

Ottawa
1968
}
Oct. 2-4,
7-11, 16-18,
21-24, 28-30

ALADDIN INDUSTRIES, INCORPORATED }
RATED

APPLICANT;

AND

1969
}
Mar. 11

CANADIAN THERMOS PRODUCTS }
LIMITED and THE REGISTRAR }
OF TRADE MARKS

RESPONDENTS.

Trade Marks—Application to expunge—“Thermos”—Whether generic word—Whether also distinctive—Registrability in 1907—Validity of in 1964—Expert evidence as to meaning, whether admissible—Newfoundland registration in 1908—Validity of—Parent company substituted for subsidiary—Whether “interested person”—Jurisdiction—Use of dictionaries—Laches, acquiescence—Trade Marks Act, s. 12, 18(1)(a) and (b).

In 1964 a company which competed with respondent in the manufacture and sale of vacuum bottles etc. in Canada applied under s. 56 of the *Trade Marks Act* to expunge respondent's trade mark, THERMOS, registered in Canada in 1907 and in 1960, and in Newfoundland in 1908, on the grounds that the word “thermos” was generic and not distinctive at the dates of registration and also at the date these proceedings were commenced, and that the registrations were therefore invalid under s. 18(1)(a) and (b). Subsequently the original applicant was liquidated and its parent company, which was also in competition with respondent, was, with respondent's consent, given leave to continue the proceedings; the style of cause was amended accordingly but the original pleadings remained unamended. Evidence was lacking as to usage of the word “thermos” in Canada and Newfoundland in 1907 and 1908 but it was established that by 1960 the word had come into common use as a generic word descriptive of the ordinary vacuum bottle and that it was also distinctive of respondent's vacuum bottle both to the trade and in a lesser degree to the public when purchasing vacuum bottles.

The application also contained a claim for expungement of the respondent's trade mark SUPER THERMOS registered in Canada in 1931.

Held, the application must be dismissed.

1. None of the Canadian registrations was invalid under s. 18(1)(a) as not being registrable when registered. In 1907 the word “thermos”, taken from the Greek word for hot, was a new and freshly coined fancy word without obvious meaning to ordinary Canadians and it was therefore registrable under the *Trade Marks and Designs Act* R.S.C. 1906, s. 71 (see secs. 5(1), 11 and 13.). For the like reason the trade mark SUPER THERMOS was registrable in 1931: the addition of SUPER to THERMOS did not make the trade mark descriptive or non-distinctive. In 1960 the word “thermos”, although commonly used in a descriptive sense for ordinary vacuum bottles, was not a merely descriptive word but was also distinctive of respondent's bottles and it was therefore registrable under the *Trade Marks Act*, 1952-53, c. 49 (see secs. 12, 2(f) and (t)(i)).

Bayer Co. v. American Druggists' Syndicate [1924] S.C.R. 558; *General Motors Corp. v. Bellows* [1949] S.C.R. 678; *In re Joseph Crosfield & Sons* [1910] 1 Ch. 130, applied. *American Thermos Products Co. v. Aladdin Industries Inc.* (1962) 207 F. Sup. at p. 9; 134 U.S.P.Q. at 98, affirmed *sub nom. King-Seeley Thermos Co. v. Aladdin Industries Inc.* (1963) 321 F. 2d. 577; 138 U.S.P.Q. 349; *Kodak, Ltd v. London Stereoscopic et al* (1903) 20 R.P.C. 337, referred to.

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2. None of the Canadian registrations was invalid under s. 18(1)(b) as not being distinctive when these proceedings were commenced in 1964. Although the word "thermos" had become generic and descriptive by 1964 the trade marks were distinctive of respondent's bottles to a substantial portion of the consumer public throughout Canada in 1964. *Lightning Fastener Co. v. Canadian Goodrich Co.* [1932] S.C.R. 189 at 196, referred to.
3. As to the Newfoundland registration in 1908, applicant had not satisfied the onus of establishing that the trade mark was not then registrable under the Newfoundland statute respecting trade marks, *viz* c. 112 of the Newfoundland Consolidated Statutes 1896 (2nd series). See s. 65 of the *Trade Marks Act* S. of C. 1952-53, c. 49, *B.N.A. Act* 1949 (U.K.) c. 22; Terms of Union, Newfoundland and Canada, term 21; *Imperial Tobacco Co. (Newfoundland) v. Duffy* [1918] A.C. 181; *Orange Crush Co. et al v. Gaden Aerated Water Works Ltd Nfld* L.R. 1921-26, 301, referred to.
4. In the interests of justice the proceedings should not be dismissed on the narrow technical ground that the present applicant was not an "interested person" within the meaning of s. 56 of the *Trade Marks Act* at the time these proceedings were commenced.
5. Having regard to s. 21 of the *Exchequer Court Act* and secs. 2(n), 54 and 56(1) of the *Trade Marks Act*, the Exchequer Court has jurisdiction to expunge the Newfoundland registration.
6. Whether a common word used in the ordinary way in the English or French languages is generic, and what it means, are not questions on which expert opinion evidence should be received. *Home Juice Co. v. Orange Maison Ltd* [1968] 1 Ex. C.R. 163, followed; and *quaere* whether the judge must decide those questions solely on the evidence or may use his own knowledge of the word and of the way persons use and respond to it in conversation in ordinary society.
7. While the court may refer to dictionaries these do not always reflect accurately the true meanings of words.
8. Respondent's contention that a trade mark may lose distinctiveness only through the actions of its owner is incorrect. *Cheerio v. Dubiner* [1966] S.C.R. 206; *General Motors Corp. v. Bellows supra*, referred to.
9. Respondent's contention that the application should be dismissed because of laches and acquiescence by appellant in delaying the commencement of these proceedings until 1964 could not be upheld.
10. Appellant's contention that respondent's trade marks were "deceptively misdescriptive" of its non-vacuum insulated wares such as ice buckets and chests within the meaning of the quoted words in s. 12 of the *Trade Marks Act* was without merit: it had validity only if "thermos" were synonymous with "vacuum insulated" which it was not.

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ORIGINATING notice of motion for expungement of trade marks.

Miss Joan Clark, Paul M. Amos and George B. Mauchan
 for applicant.

Donald J. Wright, Q.C. and Donald MacOdrum for
 respondent Canadian Thermos Products Limited.

No one for the Registrar of Trade Marks.

KERR J.:—These proceedings were initiated by an originating notice of motion dated August 17, 1964, for the expungement of the following trade mark registrations:

No. 50/12223, dated September 12, 1907, "THERMOS"; Newfoundland No. 264, dated January 8, 1908, "THERMOS"; No. 245/52994, dated September 12, 1931, "SUPER THERMOS"; and No. 118,050 dated May 13, 1960, "THERMOS".

The subsequent proceedings have been intermittent and protracted, due in part to illness of the counsel on each side who were originally retained and to the volume of the work of preparing the cases of the parties, which is indicated by the fact that the applicant introduced into evidence approximately one hundred affidavits and more than 40,000 letters, price lists and other documents.

The applicant and the respondent company are competitors in the manufacture and sale of their products in Canada, principally vacuum-insulated bottles used to keep liquids and foods hot or cold or at the temperature they had when put in the bottle. The main feature of such a bottle is its "filler", a double-walled glass container from which the air between the walls has been evacuated. The fillers have protective casings, corks or closures of various kinds and other improvements. Its forerunner was Sir James Dewar's vacuum flask of about 1893. Terms used by the public and in the trade to describe the bottles include "thermos"; "thermos bottle"; "vacuum bottle"; "vacuum-ware" and "bouteille isolante". The applicant contends that "thermos" and "thermos bottle" are generic and descriptive terms in Canada for such bottles and are synonymous with "vacuum bottle".

I shall deal first with an objection of the respondent company that the present applicant, Aladdin Industries, Incor-

porated, was not, as of the date when the proceedings were commenced, a "person interested" within the meaning of section 56(1) of the *Trade Marks Act*, S. of C. 1952-53, c. 49. This objection is in paragraph 3 of the respondent's reply, as follows:

3. This respondent says that the applicant, Aladdin Industries, Incorporated, was not as of August 17, 1964, a person interested within the meaning of Section 56(1) of the *Trade Marks Act*, S.C. 1952-53, c. 49, as amended, and accordingly, alleges that this Honourable Court has no jurisdiction to hear these proceedings.

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Sections 56(1) and 2(k) of the *Trade Marks Act* are as follows:

56. (1) The Exchequer Court of Canada has exclusive original jurisdiction, on the application of the Registrar or of any person interested, to order that any entry in the register be struck out or amended on the ground that at the date of such application the entry as it appears on the register does not accurately express or define the existing rights of the person appearing to be the registered owner of the mark.

2(k) "person interested" includes any person who is affected or reasonably apprehends that he may be affected by any entry in the register, or by any act or omission or contemplated act or omission under or contrary to the provisions of this Act, and includes the Attorney General of Canada;

When the originating notice of motion was filed it was on behalf of Aladdin Industries (Canada) Ltd., hereinafter referred to as Aladdin (Canada), as applicant, but by order dated December 9, 1965, Aladdin Industries, Incorporated, was granted leave to continue the proceedings in lieu and stead of Aladdin (Canada). The order was made with the consent of the respondent company and upon an affidavit of Mr. Arthur Leslie Kingdon, president of Aladdin (Canada) and general manager for Canadian operations of Aladdin Industries, Incorporated, wherein he said that on July 5, 1965, it was resolved by the directors of Aladdin (Canada) that it liquidate its assets and surrender its charter, that the resolution was approved and confirmed by the shareholders of the company and was duly carried out on or about July 26, 1965; and that the company's debt to Aladdin Industries, Incorporated, was satisfied by a transfer by Aladdin (Canada) of all its physical assets, together with choses in action, registered trade mark and the application herein to have the word "Thermos" expunged as a trade mark; also that Aladdin Industries, Incorporated, was at all relevant times the only shareholder

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of Aladdin (Canada), except for directors holding qualifying shares; and that Aladdin Industries, Incorporated, has been carrying on business in Canada since July 26, 1965, utilizing the assets mentioned.

On this issue there was affidavit evidence by Kingdon that as of August 17, 1964, Aladdin (Canada) was a wholly-owned subsidiary of Aladdin Industries, Incorporated, and the latter company was exporting from the United States of America into Canada certain parts for vacuum bottles and certain vacuum bottles; that Aladdin (Canada) was incorporated on June 24, 1953, and following its incorporation it carried on in Canada substantially all the business which had previously been carried on by Aladdin Industries, Incorporated. At the hearing counsel for the respondent company contended that the present applicant came into the case as an assignee of Aladdin (Canada), that the application was not assignable, that when the present applicant was substituted for Aladdin (Canada) only the style of cause was amended, and there was nothing in the notice or pleadings alleging that the present applicant was a "person interested". Counsel for the present applicant submitted that it had an interest in the action when it was commenced, by reason of its ownership of the shares of Aladdin (Canada) and the fact that it was exporting vacuum bottles and parts for bottles to Canada at that time; that the objection is technical and the respondent is estopped from raising it, because of the decision and order granting leave to substitute the present applicant for Aladdin (Canada) and because the respondent consented to such substitution.

I will dispose of this objection now before moving on to deal with other issues that I regard as much more important. The proceedings, as I have said, have involved a great deal of preparation; and practically all of the preparation was in respect of those other issues. I have no reason to think that the factual situation in respect of those issues was not the same on December 9, 1965, when the present applicant was granted leave to continue the proceedings in lieu of Aladdin (Canada), as the factual situation was on August 17, 1964, when the proceedings were commenced. I also think that the present applicant was a "person interested" within sections 56(1) and 2(k) of the Act when these proceedings were commenced, because it was then

the owner of the shares of Aladdin (Canada) and also as of that date was exporting its wares to Canada for sale in Canada. I regard as technical the objection of the respondent that, following the granting of leave to carry on the proceedings, only the style of cause was changed and the body of the originating notice did not state that the present applicant was an interested party. I feel that the other more important issues should be determined in these proceedings, in the interest of justice and to avert the institution of fresh proceedings raising essentially the same principal issues, and that the application should not be dismissed on the narrow ground on the objection set forth in paragraph 3 of the reply.

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For convenience, the term "respondent" will be used hereinafter to designate Canadian Thermos Products Limited and its predecessors in title, and the term "applicant" will be used to designate Aladdin Industries, Incorporated, and its predecessors in title, the particular corporation or corporations referred to in each instance being indicated by the context. For convenience, also, and to avoid repetition of the date on which these proceedings were commenced, I may sometimes use the present tense when referring to the situation as it was on that date.

The grounds upon which the expungement of the trade marks is sought are set forth in the originating notice of motion, dated August 17, 1964, and they are as follows¹:

...that at the date hereof the entries respecting the above trade marks as they appear on the register of Trade Marks do not accurately express or define the existing rights of the person appearing to be the registered owner of the said marks. The grounds upon which the relief aforementioned is sought are as follows:

- (1) The applicant is a Canadian federal company² with its head office at Toronto, Ontario. It deals in many wares including vacuum bottles.
- (2) The respondent, Canadian Thermos Products Limited, is a Canadian federal company with its head office at Scarborough, Ontario. It deals in many wares including vacuum bottles.
- (3) The respondent, Canadian Thermos Products Limited, is the registered owner of the word "THERMOS" as a trade mark under the registrations above set forth.

¹ The pleadings are too lengthy for full quotation, and I have paraphrased or summarized certain portions, and omitted portions.

² Aladdin Industries (Canada) Ltd.

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- (4) The said word "THERMOS" as of the date hereof does not express or define any right of the respondent, Canadian Thermos Products Limited, thereto, being generic and descriptive of vacuum bottles.

The particulars of the grounds upon which expungement of the trade marks is sought run to forty-nine pages. They are mainly as follows:

A. The word "thermos" has been generic and descriptive in Canada of vacuum bottles since prior to the date of application for trade mark registration No. 50/12223, being already in the Oxford English Dictionary at that time.

B. The word "thermos", whether used alone or with such words as "bottle", "jug", "flask", "jar" or "bouteille", is both in English and French the name of the wares in connection with which it is used or is clearly descriptive or deceptively misdescriptive both in English and French of the character or quality of wares in association with which it is used, such character or quality being that such wares will keep liquids hot or cold for extended periods of time.

C. Vacuum bottles are generally known and have been generally known for the last sixty years in Canada by the name "thermos".

D. The word "thermos" appears in the following dictionaries and encyclopedias. Throughout the particulars, libraries where each work may be found are indicated. (And then the names of 128 dictionaries and encyclopedias are given, and in these and other particulars giving the names of books, the libraries in Canada where the books are found are also named).

E. The word "thermos" has been used generically and descriptively by the following authors of scientific books and textbooks, all of which are well known and used in Canada, and considered authoritative: (134 books).

F. References to the word "thermos" as generic and descriptive are to be found in the following works by philologists widely read and considered authoritative in Canada: (5 books).

G. The word "thermos" has been used generically and descriptively in the following works which are well known in Canada and considered authoritative in their respective fields: (15 books).

H. The word "thermos" has been used generically and descriptively by the following authors in the works hereinafter set forth, all of which have or have had wide Canadian circulation: (34 books).

I. The works listed in paragraphs D, E, F, G and H above are to be found in a great many libraries (public and private) in addition to those indicated, as well as in schools, colleges, universities and other educational institutions and in homes throughout Canada. Their language in either English or French and in particular their use of the word "thermos" is that of English-speaking and French-speaking Canadians respectively.

L. The word "thermos" has been used generically and descriptively in the following articles which have appeared in newspapers published in Canada or, where published elsewhere, widely circulated in Canada: (39 articles).

M. The word "thermos" has been used generically and descriptively in numerous obituaries concerning the death of Sir James Dewar which have appeared in newspapers published in Canada: (28 newspapers).

N. The word "thermos" has been used generically and descriptively in magazines published in Canada or, where published elsewhere, widely circulated in Canada: (84 magazines).

O. The word "thermos" has been used generically and descriptively in the Canadian patent literature in the face of Rule 28 under the Patent Act which prohibits the use of trade marks in patent specifications, except in unusual circumstances, or unless identified as such, and in the face of the constant practice of the Patent Office not to allow the use of trade marks in patent claims. The applicant will rely on the following documents: (11 patent documents).

T. The word "thermos" has been used generically and descriptively on innumerable occasions by the respondent Canadian Thermos Products Limited itself in its advertisements, correspondence both internal and external and otherwise...The respondent's corporate name, prior to its change in 1960, involved a generic and descriptive use of the word "thermos", such name being "Canadian Thermos Bottle Co. Limited".

In its reply, in addition to denying allegations in the originating notice and particulars and putting the applicant to proof, the respondent alleges, *inter alia*:

5.(b)...

- (i) that the said trade mark "Thermos" was at the time of first use, has continued to be, and is an invented, coined and/or fancy word;
- (ii) that the trade mark was at all material times, and in particular, as of August 7, 1964, distinctive within the meaning of the *Trade Marks Act* in that it actually distinguished the wares of the respondent from the wares of others;
- (iii) that the trade mark was adapted to distinguish the wares of the respondent from the wares of others.

...

- (d) that if the trade mark "Thermos" has been used generically or descriptively as alleged, such use was mere ignorant and careless misuse of the trade mark;

and also states that:

- 6. the respondent or its predecessors in title to the trade mark "Thermos" have continuously since prior to September 12, 1907, used and advertised that trade mark in association with wares of various kinds from time to time manufactured and sold by them.
- 7. the respondent or its predecessors in title to the trade mark "Thermos" have since prior to September 12, 1907, taken all reasonable steps to advise and educate the public in Canada that the respondent's trade marks are their registered trade marks

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and to persuade and compel others to refrain from using the trade marks other than in association with wares sold and manufactured by them.

...

9. since September 12, 1907, the trade mark "Thermos" has been the registered trade mark in Canada of the respondent or its predecessors in title and has been continuously and widely used in Canada by the respondent or its predecessors in title since prior to that date in association with its wares...and that the applicant is barred by laches and acquiescence from now alleging that the entries as they appear in the Register of Trade Marks did not as of August 17, 1964, accurately express or define the existing rights of the respondent.

...

11. this court has no jurisdiction to expunge the Newfoundland registration No 264; and the respondent pleads section 65 of the Trade Marks Act.

Three of the more important dates in this case are: *September 12, 1907*, the date of the first registration of the trade mark "Thermos" in Canada. This date is important because of the applicant's claim that the word "thermos" has been generic and descriptive in Canada of vacuum bottles since prior to the date of application for that first registration, and that it was not registrable then and is invalid under section 18(1)(a) of the present *Trade Marks Act*. There was dispute between the parties as to whether the applicant's pleadings include this ground that the respondent's trade marks were not registrable and are invalid under section 18(1)(a). I find that the pleadings do include this ground. It cannot be doubted that the respondent's counsel was amply informed that this was one of the grounds upon which expungement was sought and came to court prepared to meet a case made on that ground. *January 8, 1908*, the date of the first registration of the trade mark "Thermos" in Newfoundland. This registration presents special problems not common to the other registrations and I shall deal with it separately. *August 17, 1964*, the date of the originating notice of motion. This date is important because the main allegation upon which expungement of the marks is sought is that they were generic and not distinctive at the time these proceedings were commenced and are therefore invalid under section 18(1)(b) of the Act.

The respondent was incorporated by letters patent dated October 28, 1910, as Thermos Bottle Company Limited, and its name was changed on May 31, 1956, to Canadian Thermos Products Limited. A predecessor company, Canadian Thermos Bottle Company Limited, was incorporated on September 16, 1907. This last named company was the assignee of the first Trade Mark No. 50/12223, and in turn assigned it to Thermos Bottle Company Limited.

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The trade mark "THERMOS" No. 50/12223 was registered in Ottawa on September 12, 1907, in accordance with the *Trade Mark and Design Act*, R.S.C. 1906, c. 71, by Thermos-Gesellschaft mit Beschränkter Haftung, of Germany, as applied to the sale of vessels and bottles and the like. The assignment of the trade mark by that company to Canadian Thermos Bottle Company Limited was registered on November 15, 1907. The assignment of the trade mark by the last named company to Thermos Bottle Company Limited was registered on August 8, 1931. The trade mark is now registered in the present name of the respondent.

The trade mark "THERMOS" was registered in Newfoundland on January 8, 1908, as No. 264, by Thermos Limited of London, England, to be applied to the sale of bottles, flasks and other vessels, culinary and other utensils . . . and their fittings, coverings or other appurtenances. The assignment of the trade mark by that company to Thermos (1925) Limited was registered on October 5, 1926. An assignment by the last named company to Thermos Bottle Company Limited was registered on September 30, 1949. The trade mark is now registered in the name of the respondent.

The trade mark "SUPER THERMOS", No. 245/52994, was registered on September 12, 1931, in Ottawa, in accordance with the *Trade Mark and Design Act*, R.S.C. 1927, c. 201, by Thermos Bottle Company Limited, and it is now registered in the name of the respondent. To be applied to the sale of vacuum insulated equipment, including bottles, carafes, jugs, jars, kits, etc.

The trade mark "THERMOS", No. 118050, was registered on May 13, 1960, in Ottawa, in accordance with the

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Trade Marks Act by Canadian Thermos Products Limited, the respondent. The application stated that it had been used in Canada since 1907 on wares marked (1), (2) and (3); since 1954 on wares marked (4); since 1949 on wares marked (5) and since 1957 on wares marked (6):

- (1) vacuum laboratory vessels, vacuum bottles, vacuum jars, vacuum cooking jars, vacuum food jars, vacuum carafe sets, vacuum desk sets, vacuum water sets, vacuum coffee servers and vacuum ice bowls.
- (2) workmen's lunch kits, school lunch kits, ladies' lunch kits, motor lunch kits and picnic lunch kits.
- (3) corks, replacement caps, replacement inners, replacement barrels and paper discs.
- (4) replacement parts, namely, plastic closures and plastic pouring lips.
- (5) non-vacuum insulated vessels, namely, insulated ice chests, insulated coolers, picnic jugs and outing jugs.
- (6) insulated ice tubs and ice bowls.

The applicant's affidavit evidence includes an affidavit by Mr. Kingdon, the applicant's general manager in Canada, one by Dr. Walter S. Avis, professor of English and lexicographer, one by Jean-Paul Vinay, a professor of languages, and upwards of 100 others by librarians, publishers and other persons. The respondent's affidavit evidence is an affidavit by John P. Parker, president of the company. There was cross-examination of Kingdon, Avis and Parker on their affidavits. There was also examination for discovery of Parker, portions of which were put in evidence. At the commencement of the hearing it was indicated that numerous objections would be made to the admission of various portions of the evidence and exhibits which were to be offered, and it was then agreed and decided that the evidence and exhibits would be received under reserve of objections which would be made and argued at the conclusion of the presentation of evidence. I will refer to such objections later. One objection of counsel for the respondent I disposed of before presentation of the evidence was completed. It was an objection to the admission of photocopies of specific pages of certain dictionaries, encyclopedias, novels and other books (for example, pages of dictionaries on which the words "Thermos" and/or "thermos" appear),

without production of the entire dictionary or book itself. Numerous readily available dictionaries and books were produced complete and received in evidence as originals. On that objection I said that I had no reason to think that the pages are out of context or show anything different from what is in the books or that the picture would be different if the books themselves were produced, and that I thought the copies are adequate for the purposes of this case; and I received them in evidence. There was nothing suspect about the pages in question and I had no reason to think that the production of the whole dictionary (or encyclopedia, etc.) would be of material assistance to any of the parties or to the court or that non-production of it would be disadvantageous to the respondent. Insistence on production of the books might have entailed an adjournment of the hearing. The so-called "best evidence" rule has its place and purpose. But I did not think that a strict application of the rule was required in respect of the copies of the pages in question³.

The respondent objected to the admission of the affidavit of Dr. Avis and asked that it be rejected in its entirety. The affidavit runs to 58 pages, not including exhibits. It is not divided into numbered paragraphs. It was dictated on tapes by Dr. Avis himself, which may explain its contents and form, but hardly excuses its presentation in that form in these proceedings. It contains matters of hearsay, statements of opinion and argumentative matters, and is not confined to such facts as Dr. Avis is able of his own knowledge to prove. To the extent that it offends in that respect, I rule it inadmissible. I also reject as inadmissible his conclusions on questions which fall for determination by the court. I also reject as inadmissible the opinion of Dr. Avis, expressed or implicit in the affidavit, that the word "thermos" is a generic term which has been established in common usage for at least two generations. The question whether a common word used in the ordinary way in the English or French languages is generic, and what it means,

³ Cf. more recent judgment of Lord Denning, M.R., in *Garton v. Hunter* [1969] 2 W.L.R. 86 at p. 90.

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is not, in my opinion, a question on which expert opinion evidence should be received. The President of this court said in *Home Juice Company v. Orange Maison Limited*⁴:

After the time for filing its affidavits had expired, the respondent applied *inter alia* for leave to file "expert evidence with respect to the meaning of the words Orange Maison". I rejected this application on the ground that, as I understand the rules of evidence, such evidence was clearly not admissible. As I understand the law, while the meaning of words having a special meaning in a particular trade, science, industry, or other particular element of society may be the subject matter of evidence in connection with a contention that the words have been used in a statute, contract or other context in that particular meaning, the meaning of words when used in the ordinary way as part of one of the official languages is a matter for the Court with such aids to interpretation as are available to it and cannot be the subject matter of opinion evidence. Otherwise, the Court could be inundated with expert testimony on every question of interpretation that arises. I therefore dismissed the application to adduce such expert evidence.

The affidavit of Professor Vinay follows along lines similar to the affidavit of Dr. Avis, and it is subject to like objections and exclusions. However, I do not reject their affidavits in their entirety, for I think that portions of them are relevant and useful, more particularly the portions respecting the way in which words come into common use and the factors which influence that course, the nature and characteristics of various kinds of dictionaries, dictionary practice in respect of the entry and use of words, the process by which proper names and trade marks enter the common domain, and the various recorded occurrences of the word "thermos" in dictionaries and other books.

In looking at the use of the word "thermos" in dictionaries one must bear in mind that the word is registered as a trade mark in England, the United States, France and many other countries, and that when it appears in a dictionary published in one of those countries it may indicate only the meaning and usage of the word there, which may not be the same as in Canada. However, dictionaries and books that are used and read in Canada, no matter where published, have an influence on the use of words in Canada.

Dictionaries and books of reference do not always reflect accurately the true meaning of words. Many of them have a preface which explains the use of capitals, trade mark

⁴ [1968] 1 Ex C.R. 163 at pp. 164-65.

designations and other indications of the meaning or use of the words in the dictionary. However, the courts may refer to dictionaries. The Judicial Committee of the Privy Council said in *The Coca-Cola Co. of Canada Ltd. v. Pepsi-Cola Co. of Canada Ltd.*⁵:

While questions may sometimes arise as to the extent to which a Court may inform itself by reference to dictionaries, there can, their Lordships think, be no doubt that dictionaries may properly be referred to in order to ascertain not only the meaning of a word, but also the use to which the thing (if it be a thing) denoted by the word is commonly put.

The following are excerpts from a number of dictionaries respecting the words "thermos", "thermos bottle", "vacuum bottle" and "bouteille isolante":

Oxford English Dictionary, Vol. IX of 1919 Edition:

Thermos (a. Gr. warm, hot.)

A registered trade term noting a flask, bottle, or the like capable of being kept hot by the device (invented by Sir James Dewar) of surrounding the interior vessel with a vacuum jacket to prevent the conduction of heat.

Patented 1904, No 4421; not named. Name (Trade Mark No. 289,470) adv. in *Trade Marks Jrn.* 20 March, 1907.

1907. *Eng. Mech.* 18 Oct. 246. This invention (of Sir James Dewar) is utilised in the thermos flask. 1909 *Ladies Field* 28 Aug. 511/2 A Thermos bottle filled with hot coffee was not forgotten. 1909 *Westm. Gaz.* 16 Sept. 5/2 Lieutenant Shackleton testified to the fact that the Thermos flask helped him to perform his wonderful feats in the Antarctic. 1910 *Repts. Patent Cases XXVII.* 396 This was the Dewar vessel...In 1904 it occurred to a Mr. Burger that this vessel could be adapted for use as a flask...the result...was the production of the well known *Thermos* flask.

Neither vacuum bottle nor vacuum flask appeared in the 1919 Edition of the *Oxford English Dictionary*, but the 1933 *Supplement* to that dictionary has the following:

Vacuum. 4. Add: vacuum-bottle, flask, a bottle or flask with a double wall enclosing a vacuum, designed originally to keep liquids cold but now widely used to keep liquids hot;

1910 *Chambers's Jrn.* June 413/2 The vacuum-bottle has entered so extensively into the domestic circle as to become regarded almost as indispensable.

Shorter Oxford English Dictionary, 1947:

Thermos: A registered trade term noting a flask, bottle, or the like capable of being kept hot by the device (invented by Sir James Dewar) of surrounding the interior vessel with a vacuum jacket to prevent the conduction of heat.

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⁵ (1942) 59 R.P.C. 127 at p. 133.

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Vacuum flask: a flask with two walls separated by a vacuum, the existence of which keeps the contents of the inner receptacle at their original temperature for a considerable period;

Webster's New World Dictionary of the American Language, College Edition (The World Publishing Company) (1953):

thermos bottle (or flask, jug): a bottle, flask or jug for keeping liquids at almost their original temperature for several hours: it has two walls enclosing a vacuum and is fitted in a metal outer case: a trade-mark (Thermos).

vacuum bottle: a bottlelike container used to keep liquids hot or cold by means of a vacuum between its inner and outer walls.

Webster's Seventh New Collegiate Dictionary, 1963:

Thermos: *trademark*—used for a vacuum bottle.

vacuum bottle: a cylindrical container with a vacuum between an inner and an outer wall used to keep liquids either hot or cold for considerable periods.

Encyclopaedia Britannica, Vol. 22, 1954:

Vacuum Flask: A glass vessel with double walls, the space between which is evacuated. The only junction of the walls is at the neck of the vessel. It is also known as a Dewar vessel after its inventor Sir James Dewar; Thermos flask is a proprietary name applied to a form protected by metal casing.

A Dictionary of Americanisms on Historical Principles (Chicago, 1951):

thermos: A bottle so made that liquids may be kept at a desired temperature for a considerable time. Usu. Thermos bottle, a trade-mark name for a bottle of this kind.

1908 *Sat. Ev. Post* 15 Aug 21/1 The Thermos Bottle keeps baby's sterilized milk at feeding temperature day or night. 1948 *Nat. Geog. Mag.* Aug. 233/1 Our host walked down from his house with a gallon thermos of hot coffee. 1950 *Time* 3 April 24/3 Simon began to pack blankets and Thermoses for a fishing trip. Also thermos jug.

Dictionnaire Alphabétique et Analogique (Paul Robert):

thermos: (nom déposé): Récipient isolant qui maintient durant quelques heures la température du liquide qu'il contient...

Thorndike-Barnhart, High School Dictionary, 1957:

Thermos bottle: *Trademark.* bottle, flask, or jug having a case or jacket that heat cannot pass through easily. It will keep its contents at about their original temperature for hours.

vacuum bottle: bottle surrounded by a container, with a vacuum between, used to keep liquids hot or cold.

Dictionary of Canadian English, The Beginning Dictionary, 1962: (Based on Thorndike-Barnhart)

Thermos bottle: the trademark for a kind of bottle or jug that will keep its contents at about the same temperature for several hours.

Dictionnaire Usuel, Quillet Flammarion, 1963:

thermos: Marque déposée de récipients isolants à double paroi avec vide intérieur et argenture, pour conserver le contenu à sa température initiale.

Harrap's Standard French and English Dictionary (1962):

Thermos: Trade mark applied to vacuum flasks and other articles manufactured by Thermos (1925) Limited, Bouteille Thermos, Thermos flask.

Part II—English—French:

Thermos: Marque déposée désignant les articles fabriqués par Thermos (1925) Limited. Thermos flask, bouteille Thermos.

Funk and Wagnall's Standard College Dictionary—Canadian Edition, 1963:

thermos bottle: Sometimes cap. A glass bottle that keeps the contents hot or cold ...; also called vacuum bottle.

Petit Larousse, 1969:

BOUTEILLE—*Bouteille isolante*, bouteille à deux parois entre lesquelles on a fait le vide, et qui conserve longtemps la température de son contenu.

THERMOS: Nom déposé d'un récipient isolant, pour conserver les liquides à une température voisine de celle à laquelle on les a introduits.

Webster's Third New International Dictionary, 1964:

Thermos: *trademark*—used for a vacuum bottle.

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Much information as to the use by the respondent of its trade mark "THERMOS" and its course of conduct is found in the evidence of Mr. Parker, its president, who has been with the company ever since 1935, and in catalogues, price lists, advertisements and other documents emanating from the respondent and put in evidence. I will reproduce some pages of the catalogues, for they speak for themselves better than any description I can give. Some of the documents go back to the early days of the company. However, it is unreasonable to expect that the respondent would preserve and still have a mass of correspondence and records from those early days showing the way in which its trade mark was used at that time and the situation in which its products were manufactured or marketed at that time. Moreover, a fire in 1957 destroyed much of the correspondence and records of the company prior to that date. Consequently, the documents of those early days are not in great volume.

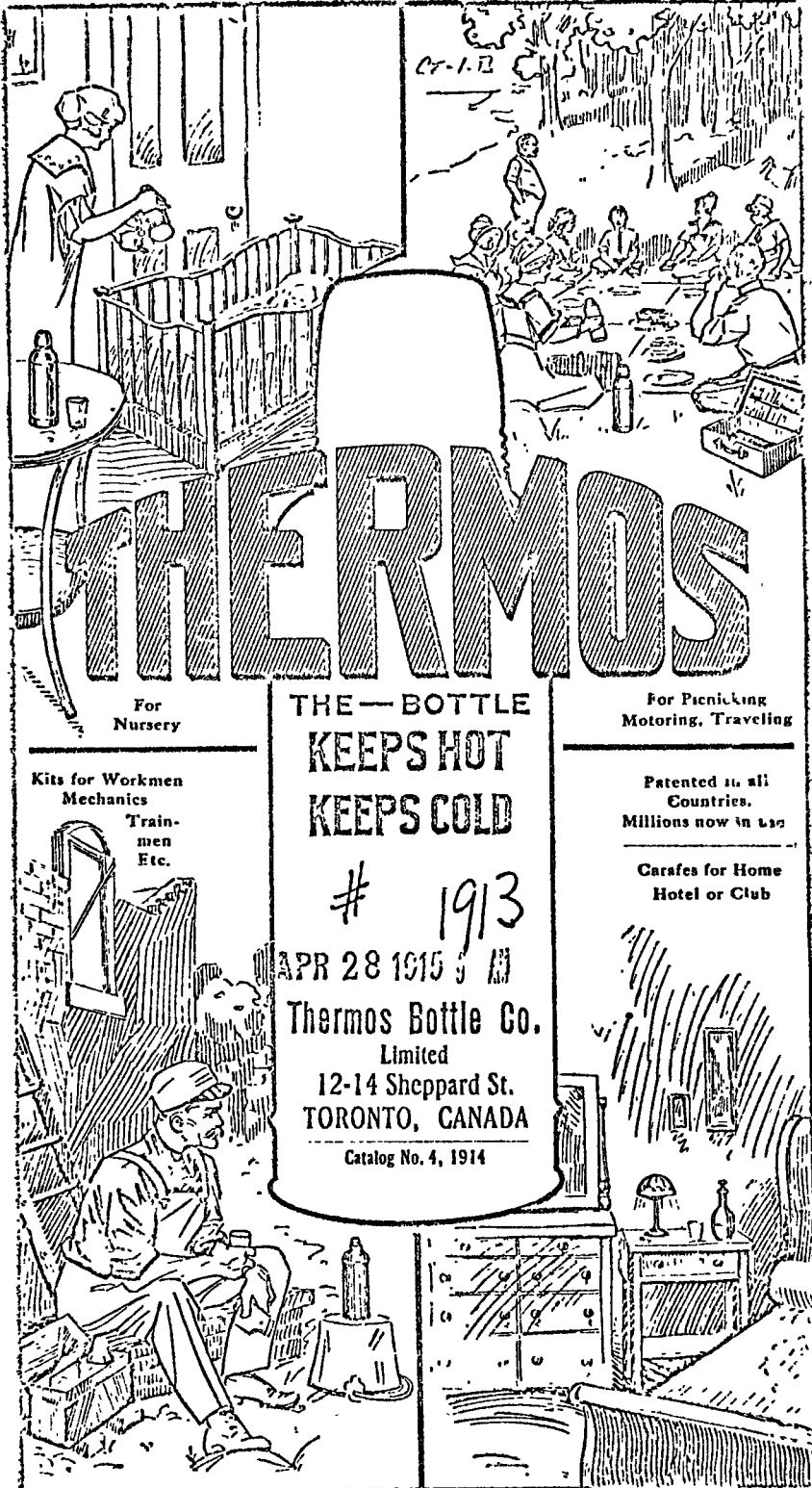
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The business of the respondent was founded on the vacuum-insulated bottle. Its business initially consisted of marketing in Canada of vacuum bottles, vacuum carafes, lunch kits, picnic sets, desk jugs and associated articles. The respondent commenced its operations in Toronto in 1910, and was using German glass blowers to make its bottles around 1912 or 1913. Their activity stopped in the years of World War I, but assembly of bottles continued with parts obtained through other suppliers. The majority of vacuum bottles sold in Canada prior to 1951 were marketed by the respondent. Until 1949 its sales consisted mainly of insulated wares including vacuum bottles, replacement fillers and accessories. In 1949 it started to market non-vacuum insulated wares, such as coolers and ice chests. In 1955 it diversified its products and, by about 1962, was marketing tents, gasoline stoves, camping equipment and related articles under its trade mark "THERMOS". It was at about this time, on May 31, 1956, that the company changed its name to Canadian Thermos Products Limited. The following questions and answers appear in the transcript of the cross-examination of Parker taken on August 15, 1968:

- 153. Q And this diversification and this change of name were carried out in Canada as part of an effort to protect the Canadian trademark, is that not right?
 A. It could be right.
- 154. Q. You have no reason to doubt that?
 A. No.

Numerous catalogues, price lists, advertisements, forms and other documents were put in evidence as exhibits to Parker's affidavit as examples of documents used or put out by the respondent in connection with the marketing of its products. I shall now proceed to refer to some of them.

Documents of the respondent issued in its early days include Exhibits E1, E2, E3, E4 & E5 to Parker's affidavit. E1 is described on its cover page as Catalogue No. 4, 1914. I will deal with this first catalogue in some detail, and mention particular aspects of some of the others. The cover of E1 is reproduced next. It shows a picture of the bottle and a carafe and workmen and picnickers. It also has the words "Patented in all countries—Millions now in use".



For Nursery

For Picnicking
Motoring, Traveling

Kits for Workmen
Mechanics
Trainmen
Etc.

THE — BOTTLE
KEEPS HOT
KEEPS COLD

Patented in all
Countries.
Millions now in use

Carafes for Home
Hotel or Club

1913

APR 28 1915

Thermos Bottle Co.
Limited
12-14 Sheppard St.
TORONTO, CANADA

Catalog No. 4, 1914

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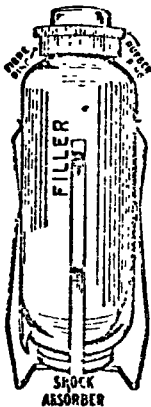
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The inside of the cover page of E1 is reproduced next. It uses "Thermos" without the words "vacuum bottle" or other generic terms.

THERMOS

THE BOTTLE

The improved Thermos Products have made Thermos more popular with all classes. All models are now made cementless, paperless and padless. The protection afforded with the new shock absorber in all cases and the improved methods recently made in our new complete factory make Thermos more serviceable for carrying, motoring and use in kits and luncheon outfits. Ask to see the new models as shown in this catalog.



This sectional view of Models No. 15 and No. 16 Bottles in all sizes shows the construction and protection of the glass filler and has made the popular priced bottles more serviceable than heretofore. Note the protection on sides as well as at base.

NOTICE.

By the introduction of the new cementless, paperless and padless models in all Thermos Products, it is rarely profitable to return old bottles for repairs. We request that you write for information before incurring express charges. In most cases customers will profit by buying the new No. 15 or No. 16 Models, as illustrated on page 3.

Throughout Exhibit E1 are pictures of the battles, carafes, lunch kits, decanters, cups, corks and other products of the company; and the words "Thermos Bottle" frequently occur. In a Notice to Dealers in the catalogue are the words "Genuine Thermos Products" and the sentences "Thermos is patented the world over"; and "The Original Bottle".

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Exhibit E2 is a price list in effect May 15, 1914. It has the same stylized "THERMOS" as on Exhibit E1. It refers to "Thermos Products" and "Thermos Bottles" and says that they are guaranteed to keep boiling liquids hot for 24 hours or ice-cold liquids cold for 3 days.

Exhibit E3 is another catalogue. It may have been issued about 1922. It says:

A NEW FACTORY built and equipped expressly for the manufacture of Thermos Products makes Thermos at prices within the reach of all wage earners.

We introduce an entirely new line of Thermos Bottles and Carafes with the long-desired improvement in construction, wherein no cement, corrugated paper, felt pad or other absorbent materials are employed, supporting the weight of the bottle and contents from the base, introducing at this point the new Thermos Shock Absorber, made possible by the new Walker-Burrows automatic machine process of manufacture, the glass base of the Thermos filler being seven times as heavy as in the hand-made models, making the filler practically unbreakable by ordinary usage.

This E3 catalogue, like the earlier catalogue, uses the terms "Thermos Bottle", "Thermos Food Jar", "Thermos Flask", "Thermos Carafe" and directions "How to use a Thermos Bottle". The outside back cover, reproduced next, shows a motor vehicle, used as a travelling advertisement, in the shape of a vacuum bottle. There is a picture of the respondent's bottle on page 4, and on the filler there is the word "THERMOS", and above it the words "Trade Mark", and below it the word "Patented".

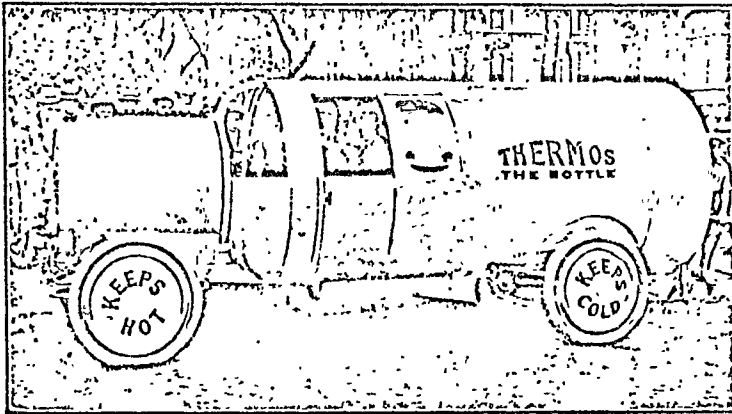
THERMOS

THE

BOTTLE

KEEPS HOT

KEEPS COLD



Thermos Bottle \$15,000 Advertising Car, which has toured the United States from Coast to Coast. One of the best Advertising mediums known.

THERMOS BOTTLE COMPANY, LIMITED
TORONTO, CANADA

Exhibit E4 is Catalogue No. 9, said to be about 1923. Here under the word "THERMOS" the words "REGISTERED TRADE MARK" appear. The catalogue continues to use the term "Thermos Bottle". Reproduced next are the first two paragraphs on page 2.

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is our registered trademark. It is plainly impressed on the many original and exclusive designs of temperature retaining vessels and accessories that constitute our extensive line of manufacture. It identifies, distinguishes and protects our product against imitation, for it cannot be legally applied to goods that are not produced by us.

It signifies and assures the trade and public of quality and efficiency, for not a single article manufactured by us and bearing this trade mark is permitted to leave our factories without first being subjected to the most thorough inspection and rigid tests. By adhering to these principles since the inception of this industry, linked with our extensive educational publicity campaigns, confidence has been established in the minds of the public that Thermos, the original temperature retaining vessels in the various designs, has become a necessary commodity and a boon to humanity.

Exhibit E5 is Catalogue No. 10 of about 1924. Here the words "vacuum bottle" and "genuine" appear, as is shown on page 3 of the catalogue reproduced next, and elsewhere in the catalogue the public is told to look for the mark of a genuine Thermos vacuum bottle—on the Bottom—and when buying replacement parts to be sure to get genuine Thermos vacuum fillers and parts, and that the best way to do this is to look for the name "THERMOS".

Exhibit E6 is a price list of about 1924 which refers to "Genuine Thermos Vacuum Bottles", "Reg. Trade Mark", "The Trade Mark of the Genuine—It is Advertised—Your Customers look for it".

Exhibit E9 is Catalogue No. 13 of 1929. It features the "Stronglas" registered trade mark of the respondent. A sectional picture shows the words "Thermos Stronglas Patent Filler" on the filler part. Other references are "Genuine Thermos Stronglas Bottles", "Genuine Thermos

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Vacuum Bottle Filler” and “Genuine Thermos Bottle Cases”. The catalogue also contains directions to dealers, which include the following paragraphs in respect of Thermos and Stronglas: “You can depend on these trade marks on vacuum bottles..”; “In this connection let us emphasize again the risk that some dealers are taking in representing other vacuum bottles as ‘Thermos’ and in substituting other bottles when a customer asks for a ‘Thermos’ bottle”; “Sell the Genuine—your customer asks for THERMOS”.

GENUINE THERMO #ACUUM BOTTLES

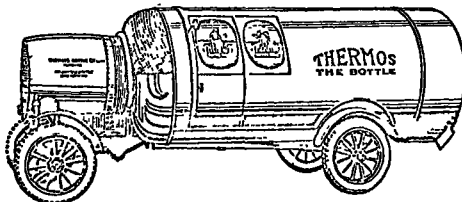
Canadians have learned to put their faith in

*Vacuum Bottles
 with the
 Genuine*

THERMOS

*Trade Mark
 Stamped on the
 Bottom*

The Original Vacuum Bottles were **THERMOS** Vacuum Bottles. Very early in their history they gained the confidence of the Canadian public because Canadians appreciate comfort, and Genuine **THERMOS** Vacuum Bottles go one step further by combining comfort with dependable efficiency.



Thermos advertising car, which reminds your customers of Genuine Thermos Vacuum Bottles. Touring the country to assist in selling and advertising.

The Bottle for A Thousand Uses

A page of E13, Catalogue No. 15, is reproduced next.

THERMOS

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In 1907 the Thermos Bottle was introduced to the world as a new invention and promptly accepted because of its wonderful application to the need of the Home and Sports. Following the invention of the Thermos principle, this Company has developed every important achievement in the manufacture of vacuum products, which now includes Bottles, Carafes, Jugs, Desk or Bedside Sets, Jars, Lunch Kits for workmen and school children, Motor Outfits and Picnic Sets, Dispensing Urns and large Containers for all Kinds of Food Products, Ice Cream, etc. • Each piece of Thermos vacuum ware is plainly stamped, and purchasers who demand a quality product should look for the trade mark THERMOS • During the last ten years, a new glass for making Thermos fillers has been introduced called "Stronglas". This new product is much stronger and more serviceable than any other vacuum ware ever manufactured. It has allowed for a wider use of Thermos in Institutions, Hotels, Clubs and Railways. These items are stamped THERMOS STRONGLAS. • A New Super Bottle was introduced in 1933, called Super Thermos, and the method of manufacture in this new small mouth filler, makes it extra strong and serviceable. • Cooking Jars are the latest introduction to the Thermos line. These make a wonderful saving in cooking many foods, such as cereals, fruits, vegetables, etc. A need in every home. • Peruse the following pages and learn of the new uses and new items for home and travel use.

Exhibit E15 is a supplement of 1938 and for the first time the word "Brand" appears in the documents put in evidence.

Exhibit E18 is Catalogue No. 16 and Price List of 1949 and the following appears on the back cover:

The word "Thermos" is not a bottle name but a trade-mark—a brand name applying exclusively to products of Thermos Bottle Company Ltd., so branded, and to nothing else. It is the accepted standard of vacuum-insulated products. Show your customers the name "Thermos" on the bottom of vacuum ware.

Exhibit E21 is a Catalogue of about 1951 which contains a message to dealers which states "Today, more

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than ever before, 'Thermos' is a part of everyday living", and on the back cover "The Vacuum Ware Everybody asks for".

Exhibit N to Kingdon's affidavit is an advertisement in the *Star Weekly*, May 15, 1954, inserted by the respondent, which includes the following:

But, remember, although almost everyone calls "vacuum" bottles, "Thermos" bottles, only those plainly marked Thermos are made by the Thermos Bottle Company Limited, Toronto, Ontario. Trade Mark Reg

After the respondent diversified its products it marketed its non-vacuumware, such as ice chests and ice preservers and jugs with fiberglass insulation, under its trade mark "Thermos".

Exhibit C1 is an example of numerous "Directions for Use" sent out by the respondent with its bottles. It is undated, Parker said it was prior to 1935. It contains the following paragraph:

What is a THERMOS Bottle?

A THERMOS Brand Bottle is a vacuum bottle manufactured by Thermos Bottle Company Limited. "THERMOS" is a coined word—a registered trade-mark belonging exclusively to Thermos Bottle Company, Limited, in Canada. If the Vacuum product is not marked "THERMOS", it simply is not THERMOS brand ware, and cannot be advertised or sold as such

Exhibit C2 is another such document and it states:

Everyone knows there is only one Thermos...Be sure and look for the —THERMOS— Trade Mark on every Vacuum Bottle you buy.

Exhibit C3, sent out prior to 1935, refers to "GENUINE THERMOS VACUUM BOTTLES", as does Exhibit C4, sent out about 1935.

The first of the respondent's documents in French that were put in evidence is C6, sent out in the 1952-60 period. It is a French version of the respondent's English material. It has such expressions as "Bouteille Thermos", "Bouteilles 'vacuum' de marque THERMOS", and it states:

"THERMOS" est une marque exclusive—une marque déposée propre à Canadian Thermos Products Limited du Canada. Tout article isolant non marqué "Thermos" n'est pas de notre Compagnie et ne peut s'annoncer ni se vendre comme tel.

In many letters from the trade, hotels, hospitals, governmental departments and individual users, to the applicant and to the respondent, the writers use the word

“thermos” in a generic sense, synonymous with “vacuum bottle”, but it also appears that in numerous instances the writers knew the word as a brand name, because, for example, they spelled it with a capital “T”. It is reasonable to infer that those who were writing in respect of specific bottles in their possession, on which the brand name and the manufacturer’s name were shown, had notice of the brand name for that reason. In many advertisements inserted in Canadian newspapers and magazines by persons other than the respondent, “thermos” has been used as a generic word. So also in magazine articles and novels circulated and read in Canada. As far back as 1923, in obituaries published in leading newspapers in Canada in that year respecting the death of Sir James Dewar, it was said that he brought forward the Dewar flask, “popularly known as the Thermos Flask”, and that “il perfectionna aussi la bouteille Thermos” (quotation marks mine). It seems probable that the obituaries originated from a common source in England, for they follow generally the same form and use the expression “Thermos Flask”.

I do not think that it is necessary to select and give examples from such advertisements, magazines and novels or from the many types of letters from the public in which the word “thermos” was used, either in lower case or with a capital “T”. It was not used uniformly. In some letters it was used in a generic sense, in others it was obviously used as a brand name, and in some it was even used in both senses.

In the period 1951-64 the applicant collected and preserved letters, correspondence and advertisements in which the word “thermos” was used, having in mind the possibility of their use in litigation respecting the respondent’s trade marks. As early as 1952 the applicant was contemplating the institution of proceedings to attack the marks. In appraising these letters and documents, and the volume of them, more than seven hundred, I realize that during the same period, and in accordance with its practice relating to the destruction of documents, the applicant was destroying correspondence which contained a reference to “vacuum bottle” or “bouteille isolante” or other generic terms, unless it also contained a reference to “thermos”. The applicant’s view was that references to the use of “thermos” as a generic term were relevant, but that references to

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“vacuum bottle” were not. In my view, the use of the term “vacuum bottle” is relevant when considering whether the words “thermos” and “thermos bottle” were synonymous with “vacuum bottle” in Canada at the dates concerned in these proceedings.

The applicant’s vacuum bottles were marketed in Canada as early as 1931, at that time in limited quantities. In 1951 it established manufacturing facilities for production of its bottles in Canada.

It sold about five million vacuum bottles in Canada in the period 1954-64. It sells and markets its bottles through hardware stores, drug stores and other sales outlets in competition with the respondent and it also carries on extensive advertising and sales promotion endeavours in which the bottle is described as a “vacuum bottle” or “bouteille isolante”, accompanied by pertinent registered trade marks.

Imported vacuum bottles have been on the market in Canada for many years. Numerous bottles, some manufactured in Canada, some imported from Japan, Germany and other countries, some bearing registered trade names, others bearing unregistered names, were received as exhibits in the case. It is clear that the respondent’s trade mark “THERMOS” was recognized as such by competing manufacturers and that they adopted distinctive names of their own choosing for their bottles. The word “thermos” was not the only apt word available for the article. The generic term “vacuum bottle”, coupled with particular brand names, has been in common, extensive and successful use in Canada.

Since the early part of 1950 the respondent employed a “clipping service” to note, clip out and send to the respondent all references to its trade mark in the major publications in Canada, in English or French, of newspapers, trade magazines, etc.

The respondent used such clippings to advise advertisers, publishers and other persons that the trade mark “Thermos” was its registered trade mark. To further protect its trade mark, the respondent instructed its employees, patent agents and solicitors, for many years before 1964, to watch for the use by others of trade marks and registrations and

applications for registration of trade marks which might be confusing with the respondent's "THERMOS", and to take steps to stop such use, oppose such applications, and take remedial measures. Parker gave examples of action of that sort in the period 1956-64. The respondent's file No. 15, Exhibit No. 7 on Parker's examination for discovery, contains copies of form letters and correspondence used in that respect, including letters to newspapers. Some replies to the respondent accepted the respondent's advice, whereas others indicated that they had regarded "thermos" as a generic word.

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The respondent has made substantial efforts, in greater measure during the past thirty years than previously, to impress upon the public that "THERMOS" is a registered trade mark and should not be used otherwise. These efforts increased considerably after it became apparent that there was a growing tendency to use the word in a generic sense. The applicant says that the suggestion in a decision⁶ in the United States, in 1922, that "thermos" was then a descriptive word, was a reason for such increased efforts. The tendency was due, in part at least, to the respondent's course of conduct and its use of the word. The applicant says that by then the word had fallen into the public domain and the respondent's efforts were too little and too late to retrieve it or to reverse the trend of its use as a generic word. The respondent says that, in any event, its trade mark was and is distinctive of its wares, whether or not the word is used by some persons in a generic sense.

With respect to section 18(1)(a) of the *Trade Marks Act*, the question of the registration of a trade mark must be examined by reference to the statute under which it was registered. Section 18(1) of the *Trade Marks Act* is as follows:

18. (1) The registration of a trade mark is invalid if
- (a) the trade mark was not registrable at the date of registration;
 - (b) the trade mark is not distinctive at the time proceedings bringing the validity of the registration into question are commenced; or
 - (c) the trade mark has been abandoned;
- and subject to section 17, it is invalid if the applicant for registration was not the person entitled to secure the registration.

⁶ American Thermos Bottle Co. v. W. T. Grant Co. 279 Fed. 151.

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The registration of "THERMOS", No. 50/12223, was made in 1907 under the *Trade Mark and Design Act*, R.S.C. 1906, c. 71. The provisions of that Act pertinent for consideration in these proceedings are sections 5, 11 and 13. Section 5(1) defines what for the purposes of the Act shall be considered and known as trade marks, in the following terms:

All marks, names, labels, brands, packages or other business devices, which are adopted for use by any person in his trade, business, occupation or calling, for the purpose of distinguishing any manufacture, product or article of any description manufactured, produced, compounded, packed or offered for sale by him, applied in any manner whatever either to such manufacture, product or article, or to any package, parcel, case, box or other vessel or receptacle of any description whatsoever containing the same, shall, for the purposes of this Act, be considered and known as trade marks.

By section 13 it is provided that after registration the proprietor:

shall have the exclusive right to use the trade mark to designate articles manufactured or sold by him.

By section 11, however, registration may be refused:

if the so-called trade mark does not contain the essentials necessary to constitute a trade mark, properly speaking.

The effect of this provision was that a word was not registrable under the Act as a trade mark which was merely descriptive of the character and quality of the goods in connection with which it was used.

In respect of the 1907 registration, the applicant contends that the respondent has held itself out as holding a patent on its vacuum-insulated bottle and that this is an admission by the respondent that there was such a patent; that the respondent introduced the bottle as a new product and had a monopoly on its manufacture and sale and gave the name "thermos" to it; and that, in consequence, "thermos" was the name of and was descriptive of the bottle and was non-distinctive when the word was registered as a trade mark in 1907 and, therefore, is invalid under section 18(1)(a) of the present Act⁷.

The word "thermos" appears to have originated in Germany, about 1905, from a Greek word meaning hot or

⁷ See the *Linoleum* case (1878) 7 Ch.D. 834, Fry J. at p. 836.

warm. But when it was originated and when it was first registered as a trade mark in Canada in 1907, such a derivation would have been known by few persons other than classicists and persons familiar with the Greek language, and in my opinion, it was a new and freshly coined fancy word which would not convey any obvious meaning to ordinary persons in Canada. In the *Frigidaire*⁸ case, Rinfret, C.J.C. and Kerwin J. (dissenting on other points) quoted at p. 683 the remarks of Lord Macnaghten in the *Solio* case:

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If it is "new and freshly coined" (to adopt an old and familiar quotation), it seems to me that it is no objection that it may be traced to a foreign source, or that it may contain a covert and skilful allusion to the character or quality of the goods.

In *Kodak, Ltd. v. London Stereoscopic and Photographic Company, Ltd.*⁹, Swinfen Eady J., said:

...It cannot be disputed since the case of the *Eastman Photographic Materials Company, Ltd. v. The Comptroller-General* (L.R. (1898) A.C. 571) that a word may be a perfectly good invented word although it has some reference to the character or quality of the goods, and even if the word "Kodak" as applied to films was to some extent descriptive, or had some reference to the character or quality of the films, it would not be a fatal objection to the validity of the Trade Mark.

As to the question of patent. Having regard to the work and research in this case on behalf of the applicant, I would expect that if there was a pertinent basic patent, an official record of it would have been presented in evidence. A patent on a covered insulated bottle was taken out in England in 1904 and was held invalid in 1910 in *Thermos Ltd. v. Isola Ltd.*¹⁰.

The respondent's descriptions, from time to time, of its bottle as the "genuine Thermos" and the "original" bottle may have been ways of affirming its claim to the exclusive use of the trade mark in connection with its bottles, or it may have been inaccurate or laudatory puffing. The words infer, also, that there were other vacuum bottles not of the respondent's manufacture.

The evidence in respect of the situation in 1907 and prior thereto is scanty and not, in my opinion, sufficient

⁸ *General Motors Corp. v. Bellows* [1949] S.C.R. 679.

⁹ (1903) 20 R.P.C. 337 at pp. 350-51.

¹⁰ (1910) 27 R.P.C. Supplement 388. Referred to in Vol. 19 Oxford English Dictionary, *ante*.

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to warrant a finding that the trade mark "THERMOS", No. 50/12223, was not registrable at the time it was registered in 1907. The mark has stood unchallenged for more than half a century, until attacked in these proceedings.

The trade mark "SUPER THERMOS" was registered in 1931 under the *Trade Mark and Design Act*, R.S.C. 1927, c. 201, which is similar to the previous Act of the same name, R.S.C. 1906, c. 71. The applicant contends that this mark was descriptive and non-distinctive at the date of its registration and, consequently, was not registrable at that time and is therefore invalid under section 18(1)(a).

In my opinion, the word "THERMOS" is the dominant word in that trade mark, and the mere addition of the word "SUPER" does not make the trade mark descriptive or non-distinctive. The evidence does not satisfy me that the trade mark was not registrable when it was registered in 1931.

The attack under section 18(1)(a) of the *Trade Marks Act* on the 1907 registration of "THERMOS" and the 1931 registration of "SUPER THERMOS" therefore fails.

As to the 1960 registration of "THERMOS", one attack is under section 18(1)(a) of the present Act on the ground that it was not distinctive and not registrable under that Act when it was registered. Section 12 of the Act is as follows:

12. (1) Subject to section 13, a trade mark is registrable if it is not
 - (a) a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years;
 - (b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French languages of the character or quality of the wares or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or their place of origin;
 - (c) the name in any language of any of the wares or services in connection with which it is used or proposed to be used;
 - (d) confusing with a registered trade mark; or
 - (e) a mark of which the adoption is prohibited by section 9 or 10.
- (2) A trade mark that is not registrable by reason of paragraph (a) or (b) of subsection (1) is registrable if it has been so used in Canada, by the applicant or his predecessor in title as to have become distinctive at the date of filing an application for its registration.

The word "distinctive" in the Act is defined in section 2(f), as follows:

2. In this Act,

- (f) "distinctive" in relation to a trade mark means a trade mark that actually distinguishes the wares or services in association with which it is used by its owner from the wares or services of others or is adapted so to distinguish them;

"Distinctive" thus means a trade mark that actually distinguishes or is adapted to distinguish.

Section 2(t)(i) reads as follows:

2. In this Act,

(t) "trade mark" means

- (i) a mark that is used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others,

A trade mark thus now means a mark that is used by a person for the purpose of distinguishing or so as to distinguish his wares or services from those of others.

The other attack on the 1960 registration, and on all the registrations except the Newfoundland registration, is under section 18(1)(b) on the ground that the word "thermos" was generic and not distinctive when these proceedings were commenced.

There is no doubt that to some extent the buying public identifies the word "thermos" particularly with the respondent's vacuum bottles, and that it would be very advantageous to the applicant if it could use the word in connection with the merchandising of its own bottles. Correspondence between Kingdon and the applicant's president, Mr. V. S. Johnson, in the United States, points this up very clearly. I quote the following excerpts from the correspondence.

Letter dated September 25, 1953, from Kingdon to Johnson:

In line with my letter on the injection moulding and production difficulties of Thermos, I would like to again put before you the suggestion that we either attempt to have the word "Thermos" declared generic, or that we very quietly move in and use the name, anticipating any legal action that may result.

The feeling that I have is that they are getting far more benefit from the use of the name than to which they are entitled and I am satisfied that our sales would take a very marked swing if we were able to take over the generic term. In discussing the question with the Mail Order division of the T. Eaton Company, they are thoroughly

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convinced that our products are far superior—but, to use their own terms, “the public see the name Thermos and immediately associate your company with the inferior products from Germany, England and Japan”

Comparative sales, for instance, on the 098 workmens' lunch kit, which is the kit with the one-pint bottle, indicate that the Mail Order received orders for 101 Aladdin kits, whereas the Thermos kit sold 1,290. This is strictly a matter that the name has been instrumental in creating the demand and no conscious choice has been made by the consumer apart from the recognition of the name.

In the question of childrens' lunch kits, the Thermos kit, which is a plain kit with a 7-ounce bottle, through the catalogue, sold 790 units. The Hop-a-long Cassidy kit which was displayed and described equally as well as Thermos and sells for 20 cents more, only sold 52 kits in the entire season.

The situation here is one, as you can appreciate, that the Mail Order do not want to devote catalogue space to a product that is not moving readily, and I am personally satisfied that this is the very best evidence of the power of the name “Thermos”.

Reply dated September 28, 1953, from Johnson to Kingdon:

Of course, there are two considerations which must be answered affirmatively before we could proceed in Canada on the Trade Mark situation. First, we must be convinced that legally Thermos is no longer entitled to the exclusive use of the word “thermos” in this country. The nub of the matter would be whether the word “thermos” suggests to the purchasers a product specifically made by the Canadian Thermos Bottle Company. If it doesn't mean this to the purchaser, then Thermos is not entitled to the benefit of its protection. Secondly, we must make sure that if the word “thermos” could be declared in the public domain, that our initiative in the matter would not hurt us commercially either in this country or in your country. We must be unusually sensitive to this problem because of our own Trade Mark situation.

Your letter of the 25th would suggest that the public in Canada seems to identify “thermos” with the Canadian Thermos Bottle Company. Read over your paragraph 2 very carefully and see if that isn't the implication of it. Of course, we have letters from Charlie Edwards that the word “thermos” is generic, but I don't know how much weight that would carry.

Letter dated September 30, 1953, from Kingdon to Johnson:

This question has been posed in a fashion that requires a good deal of thought and, quite frankly, I think that it must be answered in two ways. The public, I do not believe, associate the name “thermos” specifically with the Canadian Thermos Bottle Company, but rather with the original vacuum bottle and, as such, it is recognized as a brand name. The reference made in the second paragraph of my letter with regard to the T. Eaton Company is in line with this thinking—that the term “thermos”, whether it be the Canadian or the XYZ Thermos Bottle Company, is the thing that catches the public eye and, as a result, they place their order for a product bearing this name rather than for our products which, while they look identical, are not called “thermos” and there is a tendency for the public to associate our products with the inferior products from the foreign countries.

The second thought that comes to mind in regard to this term is that I believe in the minds of the trade that they do themselves associate the word thermos with the Canadian Thermos Bottle Company. In other words, I do sincerely believe that they do not see any marked advantage in the term but, here again, there perhaps is reason for it as I am sure we have all had the experience in talking with either a jobber, departmental or retail store of finding them referring to our bottles as thermos bottles. My main concern is that in the eyes of the public the original thermos gives a definite advantage because of that one little word I am firmly convinced that were we able to call our bottles the Aladdin thermos bottles, that there would be a very definite and quick changeover from our competitor to ourselves; and it would seem to me that with the gains that have been made to this point that it would be highly advantageous.

...I feel that the trade and the public would accept Aladdin vacuum bottles more readily, were they referred to as the Aladdin thermos bottle.

Letter dated October 15, 1953, from Kingdon to Johnson:

The situation with this account is that we have obtained a small amount of business from them for the past year, which I have felt is unsatisfactory, and due to a co-operative advertising programme which they intend to conduct next month, it gave me an opportunity of discussing the entire situation at the higher level of the Supervisor, which we have not been able to do in the past. His expression was that certainly from a merchandising standpoint the eye appeal alone of our line should be sufficient to sell it—but, on the other hand, he raised the old question that while they recognize that a thermos bottle is a vacuum bottle exactly the same as ours, that in the minds of the public it poses quite a problem and operating on a self-serve basis, they feel that it gives a decided advantage to our competitor.

Kingdon said in cross-examination that the generic position of the word “thermos” was the same through the period 1949-64.

In my opinion, the evidence establishes two facts of major importance insofar as this case is concerned. The first is that at the date the proceedings were commenced the words “thermos” and “thermos bottle” had come into popular use in Canada and, when used in relation to the common kind of vacuum bottles, the kind found in the average home, were used and understood by persons of average education and intelligence in ordinary society as generic words descriptive of that class of bottle, and they had fallen into the day-to-day English and French languages of the Canadian people as synonymous with “vacuum bottle” in English and “bouteille isolante” in French, and as descriptive of the common household vacuum bottle.

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Before I state the second fact I will say that I am not convinced that on a question whether in Canada a particular word is a generic or descriptive word in the English or French languages, or as to what its meaning is, (other than technical words and words having special meaning in a profession, trade, etc.), a judge must decide the question solely on the evidence which is adduced and cannot use his own knowledge of the word and of the way persons use and respond to it in conversation in ordinary society. If I were to use my own knowledge and experience respecting the use of the word "thermos" in conversation, it would support my conclusion above stated. However, as I have the impression that counsel's view was that my findings should be based upon the evidence adduced, I have endeavoured to make my findings solely on that evidence and inferences therefrom, without being influenced by any personally subjective feelings I may have.

The second fact so established, in my opinion, is that as of the date the proceedings were commenced an appreciable portion of the population in Canada knew and recognized the respondent's trade mark "THERMOS" and its significance, and that to them it was distinctive of the respondent's vacuum bottles. They were influenced, no doubt, by the 20,000,000¹¹ of the respondent's bottles bearing the trade mark which were sold in Canada in the period 1935-64 in competition with imported and other bottles, and by the extensive advertising by the respondent and by the millions of "directions for use", etc., in connection with the respondent's bottles and trade mark, which reached the public and purchasers of vacuum bottles. The applicant's experience with the trade such as with Eaton's mail order business, where purchasers had a choice between brand names, and the correspondence between Kingdon and Johnson, provide evidence that, relative to vacuum bottles, the trade mark "THERMOS" was distinctive of the respondent's bottles, in the trade in great measure and to a lesser degree among members of the general public. Kingdon said that trade marks are an im-

¹¹ Parker's figure.

portant feature to the public when purchasing vacuum bottles. I think there can be little doubt that trade marks used in connection with articles sold in large volume over a long period usually have a reputation associated with them. The catalogue sales figures referred to in the Kingdon-Johnson correspondence show that the purchasers who had a choice of brand name bottles chose the "THERMOS" brand in preference to the other brands.

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It is my opinion, also, that many of the public are aware of the dual use and meaning of the word "thermos" and that they use it in its generic sense or in its trade mark sense, as the case may be, as circumstances may call for. In day-to-day conversation such persons may use the word in a generic sense without adding "brand" or "vacuum bottle", and without having in mind a bottle of a particular manufacturer; but when they go to a store to buy a vacuum bottle they will have in mind that the name "THERMOS" on a bottle has a significance which distinguishes bottles made by the respondent and sold under that brand name from bottles bearing some other brand or no brand. They may have had experience with vacuum bottles or have been induced to regard bottles bearing the word "thermos" as bottles warranted by a reputable maker, although they do not know the manufacturer by name—people often look for brand name goods without knowing the name of the manufacturer.

Counsel for the respondent submitted that on the evidence the court cannot make a finding as to how many people or what percentage of the people in Canada use the word "thermos" descriptively or generically, and that it was not shown that the persons who used it in that way were representative of the general public. Certainly, there was in the evidence nothing in the nature of a Gallup poll or a sampling on a statistical basis, such as is used by the Dominion Bureau of Statistics, and I cannot put a percentage figure on the portion of people who use the word generically. But the evidence as a whole as to its widespread use, and especially the indication of its spontaneous use, satisfies me that it is used as I have found, *i.e.*, (a)

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generically and descriptively in popular usage in day-to-day language, and, (b) in a distinctive sense extensively in the trade, and to a lesser degree by the public when purchasing vacuum bottles.

Having concluded that the word "thermos" has come into common use as a generic word, in speech and in writing, I must go on to determine whether for that reason the respondent's registration of it should be expunged, as being not distinctive, notwithstanding that it is distinctive to a significant portion of the people who sell or buy vacuum bottles. The words of Maclean J. in *The Bayer Company, Limited v. The American Druggists' Syndicate, Limited*¹², in reference to the situation in that case, are pertinent here. He said at p. 598:

The same section of the public in Canada, would no doubt today, identify aspirin as the Bayer production of acetyl salicylic acid and, to that extent at least, the word aspirin does not denote the name of the article. It was through the sale of acetyl salicylic acid in tablet form under the name of "Aspirin" first by manufacturing chemists and later by the Bayer Company itself, that the public began to purchase direct from retail druggists, instead of through the physician's prescription. Owing to this fact, possibly another section of the public, consumers of aspirin, gradually came to identify that word as the name of the article. But all this has occurred in recent years. Much advertising has brought this about and produced the strange situation, if the respondents' contention be sound, that the more successful the manufacturer of a product, identified by some registered word mark, is in inducing the public to consume his product, the nearer he approaches the end of the user of his trademark even though originally it was a proper entry. The implications from such a state of the law are considerable and serious, and even with statutory authority existing to expunge trade-marks in such a condition of facts, one can readily perceive the difficulties in justly resolving the many complex issues which might arise.

Rand and Locke JJ. said in *General Motors Corp. v. Bellows*¹³, in reference to marks in issue in that case:

No doubt there is a public interest against confusion of these marks, but on the other hand there is a like interest in the freedom of the individual trader in ordinary trade practices and in particular in using the main stock of the language. If the latter interest is disregarded, a single word might effect a wholesale appropriation of the only apt language available.

¹² [1924] S.C.R. 558.

¹³ [1949] S.C.R. 678 at p. 691

And at p. 688 they said:

The first question is, then, whether the word "Frigidare" was properly placed on the register in 1933. The rule quoted illustrates the conflict early recognized by the courts before the subject matter came under legislation, i.e. between the appropriation by a trader of a word within the range of language that would ordinarily be used by traders to describe particular goods, and the right of other traders in the normal carrying on of their business to employ the same or similar words. In the technique of advertising, the more complex and expensive the goods are, the greater the imaginative seeking by those producing them for attractive and arresting words; but in fixing the limits of legislative protection the courts must balance the conflicting interests and avoid placing legitimate competition at an undue disadvantage in relation to language that is common to all.

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There is ample authority for the proposition that, as a general rule, a word merely descriptive of the article to which it is applied cannot be used as a trade mark for that article, because everyone has the right to use the common appellatives of the language. For example, a dealer in flour cannot adopt that word as his trade mark, and prevent others from applying it to their packages of flour. I am satisfied that the word "thermos" has become a commonly used word descriptive of the ordinary vacuum bottles which the applicant and the respondent manufacture and sell, and, if the rule above mentioned were absolute and of unlimited application, the case of the applicant for expungement of the respondent's trade marks would be completely tenable. But the respondent registered its trade mark in 1907. It was a good trade mark then and has been recognized as such for many years. The competitors of the respondent have respected it. They had and have available the generic term "vacuum bottle", and have used it on millions of their bottles and, as already found by me, to many persons the trade mark is distinctive of the respondent's bottles.

Although the word "thermos" is now commonly used in a descriptive sense, I do not regard it as a merely descriptive word, in the sense that "shredded wheat" or "cellular cloth" were said to be merely descriptive in the cases in which their significance was the subject of judicial decision. As Fletcher Moulton, L.J., pointed out in *Re Joseph Crossfield & Sons, Ltd.*¹⁴, there is no absolute incompatibility

¹⁴ [1910] 1 Ch. 130 at p. 145.

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between what is descriptive and what is distinctive. A descriptive word can be distinctive when used in certain circumstances.

It is also recognized, at least in our neighbour, the United States, that a word registered as a trade mark may in fact retain its significance as a trade mark even after it has become *publici juris* and has become a part of the public domain as a generic descriptive designation for the class or type of goods. In 1962, in *American Thermos Products Co. v. Aladdin Industries, Inc.*¹⁵, the United States District Court, District of Connecticut, found, on the evidence before it, that the word "thermos" had become a generic descriptive word in the English language as used in the United States and had become a part of the public domain, but that there is an appreciable, though minority, segment of the consumer public which knows, recognizes and uses the trade mark "Thermos" and, therefore, to eliminate confusion and the possibility of deceit of such consumers, the court decreed that the generic use of the word "thermos" by Aladdin Industries, Incorporated, in its literature and advertising and on its labels would be subject to certain restrictions and limitations set forth in the decision. The court declared the "Thermos" trade marks there in question to be valid, except that they will not be infringed by the generic and descriptive use of the word "thermos" when used in accordance with the provisions of the decision. The decision was affirmed by the United States Court of Appeals, Second Circuit, sub name *King-Seeley Thermos Co. v. Aladdin Industries Inc.*¹⁶. It appears from the decisions that the courts acted upon the following provisions of the law of the United States:

(1) A designation which is initially a trademark or trade name ceases to be such when it comes to be generally understood as a generic or descriptive designation for the type of goods, services or business in connection with which it is used.

(2) To the extent that a designation of the kind described in Subsection (1) retains its significance as a trade-mark or trade name,

¹⁵ (1962) 207 F. Sup. at p. 9: 134 U.S.P.Q. at p. 98.

¹⁶ (1963) 321 F. 2d. 577: 138 U.S.P.Q. 349.

its use as such is protected as far as it may be practicable without impeding the use of the designation by others in its generic or descriptive significance.

The situation in Canada in 1960 was much the same as when these proceedings were commenced, and it is my opinion that the trade mark "THERMOS" was registrable under the present *Trade Marks Act* when it was registered in 1960, and that it is not invalid under section 18(1)(a).

It is also my opinion that when the proceedings were commenced the trade mark registered in 1960, and the other trade marks whose expungement is sought, were distinctive of the respondent's bottles to a substantial portion of the consumer public throughout Canada, to many and not only to a few, although I cannot put percentage figures on the portion to which the trade mark was then distinctive and the portion to which it was not. Therefore, notwithstanding my conclusion as to the generic and descriptive use of the word "thermos", I do not think that the trade marks should be found to be invalid under section 18(1)(b).

Legislation concerning trade marks exists primarily in the interest of and for the protection of the public¹⁷, and perhaps it is not out of place for me to deal with the argument of respondent's counsel that if the trade marks are maintained, no harm will be done, but if they are expunged there will be a danger that the public will be deceived into buying other bottles thinking that they are the respondent's.

There are conflicting interests among the manufacturers and sellers of vacuum bottles. There is the interest of the respondent to maintain its trade mark and to have the advantage of whatever good reputation is associated with that trade mark. There is the interest of the applicant to be allowed to use the generic term "thermos" in connection with its vacuum bottles so as to improve its competitive position. I am assuming that the applicant is under a disadvantage of not being able to use that generic term. How-

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¹⁷ *Lightning Fastener Co. v. Canadian Goodrich Co.* [1932] S.C.R. 189 at p. 196.

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ever, I do not preclude the possibility that the applicant might find it possible to use that term in its generic sense, with limitations or qualifications, in a way that would not mislead the public or infringe the respondent's trade marks or depreciate the value of the goodwill attaching to the trade marks. A way was found in the United States. I express no opinion as to whether it is possible to find a way in Canada.

The applicant contends that the continued registration of the word "thermos" as a trade mark puts it at a competitive disadvantage vis-à-vis the respondent, for prospective purchasers of vacuum bottles may and do ask for a "thermos" and they are consequently sold a "THERMOS" brand bottle, rather than an "Aladdin" brand bottle, even when they use the word in a generic sense and are not seeking only "THERMOS" brand bottle or a bottle of a particular manufacturer. I have no doubt that this occurrence is common. The fact that the buyer could have used the synonymous term "vacuum bottle" is of no great significance; he uses a term in common use.

There is the question whether the average purchasers of vacuum bottles, acting with normal caution, would be likely to be misled or confused if the respondent's trade marks are expunged and if, in consequence, bottles of the respondent's competitors, including imported bottles, are then marked and sold as "thermos" bottles without explanation, qualification or distinction. Might such purchasers be misled into buying those other bottles, thinking that they are buying the respondent's bottles? Vacuum bottles are inexpensive articles sold from shelves, across the counter and through mail order catalogues. I would not expect purchasers to exercise as much care in buying a vacuum bottle as in buying a more expensive article. Bottles of various origins look much alike. Ordinary persons might not look for the manufacturer's name. If the label says that it is a thermos bottle, they might assume that it is a bottle made by the same manufacturer whose bottles have carried the trade mark and the manufacturer's warranties, and that replacement parts would be obtainable if needed.

Counsel for the applicant argued that purchasers who do not know the significance of the respondent's trade marks would not be misled; and that those who know "thermos" as a generic term and also as a trade mark would not be misled either, because if they wanted a bottle made by a particular manufacturer they would know enough to look for the maker's name. This is an attractive argument, but, having regard to buying habits and the class of purchasers and the way in which the bottles are sold, it is my opinion that there is a real risk that an appreciable number of ultimate purchasers might be misled or confused if imported bottles and bottles of manufacturers other than the respondent are marked thermos bottles. Comparing and evaluating that risk vis-à-vis the above mentioned competitive disadvantage of the applicant, and endeavouring to balance the several conflicting interests involved, of which the public interest is paramount, I have come to the conclusion that expungement of the respondent's trade mark would involve the risk above mentioned and that the risk is sufficiently serious to override the disadvantage under which the applicant is labouring in not having the use of the word "thermos" in its business. That word is not the only apt or practical term. The applicant has the term "vacuum bottle". I agree that it is not used as frequently as "thermos".

I now turn to the question of the Newfoundland Registration "THERMOS", No. 264, dated January 8, 1908.

The *Trade Marks Act* contains special provisions in respect of trade mark registration under the laws of Newfoundland prior to April 1, 1949. Those provisions are in section 65, which reads as follows:

65. (1) The registration of a trade mark under the laws of Newfoundland prior to the 1st day of April, 1949, has the same force and effect in the Province of Newfoundland as if Newfoundland had not become part of Canada, and all rights and privileges acquired under or by virtue thereof may continue to be exercised or enjoyed in the Province of Newfoundland as if Newfoundland had not become part of Canada.

(2) The laws of Newfoundland as they existed immediately prior to the expiration of the 31st day of March, 1949, continue to apply in respect of applications for the registration of trade marks

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under the laws of Newfoundland pending at that time and any trade marks registered under such applications shall, for the purposes of this section, be deemed to have been registered under the laws of Newfoundland prior to the 1st day of April, 1949.

Section 65 carried into the *Trade Marks Act* Term 21 of the Agreement containing Terms of Union between Canada and Newfoundland which was approved by the Parliament of Canada in Acts of 1949, Chapter 1, and confirmed by the *British North America Act*, 1949. Term 21 is as follows:

21. (1) Canada will provide that the registration of a trade mark under the laws of Newfoundland prior to the date of Union shall have the same force and effect in the Province of Newfoundland as if the Union had not been made, and all rights and privileges acquired under or by virtue thereof may continue to be exercised or enjoyed in the Province of Newfoundland as if the Union had not been made.

(2) The laws of Newfoundland existing at the date of Union shall continue to apply in respect of applications for the registration of trade marks under the laws of Newfoundland pending at the date of Union and any trade marks registered upon such applications shall, for the purposes of this Term, be deemed to have been registered under the laws of Newfoundland prior to the date of Union.

Appendix II to Volume V of the 1949 *Consolidation of Statutory Orders and Regulations* provides an accurate summary in respect of the Terms of Union, and for convenience I will repeat it here, as follows:

APPENDIX II

NEWFOUNDLAND

The agreement containing the Terms of Union of Newfoundland with Canada was approved by chapter 1 of the Statutes of Canada, 1949, and confirmed by *The British North America Act, 1949*. By paragraph (1) of Term 18 all laws in force in Newfoundland at or immediately prior to the date of Union continue therein as if the Union had not been made, subject nevertheless to be repealed, abolished or altered by the Parliament of Canada or by the Legislature of the Province of Newfoundland according to the authority of the Parliament or of the Legislature under the British North America Acts, 1867 to 1946. Paragraph (2) of Term 18 provides that Statutes of the Parliament of Canada in force at the date of Union, or any part thereof, shall come into force in the Province of Newfoundland on a day or days to be fixed by Act of the Parliament of Canada or by proclamation of the Governor General in Council issued from time to time. Paragraph (2) of Term 18 provides further that any such proclamation may provide for the repeal of any of the laws of Newfoundland that

(a) are of general application;

(b) relate to the same subject-matter as the statute or part thereof so proclaimed; and

(c) could be repealed by the Parliament of Canada under paragraph (1) of Term 18.

Proclamations of the Governor General in Council bringing certain statutes of the Parliament of Canada into force in the Province of Newfoundland and repealing certain statutes of Newfoundland were issued on April 1, 1949, May 9, 1949 and September 13, 1949. For convenience the schedules to these proclamations, listing the statutes brought into force and the statutes repealed, are set forth hereunder.

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The First Schedule, namely, Statutes of the Parliament of Canada to come into force in the Province of Newfoundland on April 1, 1949, includes the *Exchequer Court Act*, the *Trade Mark and Design Act*, and *The Unfair Competition Act, 1932*.

The Second Schedule, Statutes of Newfoundland to be repealed on April 1, 1949, includes Chapter 154, Consolidated Statutes of Newfoundland (Third Series), *Of Trade Marks and the Registration Thereof*, and Act No. 39 of 1948 amending chapter 154.

The Newfoundland registration was made under Chapter 112 of the Newfoundland Consolidated Statutes, 1896 (2nd Series)¹⁸. The definition of "trade mark" in section 2 is as follows:

The expression "trade-mark" means a trade-mark registered in the register of trade-marks kept under the provisions of this chapter, and includes any trade-mark which, either with or without registration, is protected by law in any British possession or foreign State, to which the provisions of the one hundred and third section of the Imperial "Patents, Designs, and Trade Marks Act, 1883," are under Order in Council for the time being applicable.

The Judicial Committee of the Privy Council said, in *Imperial Tobacco Co. (Newfoundland), v. Duffy*¹⁹, that this Newfoundland statute was undoubtedly ill expressed.

The statute provides that a trade mark must consist of or contain at least one of certain essential particulars which include:

...

(c) A distinctive device, mark, brand, heading, label or ticket; or

¹⁸ Later re-enacted as Chapter 154 of Consolidated Statutes of Newfoundland (Third Series).

¹⁹ [1918] A.C. 181 at p. 183.

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(d) An invented word or invented words; or

(e) A word or words having no reference to the character or quality of the goods...

The Supreme Court of Newfoundland considered those essentials in *Orange Crush Co. and British Aerated Waters Co. v. Gaden Aerated Water Works Ltd.*²⁰. Kent J. said at p. 308:

The first four of these classes specify what a trade mark may consist of; the last what it may not consist of. It may not consist of a word or words having reference to the quality or character of the goods. In other words, a trader may indicate his connection or dealing with goods by adopting any of the particulars falling within classes (a) to (d) which are neutral as to the character of the goods themselves, but he may not by adopting words having reference to the character or quality of the goods and thereby monopolize the use of words descriptive of the goods in question.

And at p. 309:

...Our Statute contains no provisions for rectification of the register, and the only way in which in an action for an infringement the question of the validity of a registered trade mark or its component parts may be questioned is by setting up that it is not duly registered. That this is so is suggested in the judgment of the Privy Council in the case of the *Imperial Tobacco Company vs. Duffy*, 87 L.J., P.C. 50, in which Lord Wrenbury says on p. 51, "It is strange, but it is the fact, that the Newfoundland Statute contains no provisions for rectification of the register. Under these circumstances the defendant cannot, of course, be blamed for not taking proceedings for rectification. But it might be a defence to an action for infringement that the plaintiffs are not duly on the register."

It remains to determine whether the words "Orange Crush", etc., are entitled to protection. If they refer to or are descriptive of the character or quality of the beverages, they are not "words having no reference to the character or quality of the goods" and may not be or form part of the essential particulars of which the trade mark is made up.

It was common ground on the argument before me that, having regard to the provisions of the Newfoundland statute and section 65 of the *Trade Marks Act*, any lack of distinctiveness of the Newfoundland trade mark when these proceedings were commenced does not afford a good ground for finding it invalid. The question is whether it was registrable when it was registered in 1908. The evidence respecting the situation in Newfoundland at and before that date is even more scanty than the evidence respecting the situation in Canada when the trade mark was registered

²⁰ Nfld. L.R. 1921-26 at p. 301.

at Ottawa in 1907. If any doubt exists as to registrability, it must be resolved in favour of the trade mark. The applicant has not acquitted itself of the onus of showing that the trade mark was not duly registered in Newfoundland in 1908. The application to expunge the Newfoundland registration is therefore dismissed.

Counsel for the respondent also argued that even if the trade mark was not duly on the register in Newfoundland, this court has no power to expunge it, because of section 65 of the *Trade Marks Act* and because, so he argued, the "register" in section 56 is the register at Ottawa and does not include the register in Newfoundland.

Having regard to my finding respecting the trade mark when it was registered in Newfoundland, it is not essential for the determination of the application that I deal with this argument, but I will state my conclusion on it briefly.

As I construe section 65, its purpose and effect is to preserve in the Province of Newfoundland the rights and privileges acquired under or by virtue of the registration of a trade mark under the laws of Newfoundland prior to April 1, 1949. It is not a section dealing with the jurisdiction of the courts.

The *Exchequer Court Act* and the *Trade Marks Act* are in force in the Province of Newfoundland. Chapter 154 of the Consolidated Statutes of Newfoundland (Third Series) *Of Trade Marks and the Registration Thereof*, was repealed on April 1, 1949.

Section 21 of the *Exchequer Court Act* and sections 2(n), 54 and 56(1) of the *Trade Marks Act* are pertinent. Section 21 of the *Exchequer Court Act* is in part as follows:

21. The Exchequer Court has jurisdiction as well between subject and subject as otherwise,

...

- (b) in all cases in which it is sought to impeach or annul any patent of invention, or to have any entry in any register of copyrights, trade marks or industrial designs made, expunged, varied or rectified; and
- (c) in all other cases in which a remedy is sought under the authority of any Act of the Parliament of Canada or at common law or in equity, respecting any patent of invention, copyright, trade mark, or industrial design.

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Sections 2(*n*), 54 and 56(1) of the *Trade Marks Act* are as follows:

2. In this Act,

(*n*) "register" means the register kept under section 26;

54. The Exchequer Court of Canada has jurisdiction to entertain any action or proceeding for the enforcement of any of the provisions of this Act or of any right or remedy conferred or defined thereby.

56. (1) The Exchequer Court of Canada has exclusive original jurisdiction, on the application of the Registrar or of any person interested, to order that any entry in the register be struck out or amended on the ground that at the date of such application the entry as it appears on the register does not accurately express or define the existing rights of the person appearing to be the registered owner of the mark.

The *Trade Marks Act* provides for the appointment of a Registrar of Trade Marks. Various sections of the Act prescribe his duties, including section 26 (to keep a register); section 27 (to keep an index of registered trade marks, etc.); section 40 (amendments to the register); and section 47 (transfer of a registered trade mark).

I may mention here that the contention that the "register" defined in section 2(*n*) does not include the register in Newfoundland is hardly consistent with the respondent's prior conduct, for the application on behalf of the respondent by its Trade Mark Agents to amend the register by changing the name of the owner of the Newfoundland trade mark was made on January 27, 1960, to the Registrar of Trade Marks, Ottawa, and was granted there by that Registrar; and the request, dated September 30, 1949, to record the assignment from Thermos (1925) Limited to Thermos Bottle Company Limited, was made to the Registrar at Ottawa and was recorded in the Trade Marks Office there on September 30, 1949.

However, whatever jurisdiction the Exchequer Court has depends on the statutes, not on the conduct of the respondent.

In my opinion, this court has jurisdiction to expunge the Newfoundland registration on a showing of sufficient cause to expunge it.

In case I have failed to accurately appraise the factual situation or to recognize the legal consequences flowing from the fact that the word "thermos" has become a generic word,

I shall deal briefly with certain other points argued by counsel for the respondent against the application to expunge.

The respondent contends that a trade mark may lose its distinctiveness only through the actions of its owner. I am unable to agree with that contention. Judson J. dealt with an issue of that kind in *Cheerio Toys and Games Ltd. v. Dubiner*²¹. The court decided the case on other grounds and did not deal with that issue, but Judson J. said at pp. 226-27:

What the Court is concerned with under s. 18(1)(b) is the actual state of facts at the time of the commencement of the proceedings. Distinctiveness may have been lost many years ago for reasons and because of usage which cannot now be traced or ascertained. The mere fact that at times the proprietor or permitted user has identified the word "Yo-Yo" as a trade mark does not mean that there could not be a loss of distinctiveness, if, in fact, there is a loss of distinctiveness. Careless user or the permission of extensive piracy of the mark by others, two of the factors relied upon by the judge, are merely two possible ways in which distinctiveness may be lost. If the Court concludes that at the time of the proceedings the mark is not distinctive, it is error to hold that this conclusion must be wrong because those two particular causes mentioned by the trial judge are absent.

Also in *General Motors Corp. v. Bellows (supra)*, Rand J., giving the judgment of himself and Locke J., said at p. 690, in reference to section 52(1) of *The Unfair Competition Act, 1932*, which is much the same as section 56(1) of the present *Trade Marks Act*:

...But I cannot interpret this language to do more than to allow the Court to deal with a properly registered mark as the exigencies of time may have affected it. In the other view, a retroactive validation would be given without restriction. A word mark may lose distinctiveness through, for instance, becoming the common name of the goods or from disuse or abandonment; and it is these changes leading to residual rights which the section envisages.

The respondent contends that the purpose of the applicant in these proceedings is to obtain the benefit of goodwill associated with the respondent's trade mark "THERMOS", and, therefore, the application should be dismissed. The evidence establishes that the applicant has diligently respected the respondent's trade marks. In taking these

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²¹ [1966] S.C.R. 206.

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proceedings the applicant has followed a course which is legally available to it and seeks relief to which it *bona fide* believes it is entitled under the law. I must reject this contention of the respondent, even although some benefit of the goodwill heretofore associated with the respondent's trade mark would flow to the applicant if the respondent's trade marks are expunged.

The respondent also argues that there has been laches and acquiescence on the part of the applicant in delaying the commencement of proceedings against the respondent until 1964, and that, therefore, the application should be dismissed. I find little merit in this argument. The respondent was not misled or lulled into a false sense of security by the applicant. Nor was the respondent unaware of the possibility, even the probability, that it might have to defend its trade marks. The applicant was under no obligation to commence proceedings prior to 1964 and was not estopped from taking them when it did in that year.

Finally, I will deal with the applicant's contention that the respondent's "THERMOS" trade marks are "deceptively misdescriptive", within the meaning of section 12 of the *Trade Marks Act*, in respect, for example, of its non-vacuum insulated wares, such as ice buckets and chests with fibreglas insulation. This contention would have validity if "thermos" were synonymous with "vacuum insulated". I have not found that these terms are synonymous. I do not think that they are, even although some of the respondent's wares, besides ordinary household vacuum bottles, are vacuum-insulated, e.g., "THERMOS" carafes. As to such things as tents and stoves, there can be no question of deceptiveness. In my opinion, it has not been shown that the respondent's trade marks are deceptively misdescriptive of any of the wares to which they are applied.

In the result, the application to expunge the respondent's trade marks is dismissed with costs.