1935
June 24.
July 31.

BETWEEN:

VASENOLWERKE DR. ARTHUR KÖPP AKTIENGESELLSCHAFT. } APPELLANT;

AND

THE COMMISSIONER OF PATENTS AND CHESEBROUGH MFG. CO. .... } RESPONDENTS.

Trade Mark—"Vaseline" and "Vasenol"—Calculated to deceive—Unfair Competition Act—Motion to limit trade mark "Vaseline".

An application for the registration of "Vasenol" as a trade mark in connection with the sale of hygienic and antiseptic skin powder, wound and baby powder, foot powder, toilet powder, soaps, bandaging material, cold cream and baby cream, was refused by the Registrar of Trade Marks. At the hearing of an appeal from such refusal the Chesebrough Manufacturing Company, Consolidated, owner of the trade mark "Vaseline," appeared as objecting party.

Applicant also moved to have the register amended so that the trade mark "Vaseline" should be limited to certain wares and should exclude those named in applicant's application, on the ground that Chesebrough has not used its mark in connection with these wares.

Held: That the marks "Vasenol" and "Vaseline" are similar and that the registration of the word Vasenol would be calculated to deceive and would be in conflict with the word mark Vaseline.

2. That for the purposes of the Unfair Competition Act the wares for which Chesebrough is registered in Canada, and the wares for which the applicant seeks registration in Canada, are similar.

3. That it is sufficient that the articles sold by each party fall within the same general description of wares, to refuse registration of vasenol for the powder applications of the applicant.

APPEAL from the refusal of the Registrar of Trade Marks to register the trade mark "Vasenol." The applicant also moved to limit the trade mark "Vaseline."

The motion was heard before the Honourable Mr. Justice Maclean, President of the Court, at Ottawa.

G. E. Maybee for the appellant.

O. M. Biggar K.C. and *R. S. Smart K.C.* for Chesebrough Mfg. Co.

No one appeared for the Commissioner of Patents.

The facts are stated in the reasons for judgment.

THE PRESIDENT, now (July 31, 1935) delivered the following judgment:

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This is a motion by way of appeal from the refusal of the Registrar of Trade Marks to register the trade mark "Vasenol," applied for by the above named applicant, a corporation organized under the laws of Germany and having its chief place of business in Leipzig, Germany. The applicant states that it is "commercially concerned in the manufacture and sale of remedies, medical, pharmaceutical, hygienic and cosmetical preparations and toilet articles." The applicant further states that it has used for many years the trade mark Vasenol in connection with the sale of "hygienic and antiseptic skin powder, wound and baby powder, foot powder, toilet powder, soaps, bandaging material, cold cream and baby cream," and it is in connection with the sale of such articles the applicant desires registration in Canada of the word mark "Vasenol." The trade mark "Vasenol" first came into use, by the applicant or its predecessors, in 1903, in Germany, where it was first registered in connection with the sale of such goods and subsequently in most European countries, several South American countries, and in other countries as well, but not in any English speaking countries. Any printed matter appearing on the containers of the applicant's wares would seem to be in the German language, and its advertising matter seems to be limited to German language journals. The wares of the applicant have never been sold in Canada.

The objecting party is the Chesebrough Manufacturing Company, Consolidated, a corporation organized under the laws of the State of New York, and hereafter to be referred to as "Chesebrough." This company, or its predecessors in business, have been using the trade mark "Vaseline" for upwards of sixty years to denote its manufactures, and in many countries of the world. In 1879 it registered Vaseline in Canada as a specific trade mark to be applied to the sale of "a certain product of petroleum of certain medicinal or toilet articles or preparations in which said product is incorporated." In 1908 Chesebrough registered Vaseline as a general trade mark to be used in connection with the sale of petroleum jelly, ointments, lubricants, toilet articles and medicinal preparations, and that trade mark has continuously since appeared in the trade

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mark register, in Canada. Vaseline is registered as a trade mark in many of the countries of Europe, South America, Asia, Africa, throughout the whole British Empire, in the United States, and elsewhere. However, the principal markets for the goods manufactured and sold by Chesebrough under its mark are the North American continent, the British Isles and the British Dominions, and speaking generally, English speaking countries. The average value of the products sold by Chesebrough, under its trade mark, during the last ten years has exceeded the sum of $3,500,000 per annum, and its average expenditure for advertising during that period is said to exceed $400,000 per annum. It is almost unnecessary to state that the trade mark Vaseline is well known in very many countries of the world but particularly in English speaking countries.

An affidavit made by Robert S. Gill, Vice-President of Chesebrough, was produced on the hearing of the motion, and Mr. Gill therein states that the mark Vaseline was invented and adopted as a trade mark, in 1870, by Robert A. Chesebrough, the founder of Chesebrough, and has been in use ever since. At first it was used as a trade mark for highly refined petroleum jelly, which Robert A. Chesebrough then manufactured. In 1884, when Mr. Gill entered the employ of Chesebrough, he states it was then, under its trade mark Vaseline, manufacturing and selling white petroleum jelly, yellow petroleum jelly, pomade, camphor-ice, cold cream, hair tonic, soap, oil of petroleum perfumed, perfumed white zinc ointment, and a number of other petroleum jelly products. He also states that Chesebrough has always been zealous in the protection of its exclusive right to the use of the trade mark Vaseline to distinguish its products from those of other manufacturers. In a few countries, he states, Chesebrough has been denied such exclusive right owing to the domestic laws of such countries, but in Great Britain, the United States, and many other important countries, Chesebrough's exclusive right in its trade mark has been successfully asserted and the registration or use by others of similar words for similar ware, capable of being confused with the word Vaseline, has been prevented, among others, the

words "Vasogene," "Vistroleum," "Vasano," "Velv-o-rene," "Vazinol," "Vaza," "Vassar," "Vasa-jell," "Vaz-o-lyn," and "Velvolatum.' In England, in 1898, on the application of one Pearson, it was sought to register the word "Vasogen." As I understand it, the virtual result of the application to register this word was its refusal, on the grounds of its resemblance to "Vaseline," though the controversy largely related to another important point. The case is to be found reported in 18 R.P.C. at page 191, and 19 R.P.C. at page 342. I am not sure whether Mr. Gill by his affidavit meant to distinguish between "Vasogen" and "Vasogene." I might here add that it would appear from the material before me, that since 1884 Chesebrough has added to its list of manufactured products sold under the trade mark Vaseline and that now the same are twenty-three in number.

The applicant's motion concerns not only an appeal from the refusal to register the word Vasenol for the articles mentioned in its application, but it seeks also to amend the register concerning the trade mark Vaseline, so that Chesebrough's registration of Vaseline should be limited to the following wares: petroleum jelly, hair tonic and pomade, oxide of zinc ointment benzoinated, and camphor-ice, and should exclude hygienic and antiseptic powder, wound and baby powder, foot powder, toilet powder, soaps, bandaging material, cold cream and baby cream. This feature of the applicant's motion is made upon the ground that the register does not accurately express or define the existing rights of Chesebrough, because it has not used its mark in connection with the last mentioned list of wares, being the wares for which the applicant seeks registration for its mark. This means that the applicant contends that Chesebrough is only entitled to the use of its mark Vaseline in respect of the wares which presently it sells in Canada. I perhaps should state the specific grounds upon which the applicant urges that its application to register Vasenol should be allowed. They are set out in the notice of motion as follows: (1) The applicant's said trade mark is not within the meaning of the Unfair Competition Act similar to the trade mark Chesebrough Manufacturing Company (Consolidated) Reg. No. 52 Folio 12639 cited

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against the said application of Vasenolwerke Dr. Arthur Köpp Aktiengesellschaft. (2) The wares in connection with which the applicant's mark is used are not within the meaning of the Unfair Competition Act similar to the wares to which the said trade mark of Chesebrough Manufacturing Company (Consolidated) is applied. (3) That applicant's said trade mark is registrable by virtue of the provisions of Section 28 (1) (*d*) of the Unfair Competition Act.

Before proceeding further this would be a convenient stage at which to discuss two or three points which are directed mainly towards the plea of acquiescence by Chesebrough, in the use abroad by the applicant, of its mark. It is stated in an affidavit made by Dr. Arthur Köpp, managing director of the applicant company, that the trade mark of the applicant and that of Chesebrough have been used side by side, without conflict, confusion or deception, in about forty different countries, in most of which Vasenol is registered, and in some of which both Vaseline and Vasenol are registered, and that Chesebrough has never objected to or opposed the use or registration of the applicant's mark in such countries. It is contended that the concurrent use of both marks in such countries should operate as a bar to any opposition from Chesebrough in respect of the applicant's application to register Vasenol in Canada. Mr. Gill in his affidavit states that Chesebrough has never had any notice of any application to register the trade mark Vasenol in any country in which the English language is commonly in use, except in South Africa and Palestine, in which two countries certain applications for registration of Vasenol have recently been made and are being opposed by Chesebrough; the applications have not yet been disposed of. Mr. Gill also states in this affidavit that in many foreign countries where the English language is not commonly used the products of Chesebrough are not identified solely by the mark Vaseline. In many of such countries the products bear, for example, the compound name Vaseline-Chesebrough. I do not think that all this of itself deprives Chesebrough of the right to object to the registration of the applicant's mark in Canada. In the first place I should remark that whether or not the

two marks are in concurrent use in forty countries abroad, without conflict, can hardly be established satisfactorily by the affidavit evidence of a single interested party. One would wish to know more than appears in Dr. Köpp's affidavit, before accepting his conclusion here. Then, it does not seem reasonable to say that if Chesebrough has not taken proceedings against the applicant, in all the countries where the applicant uses its mark, that this means that Chesebrough has acquiesced in the right of the applicant to do what it has been doing. Failure to resist registration or infringement in countries abroad would not, I think, be a bar to proceedings against registration of Vasenol in Canada, except perhaps under an unusual state of facts. Upon the facts before me it would be impossible to hold that there has been such acquiescence on the part of Chesebrough, in respect of what the applicant has been doing abroad, as to preclude it from opposing the motion here.

It was also urged against Chesebrough that it had at one time consented to the registration of the word "Vasano." It appears that an application for the registration of this word mark was made in England, in 1928, and was at first opposed by Chesebrough, but the opposition was withdrawn upon an undertaking being given by the applicant that the mark would be limited in its use to goods prepared for use in the treatment of sea-sickness and like ailments. I think no comment whatever is necessary in respect of this point. Chesebrough consented to the registration, I assume, in the belief that the use of that mark, so limited, was not liable to cause confusion with the use of its mark in England.

The Registrar refused registration of Vasenol, on the ground that the word itself was similar to Vaseline, and that the wares on which Chesebrough applied its mark were similar to the wares to which the applicant proposed to apply its mark, in Canada. I think the Registrar reached the proper conclusion.

There are two points to decide, first, are the words Vaseline and Vasenol if applied to similar wares, so similar as to cause confusion, and secondly, whether the wares mentioned by the applicant in its application are similar

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to those made and sold by Chesebrough. If those wares are not similar within the intendment of the statute, then the applicant would, I apprehend, be entitled to registration. If they are similar then the question for decision is whether the two marks in question are so similar as to be in conflict and liable to cause confusion. Sec. 26 (1) (*d*) and (*f*) states what marks shall be registrable and the relevant portions are as follows:—

26. (1) Subject as otherwise provided in this Act, a word mark shall be registrable if it

(*d*) would not if sounded be so descriptive or misdescriptive to an English or French speaking person;

(*f*) if not similar to, or to a possible translation into English or French of, some other word mark already registered for use in connection with similar wares;

Sec. 28 (1) (*d*) is to the following effect:—

28 (1) Notwithstanding anything hereinbefore contained:—

(*d*) A word or group of words, which the applicant or his predecessor in title, without being guilty of any act of unfair competition, has already caused to be duly and validly registered as a trade mark in the country of origin of such registration, shall, although otherwise unregistrable by reason of its or their form, sound or meaning, be registrable under this Act provided . . . (iii) that it is not in conflict with any mark already registered for similar wares; . . .

Sec. 2 (*k*) and (*l*) define what may be construed as similar words, or similar wares, and they are as follows:

2. (*k*) "Similar," in relation to trade marks, trade names or distinguishing guises, describes marks, names or guises so resembling each other or so clearly suggesting the idea conveyed by each other that the contemporaneous use of both in the same area in association with wares of the same kind would be likely to cause dealers in and/or users of such wares to infer that the same person assumed responsibility for their character or quality, for the conditions under which or the class of persons by whom they were produced, or for their place of origin;

(l) "Similar," in relation to wares, describes categories of wares which, by reason of their common characteristics or of the correspondence of the classes of persons by whom they are ordinarily dealt in or used, or of the manner or circumstances of their use, would, if in the same area they contemporaneously bore the trade mark or presented the distinguishing guise in question, be likely to be so associated with each other by dealers in and/or users of them as to cause such dealers and/or users to infer that the same person assumed responsibility for their character or quality, for the conditions under which or the class of persons by whom they were produced, or for their place of origin;

Now, I think, the wares manufactured and sold by the applicant and Chesebrough respectively, under their respective registered trade marks, are similar; they have common characteristics, the purposes for which they are to be used are much alike, and they probably would be

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dealt in and distributed to the consuming public through the same trade channels. The applicant describes generally its manufactures and sales, as I already observed, as "remedies, medical, pharmaceutical, hygienic and cosmetical preparations and toilet articles," much as Chesebrough describes its products. For the purposes of the Unfair Competition Act I think it can fairly be said that the wares for which Chesebrough is registered in Canada, and the wares for which the applicant seeks registration in Canada, are similar.

I have little hesitation in saying that, in my opinion, the word marks "Vasenol" and "Vaseline" are similar; the registration of the word Vasenol would be calculated to deceive and would be in conflict with the word mark Vaseline already registered in Canada, and particularly would this be so in Canada, where printed labels, directions, descriptive and advertising matter, would likely be largely in the English language. I think there is a very great similarity between the two words, both to the ear and the eye; they sound much alike if not pronounced distinctly and carefully, and they look considerably alike if not read with care. It is undesirable to cause even a liability to confusion or deception. While the applicant's mark was duly and perhaps validly registered in Germany, the country of origin of such registration, still it is not entitled to registration in Canada because it would be in conflict with a mark already registered there for similar wares.

Before concluding I should observe perhaps that the applicant urged that Chesebrough was not now entitled to the registration of the word mark Vaseline for toilet soap because that article was not sold in Canada by Chesebrough. The applicant's evidence on this point is only to the effect that one Charles was informed by the manager of a store in Toronto that he believed Vaseline toilet soap was not sold in Canada. It is made and sold in the United States, and a sample of it was produced in evidence, but it is not clear from the material before me, whether it is presently being sold in Canada, but I do not think that this is of such importance as to require me to direct that oral evidence be heard to establish the fact one way or

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the other. Vaseline is registered for toilet articles, and we know that toilet soap is made and sold by Chesebrough, and that it is possible that it may be sold in Canada. I should not like to say how persistent and regular must be the sale of any particular ware in Canada, which is made abroad, to maintain a Canadian registered trade mark to be there used in connection with such a ware. I should hardly think that a registered trade mark should be removed from the register, or amended, solely because any particular ware, well known to be made abroad in the country of origin, and sold under that trade mark, is not sold in Canada in some years. If the trade marks here in question are similar and the wares are similar, that, I think, is sufficient ground to refuse the application to register Vasenol for soap; if Vaseline toilet soap is sold in the United States, and possibly elsewhere, and Vaseline is registered in Canada for toilet soap that, I think, alone should be sufficient ground for refusing the registration of Vasenol for soap in Canada.

Mr. Maybee at the end of his argument stated that his client would be willing to limit its application to the powder articles mentioned therein if I entertained any difficulty concerning the balance of them. As is stated in one of the affidavits of Mr. Gill, Chesebrough does not sell toilet or remedial preparations in powder form, but such preparations are used for purposes very similar to those for which some of the Chesebrough preparations are used, and they are distributed through the same channels of trade, and the manner and circumstances of their use are very much the same. Mr. Gill, in his affidavit, states that Chesebrough's "petroleum jelly products are used in substantially identically the same way as baby cream," and its "zinc ointment is definitely recommended for nursery use and is commonly used in the care of small children." It is useless to refine too much as to the precise similarities and distinctions between the several wares made by Chesebrough and the applicant; what is desired is the avoidance of any conflict or confusion between the two trade marks in question, in the same market, for the protection of the public. I think it is sufficient that they fall within

the same general description of wares to refuse registration of Vasenol for the powder preparations of the applicant.

The motion is therefore refused with costs.

Judgment accordingly.