1929
Jan. 10.
Feb. 4.

HENRY K. WAMPOLE & CO., LIMITED..PLAINTIFF;

AND

HERVAY CHEMICAL CO. OF CANADA LIMITED ..... } DEFENDANT.

Trade-Marks—Infringement—Packings common to the trade—Form, size or colour—"Get-up"

For some years previous to the date of plaintiff's registration of its trade-marks in question herein, it had been common to the trade, including the defendant, to market cod liver oil in pink or red packings, similar to the plaintiffs. The defendant's package complained of however bore his name prominently at the top. This was so also of the label on the bottle itself inside. Plaintiff's outside package also bore the name "Wampole" in large letters at top. This being the essential characteristic of the two trade-marks.

Held: That when the goods of one manufacture are so packed or arranged externally as to resemble those of others engaged in the same trade (as in the case of starch and tea), the similarity common to all does not of itself expose the manufacturer to an action for infringement, but makes it incumbent upon him to take care that his distinguishing mark is really distinguishing. The imitation or similarity must be in respect to matters which are not common to the trade, but special to one trader. And in this case the manufacturer's name, printed in large letters at the top being really distinguishing, the public could not be deceived, and the action was dismissed.

2. A trade-mark does not lie in each particular part of the label, but in the combination of them all. It is the impression produced by the mark as a whole, *dans son ensemble,* in its "get-up" and which strikes the eye, that must be considered.

3. The user of a trade-mark does not result in what the person using it may have in mind; but what the public would obviously understand upon looking at the package.

4. There can be no trade-mark right in the mere form, size or colour of a package containing an article used commercially.

5. Where two traders are selling the same medicine, and the one prints on his bottle directions for its use, assuming such directions to be correct, it is no infringement of such label to copy or repeat such directions; otherwise his liberty as a manufacturer would be unduly interfered with.

ACTION by the plaintiff to restrain the defendant from infringing its trade-marks.

The action was tried before the Honourable Mr. Justice Audette, at the city of Quebec.

O. M. Biggar, K.C., and *H. A. O'Donnell* for plaintiff.

The Honourable J. L. Perron and *E. J. Flynn* for defendant.

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The facts are stated in the reasons for judgment.

AUDETTE J., now (February 4, 1929), delivered judgment.

This is an action whereby it is sought to restrain the defendant from infringing the plaintiff's specific trade-mark and from selling any cod liver extract in packages and in bottles which the plaintiff alleges have labels colourably resembling the plaintiff's two trade-marks:—one upon the outside wrapper and one upon the bottle inside of the wrapper.

For the proper understanding of this case it is thought advisable to here recite these two trade-marks and to show how often the plaintiff's name appears upon his goods.

The mark applicable to the outside package consists of a

Specific trade-mark to be applied to the sale of a preparation of Cod Liver Extract, and which consists of a four-part label, of a *peculiar salmon pink colour*, the front panel bearing the word "Wampole's" "Tasteless preparation of an Extract of Cod Liver," and descriptive matter, across which appears the signature "Henry K. Wampole & Co.," underneath is the name "Henry K. Wampole & Co. Limited"; one of the side panels, printed longitudinally, bears the words "Henry K. Wampole & Co. Limited" and descriptive matter; the corresponding side and back panels bear a translation in French.

The plaintiff's mark for the bottle, placed inside this wrapper, consists of a

Specific Trade-Mark to be applied to the sale of a preparation of Cod Liver Extract, and which consists of a label for a bottle, comprising three white panels bordered with a peculiar salmon pink, the center panel bearing the word "Wampole's", "Tasteless preparation of an Extract of Cod Liver", and descriptive matter, across which is the signature "Henry K. Wampole & Co." diagonally, in red; underneath is the name "Henry K. Wampole & Co. Limited;" one of the side panels contains the words: "Wampole's has stood the test for nearly half a century" and descriptive matter, with a translation in French underneath; the remaining panel is a translation in French of the center panel.

Both trade-marks bear date the 19th July, 1924.

It is well to bear in mind that, unlike a patent or copyright which relates to the substance of an article, a trade-mark differs from them and does not protect the substance of the article to which it is attached from being imitated; but it identifies an article and indicates the source to which that article is to be attributed. The function of a trade-mark is to identify goods of an individual.

The evidence discloses that cod liver oil has been on the market in similar pink or red packings for a number of years. This similarity, common to so many in that trade,

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has in the present case been made distinguishable, among other manners, by the name of each party in very large type placed at the most conspicuous part of the packing, at the very top of the wrapper to avoid any confusion and possibility of deception. Here, there is the signature across Wampole's wrapper in very striking type, which is not correspondingly to be found on Hervey's wrapper.

The defendant was using similar packing, with almost the same colour, upon the same article, some twenty-five years ago and more, as shewn by exhibit No. 3. A number of other such packings, practically of the same colour, were also used for a number of years back by a number of cod liver oil manufacturers; all before the date of the registration of the plaintiff's trade-mark. *Fafard* v. *Ferland* (1). The registration, by the plaintiff, of these trade-marks did not *per se* give him any new rights in respect thereto.

When goods of one manufacturer are so packed or arranged externally as to resemble those of others engaged in the same trade (as when starch was put up commonly in the trade in packets of a certain colour and appearance, tea in well known kind of boxes, flour in barrels) the similarity common to all does not of itself expose the manufacturer to an action; but it makes it incumbent upon him to take care that his distinguishing mark is really distinguishing, as in the present case. Sebastian, 14 ed. 154. *Payton & Co. Ltd.* v. *Snelling, Lampard & Co. Ltd.* (2); *Payton* v. *Titus Ward & Co. Ltd.* (3); *Smith Potato Crisps Ltd.* v. *Paige's Potato Crisps Ltd.* (4). The trend of the law is strongly towards the proposition that in ordinary circumstances the adoption of packages of peculiar form or colour alone, unaccompanied by any distinguishing symbol, letter, sign or seal, is not sufficient to constitute a trade-mark. If the article produced by one person is the same as that produced by another, and the latter is quite at liberty to produce the same article, and if the directions used by the latter are the correct directions for use of the former's article, he can only repeat them. In fact, if he could not give the appropriate directions for using the

(1) (1903) 6 Q.P.R. 119.
(2) (1899) 17 R.P.C. 48, at p. 50.
(3) (1899) 17 R.P.C. 58.
(4) (1928) 45 R.P.C. 132 at 136.

article which he is entitled to make, his liberty to manufacture would be unduly interfered with.

In other words the imitation or similarity must be in respect to matters which are not common to the trade but special to the plaintiff.

Can a wrapping be made the subject of a trade-mark by only being coloured, without any other distinguishing features? *Smith* v. *Krause* (1); *Philadelphia Novelty Mfg. Co.* v. *Blakesley Novelty Co.* (2).

The difference between the plaintiff's and the defendant's wrappers is honestly accentuated by the name of each trader, in very large type. No one could be deceived, because the name of each trader is what necessarily strikes the eye upon looking at the package.

Distinctiveness is of the very essence of the mark and that principle applies to the component parts visible upon the exterior of the package. Distinctiveness means adoption to distinguish. Sebastian 55.

The trade-mark does not lie in each particular part of the label, but in the combination of them all. It is the impression produced by the mark as a whole, *dans son ensemble,* in its "get-up" that must be considered. It is the appeal to the eye that must control and decide. The essential characteristic of the two trade-marks in question is the name of each trader at the very top of the package, which is the main feature of the whole "get-up."

The user of a trade-mark does not result in what the person who makes use of it may have in his mind; but what the public would obviously understand when the name or trade-mark is impressed upon the wrapper or the bottle. And the weight of the evidence, with which I concur, establishes that in view of the name so largely printed and disposed in such conspicuous place and manner, the public, even the unwary and incautious purchaser, could not be made or led to purchase the goods of one party for that of the other.

Coming to the joint consideration of the outside wrapper with the bottle inside the same, upon which much stress was put at trial, it would seem that if one would stop and think, that the answer to the matter is indeed

(1) (1908) 160 Fed. Rep. 270 at 271.

(2) (1889) 40 Fed. Rep. 588.

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that if a purchaser cannot be deceived by the outside cover —the wrapper in which the bottle is sold without being exhibited at the time of sale—how can it be logically contended that he could or might be deceived by the label on bottle inside the wrapper. The evidence even discloses that a commercial traveller selling the plaintiff's goods for a number of years had never looked at the bottle inside and could not speak in respect of the same.

Each bottle,—of either party—bears the name of each trader as upon the wrapper, and the description or direction as to use; but the same language cannot be invoked as infringement for the reasons above set forth.

If a purchaser bought a Hervay bottle from the outside wrapper, he expects a bottle of Hervay inside. When the wrapper is broken and he extracts the bottle from the inside he obviously sees in large type the name of Hervay, which confirms him that he has what he bought and he could not, under such circumstances, in any way conceive that he has a Wampole bottle.

This cod liver oil is sold to the public only in those outside packages and it is the mark on the package that strikes the eye of the purchasing consumer before he comes to look at the inside bottle; and that very fact is of controlling importance with respect to the label on the bottle.

And I may here repeat with respect to the literature on the label of the bottle placed inside the wrapper, that it is a well settled rule that there can be no trade-mark right in the mere form, size or colour of a package containing an article used commercially.

It is also an established principle that there can be no trade-mark right in the direction, notices or usual advertising matter used upon or in the description of merchandise. Hopkins, pp. 280, 315 et seq.

Much more might be said in the same stress showing that each party is entitled to his trade-mark which cannot produce deception, but the case seems so simple and clear that I see no justification to add anything to what has already been said. Further comments are unnecessary.

I find the two marks perfectly distinct and not liable to create deception.

There will be judgment dismissing the action with costs.

Judgment accordingly.