

Cecil de Cordova and others - - - - - *Appellants*

v.

Vick Chemical Company - - - - - *Respondents*

FROM

THE COURT OF APPEAL FOR JAMAICA

**JUDGMENT OF THE LORDS OF THE JUDICIAL COMMITTEE
OF THE PRIVY COUNCIL, DELIVERED THE 15TH MARCH, 1951**

Present at the Hearing :

LORD SIMONDS
LORD MORTON OF HENRYTON
LORD MACDERMOTT
LORD RADCLIFFE
SIR JOHN BEAUMONT

[*Delivered by* LORD RADCLIFFE]

In this consolidated appeal the appellants seek to obtain reversal of an Order of the Court of Appeal in Jamaica dated the 12th January, 1948 and the restoration of an Order which was made at the trial of the action by Savary, J. on the 14th February, 1947. The substance of the dispute between the parties concerns two Trade Marks registered in the name of the respondents and bearing the numbers 1852 and 3707 respectively in class 3 of the Jamaican Register of Trade Marks.

Their Lordships have come to the conclusion that the appeal must fail on all points. The effect of the decision of the Court of Appeal was to hold the appellants liable for infringing the respondents' Trade Marks 1852 and 3707 by the sale in Jamaica of certain jars of ointment styled "Karsote Vapour Rub" and for passing off these goods as the goods of the respondents. This involved the maintenance on the Register of the latter of the two marks and the consequent dismissal of the appellants' motion to expunge it. In view of the conclusion that their Lordships have come to it is not necessary to enter upon any detailed recital of the facts or a review of the evidence. This is fully dealt with in the careful judgments of the trial Judge and of the Court of Appeal in Jamaica and no material conflict has appeared between the respective findings of fact in the two Courts. Indeed the facts are not in dispute: the difference that has arisen is as to the legal consequences that should be attributed to those facts. Their Lordships will confine themselves to indicating what are the grounds upon which they have decided this appeal.

The primary issue is, what is the status of the word "VapoRub"? This word forms a part of Trade Mark 1852 and is the whole of Trade Mark 3707. There is no doubt how it originated. Before 1911 there was no such word, although the kind of ointment which it has been used to denote has been known for centuries. The British Pharmaceutical

Codex of 1934 gives a description of such ointments in the following words:—"Vapour rubs are preparations of menthol with other volatile substances in a basis of soft paraffin, and are applied to the chest for their local action and on account of their value when inhaled"; and this may be taken as a sufficient description of the substance, although something must be said later as to the circumstances in which it came about that the British Pharmaceutical Codex was, by 1934, referring to "Vapour rubs" as a generic title. In 1911, a Mr. Richardson, an American druggist, coined the word "Vaporub" to form the trade appellation of one of these medicated ointments which he had then been manufacturing for some years. Thus the ointment was not a new substance, but the name that he gave to it was a new name. In 1915 the word "Vaporub" was registered as a Trade Mark in the United States of America, and it has since been registered (denoted by the symbols "VapoRub" or "Vaporub") in fifty different countries, of which twenty are English speaking countries and include England, Canada and New Zealand.

The respondents registered Trade Mark 1852 in Jamaica in the year 1924. It consists of the words "Vicks VapoRub Salve," a device consisting of a triangle with the words "Vicks Chemical Company" printed on the sides, and other subsidiary words below the triangle. In the year 1941 the respondents registered in Jamaica Trade Mark 3707, which consists of the single word "VapoRub".

The Court of Appeal have held the appellants liable for infringing both these Trade Marks. It is not disputed that, if Trade Mark 3707 is validly on the Register and is not now to be expunged, the appellants' actions have infringed it; for what they have been doing since the year 1942 is to import from England and market in Jamaica a medicated ointment of the "Vapour rub" type which bears on the jar, as a trade name, the words "Karsote Vapour Rub." But the appellants' case is that Trade Mark 3707 was not capable of being registered in 1941 and ought to be expunged from the Register now, and that, unless they can be found guilty of infringing Trade Mark 1852, which they say that they have never infringed, there is no case against them under the Jamaican Trade Marks Law (Chapter 272). It will be convenient to deal first with the questions relating to Trade Mark 1852.

Their Lordships consider that the Court of Appeal were right in holding that the appellants had infringed Trade Mark 1852. They have not used the mark itself on the goods that they have sold. But a mark is infringed by another trader if, even without using the whole of it upon or in connection with his goods, he uses one or more of its essential features. The identification of an essential feature depends partly on the Court's own judgment and partly on the burden of the evidence that is placed before it. A trade Mark is undoubtedly a visual device: but it is well-established law that the ascertainment of an essential feature is not to be by ocular test alone. Since words can form part, or indeed the whole, of a mark, it is impossible to exclude consideration of the sound or significance of those words. Thus it has long been accepted that, if a word forming part of a mark has come in trade to be used to identify the goods of the owner of the mark, it is an infringement of the mark itself to use that word as the mark or part of the mark of another trader. For confusion is likely to result. It is sufficient to refer to the words of Lord Cranworth, L.C. in *Seixo v. Provezende*, L.R., 1 Ch. App. 192 at 197:—"If the goods of a manufacturer have, from the mark or device he has used, become known in the market by a particular name, I think that the adoption by a rival trader of any mark which will cause his goods to bear the same name in the market, may be as much a violation of the rights of that rival as the actual copy of his device." Decisions to the same effect are to be found in *Ford v. Foster*, 7 Ch. App. 611, *Orr Ewing & Co. v. Johnston & Co.*, 13 Ch. D. 434, *Saville Perfumery Ltd. v. June Perfect, Ltd.*, 58 R.P.C. 147. The likelihood of confusion or deception in such cases is not disproved by placing the two marks side by side and demonstrating how small is the chance of error in any customer who places his order for goods with both the marks clearly before him. For orders are not placed, or are often not placed, under

such conditions. It is more useful to observe that in most persons the eye is not an accurate recorder of visual detail, and that marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole.

Tried by these tests the importance of "VapoRub" in Trade Mark 1852 becomes plain. Quite apart from what is shown by the oral evidence, it is itself a fancy word, coined originally to serve as the trade appellation of the respondents' product. There was an inherent likelihood that in course of time it would come to be used in the market as a distinctive name or one of the distinctive names of that product. And that is what the evidence shows to have happened in Jamaica. Both Courts in Jamaica have agreed in their findings that "Vicks VapoRub" and "VapoRub" are there synonymous terms. Mr. Justice Savary says in one passage of his judgment:— "The evidence, which was not contradicted or seriously challenged, established that for a period of 10 years or more the trade and the public used the expression 'Vicks VapoRub' as indicating the salve or ointment made by the plaintiffs, and that the words 'Vicks' alone and 'VapoRub' alone are used respectively as synonymous with 'Vicks VapoRub.' I must confess that but for the unchallenged evidence I would have had difficulty in concluding that the word 'VapoRub' as meaning 'Vicks VapoRub' was in common use by the public." In the light of these considerations their Lordships think that "VapoRub" must be treated as an essential feature, or, to use an alternative phrase, a material or substantial element, of Trade Mark 1852, and that the appellants have infringed the mark by selling their ointment under the designation "Karsote Vapour Rub"; for the word "Karsote" prefaced to "Vapour Rub" is quite insufficient in itself to dissolve the confusion that is bound to arise from associating the appellants' goods with a word so distinctive as "Vapour Rub."

What the appellants have sought to establish is that the word "VapoRub" in the respondents' mark is merely descriptive. To say that it is descriptive would not be enough, for, as Fletcher Moulton, L.J. pointed out in *Re Joseph Crosfield & Sons Ltd.*, 1910, 1 Ch. 130 at 145, there is no absolute incompatibility between what is descriptive and what is distinctive. A descriptive word, such as "sheen," can be recognised in law as distinctive if the evidence clearly shows that it is distinctive in fact. See e.g., *Re J. & P. Coats Application* 53 R.P.C. 355. But if a word or words are merely descriptive, in the sense that "cellular cloth" or "malted milk" or "shredded wheat" were said to be merely descriptive in the well-known cases in which their significance was the subject of judicial decision, then it would follow that the use of such words by one trader in his mark could not amount to an infringement of the mark of another trader, even if the words formed a part of that mark. For no Court could conclude that they amounted to one of its essential features and thus sanction just that encroachment on the common of the English language which the law has always refused to permit.

In this case it would be an abuse of language to place a fancy word such as "VapoRub" in the same descriptive class as such phrases as "malted milk" or "shredded wheat". This much can be said, that the word has a descriptive element; for it is a compound of two ordinary English words which were chosen for the purpose of suggesting to the reader leading characteristics of the substance sold. But the word itself is no description of a substance except to those persons to whom the term "a vapour rub" would be an intelligible use of words. And the evidence shows that those persons were not to be found in Jamaica at the relevant date. The affidavits filed on behalf of the appellants in support of their Motion to rectify the Register disclose quite clearly that they did in fact suppose "vapour rub" to be a merely descriptive term in the market, and that they based this supposition on their experience of the market conditions of the United Kingdom for some years back. It would be out of place in these proceedings to express any concluded view as to what the situation in the United Kingdom may have come to be. Such evidence as is available seems to

show that since the year 1929 the word "Vapour Rub" has come to be used in that field as a common term for any ointment having properties of the same kind as those of the appellants' and the respondents' ointments. But the reason why the respondents have taken no steps to try to prevent this happening is peculiar to the United Kingdom and what they have done and what they have not done have to be seen in the light of the provisions of the Medicines Stamp Duty Act of this country. If the evidence showed that the United Kingdom usage had spread to Jamaica, certainly that would tend to establish that the term "vaporub" had become merely descriptive in the Island and therefore could not be treated as an essential feature of the respondents' mark. The evidence, however, is to the contrary. The most that can be said is that such publications as the British Pharmaceutical Codex of 1934 and the 1929 Edition of Pharmaceutical Formulae treat "vapour rub" as a generic term and that one or more copies of these publications were to be found in Jamaica at the date of the action. Merely to find these books in Jamaica is not enough if, as is evidently the case, this particular part of their contents has not passed into the speech of doctors, or of druggists, or of dealers, or of the general public. For the Jamaican Register is a source of title in its own right: and, in considering any question that bears on registration in Jamaica or on the nature or extent of the monopoly in Jamaica that is granted by s. 39 of its Trade Marks Law, it is usage within the territorial jurisdiction of its law-making authority that must be taken into account. What is not merely descriptive by Jamaican usage is not altered in character by what may well be the different usage of the United Kingdom. To say this is only to say what has been said more than once in Trade Mark cases in this country; see, for instance, *Re Reddaway & Co.'s application*, 42 R.P.C. 229, 397, 44 R.P.C. 27., *Impex Electrical Ltd. v. Weinbaum*, 44 R.P.C. 405.

In these circumstances the appellants cannot find any protection in the provisions of s. 44 of the Trade Marks Law. That section declares that no registration under the 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. There is nothing in the section to suggest that it is directed specifically, if it is directed at all, towards protecting use by a person of a name or place of business or description by way of a trade mark. However that may be, it seems plain on the facts of this case that "Vapour Rub" cannot be regarded in Jamaica as a "bona fide description" of the character or quality of the appellants' goods. Perhaps the matter can be put most simply in this way: when the words "Vapour Rub" appear on the jars of ointment sold by the appellants they do not present themselves in Jamaica as a description of the character or quality of the substance which is sold but as the name of a substance which everyone regards as a product of the respondents' manufacture. If the makers of the goods which the appellants are selling desire to inform their customers that the properties of their ointment are such that, if it is rubbed on the chest or throat, it will give off a healing vapour which can be inhaled through the mouth or nose, there is nothing to prevent them from doing so. But that would be something different from what they have done hitherto.

It is necessary now to turn to Trade Mark 3707. When the respondents secured the registration of this mark in 1941 they stated in their application that they did not claim registration under the special provisions of clause (5) of s. 8 of the Trade Marks Law. Consequently no order of the Court permitting such registration was ever obtained. In the absence of such an order the word "VapoRub" could only be eligible for registration under clause (3) as "an invented word or invented words", or under clause (4) as "a word or words having no direct reference to the character or quality of the goods". Was it qualified for registration under either of these heads? Both the Courts in Jamaica have held that it was not eligible under clause (4). Counsel for the respondents did not challenge this interpretation before their Lordships' Board and their Lordships accept it as correct. Both Courts in Jamaica also held that "VapoRub"

was not an invented word within the meaning of clause (3), and this point was argued before their Lordships. It is, in their opinion, a difficult one. If "VapoRub" is not within the range of "invented words" it is at any rate only just outside. In both Courts the point was regarded as virtually determined by what appears in the speeches of Lord Herschell and Lord Shand in the *Solio* case, 1898, A.C. 571. No doubt all that was said in that case as to the meaning of "invented word" in the Trade Marks Acts is to be treated as authoritative guidance: but it is well to remember that the general construction of that phrase was not what was directly in issue in the *Solio* decision. What the House of Lords actually decided was that clauses (d) and (e) of subsection (1) of s. 64 of the Patents, Designs, and Trade Marks Act, 1883, as amended, were independent of each other and an "invented word" was not the less invented because it contained a reference to the character or quality of the goods it was to be applied to. To extract from that decision any final and general interpretation of the phrase "invented word" would require a synthesis of the views of the five members of the House who took part in the disposal of the appeal, and they did not all express themselves in exactly the same way. Perhaps the best standing interpretation is contained in the words of Mr. Justice Parker in *Philippart v. William Whiteley Ltd.*, 1908, 2 Ch. 274 at 279:—"To be an invented word within the meaning of the Act a word must not only be newly coined, in the sense of not being already current in the English language, but must be such as not to convey any meaning, or, at any rate, any obvious meaning, to ordinary Englishmen. It must be a word having no meaning or no obvious meaning until one has been assigned to it."

If this test is applied to the Jamaican conditions of 1941 it is true to say that the history of "VapoRub" showed it to be a word newly coined about the year 1911. But it was coined by putting together two ordinary words of the English language: and it is only common sense to infer that the word produced by this combination was intended, not to conceal, but actually to suggest the nature of the substance that it was to be applied to. Can that word be said to have had any obvious meaning? Taking into account the fact that it was coined as an appellation for an ointment of a particular kind and that the properties of such an ointment were already widely known, their Lordships think that Savary, J. and the Court of Appeal were right in refusing to treat it as an invented word and in regarding it as covered by Lord Herschell's proposition in the *Solio* case supra at p. 581: "I do not think the combination of two English words is an invented word, even although the combination may not have been in use before".

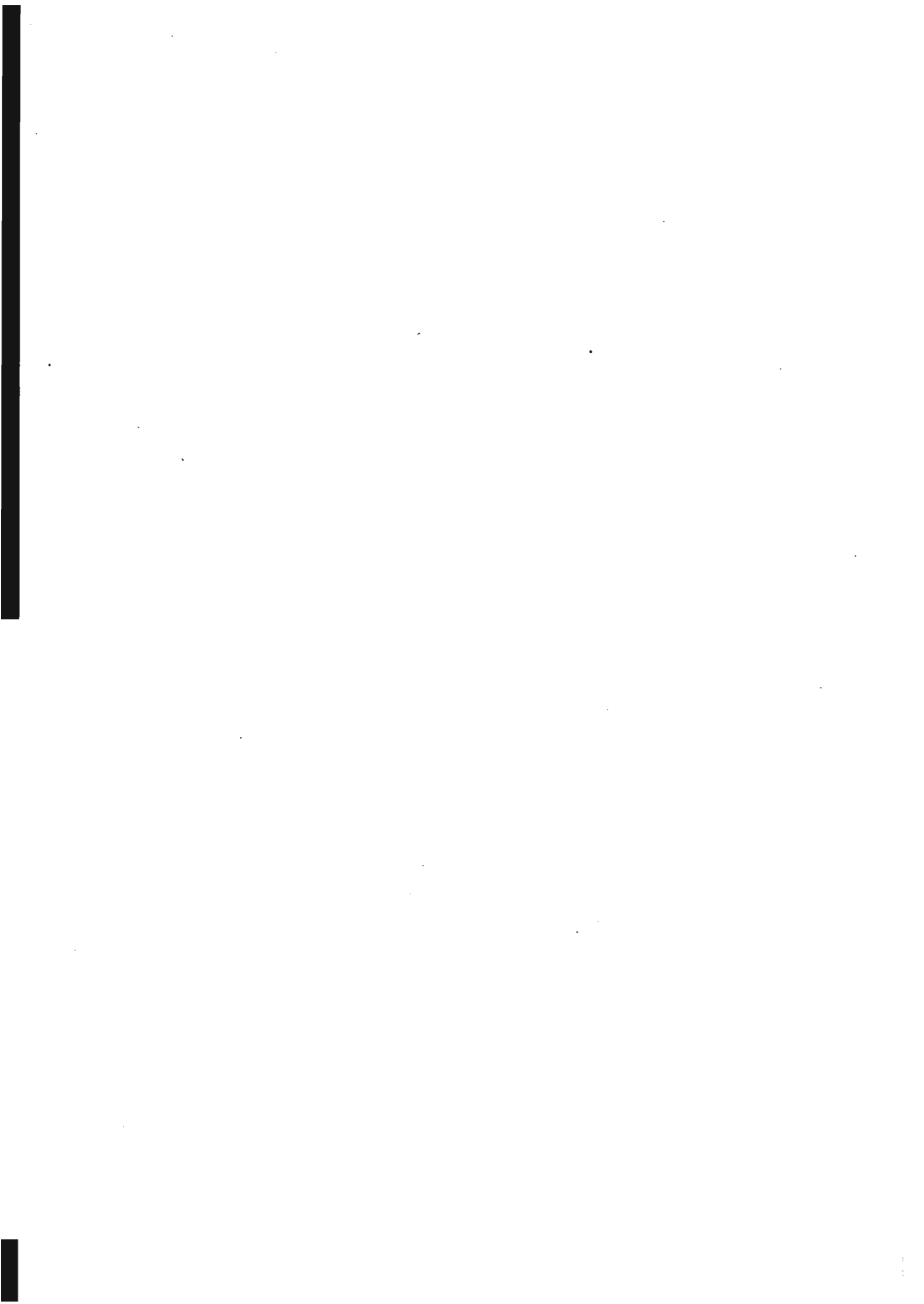
Where the Courts below have differed is that, whereas the trial Judge held that, if "VapoRub" was not within Clauses (3) and (4) of S.8 of the Trades Marks Law, he had no power not to expunge it from the Register, since a preliminary Order under Clause (5) had never been asked for or obtained, the Court of Appeal held that they had a discretion under S.35 of the Law to decline to expunge the mark from the Register, even if it could only have got there in the first place under the sanction of an Order that was never made, provided that they satisfied themselves that registration would have been effected in 1941 under the provisions of Clause (5), given the making of the necessary preliminary Order. Accordingly they reversed the Order of Savary, J. which had expunged Trade Mark 3707 from the Register and dismissed the appellants' motion to rectify.

Their Lordships agree with the Court of Appeal in holding that the learned trial Judge was in error in thinking that it was not open to him to overlook the defect in the respondents' registered title. Consequently, the discretion which, if exercised on proper principles, would not have been open to review had never been exercised at all, and the Court of Appeal were entitled to enter upon the matter and make their own order. There are not a few instances to be found in cases in this country in which the Court has declined to direct the removal of a mark from the Register even though some statutory requirement necessary to the validity of its entry has not been complied with. In the case of *W. N. Sharpe, Ltd.*

v. Solomon Brothers, Ltd. 31 R.P.C. 441, to which reference is made in the judgment of the Court of Appeal, Mr. Justice Warrington actually dealt with a case which raised the same point as that now under consideration and exercised his discretion by making no order for the removal of the mark. The decision itself is not one of any great authority, since his order was reversed on appeal on the ground that the mark in question was not in any event distinctive. Also, it is fair to add that all cases of this kind depend on their individual facts and the exercise of individual discretion appropriate to them. It is obvious that there is a considerable range of difference between the sorts of defect that may exist, just as the circumstances attending one failure may be very different from the circumstances attending another. Their Lordships do not think that it can be overlooked that the course which has been taken by the Court of Appeal amounts to what is in effect a substantial departure from the statutory scheme which was to govern the registration of Trade Marks under S.8 (5). It amounts to deciding in 1948, on evidence adduced in 1946, *inter partes*, and without the assistance of the Registrar's judgment a question which, if the law had been carried out, would have been decided in 1941, in the face of objections, if any, advanced by any interested party and with the assistance of a decision by the Registrar, the official entrusted by the statute with the general responsibility for the maintenance of the Register. Their Lordships do not express any opinion as to the course that they would have taken had they regarded the discretion under S.35 as exercisable by them on this appeal. In their view it would be contrary to principle to interfere with the discretion which the Court of Appeal have exercised unless it should appear that some misconception of law has vitiated the decision that was come to. And that does not appear. On the contrary, there is nothing to suggest that the considerations alluded to were not present to the minds of the members of that Court or that, having them in mind, they were not at liberty to conclude that the case was sufficiently clear to make it a reasonable certainty that registration under S.8 (5) would have been obtained in 1941. For that is what is involved in the decision to leave Trade Mark 3707 on the Register now. The Court expressed its conclusion that the word "VapoRub" was in itself adapted to distinguish the respondents' goods, apart from the circumstance that, by 1941, user had rendered it in fact distinctive; and from what has been said above, it will be clear that Their Lordships find no fault with the conclusion that "VapoRub" was "adapted to distinguish" for the purposes of the Act, and that the formalities that were omitted in 1941 were formalities and no more.

There remain two points to be mentioned. Firstly, a defence under S.44 is no more available in respect of an infringement of Trade Mark 3707 than of an infringement of Trade Mark 1852. The reasons are the same. Secondly, the Order made by the Court of Appeal evidently involved the view that the appellants had been guilty of passing off as well as of infringement, although the point is not dealt with separately in their Judgment. Their Lordships consider that there has been passing-off. For all the accepted differences between the two causes of action, the significance of the word "Vaporub" in the Jamaican market is a dominating element in the consideration of either; and it appears to Their Lordships that its significance was such that the appellants did not effectively distinguish their goods from those of the respondents by the use of the word "Karsote" or by the manner of the "get-up" of their jars. Nor is it of sufficient assistance to them that the respondents sold their jars in individual containers, while the appellants' jars were intended for delivery without outer covering.

Their Lordships will humbly advise His Majesty that the appeal should be dismissed. The appellants must pay the respondents' costs of the appeal.



In the Privy Council

CECIL DE CORDOVA AND OTHERS

v.

VICK CHEMICAL COMPANY

DELIVERED BY LORD RADCLIFFE

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