public to associate the name, not with the product itself, but with its
 trade origin. The Appellants submit that the use by the three Companies
 referred to in paragraph 14 of the term “ Vapour Rub ” can be neglected ;
 none of the independent witnesses called by the Respondents had any
 knowledge of such use. It therefore follows that from 1923 to 1941
 virtually the only vapour rubs so described on sale in Jamaica were of
 the Respondents’ manufacture and that persons purchasing or using
 vapour rubs may have associated such products with the Respondents.
 No opportunity had been provided to them of associating the term with

any other manufacturer. In 1942, however, such an opportunity was provided when "Karsote Brand" Vapor Rub was put upon the market and the Appellants submit that the evidence shows that, while the bulk of the public showed a preference for Vicks, they appreciated that "Vapour Rub" was descriptive of the product and that reputable traders would supply "Karsote Brand" to a purchaser who asked for Vapour Rub. The following evidence of witnesses called by the Respondents is material :—

p. 30.

Francis, druggist, in chief, said : "Have at present Vicks and Karsote in store—but if person asks for VapoRub I hand 10 bottle of Vicks. At times I have had only Karsote and if people asked for VapoRub I would say I have only Karsote and invariably they have refused it—but I have tried to get them to take it as I had it in stock."

p. 32.

Haughton, druggist, in chief, said : "If customer asks for VapoRub I understand he wants Vicks," but in cross-examination said : "If a man wanted VapoRub and could not afford to pay for it I would offer him Karsote."

p. 45.

Herbert Kong, formerly a retailer, in chief, said : "There was one occasion during war that I had Karsote and not Vicks. 20 If someone asked for VapoRub I would then show Karsote and they would go away saying they wanted Vicks. If it was a written order for VapoRub I would send Karsote if I had no Vicks—and sometimes I would be phoned and told Vicks was wanted."

The Appellants submit that none of the above instances would have been consistent with honest trading if "VapoRub" had been distinctive of the Respondents' product and not descriptive of the type of product, and that it is demonstrated that even after the date of registration the Trade Mark had not acquired distinctiveness of the Respondents' product. The true effect of the evidence is that the public appreciated that the 30 word "VapoRub" was a description of the product, even though they may have associated it with but one manufacturer.

Exhibits 8-37.

28. It is material to look at the manner in which the Respondents themselves have used the word "VapoRub" upon wrappings, and in folders and other documents put before the public. No examples of newspaper advertisements of date prior to registration were in evidence. The following facts emerge :—

(i) In the principal representations of the name of their product "Vicks VapoRub," the word "Vicks" is always shown in letters substantially larger than the word "VapoRub." 40

(ii) The dual properties of the product, realised by rubbing and vaporisation, are stressed in the documents.

(iii) Until the year 1936, the word "Vicks" by itself was in nearly every case used to describe the product, in those passages of the documents which related to the history, nature and method of use of the product.

(iv) After 1936, the product is described, in such passages, as "Vicks VapoRub" or "VapoRub." It was in evidence that from about that date, other Vicks products, namely, "Vicks Va-Tro-Nol," "Vicks Medicated Cough Drops" and "Vicks Inhaler" were put upon the market with the result, as the Appellants submit, it was necessary to identify which Vicks product was being referred to.

10 (v) After 1936, there appeared in small letters on a side panel of cartons and upon certain of the directions folders the words "Note: Vicks and 'VapoRub' are trade marks of Vicks Chemical Company."

The Appellants submit that save for the use specified in (v) above the Respondents have used the word "VapoRub" purely descriptively of their product.

29. The Appellants have discussed in paragraph 27 hereof the nature and effect of any association between the words "Vicks" and "VapoRub" which may have been created in the minds of the purchasing public. It would appear, however, from the trade orders put in evidence by the Respondents that traders do not regard the word "VapoRub" 20 by itself as a sufficient indication that they require a product of the Respondents' manufacture. Ninety-eight orders, most of which were of date later than the application, were relied upon; of these some described the product as "Vicks" alone, but in no instance was it ordered as "VapoRub" (or a misspelling thereof) without reference to the word "Vicks." pp. 129-141.

30. In the light of the above considerations, the Appellants humbly submit that the evidence does not establish that the Trade Mark had become distinctive of the Respondents' goods and that the Court of Appeal were wrong in so finding. Their Judgment on this point reads as follows: 30 "Vicks VapoRub, as was found by the learned Judge, was identified pp. 88, 89. both by the trade and the public with the salve or ointment made by the Appellants (i.e. Respondents) and was referred to as 'Vicks' alone or 'VapoRub' alone. VapoRub was not *publici juris*, it was distinctive of the Appellants' product. The word was not used to describe all medicaments of a particular character but only the particular medicaments put on the Jamaica market by the Appellants. On these points the evidence of reputable witnesses is overwhelming." Having found, as they did, that the word "VapoRub" was inherently distinctive or adapted to distinguish, evidence of mere association of the name with the Respondents' product 40 might suffice to render it distinctive in fact. If, as the Appellants submit, the mark was not inherently distinctive or adapted to distinguish, but was an apt and natural description of the product, overwhelming evidence, such as is not to be found in this case, of distinctiveness and not mere association of name and product, would be necessary to support the validity of the mark. The Appellants humbly submit that the Order of Savary J. expunging the mark should be restored.

INFRINGEMENT OF TRADE MARK NO. 3707.

31. In both the Courts below, the Appellants relied upon the protection of Section 44 of the Law, which provides that "no registration under this law shall interfere with . . . the use by any person of any *bona fide* description of the character or quality of his goods." In view of the evidence of the nature of the Appellants' product and the meaning to be attached to the words "Vapour Rub" referred to in paragraph 19 hereof, the Appellants contended that their use of the words constituted a *bona fide* description of the character of their goods. In view of his finding that the Trade Mark was invalid, Savary J. did not decide this issue, though he indicated his opinion that the Appellants were entitled to the protection of Section 44. The Court of Appeal rejected the contention and stated, with reference to the opinion of Savary J., "We are unable to agree with this conclusion. We think that with the knowledge that 'VapoRub' was on the Register the use of the words 'Vapour Rub' by the Respondents (i.e. the present Appellants) could not be said to be *bona fide* within the meaning of Section 44." In coming to this decision, the Court of Appeal gave weight to the *dictum* of Parker J. in *Gramophone Co.'s Application* ([1910] 2 Ch. D. 423 at p. 436): "If Section 44" (of the English Trade Marks Act 1905, which was in identical terms) "were relied on as a defence, the question would at once arise whether the use of a word known to be on the Register as a Trade Mark could be *bona fide* within the meaning of the Section."

p. 68.

p. 92.

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32. In the submission of the Appellants, knowledge by an honest defendant of the existence of the mark sued upon does not of itself prevent his description of his goods from being *bona fide*. To hold otherwise would be to rob the Section of its whole effect, save as a protection against past infringement, since knowledge of the existence of the mark would be imputed to the defendant upon the issue of the Writ. In the Appellants' submission the consideration to be applied to the construction of Section 44 of the law are those applicable to Section 21 of the English Trade Marks Act 1905 which provided that "in the case of honest concurrent user . . . the Court may permit registration of the same Trade Mark, or of nearly identical Trade Marks, for the same goods or description of goods by more than one proprietor . . ." The question of what was "honest" concurrent user was considered by the House of Lords in *Alex Pirie's Application* (50 R.P.C. 147). Lord Tomlin, who delivered the leading speech, said at page 159: "Secondly, the Appellants say, and this is their main line of attack upon the conclusion of the Court of Appeal, that though the Respondents were honest in their user in the sense that they never intended to cause confusion or pass off their goods as those of the Appellants, yet inasmuch as they knew of the Appellants' mark when they adopted their own and that the marks had been used on the same goods in the same market, the user of the Respondents' mark cannot be treated as honest within the meaning of the Section and that in any case by refusal of registration there would not in these circumstances be the hardship to the Respondents which the Section is intended to prevent."

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"My Lords it has never been suggested throughout this case that the conduct of the Respondents has in the slightest respect been open to

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criticism, and I should be sorry to place upon this Statute a construction which would brand as statutory dishonesty conduct justified in the eyes of honourable men. There is in fact no ground for doing so. Knowledge of the registration of the opponent's mark may be an important factor where the honesty of the user of the mark sought to be registered is impugned, but when once the honesty of the user has been established the fact of knowledge loses much of its significance, though it may be a matter not to be wholly overlooked in balancing the conveniences for and against registration."

- 10 In the present case, no suggestion was made against the honesty of the Appellants or of E. Griffiths Hughes Ltd., the manufacturers, who were admitted to be of repute. The Appellants accordingly submit that their use of the words "Vapour Rub" did not cease to be *bona fide* by reason of their knowledge of the Respondents' Trade Mark, and that it was in fact a *bona fide* description of the character of the product they sold. They humbly submit that the Court of Appeal was wrong in deciding the contrary.

VALIDITY OF T/M NO. 1852

33. This Trade Mark, which consists of the words "Vicks VapoRub p. 159.
 20 Salve," a triangular device bearing the words "Vick Chemical Company" and additional matter, was registered on the 7th April 1924, more than seven years before the date of the Motion herein. Under Section 41 of the law the original registration shall be taken to be valid unless such original registration was obtained by fraud or unless the Trade Mark offends against Section 10 of the Law. It was conceded that the original registration has not been obtained by fraud and Savary J. held that the Trade Mark did not offend against Section 10. The Appellants, by their Motion, p. 10.
 30 held that although the single word "VapoRub" was not registerable p. 72.
 as a Trade Mark, the words "Vicks VapoRub" had been identified by long user with the Plaintiffs' goods and refused the relief asked for in respect of this mark. The Appellants have not appealed from this decision and this Trade Mark is accordingly admitted to be valid.

Savary J. ordered the Respondents to enter on the Register a disclaimer in respect of certain goods with which these proceedings are not p. 74.
 concerned. The Court of Appeal affirmed the order of Savary J. so far as it extended to this Trade Mark.

INFRINGEMENT OF TRADE MARK NO. 1852

- 40 34. The Appellants contended at the trial that they had used the words "Vapour Rub" as a *bona fide* description of the character of their goods and were protected by the provisions of Section 44 of the Law. The findings of the Courts below and the submissions of the Appellants on this issue are set forth in paragraphs 31 and 32 hereof.

p. 67. 35. The Appellants further contended that the use of the words "Vapour Rub" upon the labels and other representations complained of did not constitute an infringement of the Respondents' Trade Mark, considered as a whole. Savary J. held as follows:—

"A comparison of the carton and jar put in evidence with the registered Trade Mark shows that with the exception of the words 'Vicks VapoRub' there has been a departure from the Trade Mark on the labels. It is a fair conclusion from this that the Plaintiffs consider those words as the dominant part of the Trade Mark The question for determination therefore is whether 10 the use of the words 'Karsote Vapour Rub' by the Defendants is an infringement of the Plaintiffs' Trade Mark No. 1852 so far as the words 'Vicks VapoRub' are concerned. The Plaintiffs have marketed their products as 'Vicks VapoRub' and the Defendants have called their product 'Karsote Vapour Rub', and it seems to me that the words 'Vicks' and 'Karsote' respectively distinguish the goods one from the other."

The Appellants humbly submit that this finding was correct.

p. 92. 36. The Court of Appeal upset the above finding of Savary J. They found: "'VapoRub' is in our view a substantial and material part of 20 Trade Mark No. 1852 used in connection with the Appellants'" (i.e. the present Respondents) "product which has acquired in the market of Jamaica a name derived from that part of their Trade Mark; and the Respondents" (i.e. the present Appellants) "could use it only if they had taken such precautions as to avoid the reasonable probability of error and deception," the onus being on them to show that "purchasers of the goods will not be deceived'." The Court of Appeal then held that the Appellants had made no attempt to discharge this onus that was cast upon them and relied upon the fact that "their principal witness de Cordova, 30 the Managing Director of the Company which distributes 'Karsote Vapour Rub' and one of the Defendants to the action, admitted that "a number of similarities appeared between 'Vicks' and 'Karsote' on the cartons." Were these similarities calculated to avoid the reasonable probability of error or of deception? Obviously not, they were calculated to mislead."

p. 93. 37. The Appellants humbly submit that the onus is shifted to a defendant to prove non-infringement only in the case where the word or words he has used form a "material or substantial part" of the plaintiff's trade mark. In the present case the only part of the Respondents' Trade Mark which has been used by the Appellants consists of the words 40 "Vapour Rub." The Appellants submit that these words, which on the evidence constitute a complete description of the Appellants' product, cannot by themselves be a "material and substantial" part of the Respondents' Trade Mark; and that the onus therefore rests upon the Respondents to prove confusion which the evidence has failed to do. The Appellants further humbly submit that the Court of Appeal attached undue weight to the admissions of de Cordova. He did not admit, nor was there any other evidence, that any resemblance between the

p. 54.

Respondents and the Applicants' cartons was deceptive or other than that which is inevitable between cartons containing substantially identical products.

PASSING-OFF.

38. For the reasons which have been discussed above the Appellants submit that the Respondents, upon whom the onus of proof rests, have failed to establish that the word "VapoRub" had become so distinctive of goods of their manufacture or merchandise that the use by the Appellants of the words "Vapour Rub" upon their products either had in fact led
10 or was likely to lead to deception or passing-off. In considering the issue of passing-off, however, it is necessary to take into account not merely the respective Trade Marks, but the get-up of the Applicants' and Respondents' products and the manner in which they are respectively put before the trade and public.

39. The evidence established the following differences between the two preparations :—

(i) The bottles are of different sizes and colours.

(ii) The labels upon the bottles are of different colours, design and appeal to the eye.

20 (iii) The "Vicks" bottles are contained in individual cartons, distinctively printed; the "Karsote" bottles are packed in containers holding 12 bottles, the containers being wrapped in plain brown paper upon which is a label with the words "Karsote Vapour Rub."

40. The Respondents relied upon the admission, above referred to, of de Cordova that there is a similarity between advertisements of Vicks
p. 54. and the carton of Karsote. On this question the Appellants respectfully adopt what was said by Savary J. :—
p. 69, 70.

30 "So far as the Karsote containers are concerned they seem to me to play no important part in the question of deception. The retail customers are not likely to see the containers and there is no evidence that any of them has ever seen one. Vicks is not sold in large containers, but each jar is in an individual container. The wholesalers and retailers would no doubt see the Karsote containers but not one of them has suggested that he was deceived into thinking that it contained a Vicks product. It seems to me that if the representation on the container was calculated to deceive, one would expect to hear that some persons had been deceived. In
40 any event I do not feel justified in coming to the conclusion that the representation on the Karsote containers was calculated to deceive."

41. The evidence also fails to establish, in the submission of the Appellants, that there was any probability of confusion between the respective jars. The Respondents called as witnesses a number of traders and members of the public, but with one exception none of these witnesses was himself in any degree of confusion. The exception was Joseph Kong,
p. 50. the Manager of a grocery store, who gave evidence to show that he had

mistaken a jar of "Karsote Vapour Rub" which he had seen in another shop for a jar of Vicks. At the trial, this witness used a magnifying glass in order to read the label on a jar of "Karsote Vapour Rub" and neither Savary J. nor the Court of Appeal attached weight to his evidence. The Appellants rely upon the evidence of the ten retailers who gave evidence on behalf of the Respondents and were put forward by them as being honest and reputable witnesses. Of these ten retailers, nine gave evidence that they had stocked both Vicks and Karsote for sale to the public. It would not, in the Appellants' submission, have been consistent with honest trading for these witnesses to have sold the two products if there had been likelihood of confusion between them and the evidence establishes and Savary J. so found that the buying public were well aware of the fact that Karsote and Vicks were different products and were not deceived. 10

p. 70.

42. Savary J. accordingly held that the Respondents had not established that the Appellants had passed off their goods as those of the Respondents. The Court of Appeal stated the following with regard to the facts:—

p. 71.

p. 87.

"The 'Karsote' jars are appreciably smaller than the 'Vicks' jars and the colouring of the jars and the labels are different. Witnesses who testified for the Appellants" (i.e. the present Respondents) "in particular druggists and chemists who come into contact with members of the public, were not cross-examined with a view to ascertaining whether the buying public were aware of the fact that 'Karsote' and 'Vicks' are different products and that they were not deceived. The only evidence on this point was given by Mr. Gunter who said in examination-in-chief that he would personally not be deceived—it is what we would expect of a person occupying the position of a Mayor—and by Herbert Kong, who said, also in examination-in-chief, that 'there was occasion during the war that I had Karsote and not Vicks—if someone asked for VapoRub I would then show Karsote and they would go away saying they wanted Vicks.' As this occasion was during the war and as Mr. Kong was a wholesale dealer for five years before 1946 when he gave his evidence, it is possible, if not probable, that he was referring to retailers and not to members of the public. Evidence in the opposite sense was given by Joseph Kong who said that he mistook a jar of 'Karsote Vapour Rub' for what he described as 'a jar of small Vicks' but his sight appears to have been defective, as he needed the aid of a magnifying glass to read the large print on a 'Karsote' jar." 30 40

The Court of Appeal granted an injunction to restrain the Appellants from passing off, but did not give their reasons for so doing. The Appellants submit that the evidence, as cited by the Court of Appeal, fails to establish that there was risk of confusion or passing off and that the Court of Appeal proceeded upon the erroneous basis, as the Appellants respectfully submit, that the onus was laid upon the Appellants of affirmatively establishing that there was no likelihood of confusion or passing off.

43. The Appellants humbly submit that the Court of Appeal were wrong in holding that Trade Mark No. 3707 was valid and infringed by the

Appellants and that Trade Mark No. 1852 was infringed by the Appellants and that the Appellants had passed off their goods as and for the goods of the Respondents and that their Judgment should be reversed and the Order of Savary J. should be restored for the following among other

REASONS.

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- (1) BECAUSE the registration of Trade Mark No. 3707 was invalid.
 - (2) BECAUSE the Court of Appeal were not competent to decide whether Trade Mark No. 3707 could have been registered under the provisions of Section 8, subsection (5) of the Trade Marks Law.
 - (3) BECAUSE the Trade Mark " VapoRub " was not adapted to distinguish or distinctive of the Respondents' goods.
 - (4) BECAUSE the Appellants had not infringed the Respondents' Trade Marks or either of them.
 - (5) BECAUSE the Respondents were entitled to the protection of Section 44 of the Trade Marks Law.
 - (6) BECAUSE the Appellants had not passed off or threatened or intended to pass off their goods as and for the goods of the Respondents.
 - (7) BECAUSE the Judgment of Savary J. was right and should be restored.
 - (8) BECAUSE the Judgment of the Court of Appeal was erroneous and should be reversed.
- 20

GERALD R. UPJOHN.

P. STUART BEVAN.

[APPENDIX.

APPENDIX

TRADE MARKS LAW—CHAPTER 272

SECTION 2

Definitions

2. In and for the purposes of this Law (unless the context otherwise requires)—

A “mark” shall include a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof.

A “trade mark” shall mean a mark used or proposed to be used upon or in connection with goods for the purpose of indicating that they are the goods of the proprietor of such trade mark by virtue of manufacture, selection, certification, dealing with, or offering for sale. 10

A “registrable trade mark” shall mean a trade mark which is capable of registration under the provisions of this Law.

“The register” shall mean the register of trade mark kept under the provisions of this Law.

A “registered trade mark” shall mean a trade mark which is actually upon the register.

“Prescribed” shall mean, in relation to proceedings before the Court, prescribed by Rules of Court (which rules the Chief Justice with the concurrence of the Judges of the Supreme Court is hereby empowered to make), and in other cases, prescribed by this Law or the rules thereunder. 20

“The Court” shall mean the Supreme Court of Judicature of Jamaica.

SECTION 8

Registrable trade marks

8. A registrable trade mark must contain or consist of at least one of the following essential particulars—

(1) the name of a company, individual, or firm represented in a special or particular manner; 30

(2) the signature of the applicant for registration or some predecessor in his business;

(3) an invented word or invented words;

(4) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;

(5) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the above paragraphs (1), (2), (3) and (4) shall not, except by order of the Court, be deemed a distinctive mark: 40

Provided always that any special or distinctive word or words, letter, numeral, or combination of letters or numerals used as a trade mark by the applicant or his predecessors in business before the first day of April, 1889, which has continued to be used (either in its original form or with

additions or alterations not substantially affecting the identity of the same) down to the date of the application for registration shall be registrable as a trade mark under this Law.

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

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

SECTION 10

10. It shall not be lawful to register as a trade mark or part of a trade mark any matter, the use of which would by reason of its being calculated to deceive or otherwise be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design. Restriction on registration

SECTION 32

32. The Registrar may, on request made in the prescribed manner by the registered proprietor or by some person entitled by law to act in his name— Correction of register

- (1) correct any error in the name or address of the registered proprietor of a trade mark ; or
- (2) enter any change in the name or address of the person who is registered as proprietor of a trade mark ; or
- (3) cancel the entry of a trade mark on the register ; or
- (4) strike out any goods or classes of goods from those for which a trade mark is registered ; or
- (5) enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of such trade mark.

Any decision of the Registrar under this section shall be subject to appeal to the Court.

SECTION 35

35. Subject to the provisions of this Law—

- (1) the Court may on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, make such order for making, expunging, or varying such entry, as it may think fit ;
- (2) the Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of the register ;

Rectification of register

- (3) in case of fraud in the registration or transmission of a registered trade mark, the Registrar may himself apply to the Court under the provisions of this section ;
- (4) any order of the Court rectifying the register shall direct that notice of rectification shall be served upon the Registrar in the prescribed manner who shall upon receipt of such notice rectify the register accordingly.

SECTION 41

Registration to be
conclusive after
seven years

41. In all legal proceedings relating to a registered trade mark (including applications under section 35 of this Law) the original registration 10 of such trade mark shall after the expiration of seven years from the date of such original registration (or seven years from the passing of this Law, whichever shall last happen) to be taken to be valid in all respects unless such original registration was obtained by fraud, or unless the trade mark offends against the provisions of section 10 of this Law: Provided that nothing in this Law shall entitle the proprietor of a registered trade mark to interfere with or restrain the user by any person of a similar trade mark upon or in connection with goods upon or in connection with which such person has, by himself or his predecessors in business, continuously used such trade mark from a date anterior to the user of the first-mentioned 20 trade mark by the proprietor thereof or his predecessors in business, or to object (on such user being proved) to such person being put upon the register for such similar trade mark in respect of such goods under the provisions of section 21 of this Law.

SECTION 43

Infringement

43. In an action for the infringement of a trade mark the Court trying the question of infringement shall admit evidence of the usages of the trade in respect to the get-up of the goods for which the trade mark is registered, and of any trade marks or get-up legitimately used in connection with such goods by other persons. 30

SECTION 44

User of name,
address or
description of
goods

44. No registration under this Law shall interfere with any bona fide use by a person of his own name or place of business or that of any of his predecessors in business or the use by any person of any bona fide description of the character or quality of his goods.

In the Privy Council.

ON APPEAL
from the Court of Appeal for Jamaica

BETWEEN

**CECIL de CORDOVA, G. J. de
CORDOVA, CECIL de CORDOVA
& CO. LIMITED** (Defendants) *Appellants*

AND

VICK CHEMICAL COMPANY (Plaintiffs) *Respondents*

AND

IN THE MATTER of an Application by CECIL
de CORDOVA & COMPANY LIMITED

AND

IN THE MATTER of the Registered Trade Marks
Nos. 1852 and 3707 of Vick Chemical Company

AND

IN THE MATTER of the Trade Marks Law
(Chap. 272).

Case for the Appellants

McKENNA & CO.,
12 Whitehall,
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Solicitors for the Appellants.