BETWEEN

1912
May 28.

FRUITATIVES, LIMITED. . . . . PLAINTIFF.

and

LA COMPAGNIE PHARMACEUTIQUE DE LACROIX ROUGE, LIMITÉE, ... DEFENDANT.

Trade-Mark—Infringement—Descriptive word—"Fruitatives" as applied to sale of laxative medicine.

The word "Fruitatives", considered as the essential feature of a specific trade-mark applied to the sale of a laxative medicine and used on two sides of a four part label with the words "or Fruit Liver Tablets" printed thereunder, is not a mere descriptive word.

The Bovril Trade-Mark, (1896) 2 Ch. D. 600 referred to.

The distinction between the Canadian and present English trade-mark laws pointed out. *Re Hudson's Trade-Marks* (L. R. 32 Ch. D. 311); *Smith v. Fair* (14 O. R. 729); and *Provident Chemical Works v. Canadian Chemical Co.* (4 O. L. R. 549) referred to.

THIS was an action for the infringement of a trade-mark.

The facts of the case may be shortly stated as follows:—

1. The Plaintiff is an incorporated company with its head office in Ottawa, Ontario, and manufactures a proprietary medicine known as "Fruitatives".

2. On the 8th day of October, 1903, Amos Rogers, of Ottawa, applied to the Minister of Agriculture for the Dominion of Canada under the provisions of the Trade-Mark and Design Act for the registration of a new and original specific trade-mark to be applied to the sale of a medicine for human use, which had been designed by him and his application being granted, said specific trade-mark was duly registered in the

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Trade Mark Register on the 8th day of October, A.D. 1903, and a certificate under the statute that the same had been so registered, issued to the said Rogers.

The said specific trade-mark consists of a four part label with the use of the word "Fruitatives" as a title, with a sub-title "Fruit Liver Tablets" and the colours and arrangement of certain designs of fruit.

After the incorporation of the plaintiff company, the said specific trade-mark was assigned to it by the said Amos Rogers.

The plaintiff manufactures and sells its said medicine for human use, known as "Fruitatives", prepared in the form of tablets enclosed in a round wooden box covered with a paper label, which box is itself enclosed in a rectangular paper carton covered by the four part label constituting the specific trade-mark hereinbefore referred to.

The said preparation of the plaintiff is well-known and the plaintiff has spent large sums of money in advertising it throughout Canada, and in acquiring a good-will for the business.

It has been the practice of the plaintiff to reproduce the carton covered with the said trade-mark in very many of its advertisements, and retail dealers throughout Canada have been in the habit of making window displays of the said cartons, so that the appearance of the said cartons had become familiar to the people of Canada.

Defendant company placed upon the market a medicine in tablet form similar to the tablets of the plaintiff in appearance, and also enclosed in a round wooden box with paper label similar to that of the plaintiff, it again being also enclosed in a rectangular carton covered with a four part lithographed label of

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which the chief word is "Fruit-i-nol" with the word "Tablets" underneath and a sub-title "Fruit Liver Regulator," the said label being colored like the plaintiffs' label and having fruit designs upon it similar to those upon the plaintiff's label.

May 3rd, 1912,

The case came on for hearing at Ottawa before Mr. Justice Cassels.

G. F. Henderson, K. C., for plaintiff;

A. Lemieux, K. C., for defendant.

CASSELS, J. now (May 28th, 1912,) delivered judgment.

This was an action tried before me in which the plaintiff claims an injunction to restrain the defendants from infringing its trade-mark. It has to be borne in mind that the case of the plaintiff is confined to an action based upon its trade-mark which it claims is infringed. There is no case set up of "passing off".

The distinction between the two classes of cases is set out in *Standard Ideal Co.* v. *Standard Sanitary Mfg. Co.* (1)

This case also deals with the construction of the Canadian Trade-Marks Act (R. S. 1906, c. 71). If the trade-mark of the plaintiff is a valid trade-mark, I have no doubt whatever that the defendants have infringed. The registration by the plaintiff of his trade-mark bears date the 8th October, 1903. Over $300,000 has been spent in advertising, with the result that the plaintiff's sales have been very large. It is very evident from the testimony of Joseph Edmund Dubé, the president of the defendant company, coupled with a view of the defendant's boxes, that he deliberately set to work to try and obtain the benefit of the plaintiff's advertising and business. The remarks of

(1) [1911] A. C. 78.

Bowen, L. J., which are quoted by Burbidge, J. in *Melchers* v. *DeKuyper* (1) are pertinent.

I have considered the authorities cited by counsel and numerous others, and am pleased to have come to the conclusion that the plaintiff is not without remedy. I think the plaintiff's trade-mark is a valid one. It has to be taken in its entirety. In considering the later English authorities, care has to be exercised as the Canadian statute and the English statutes are not the same. The distinction is pointed out in *Smith v. Fair* (2). Also by Sir Charles Moss, C. J., in *Provident Chemical Works v. Canadian Chemical Co.* (3) An interesting case in England is re *Hudson's Trade-Marks* (4) where it was sought to register "Carbolic Acid Soap Powder." The application was a few days prior to the enactment of the Imperial Act of 1883 and was governed by the statute of 1875 (See Cotton, L. J. p. 320). It was held that the label was a good trade-mark under the statute of 1875, although it might not be so under the statute of 1883.

It is argued that the word "Fruitatives" is a mere descriptive word. I do not think so. In the *"Bovril" Trade-Mark* (5) the Court of Appeal upheld the trade-mark. The language of Lopes, L. J., in commenting on the effort of counsel to cut the word "Bovril" in two is pertinent to the present case. He observes (p. 608):—

"It is said that the word "Bovril" indicates that the substance in question was made from beef, for that the first syllable 'bov' relates to the animal from which beef comes—'Bos', 'bovis' and 'ox'. In my judgment you must look at the whole word, and not at part of it. The combination of that part of the word

(1) 6 Ex. C. R. at p. 101.
(2) 14 Ont R. 729.
(3) 4 O. L. R. at p. 549.
(4) L. R. 32 Ch. D. 311.
(5) (1896) 2 Ch. D. 600.

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with the rest of it may be such as to make the word in its totality meaningless and non-descriptive. That is the view I take of the word "Bovril" and I cannot think that, in 1886, when that was placed upon the register, it would have conveyed to the mind of an ordinary Englishman any idea involving any connection with 'bos' or 'bovis' or with 'beef'."

I would also refer to *In re Densham's Trade-Mark* (1).

Counsel for the plaintiff asked to amend by praying that the defendants' trade-mark "Fruit-I-Nol" be expunged from the register. This request I will not grant, but such refusal will be without prejudice to any further proceeding for that purpose if deemed necessary. See the judgment of Swinfen-Eady in *Coleman & Co. Ltd. v. Stephen Smith & Co. Ltd.*, (2) which case, it might be noted, is also instructive upon the point as to the "get up" used with a trade-mark.

The plaintiff is entitled to an injunction in the usual form, and an order that the defendant's cartons be destroyed. Counsel for plaintiffs abandoned at trial any claim for damages. The defendants must pay the plaintiff's cost of action, including the costs of the examination for discovery.

Judgment accordingly.

Solicitors for Plaintiff: *McCraken, Henderson, Greene and Herridge.*

Solicitors for Defendant: *A. Lemieux.*

EDITOR'S NOTE.—See the recent English case of Re *Applications of La Société Le Ferment* (28 T. L. R. 490) where the word *Lactobacilline* was allowed to be registered as a trade-mark in connection with a preparation partaking of the nature of sour milk.

(1) (1895) 2 Cd. D. 176.

(2) 27 T. L. R. 533.