

C-117-6-25

10, 1951

31134 No. 47 of 1948.

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*

10

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).

Respondents' Case

RECORD.

1. This is an appeal from the Order of the Court of Appeal for
20 Jamaica, dated the 12th January 1948, allowing an appeal by the
Respondents from the order of Mr. Justice Savary in the Supreme Court
of Jamaica dated the 14th February 1947 in an action for infringement of
certain trade marks and for passing-off in which the Respondents were
Plaintiffs and the Appellants were Defendants and on a motion for rectifica-
tion of the Register of Trade Marks in which the Appellants were Applicants
and to which the present Respondents and the Registrar-General of Trade
Marks in Jamaica were Respondents. The motion related to the trade
marks in issue in the action and was treated for the purposes of the trial
and the appeal as being by way of counter-claim in the action. The
30 Registrar-General has taken no active part in the proceedings.

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NATURE OF THE PROCEEDINGS.

- p. 1.
p. 3.
2. The respondents' action was commenced by writ on the 1st of March 1944. By their Statement of Claim the Respondents claimed an injunction to restrain the Appellants from infringing two trade marks of which the Respondents were the proprietors, namely :—
- pp. 85, 142.
Exhibit M.
- (A) Trade mark No. 1852 consisting of the words "Vicks VapoRub" above the word "Salve" with other matter as shown on the original Exhibit "M," such mark being registered in Jamaica on 7th April, 1924 in Class 3 *inter alia* for a medicinal salve and liniment. 10
- p. 143.
Exhibit M.
- (B) Trade mark No. 3707 consisting of the word "VapoRub" which was registered in Jamaica on 13th October 1941 in Class 3 for chemical substances prepared for use in medicine and pharmacy and was "associated" with trade mark No. 1852 ;
- and further to restrain the Appellants from passing-off goods not of the Respondents' manufacture as or for the goods of the Respondents and in particular from selling, offering for sale or disposing of any medicated or pharmaceutical product not of the Respondents' manufacture bearing the word "Vapour Rub" or any other words colourably resembling the Respondents' said trade marks. The Respondents also claimed an account of profits, damages and other relief. 20
- p. 3.
3. The Respondents alleged in their Statement of Claim that for upwards of 25 years they had used the said trade marks extensively upon a medicated salve manufactured by them and sold in Jamaica and that by reason of such extensive use their salve had become known to Purchasers or intending purchasers as "VapoRub" and amongst members of the medical profession and amongst druggists and chemists and in the trade of general dealers and to the public at large "VapoRub" meant a salve made and sold by the Respondents. The Respondents alleged that the Appellants were infringing the said registered trade mark and passing off their goods as and for the goods of the Respondents by advertising and selling a medicated salve not of the Respondents' manufacture under the name "Vapour Rub" and with labels got up in imitation of the Respondents' labels. 30
- p. 5.
4. By their Defence the Appellants admitted the registration of the said trade marks Nos. 1852 and 3707 but denied that the said trade marks were properly registered. They admitted that they had sold a product marked "Karsote Vapour Rub" but denied that the use by them of the words "Vapour Rub" was an infringement of trade mark as alleged by the Respondents and they further denied the allegations of passing-off. They alleged that the word "VapoRub" was descriptive and merely a mis-spelling of "Vapour Rub" which words they claimed were common to the trade and from a date long anterior to 1924 had been used to describe medicaments of a particular character. 40
- p. 10.
5. The Appellants' motion was commenced by notice dated the 11th October 1945 and by it the Appellants sought the rectification of the Register of Trade Marks under Section 35 of the Trade Marks Law

Chap. 272 (which is the same as Section 35 of the English Trade Marks Act, 1905) by removal of trade mark No. 3707 and further by expunging from trade mark No. 1852 the word "VapoRub" or by adding to the entry of trade mark No. 1852 a disclaimer of any right to the exclusive use of the word "VapoRub".

6. The action and the motion were heard together by Mr. Justice Savary who, in his judgment, held that no order should be made in the motion in relation to the trade mark No. 1852 (except as to a disclaimer in respect of a formal matter not now in issue) but that there had been no infringement of that trade mark, that an order should be made expunging trade mark No. 3707 from the Register, and that there had been no passing-off. He therefore dismissed the action, and made the appropriate order on the motion, and ordered the Respondents to pay to the Appellants four-fifths of their taxed bill of costs.

7. The Respondents appealed to the Court of Appeal in Jamaica on the grounds set out in their Notice and Grounds of Appeal and there was no cross-appeal by the Appellants in respect of the order refusing to expunge trade mark No. 1852.

8. The Court of Appeal consisting of Chief Justice Hearne, Mr. Justice Carberry and Mr. Justice MacGregor in allowing the Respondents' Appeal ordered that the judgment and order of Mr. Justice Savary be set aside save as to the formal matter relating to trade mark No. 1852 and ordered that the Respondents should be granted relief in respect of the matters claimed in the Statement of Claim. The Court of Appeal also ordered the Appellants to pay to the Respondents their costs in both Courts. From the said decision of the Court of Appeal the Appellants bring the present Appeal.

HISTORY OF THE RESPONDENTS' BUSINESS AND TRADE MARKS.

9. The Respondents are a Corporation organised and existing under the Laws of the State of Delaware in the United States of America and carry on business in the manufacture and sale of medicines, medicated articles and pharmaceutical preparations. Their products are exported to most of the countries in the world including Jamaica. The Respondents or their subsidiary companies manufacture the product concerned in these proceedings in several countries including England.

10. The Respondents are the successors in business of one Richardson, a druggist, who in about the year 1896 put on the market in the United States of America a vaporising ointment or medicated salve under the trade name "Vicks Croup and Pneumonia Cure". This ointment was not a new product as regards its nature and composition and had never been the subject of a patent. It was in fact an old and well-known type of ointment made by combining a variety of volatile substances such as camphor and menthol with a fat of low melting point. It was a form of medicament of great antiquity and at all material times a variety of similar ointments had been in use.

- pp. 34-5. 11. In or about the year 1911, the product was marketed in the United States of America under the trade mark or trade name "VapoRub." The word "VapoRub" was a newly coined word. It had never before been used by any trader on this class of medicament and has not since been in general use anywhere in the world (except in the United Kingdom and Ireland for special reasons which will hereinafter appear) as the name of this class or type of ointment for which various names were in use such as for example chest rub, vaporising salve or vaporising ointment. "VapoRub" was therefore merely a new name given to an old remedy as marketed by a particular trader. 10
- p. 178. 12. In the year 1915, "Vaporub" was registered as a trade mark in the United States of America and the word has been in continuous use in connection with the said preparation in the said business from 1911 to the present day. Sales of "VapoRub" have extended on a substantial scale to all parts of the world and a valuable reputation and goodwill have been built up around it.
- p. 34. 13. A label bearing prominently the words "Vicks VapoRub" is registered as a trade mark in about seventy countries throughout the world and the word "VapoRub" (or "Vaporub") alone is registered as a trade mark in fifty countries throughout the world, of which twenty are English-speaking countries including England, Canada, New Zealand and South Africa. 20
- p. 85. 14. In 1923 the Respondents commenced to market their products in Jamaica and in 1924 registered their trade mark No. 1852 as referred to in paragraph 2 hereof. Extensive and regularly repeated advertising campaigns were carried on and the amount of sales in Jamaica increased from 228 dozen with a sale value of 806 dollars in the period 1923-4 to 4,200 dozen with a sales value of 11,818 dollars in the period 1944-45 making a total of 111,961 dollars for the period 1923-45.
- pp. 127-8. 15. "Vicks VapoRub" has been sold in Jamaica in jars which are individually enclosed in a carton. The form of the cartons and labels on the jars has varied from time to time and the matter other than the words "Vick VapoRub" has departed from the form of the registered trade mark No. 1852 in certain respects, but the words "Vicks VapoRub" have always constituted the outstanding feature of the said cartons and labels as they do of the said registered trade mark. Specimens of the labels on the Respondents' jars and of the cartons as put on the market in Jamaica from time to time and specimen advertisements issued by the Respondents in Jamaican papers were put in evidence and these show the strong reliance which has at all times been placed by the Respondents on the words "Vicks VapoRub" in connection with the sale of their product. It is also relevant to note, on the issue of passing-off, that the Respondents' jars bore on the label above the word "Vicks" the word "stainless" and bore on the cap the words "White Stainless." 30
- p. 85. Exhibits D and E. Exhibit G.
- pp. 85, 143, 169. 16. On the 13th October 1941 the Respondents registered in Jamaica the word "VapoRub" as a trade mark No. 3707 in Class 3 as referred to in paragraph 2 hereof. The said trade mark was registered by the

Registrar of Trade Marks under Section 8 subsection 3 or 4 of the Trade Marks Law and was not objected to by the Registrar as a mark which was registrable only upon an order of the Court under Section 8 subsection 5. This mark was associated with trade mark No. 1852.

17. There is no country except the United Kingdom and Eire where the word "VapoRub" or words "Vapour Rub" are used in trade except in relation to the Respondents' preparation, apart from the alleged infringing use by the Appellants and apart also from certain other cases in which undertakings have been given to the Respondents to discontinue a use of the said or similar words which had been commenced in relation to preparations of other manufacturers. There have been several other preparations upon the market in Jamaica and elsewhere similar to the Respondents' "VapoRub" but as already mentioned the general terms used to indicate products of this type are terms such as chest rub, vaporising salve, or vaporising ointment, while particular preparations are known by other designations such as camphorated oil, or by proprietary names such as Mentholatum and Nusterole. The Respondents' principal witness stated that about 100-200 chest rub preparations had been put upon the market within the last twenty years.

18. Evidence which was given on behalf of the Respondents at the trial by doctors, druggists and nurses, and by wholesalers and retailers of the product and members of the public and was not contradicted or seriously challenged at the trial by the Appellants, and was accepted by the Trial Judge and the Court of Appeal, established that for a period of ten years or more before the date of the action (in fact the evidence established that it was for a period of upward of 15 years) the trade and the public in Jamaica used the expression "Vicks VapoRub" as indicating the salve or ointment made by the Respondents and further that the words "Vicks" alone and "VapoRub" alone were used respectively as synonymous with "Vicks VapoRub." The Court of Appeal held further that the evidence overwhelmingly established that the word "VapoRub" was not *publici juris* and was distinctive of the Respondents' product and that the word was not used in Jamaica to describe all medicaments of a particular character but only the particular medicament put on the Jamaica market by the Respondents.

19. The Appellants' contention set out in paragraph 7 of their Defence and in Ground (1) of their notice of motion to the effect that from a date long anterior to the year 1924 the words "Vapour Rub" had been commonly used to describe medicaments of a particular character was wholly refuted by the evidence given at the trial. None of the witnesses whether from the trade or members of the public, doctors or nurses, knew of any such common use of the words "Vapour Rub," which words (or the combined word "VapoRub") they associated solely with the Respondents' product, nor did any of these witnesses know until their attention was drawn to the fact at or shortly before the trial that there were certain descriptive references to "Vapour rub" in two English books namely the British Pharmaceutical Codex of 1934 and a work entitled "Pharmaceutical Formula" published in 1929, these being the general

descriptive references upon which the Appellants mainly sought to rely. These references therefore had no significance so far as the trade and public in Jamaica were concerned.

pp. 33-39.

p. 88.

pp. 36, 86.
Exhibits EE, DD,
FF.

pp. 27, 49.

20. The evidence by the Respondents' principal witness in regard to the use of the words "Vapour Rub" in England was not challenged by the Appellants at the trial and established that the Appellants in so far as they sought to rely upon the position in England, were, until that evidence was given, under a misapprehension as to the relevant facts. That evidence was to the effect that it was not until six months after the registration of "Vicks VapoRub" in Jamaica that the Respondents 10 changed the name of their product as manufactured and marketed in England to "Vick Brand Vapour Rub" in order to claim exemption from the Medicines Stamp Duty Act. The consequence of the change was that from about the year 1929 the market in England was flooded with the products of other manufacturers which were marked "Vapour Rub." As a result the words "Vapour Rub" came to be accepted as an ordinary name in common use in England for medicated ointments of a certain type or class. Finally in 1934 the words "Vapour Rub" appeared in the 1934 edition of the British Pharmaceutical Codex as the name of a type of medicated ointment and in the 1938 edition of the Extra Pharmacopoeia 20 though they have never appeared in the British Pharmacopoeia. A search of drugstores and business houses in Kingston and St. Andrew, embracing by far the largest town in Jamaica, disclosed that the British Pharmaceutical Codex and the Extra Pharmacopoeia, in which the words appeared, were found in only one drugstore, although the British Pharmacopoeia, in which there was no reference to "Vapour Rub," was found in fifteen.

21. In fact and for the reasons explained in the foregoing paragraph the United Kingdom and Ireland are the only countries in the world where the words "Vapour Rub" are used descriptively as meaning a class of medicated ointment and as set out in paragraph 19 hereof the 30 position in the United Kingdom and Ireland was of no significance in Jamaica.

THE ALLEGED INFRINGEMENT AND PASSING-OFF.

pp. 3, 5.

22. Prior to the 28th December 1943 the first two Defendants carried on business in partnership under the style or firm name of Cecil de Cordova & Company at Kingston, Jamaica, as General Merchants and Commission Agents. Since the 28th December 1943 the business of the said firm has been carried on by the third Defendants, and the first two Defendants have been actively engaged in the conduct and management of such business, the second Defendant being Managing 40 Director thereof.

p. 86.

23. In 1942 the first two Defendants commenced to sell in Jamaica a product under the trade mark or trade name "Karsote Vapour Rub" and varying quantities of the said product were sold by them and the third named Defendants in subsequent years down to the date of the issue of the writ. The said product was manufactured in England by E. Griffiths Hughes Limited of Manchester.

24. The said product "Karsote Vapour Rub" was sold in jars, Exhibit N.
 examples of which were proved in evidence. The jars are of two different
 types. In one case the jar is of white transparent glass with amber
 coloured contents, and bears a label with the words "Vapour Rub" in
 large letters with the word "Karsote" in smaller letters above. On
 the cap of this jar are the words "Vapour Rub" in large letters with the
 word "Karsote" above in smaller letters and underneath (Notwithstanding
 that the contents are amber coloured) the words "White Stainless".
 In the other case the jar is of brown non-transparent glass with a label
 10 similar to that on the first type of jar, but the cap has no writing on it.
 The said products were put up in cardboard containers containing twelve
 jars. The containers had the words "Karsote Vapour Rub" on an orange
 background, the words "Vapour Rub" being larger than the word
 "Karsote" and under them were the words "White Stainless". The
 containers were wrapped in plain brown paper on which was a label with
 the words "Karsote Vapour Rub".

25. The Defendants advertised "Karsote Vapour Rub" extensively Exhibits G, O.
 in newspapers circulating in Jamaica, the words "Vapour Rub" being
 prominently displayed, and the advertisements in general following
 20 closely the style of the Respondents' advertising.

VALIDITY OF THE RESPONDENTS' REGISTERED TRADE MARKS.

26. The Appellants attacked the validity of the Respondents'
 registered trade marks on several grounds but the substance of the attack
 was that "VapoRub" was descriptive and merely a mis-spelling of the
 words "Vapour Rub" which were alleged to be common to the trade pp. 10, 11.
 and in common use long before the registration in Jamaica to describe
 medicaments of a particular character. It was alleged that "VapoRub"
 was not an "invented word," that it was not "distinctive," and that
 if used on medical substances which were not to be rubbed on and/or
 30 did not give off a vapour, it was calculated to deceive. Upon these grounds
 the Appellants contended that Registration No. 3707 for the word
 "VapoRub" alone was wholly invalid, and that Registration for the mark
 incorporating the words "Vicks VapoRub" should have the word
 "VapoRub" removed or disclaimed.

27. At the trial Mr. Justice Savary decided in favour of the Appellants
 on their contention that registration No. 3707 was invalid. He held that
 the word "VapoRub" failed to qualify as a registrable trade mark under pp. 59-60.
 the provisions of the Trade Marks Law (Chap. 272) in Jamaica either as an
 "invented word" or as a "word having no direct reference to the character
 40 or quality of the goods." He held that it was not competent for him to
 consider whether the word "VapoRub" could have been registered as a p. 66.
 distinctive mark under Section 8 subsection (5) of the Trade Marks Law
 since in his view an order of the Court was a condition precedent to such
 registration, and no such order had been sought by the Respondents or
 had in fact been made.

28. As regards trade mark No. 1852 Mr. Justice Savary held that p. 67.
 the registration was protected by the "seven years rule" contained in
 Section 41 of the Trade Marks Law, since more than seven years had

p. 88.

elapsed between the date of registration and date of the Appellants' motion and that the original registration was therefore presumed to be valid unless obtained by fraud or unless the mark offended against Section 10 by reason of being calculated to deceive. There was no question of fraud, and the learned Judge found no reason for holding that the mark was calculated to deceive. The part of Mr. Justice Savary's order which relates to a disclaimer of liver pills and headache tablets has no bearing upon the present issues between the parties. In the Court of Appeal, the Appellants did not cross appeal or seek to vary the decision of Mr. Justice Savary as regards the validity of the registration of trade mark No. 1852. 10

pp. 89-91.

29. As regards trade mark No. 3707, the Court of Appeal agreed with the trial judge that "VapoRub" was not an invented word and, though not expressing any concluded opinion, inclined to the view also that the word had direct reference to the character and quality of the goods. The Court held, however, that "VapoRub" was inherently distinctive or adapted to distinguish the Respondents' product. They had regard to the origin of the word and the facts in relation to its user in the trade and in particular to the evidence which established that it had never had a generic significance in Jamaica but had always been used by the public and the trade as synonymous with "Vicks VapoRub" ointment and not as the name of a particular class of medicine and applied the principles laid down in the cases of *In re Joseph Crosfield & Sons Limited* (1910) 1 Ch. 130 and *The Registrar of Trade Marks v. W. & G. Du Cros, Ltd.* (1913) Appeal Cases 624. They further held that in any event, by the year 1941, the word "VapoRub" had become distinctive in fact of the Respondents' product and would have been entitled in that year to an order of the Court to proceed with its registration as a trade mark. Finally they held that the Court had a discretion in such circumstances under Section 35 (1) of the Trade Marks Law of Jamaica to refuse to expunge the trade mark notwithstanding that registration had been effected under Section 8 subsections (3) and (4) and not under subsection (5), and in fact exercised such discretion in the Respondents' favour. 20 30

ISSUES OF INFRINGEMENT OF TRADE MARK.

p. 91.

30. It was conceded in the Court of Appeal by the Appellants that, if trade mark No. 3707 were validly registered, they had no defence to the action for infringement founded on this mark unless they were protected by the provisions of Section 44 which is as follows:—

"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;" 40

pp. 91-2.

The Court of Appeal (disagreeing with the view of Mr. Justice Savary on the point) held as the Respondents submit correctly that the test to be applied was not a subjective test involving the intentions of the Appellants but an objective test involving the question whether as a fact the use of the word would lead to the result that one person might pass off his goods as the goods of another irrespective of the intention of

the person using it or the honesty of his reasons for so doing and whether the use of the word in Jamaica with knowledge that it was on the register could be bona fide within the meaning of the section. They held that Section 44 would afford no protection to the Appellants once the validity of the registration of the trade mark was upheld.

31. Mr. Justice Savary held that the Appellants' use of the words "Karsote Vapour Rub" did not infringe the Respondents' rights in their registration No. 1852 because the words "Vicks" and "Karsote" respectively distinguished the goods of one from the other. The Court of Appeal did not accept this view and held that "VapoRub" was a substantial and material part of the registered trade mark used in connection with the Respondents' product which had acquired in the market in Jamaica a name derived from part of that trade mark, No. 1852, and that the Appellants had made no attempt to discharge the onus which was cast upon them to relieve themselves of the *prima facie* liability incurred by them in taking a material and substantial part of the registered mark. The Court of Appeal accordingly held that there was infringement of trade mark No. 1852 as well as of trade mark No. 3707.

THE ISSUE OF PASSING-OFF.

32. The trial judge held that no case of passing-off had been established, on the basis either of similarity of get-up of the goods in question or of the use of the words "VapoRub" and "Vapour Rub" upon such goods or in the advertisements. He considered that there were some points of resemblance in the respective jars and advertisements, but that they were not such as would be calculated to deceive. The Court of Appeal took the opposite view. They held that it was obvious that the similarities were calculated to mislead. The Respondents refer to the fact that when the second named Appellant (Managing Director of the Appellant Company) was cross-examined he admitted that there were many similarities between the get-up of the Appellants' and Respondents' products and advertisements, and was constrained to say that he was unable to explain them.

GENERAL SUBMISSIONS ON THE FACTS.

33. The Respondents submit that the evidence showed conclusively—
- (A) That in Jamaica the words "Vicks" "VapoRub" and "Vicks VapoRub" have long been used and recognised synonymously as indicating the Respondents' goods exclusively, and the word "VapoRub" was a substantial and material part of trade mark No. 1852 as used in connection with the Respondents' product.
- (B) That in Jamaica the Respondents at no time had any monopoly, real or virtual, in the type of preparation which they sold as "Vicks VapoRub" and at all times there were similar products sold in competition with Respondents' product.
- (C) That the preparation was a very old remedy for which there were several adequate descriptive names available and in use in Jamaica.

(D) That "VapoRub" was a newly-coined and fanciful name for the preparation put on the market by the Respondents' predecessor in business.

(E) That the use of the words "Vapour Rub" in England and their appearance in certain English books of reference was fully explained and accounted for and such use, being unknown in Jamaica, was of no significance so far as the trade and public in Jamaica were concerned and was of no relevance to the questions arising in Jamaica in relation to Jamaican trade marks and the state of the trade in Jamaica. 10

(F) That the word "VapoRub" or words "Vapour Rub" could not be regarded as a *bona fide* description of the character of any medicated ointment open for use in Jamaica by any trader, and that "VapoRub" was not *publici juris* in Jamaica but was distinctive of the Respondents' product.

(G) That the use in Jamaica by the Appellants in respect of the goods sold by them and in their advertisements of the words "Vapour Rub," which is substantially the same as the word "VapoRub" associated exclusively with the Respondents' goods, was creating a likelihood of confusion, deception and passing-off. 20

GENERAL SUBMISSIONS OF LAW.

34. The Respondents will contend, if necessary, that the word "VapoRub" is an invented word and has no direct reference to the character or quality of the goods. In Jamaica the word taken by itself has no meaning, or alternatively no obvious or sensible meaning. Even if it be regarded as a mis-spelling of the two words "Vapour Rub" and therefore not an invented word, it has in the Respondents' submission no direct reference to the character or quality of the goods because it has itself no sensible meaning in Jamaica.

35. It is submitted that there was no reason in law why "VapoRub" should not have been regarded as a distinctive word in Jamaica having regard to the evidence concerning the trade in Jamaica and to the fact that it was a fancy word newly coined, was not a natural or ordinary combination of words, and that by itself it had no meaning whatever and to the fact that there were other and better descriptions of the product open to other traders to use and finally to the consideration that it was applied to an article which had never been the subject of a patent but was an old and familiar type of medicament, in a trade which was shared between rival traders. 30

36. If the word "VapoRub" was not registrable under headings (3) and (4) of Section 8 of the Trade Marks Law either as an invented word, or as a word having no direct reference to the character or quality of the goods, then the Respondents submit that having regard to the proved distinctiveness in fact of the word at the date of registration (which proof was accepted in both Courts below) the Court of Appeal rightly took this matter into account under Section 35 of the Trade Marks Law and properly 40

exercised the discretion which was open to the Court to refuse rectification of the Register merely on the ground that no order of the Court had been obtained at the time of registration. The Respondents submit that this decision is in accord with the decision of Mr. Justice Warrington on a corresponding point in relation to Sections 9 (5) and 35 of the English Trade Marks Act, 1905, in the case of *W. N. Sharpe Ltd. v. Solomon Brothers Ltd.* (1914) 31 R.P.C. 441, and with the practice of the Registrar of Trade Marks in the United Kingdom as exemplified by the case of *Peddie's Application* (1944) 61 R.P.C. 31 where the owner of a registered trade mark
 10 was permitted to rely (subsequently to registration) upon the provisions of Section 12 (2) of the Trade Marks Act, 1938 (Honest concurrent use) notwithstanding that there had been no examination of the circumstances entitling him to registration under those provisions at the time of application. Other cases including *Paine and Co. v. Daniells & Sons' Breweries* (1893) 2 Ch. 567 illustrate the proper principles that should be applied to this question. p. 91.

37. The Respondents further submit that the point taken by the trial judge as to the form which the Respondents' application took in 1941 was a technical point of procedure regarding applications which has
 20 no validity once registration has been effected. pp. 64, 67.

38. As regards the use of the words "Vapour Rub" or "VapoRub" in Jamaica and the questions whether those words were common to the trade, or adapted to distinguish the goods of the Respondents or affected by the provisions of Section 44, it is submitted that evidence of the state of the trade in regard to marks or words used in other countries is in general only admissible, as it was here, to show that a particular mark is *a priori* adapted to distinguish or to assist the Court in exercising its discretion in the particular country concerned when in doubt as to whether that mark ought to be registered there. It is submitted that it is well-
 30 established law that a mark may be open to all to use in one country though fully protected by registration or otherwise in another country. Reference is made to *National Starch Manufacturing Co. v. Munns Patent Maizena & Starch Co.* (1894) A.C. 275 (P.C.); *The Drug Club v. Lysol Ltd.* (1924) T.P.D. 614 (South Africa); and *American Trading Co. v. Heacock* 285 U.S. 247. p. 89.

39. The onus was on the Appellants to establish that "Vapour Rub" was a descriptive word in Jamaica and that onus they entirely failed to discharge.

40. As regards infringement of trade mark No. 1852 the Respondents
 submit that the decision of the Court of Appeal was entirely correct. p. 92. Once it was established that "Vicks VapoRub" was the distinguishing feature of the mark and that "VapoRub" was commonly used to mean "Vicks VapoRub" and to identify the Respondents' product, it was an infringement to use the phrase "Vapour Rub" as the name under which other goods were marketed. The Respondents submit that their approach to the issue and the decision of Mr. Justice Savary that there was no
 infringement were based upon misunderstandings of the decisions in the cases of *Edwards v. Dennis* 30 Ch. D. 454 and *Horlicks' Malted Milk Co. v. Summerskill* (1916) 86 L.J. Ch. 175; 34 R.P.C. 63 and ignored the p. 68.

different considerations which apply in actions for infringement of trade mark and in actions for passing-off as laid down by the Court of Appeal (England) and House of Lords in the case of *Saville Perfumery Limited v. June Perfect Limited and Another* 58 R.P.C. 147.

41. Moreover it is submitted that it is settled law (as applied for example in the last cited case) that evidence is admissible to prove what are the essential or distinguishing features of a registered trade mark and that once it has been established by the evidence that, as a result of the existence and use of a registered trade mark, a particular name (in the present case "VapoRub") has come to be recognised by the trade and public as distinctive of the trade mark proprietor's goods exclusively, then it is an infringement of the mark for another trader to call his goods by the same name or by a name so nearly resembling it as to be calculated to deceive or cause confusion. 10

42. As regards the issue of passing-off, the Respondents submit that Mr. Justice Savary failed to carry to its logical conclusion in accordance with well-established cases his emphatic finding that the word "VapoRub" was, on the evidence, in common use by the public meaning "Vicks VapoRub", and that in discounting the possibility of confusion or deception he relied too much upon the prefix "Karsote" and minor features of get-up in the case of the Appellants' product, and did not attach sufficient importance to the use of the words "Vapour Rub", and certain unexplained similarities, which would lead to the Appellants' product being sold in shops in response to requests for "VapoRub" which, upon the learned Judge's finding, would clearly be requests for the Respondents' preparation. The Respondents submit that the Court of Appeal was right in reversing Mr. Justice Savary's judgment on this issue. 20

CONCLUSION.

43. The Respondents therefore humbly submit that the judgment of the Court of Appeal was right and should be affirmed for the following amongst other 30

REASONS

- (1) BECAUSE the trade mark No. 1852 was validly registered.
- (2) BECAUSE the Appellants infringed the said trade mark by unjustifiably using a substantial and material part thereof.
- (3) BECAUSE the trade mark No. 3707 was validly registered or alternatively because if there were any defect in its original registration it was open to the Court as a matter of discretion not to order its removal from the Register, and trade mark No. 3707 being proved to be in fact a distinctive mark in 1941, the discretion of the Court of Appeal was correctly exercised in favour of the registration being upheld. 40

- (4) BECAUSE it was conceded by the Appellants that if trade mark No. 3707 remained upon the Register they had no defence to the action for its infringement otherwise than under Section 44 of the Trade Marks Law.
- (5) BECAUSE Section 44 of the Trade Marks Law provided no defence to the Appellants.
- (6) BECAUSE the acts of the Appellants complained of in the action were calculated to cause deception and confusion and passing-off.

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).

Respondents' Case

NEVE, BECK & CO.,
21 Lime Street,
London, E.C.3,
Solicitors for the Respondents.