

1926
 March 29.

THE THERMOGENE COMPANY LTD. . . . PLAINTIFF;

AND

LA COMPAGNIE CHIMIQUE DE PRO- }
 DUITS DE FRANCE LTEE. } DEFENDANT.

*Trade-marks—Infringement—“Thermogene”—Distinctiveness—
 Descriptiveness*

Held, that the word “Thermogene,” not being in common use anywhere, except as denoting plaintiff’s goods; not being descriptive within the meaning of the Trade-Mark and Design Act, and having acquired a secondary meaning as distinguishing the goods of the plaintiff from those of the other traders, was a valid trade-mark.

2. That even if the said word should have reference to, or be suggestive, of the quality or characteristics of the goods, that feature of it is so remote as not to constitute a practical or reasonable objection to its adoption as a trade-mark.
3. That the mark consisting of the words “Ouate Thermogène Le Dragon,” applied to medicated wadding, appearing with other matter on the container of the defendant’s goods, of which the two first words “ouate thermogène” appear above the other two and are in much more conspicuous type than the latter, and much more readily observed, infringes plaintiffs’ mark by the use of the word “Thermogene” therein. That the said word was improperly therein registered, was calculated to mislead and deceive the public, and that defendant’s mark should be varied by striking therefrom the said word.

ACTION for infringement of a registered trade-mark consisting of the word "Thermogene."

Ottawa, 8th and 9th February, 1926.

Action now tried before the Honourable the President.

R. S. Smart for plaintiff.

R. Monty, K.C., for defendant.

The facts are stated in the reasons for judgment.

MACLEAN J., now this 29th March, 1926, delivered judgment.

This is an action for infringement of a registered specific trade-mark, consisting of the word "Thermogene" as applied to the sale of medicated wadding, and which was registered by the plaintiff in Canada in 1916. The mark was acquired by the plaintiff from one Vandembroeck & Cie of Belgium, who apparently had registered the same in Europe, as far back as 1897.

There is no doubt I think, that the evidence clearly establishes, that in this country the word "Thermogene" is distinctive of the goods produced by the plaintiff, and as sold to the Canadian public for some twenty years, and which have had a very wide distribution throughout Canada, through the agency of drug stores. Practically all drug stores in Canada carry in stock the medicated wadding produced by the plaintiff. To the drug trade particularly, and to the buying public, this word mark, I find upon the evidence, denotes the medicated wadding produced by the plaintiff. Upon this point I do not think I need say anything further, as the evidence overwhelmingly establishes the fact.

The infringement alleged against the defendant, is the use of the word "Thermogene" in a trade-mark registered in Canada by the defendant in 1924, and consisting of the words "Ouate Thermogene le Dragon," the word "Ouate" being the equivalent of wadding in English, and which trade-mark is applied to a medicated wadding sold by the defendant in Canada. This mark with other matter appears upon the label covering the box or package containing the defendant's goods. The last two words "Le Dragon" appear below the first two words "Ouate Ther-

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mogene," and the latter words appear in much more conspicuous type than the former, and are much more readily observed. The defendant pleads that the word "Thermogene" is descriptive, a common word of the French language, and being descriptive, is not a valid trade-mark, and may be used by any person. I might here say that infringement of the plaintiff's trade-mark has been established in my opinion by the evidence, if the plaintiff's mark is a valid one.

The Trade-Mark and Design Act, contains no statutory definition of a trade-mark, and is quite broad in its effect. It merely states, that all marks adopted for use by any person in his trade or business, for the purpose of distinguishing any manufacture, product or article, shall for the purposes of the Act, be considered and known as his mark. Notwithstanding this very general description, of what under the Act is deemed to be a trade-mark, it is obvious that there must be some limitation in the use of the words for the purposes of a trade-mark, and it has always been held that words descriptive of the goods, or having a direct reference to the character or quality of the goods, are not properly registrable. The purpose of restricting the words capable of being registered was to prevent persons appropriating to themselves words which ought to be open to all, such as words descriptive of the goods, or which have a direct reference to the character or quality of the goods. The Act itself does not, however, impose restrictions, or require particular essentials, in the selection of word marks. This must be kept in view in a consideration particularly, of English decisions in trade-mark cases, and which are inevitably much quoted in trade-mark cases in Canada. There the area of words available as trade-marks, has been increased progressively by successive Trade-Mark Acts; under the Act of 1875 no mere word mark was registrable at all; the Act of 1883 extended the area by admitting "fancy words not in common use"; and the Act of 1888 again extended it by admitting "invented words, or words having no reference to the character or quality of the goods upon which the mark was to be used." The Act of 1905 requires that the word shall have no "direct reference" to the character or quality of the goods, but it particularly

permits of the registration of distinctive words, that is words adapted to distinguish the goods of the proprietor of the word mark, from the goods of other persons, and which is a question of fact to be established by evidence. This was I think merely declaratory of what was the law.

The first point then to consider is whether the plaintiff's word mark is a descriptive word. Many dictionary references were submitted at the trial to establish the meaning of the word mark in question in this case. Many dictionaries, particularly of the French language, establish that the word, of Greek origin, generally has reference to the generation or production of heat, by physiological and other processes. In some dictionaries the word is not defined. I am satisfied that it is not a word in common use anywhere, or in any language, but is rare and practically obsolete so far as ordinary language is concerned. When it was first used by Vandembroeck in Europe, or first by the plaintiff in Canada, I have no doubt it was practically unknown except to a select few given to etymology, and did not denote medicated wadding made by any person. To the English or French population of Canada, it may safely be said to be practically unknown to-day, except to denote the plaintiff's medicated wadding. It does not I think when pronounced, convey to the hearer any particular quality of the goods. I do not think the Act or the law requires that a person selecting or searching for a word mark for registration must arm himself with a classical dictionary or an etymologist, or both, lest perchance he select a word which is remotely suggestive of, or has an indirect reference to his goods. As was said by Vaughan Williams L.J., in *Burroughs Wellcome & Co. Trade-Mark* (1), it is not to the interest of any community to deal with any subject-matter which is regulated by statute law, so as to make the rule or law deduced from the statute, impractical, or inconsistent with the practice of mankind. To select words more or less cognate to the articles with reference to which the trade-mark is to be used is natural and to be expected, and is not I think against the statute, but one must be sure that the cognate word does not describe the goods, or seek to appropriate a word which all might

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(1) [1904] 1 Ch. D. 736, at p. 751.

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use. I cannot make myself believe that "Thermogene" ever denoted, or was ever applied in popular language in Canada by either English or French speaking persons, to any known substance other than the article sold by the plaintiff, at least up to the time when the defendant came upon the market. The plaintiff's counsel urged that medicated wadding does not by itself produce heat, but that it is a counter irritant, producing a congestion of the blood vessels and causing a flow of blood, and thus producing a sensation of heat. If this is correct, and I believe it is, and if medicated wadding apart from the human body generates no heat, it only serves to indicate the remoteness of the suggestion, that the mark is descriptive of the goods.

I do not think the word mark is descriptive of or has reference to the plaintiff's goods at all, but at least not in the sense, or in that degree which invalidates it as a trade-mark. For a word to be really descriptive, it must describe something which is material to the composition of the goods, and that cannot here I think be said. Further it is not a word I think in common use anywhere, and if it has reference to, or is suggestive of the quality or characteristics of the goods, it is so remote as not to constitute a practical or reasonable objection, or a contravention of the statute. As was said by Vaughan Williams L.J., in the *Tabloid Case* (1), if a word mark must not be descriptive it need not be absolutely unsuggestive. See also the *Bovril Case* (2); *The Solio Case* (3). If Thermogene means the plaintiff's product, it is owing to the use made of it by the plaintiff, and his success in making the public acquainted with it, but that is different from saying that the word is a common word, or a descriptive word. The defendant of course may make and vend a medicated wadding, and adopt for it a word trade-mark as others in fact have done. I think therefore the word "Thermogene" is not descriptive and is a valid trade-mark.

The plaintiff also contends alternatively that the word "Thermogene" although it be *prima facie* descriptive, or have reference to the goods, has acquired a secondary distinctive meaning; and that in Canada it distinguishes the

(1) [1904] 1 Ch. 736 (C.A.)

(2) [1896] 2 Ch. 600 (C.A.)

(3) [1898] A.C. 571.

plaintiff's goods; that before it commenced to use the word it was not commonly used to identify anything, and that now it means nothing else but the plaintiff's goods, and is therefore distinctive of the plaintiff's goods. That long and continued use of a word mark may become distinctive of one's goods and may acquire a secondary distinctive meaning, has long been a recognized doctrine of the law of trade-marks. *Reddway v. Banham* (1); *Eno v. Dunn* (2); *Re California Fig Syrup Co.* (3); *Horlick's Case* (4). In the second last mentioned case Fletcher Moulton L.J., said at p. 146:—

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The question as to whether a word is or is not capable of becoming distinctive of the goods of a particular trader, is a question of fact, and is not determined by its being or not descriptive. The law has never refused to recognize that this is the case, or to give protection to descriptive trade-marks when once established in fact.

The English Trade-Mark Act, 1905, now makes provision for the registration of distinctive words upon evidence of distinctiveness, and also for the continuance of registration for the same reason. This was really declaratory of what I think had been the law. Section 5 of that Act states that "distinctive" shall mean adapted to distinguish the goods of the proprietor of the trade-mark from that 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, take into consideration the extent to which the user has rendered such trade-mark in fact distinctive for the goods with respect to which it is registered or proposed to be registered. Our present Trade-Mark Rule 10 is to the same effect, in the case of primary registration.

Here the evidence proves abundantly that in Canada the word mark of the plaintiff, by extensive usage, has become adapted to distinguish its goods. The word was registered first in 1909, along with other matter, but for some reason the word "Thermogene" by itself was registered again in 1916, and it is upon this registration that the present action is brought. According to the evidence there are about 3,000 drug stores in Canada, and between 2,800 and 2,900 sell Thermogene, the plaintiff's goods. As some witnesses state that they have known of this mark,

(1) [1896] 13 R.P.C. 218.

(2) [1890] 15 A.C. 252.

(3) [1910] Ch. 130.

(4) [1917] 64 S.C.R. 466.

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as distinguishing the plaintiff's goods for over 20 years, I think it is probable that the goods of the plaintiff were sold in Canada prior to the registration of its first mark by either the plaintiff or Vandembroeck & Cie, its predecessor.

The validity of the plaintiff's trade-mark now being questioned, and long continued and extensive user in Canada being well established by the evidence, and it being clear from the evidence that the mark has become adapted to distinguish the goods of the plaintiff. I am of the opinion that the word has acquired a secondary distinctive meaning, and is now a valid trade-mark, whether or not it is a descriptive word, and whether or not it has reference to the character or quality of the goods in connection with which the mark is used.

The defendant pleads that a judgment of the Court of Appeal of Paris, held, that the word mark here in question was descriptive. No evidence as to what was the French law in respect of trade-marks as for instance whether the doctrine of secondary meaning finds acceptance there, and there being judgments of other French courts, and also a Belgian court, to the contrary, and which were referred to at the trial, I do not think it necessary or desirable that I should discuss that particular decision. For the reasons I have given, I am of the opinion that the plaintiff's mark is a valid mark; I am also of the opinion that the defendant's trade-mark infringes the plaintiff's mark by the use of the word "Thermogene" therein, and that the word "Thermogene" was improperly therein registered because it was calculated to mislead and deceive the public, as in fact the evidence sufficiently discloses. The plaintiff is entitled to the usual injunction; to damages, with a reference to the Registrar to assess the same; and also to an order requiring the defendant to deliver up to the plaintiff all containers, labels, etc., as claimed. The plaintiff shall also have its costs of action.

Judgment accordingly.