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sur lui, qui déplace la responsabilité du patron habituel et crée celle du patron momentané (Sirey, 1903-1-104). Il n'y a rien de tel dans l'espèce.

J'ajoute que si le jugement était maintenu il deviendrait très dangereux pour un propriétaire d'adresser une demande aux ouvriers de son entrepreneur, même si, comme dans l'espèce, cette demande consistait à exiger l'accomplissement des obligations de l'entrepreneur.

Il est malheureux que l'intimé n'ait pas appelé de la partie du jugement qui a renvoyé son action quant à l'entrepreneur Aubut, car celui-ci seul devait être condamné à l'indemniser. Avec beaucoup de déférence pour les honorables juges de la cour d'appel, je suis d'opinion que le verdict ne peut être soutenu. Il me paraît clair que les jurés n'ont pas compris ce qui, en droit, fait déplacer la responsabilité du patron habituel et crée celle du patron momentané.

Je suis donc d'avis d'accorder l'appel et de renvoyer l'action de l'intimé avec dépens de toutes les cours si l'appelante veut les exiger de l'intimé. Je n'exprime aucune opinion sur la prétention de l'appelante qu'à raison des dispositions de la loi qui la régit elle n'est pas responsable de la faute de ses employés.

Appeal allowed.

Solicitor for the appellant: *Jules Desmarais.*

Solicitors for the respondent: *Meredith, Holden, Hague, Shaughnessy & Heward.*

THE BAYER COMPANY, LIMITED.....APPELLANT;

AND

THE AMERICAN DRUGGISTS' SYNDICATE, LIMITED } RESPONDENT.

IN THE MATTER OF THE TRADE MARK "ASPIRIN"

ON APPEAL FROM THE EXCHEQUER COURT OF CANADA

Trade-Mark—Descriptive term—Mode of selling product—Acquiring distinctiveness—Validity of mark—Validity at registration—Subsequent right of public user—Removal from register—Trade-Mark and Design Act, R.S.C. [1906] c. 71, s. 42.

A trade-mark properly registered cannot be expunged under the provisions of section 42 of the Trade-Mark Act if it ceases to be used as a

*PRESENT:—Idington, Duff, Mignault and Malouin JJ. and Maclean J. *ad hoc.*

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*June 8.

trade-mark and becomes merely descriptive of the article to which it has been applied. The authority to expunge "any entry made without sufficient cause" means without sufficient cause at the time of registration.

Judgment of the Exchequer Court ([1923] Ex. C.R. 65) reversed, Idington and Malouin JJ. dissenting.

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APPEAL from a decision of the Exchequer Court of Canada (1) ordering that the entry of "Aspirin" as a trade-mark be removed from the registry.

In 1899 the Bayer Company of Germany registered in Canada the word "Aspirin" as a trade-mark to be applied to pharmaceutical preparations, and in 1913 assigned all its Canadian trade-marks to the Bayer Company of New York which assignment was registered in Canada in 1919 and the New York company shortly after assigned the trade-mark "Aspirin" and the goodwill and business connected therewith to the appellant Bayer Co., Ltd., of Canada.

The respondent applied to the Exchequer Court to have this trade-mark expunged from the registry and the court so ordered. The main question to be decided on the appeal from the judgment was whether or not the trade-mark, having been valid when registered, could afterwards be expunged because it had lost its distinctive character and become incapable of registration then.

Nesbitt K.C. and *Christopher Robinson K.C.* for the appellant. Aspirin is a distinctive word as describing the compound manufactured by the appellant and after the long period of user all presumptions will favour its validity; moreover if there is doubt the appellant should have the benefit of it, the onus being on respondent to prove that it should not have been registered. See *Wellcome v. Thompson* (2) at pages 749, 750, 757; *In re Cheeseborough's Trade-Mark "Vaseline"* (3) at page 8.

If "Aspirin" was distinctive when registered it cannot be expunged if it ceases to be so. See remarks of Parker J. in *In re Gramophone Company's Application* (4) at page 436.

(1) [1923] Ex. C.R. 65.

(2) [1904] 1 Ch. 736.

(3) [1902] 2 Ch. 1.

(4) [1910] 2 Ch. 423.

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Chipman K.C. and Smart for the respondent. Aspirin was always used as the name of the article, not the product. See *Linoleum Mfg. Co. v. Nairn* (1).

The appellant's product is merely a form of acetyl salicylic acid which has been patented by name in the United States. The patent having expired aspirin as describing the patented article has become *publici juris*. *Linoleum Case* (1). And the same holds where the article is itself *publici juris*; *Leonard & Ellis Trade-Mark v. Wells* (2). And see *Philippart v. Wm. Whiteley, Ltd.* (3).

IDINGTON J. (dissenting).—This is an appeal from the judgment of Mr. Justice Audette of the Exchequer Court of Canada whereby that court directed that the specific trade-mark registered on the 28th April, A.D. 1899, by *Farbenfabriken vormals Friedrich Bayer and Company of Elberfeld, Kingdom of Prussia, Empire of Germany*, in the Department of Agriculture, now the Department of Trade and Commerce, in Register No. 29, Folio 6889, consisting of the word "Aspirin" as applied to the sale of pharmaceutical preparations, should be expunged.

On the hearing of this appeal the argument was allowed to extend beyond the usual limits and indeed gave us every opportunity the evidence affords of understanding the basis of the respective contentions on each side.

I have given the case, since then, much serious consideration, and have come to the conclusion that for the reasons assigned by the learned trial judge this appeal should be dismissed with costs.

I am not disposed to write a treatise on the several subjects presented for consideration, but may be permitted to add to the foregoing a few remarks.

It would have been much more satisfactory to me had proof been adduced that one Bayer, in Germany, had invented "Aspirin," or its mode of production, and then coined this word "Aspirin" (as we have been told was the case) to represent it by way of a registered trade-mark, and if, as is likely, a patent was got in Germany for the invention, and has probably expired, and all that had

(1) 7 Ch. D. 834.

(2) 26 Ch. D. 288.

(3) [1908] 2 Ch. 274.

been proven, such facts would, in all probability, have ended this long-drawn-out story by the application of the law both here and in England as well as in the United States.

By reason of want thereof I do not attach quite as much importance as the learned trial judge does in his reasons so far as founded upon a United States patent brought into this case, and the legal consequences flowing from its expiration.

In many indirect ways, however, that story is very important as showing how others of that early period thought it for their interest to register the word "Aspirin" in Washington, as a trade-mark.

How did he who registered the trade-mark now in question herein allow such a thing to be done?

Why did he not, by a little energy, get the counterpart of the one in question herein registered in Washington, and thereby forestall the Farbenfabriken of Elberfeld Company of New York, who deposited theirs in the Washington office on the 3rd of April, 1899, though only registered on the 2nd of May, 1899.

Meantime the trade mark "Aspirin" was on its way from the German Farbenfabriken Company to be registered in Canada, and got so, on the 28th of April, 1899, as above stated.

Shortly before, on the 1st August, 1898, one Felix Hoffman of Elberfeld, Germany, the home town of the said company which registered the trade-mark in question herein and where it manufactured "Aspirin," was pushing his way to get a patent from the United States for the manufacture of "Acetyl salicylic acid," and got it on the 27th February, 1900, and assigned it to the said Farbenfabriken of Elberfeld Company of New York.

What is the true inside meaning of all these movements?

Was the registration now in question herein but a part of a scheme of the German company to get control of the entire American market, including Canada?

On his examination for discovery Frederick Weiss, the president of the appellant company, testifies as follows:—

Q. What is the nature of the business of the company?—A. The manufacture and sale of Bayer Tablets of Aspirin.

Q. Is that their only business?—A. They are acting as agents for the Winthrop Chemical Company of New York.

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Q. That is the only manufacturing business you carry on?—A. Yes, that is the only manufacturing business we carry on.

Q. You have a plant?—A. Yes.

Q. Where is that?—A. Windsor, Ontario.

Q. How long have you had that plant?—A. Well, you mean how long have we owned the property?

Q. How long have you operated the plant?—A. Since the beginning of the company.

Q. Did the company succeed to the business of any other firm or corporation?—A. No; it was organized.

Mr. Osler: That is rather ambiguous.

Q. Did they succeed to the active manufacturing or selling business of any other company?—A. No.

* * * * *

Q. What line of business were you in previous to that?—A. I was employed by the Sterling Products Inc.

Q. Dealing with a different line of goods?—A. Yes.

Q. And in a different market?—A. In the United States.

Q. Who are the other officers of the Canadian Company at the present time?—A. Mr. William A. Sloan, he is just a director, Mr. B. W. Tobin, he is a director of the company, and he also acts as salesman for the Bayer Company Limited.

Q. Any others?—A. Just the three directors.

Q. What shareholders besides the directors, are in the Bayer Company Ltd.?—A. Just the qualifying shareholders in Canada.

Q. Who owns the stock?—A. The Bayer Company Inc., of New York.

Q. During the last two years you have been carrying on an advertising campaign in Canada with reference to the Bayer Aspirin, have you not?—A. The company has.

Q. The representations contained in the advertisement are the representations which the Bayer Company are making to the public at the present time, and during that campaign?—A. I do not see anything there as being different from the representations made.

* * * * *

Q. That leaflet, Exhibit 3, contains the phrase: "Only tablets with the Bayer Cross are Aspirin—no other"—has that always been on?—A. Yes.

Q. Since when?—A. Ever since we started using the circular.

Q. That was at the beginning of the company two and one-half years ago?—A. Well, I would not say positively that we have been using them that long—we have been using them for quite a while.

Q. Has that phrase: "If it is not Bayer, it is not Aspirin" always been on since you have been president of the company?—A. Yes.

Q. Has this further phrase: "Get genuine Bayer tablets of Aspirin in a Bayer package, plainly marked with a Bayer Cross because the Bayer Cross is your only way of knowing you are getting genuine Aspirin prescribed by physicians for over 19 years, and proved safe by millions," been on this circular since your connection with the company?—A. Since the circular was used.

Q. I observe at the bottom of the circular it refers to the product as Monoasceticacidester of Salicylic acid—can you tell me whether that product is the product described in United States patent 644074 to Felix Hoffman of February 27, 1900—copy of which I shew you? (Exhibit 4).—

A. I am not a chemist, but it is my understanding that it is identical with the Bayer Manufacture.

Q. Who is your chemist?—A. The chemist of the Sterling Products Limited.

Q. Not of the Canadian company?—A. We have no chemist.

Q. Who supervises the manufacture in Canada?—A. Of what?

Q. Of Bayer's Aspirin?—A. Tablets?

Q. Yes?—A. It is manufactured under the druggist or—the registered man is B. W. Tobin.

Exhibit No. 8.—Copy of United States Patent (Hoffman) No. 644077, being said Exhibit No. 4 on examination of Mr. Weiss.

Q. That is the patent which described the process under which Bayer Tablets of Aspirin are made?

Mr. Osler: The Aspirin; not Bayer Tablets. The tablets are the tablet form of the Salicylic Acid which is called Aspirin when manufactured by the Bayer Company as we like to put it.—A. We do not say Bayer Aspirin—we say Bayer Tablets.

And the suspicion is not only strengthened by this evidence as to the identity of the goods patented by Hoffman with those for which protection is now being sought by the use in an advertising campaign of what is practically an amended edition of the registration now in question, which to me seems bordering on fraud.

Is the appellant to be permitted to manufacture in Canada such goods as advertised and pass them off as if manufactured by those who got the registration in the first place?

Nor does the story end there, for later on he testifies as follows:—

Q. Is all your product which you sell in Canada, manufactured in Canada?

Mr. Osler: You mean everything they sell?

Mr. Smart: No; all the Bayer Tablets of Aspirin.—A. Yes.

Q. None of it is purchased from any other firm?—A. No.

Then let us come to the actual wording of the claim for registration and what was done by the claimant thereof and see what, if anything, done thereunder, and goodwill, if any, is assignable.

In specifying, its claim is written thus:—

The Farbenfabriken vormals Freidrich Bayer and Company * * * hereby furnishes a duplicate copy of a specific trade-mark to be applied to the sale of pharmaceutical preparations in accordance with sections 4 and 9 of the "Trade-Mark and Design Act," which mark belongs to the Farbenfabriken vormals Friedrich Bayer & Company, by reason of said company having been the first to make use of the same.

The said specific trade-mark consists of the arbitrary word "Aspirin." This has been generally arranged as shewn in the accompanying facsimile, in which it appears in plain block letters arranged on a horizontal line; but

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other forms or type may be employed, or the word may be differently arranged or coloured.

The manufacturing, if any, was supposed to have been carried on in Germany but it is to be observed that it does not say, as the terms of section 5 of the Act seem to imply it should, in what way applicable

to the manufactured product or article of any description manufactured, produced, compounded, packed or offered for sale by him, etc.

And when we come to consider the assignment by said company to the Bayer Company Inc. of New York on the 12th day of June, 1913, we find appended thereto a list of articles with numbers and dates of which "Aspirin, No. 6889, dated April 28, 1899," appears the fourth in said list.

This seems to me to indicate that the parties concerned do not seem to have understood the meaning of the trade-mark in question as covering all pharmaceutical preparations, as it professes to do. And moreover, that it in truth may have been intended to cover only the goods known as "Aspirin" at the time.

If the latter, then it would seem void *ab initio* as an attempt to forestall all others then dealing in aspirin and hence void.

If it was intended to cover only "aspirin" of its own manufacture, it should have been so designated as section 5 of the Act seems to contemplate and provide, and hence is not protected by the Act.

I make these observations as worthy of consideration, in passing on to the story of the alleged goodwill.

The German company pretending to register something, never carried on business in Canada, either as manufacturers of Aspirin or selling it there.

I asked appellant's counsel and they could only refer to the following evidence of Hargreaves, a witness, who testifies as follows:—

Q. Have you ever at any time met that acetyl salicylic referred to under any other term than the chemical name?—A. Well, yes. We handled aspirin and recognized it was the same composition, the same chemical.

Q. And where did you get your aspirin?—A. We got it first, to the best of my recollection, through John Taylor & Co. At that time they were the Canadian agents for the Bayer people.

His Lordship: For the Bayer people?—A. For the Bayer people—that would be prior to 1905 first.

The only goodwill, if any, that the German company could have to assign was derived from and founded upon orders sent it direct from Canada and filled by it with goods manufactured by it in Germany.

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Can anything therein be a foundation for helping the appellant to acquire the trade-mark of said German company, and use it for goods not manufactured by it, but by appellant in Canada, of same kind as made by virtue of the Hoffman patent, and common to all the world?

I take it that there must be a goodwill passed to render an assignment of a trade-mark valid.

Section 15 of the Act is pointed to as of so general a character as to entitle the transfer of that which covers nothing—but the decisions cited to us clearly decide otherwise. A collection of those, and many others, appears on page 9 of Sebastian, 5th ed.

Anything done as herein by way of ordering from the German company some of its make of aspirin, would not, I submit, constitute, even if acted on then, such a goodwill in it as to lay a foundation for the assignment of 12th June, 1913, under which alone appellant can claim.

Indeed the privilege would exist in common with all others in the appellant to enable it to make such orders without such assignments.

That is not what it wants, but to terrorize others from doing likewise and, by virtue thereof, palm off upon the Canadian public its own aspirin manufactured in Canada.

I submit the continuation of a trade-mark for such a purpose is not within the scope of the Act, and seems to me such an improper use of it as to alone justify the expunging of the trade-mark as directed by the judgment complained of.

The appellant seems to desire to register its own mark, as I understand it has done, and cover it up by the trade-mark of another. Surely that involves a clear abandonment of the original claimant.

I am only making the foregoing several suggestions as result of my consideration of a curious case lest some of them may not have been presented at the same angle in the reasons of the learned trial judge, adopted as above.

DUFF J.—This is an appeal from a judgment of Audette J., in proceedings commenced by the respondent, the

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American Druggists' Syndicate, Limited, by a petition praying for an order expunging from the register of trade-marks the trade-mark "Aspirin," of which the appellant, the Bayer Company, Limited, is the registered owner. This trade-mark was registered on the 28th April, 1899, as a specific trade-mark on the application of Farbenfabriken vorm. Fried. Bayer & Co., which may be referred to as the Bayer Company of Germany, under which the applicant asked for the registration of a specific trade-mark, consisting of the arbitrary word "Aspirin," to be applied to the sale of pharmaceutical preparations. The Bayer Company was engaged in a large way in the business of manufacturing dyes and chemicals at Elberfeld and Leverkusen, in Germany. It and its successors entitled to the Canadian trade-mark have used the mark almost entirely in connection with a preparation made and sold by many others, a chemical compound of which the name is acetyl salicylic acid. On the 12th June, 1913, the Bayer Company of Germany assigned its Canadian trade-marks and the goodwill and business in connection therewith to the Bayer Company, Inc., a corporation incorporated in the State of New York, the trade-marks so assigned including the trade-mark "Aspirin." In October, 1914, an application was made for the registration of this assignment, but the assignment was not then registered, and by arrangement was retained by the Department of Agriculture for action after the termination of the war. On the 12th December, 1918, the Alien Property Custodian of the United States sold all the issued capital stock of the Bayer Company, Inc., to the Sterling Products, Inc., an American corporation. On the 26th March, 1919, the assignment from the Bayer Company, Inc., was registered in the Canadian Trade-Mark office. In May, 1919, the appellant, the Bayer Company, Limited, was incorporated as a Dominion company, and the whole of the issued capital stock of the company is owned by the Bayer Company, Inc. On the 30th May, 1919, the Bayer Company, Inc., assigned to the appellant the Canadian trade-mark "Aspirin" and all the goodwill and business in connection therewith; and on the 31st May, 1919, this assignment was recorded in the Canadian register. In the United Kingdom the Bayer Company of Germany ob-

tained, on the 22nd October, 1899, registration of the word "Aspirin" as a trade-mark. In the United States, the Farbenfabriken of Elberfeld, a company incorporated in the State of New York, applied on the 3rd April, 1899, and obtained on the 2nd May, 1899, the registration of the word "Aspirin" as a trade-mark under the provisions of the United States Trade-Mark Act. On the 1st August, 1898, Felix Hoffman applied in the United States for a patent for acetyl salicylic acid of which he had invented, as he stated in his specification, a new and a useful improvement. This patent was issued on the 22nd February, 1900, to the Farbenfabriken of Elberfeld of New York, to which Hoffman had previously assigned his rights.

Acetyl salicylic acid does not appear to have been manufactured in a commercial way until the year 1899. Early in that year the commercial manufacture of the product appears to have begun, the Bayer Company of Germany being one of the earliest of the manufacturers. The article first appeared in Canada in the form of a powder or crystals; later it was sold in the form of compressed tablets; and in recent years its use in the latter form has far exceeded its use in the form of a powder. For many years it was used either as powder or in tablet form in dispensing medical prescriptions, but after the appearance of the article in tablet form a trade which is described by the witness as "over the counter trade" began; the customers, that is to say, began to prescribe for themselves and to buy from the druggist without a physician's prescription. The evidence shows that various words have been coined and used as trade names to distinguish a particular manufacture of acetyl salicylic acid; Burroughs Wellcome Co., for example, using the word "Empirin," having formerly used the word "Xaxa"; Charles E. Frosst & Co., the word "Acetophen"; the National Drug Company, "Seetosal"; Henry Wampole & Co., "Ceteloyd."

In 1915, the Board of Trade cancelled the registration of the trade-mark "Aspirin" in the United Kingdom as from the 22nd December, 1914, under the provisions of special war legislation; and on the 27th February, 1917, Hoffman's patent expired. Thereafter the word "Aspirin" came to be used freely by English and American manufacturers as designating acetyl salicylic acid. On the

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8th March, 1919, the registration in the United States of the trade-mark "Aspirin" was cancelled by the United States Commissioner. After the termination of the war, upon the registration in 1919 of the assignment to the appellant, the appellant began to advertise extensively the sale of acetyl salicylic acid on the Canadian market under the trade name "Aspirin" and to assert its rights to the exclusive use of that name as a trade name.

Audette J. gave judgment in favour of the respondents, expunging the trade-mark. He identified the German Bayer Company, the predecessor of the appellant, with the American company, who became proprietors of the Hoffmann patent, and took the view that from its origin the word "Aspirin" had by the Bayers been applied to designate the product protected by the Hoffman patent. The trade, he said, and the public, as a consequence of the issue of the patent, treated the word "Aspirin" as a word descriptive of acetyl salicylic acid, a word which he thought had become a common English word. In his view, this was the state of facts at the time of the application of the appellant's predecessors in Canada; and consequently the word "Aspirin" was incapable of being registered as a trade-mark. "No man can get a monopoly of the English language," he says.

He also held that the case came within the principle that the word, having been applied by the owner of a patent to designate the product protected by the patent, and the name having thus become descriptive of the thing, everybody in Canada and the United States and elsewhere became entitled in point of law, upon the expiration of the patent, to employ the word to designate the substance. Further, the learned trial judge took the view that the evidence sufficiently established an intention on part of the appellant to abandon "Aspirin" as a trade-mark.

The Trade-Marks Act provides for a register of trade-marks. Sec. 5 describes "trade-mark" for the purposes of the Act, and is in these words:—

5. 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.

The applicant for registration must declare that the trade-mark

was not in use to his knowledge by any other person than himself at the time of his adoption of it. By sec. 11, the Minister may refuse to register a trade-mark on certain specified grounds, the only material ones being, first, if he is not satisfied that the applicant is undoubtedly entitled to the exclusive use of such trade-mark; and secondly, if the so-called trade-mark does not contain the essentials necessary to constitute a "trade-mark properly speaking." By sec. 13, the applicant, on complying with the provisions of the Act, may

have such trade-mark registered for his own exclusive use.

By the same section it is provided that upon registration the

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

By sec. 17, a specific trade-mark, when registered, is to endure for the term of twenty-five years, but is renewable from time to time for the like term. By sec. 19, a right of action is given to the proprietor against any person who "uses the registered trade-mark of such proprietor" or who sells any article bearing the trade-mark; and by sec. 20 it is provided that nobody shall institute any proceedings to prevent the infringement of any trade-mark unless such trade-mark is registered in pursuance of the Act. It is sufficiently clear that a trade-mark, in order to be registrable under the Act, must be something which the applicant is entitled to adopt as distinguishing the articles to which it is applied as his own; and it was not disputed on argument that the trial judge was entirely right in assuming that words merely descriptive at the time of the application could not properly be registered as a trade-mark. Adoption by the applicant for the purpose of distinguishing his goods is the ruling condition. There must, moreover, be adoption for use as a distinguishing mark implying a present *bona fide* intention to use the mark for such purposes; and indeed the affidavit in the form prescribed by the rules could hardly be made by an applicant who has not, in however limited a degree, actually made use

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of the mark in respect of which the application is made. If the learned trial judge has correctly appreciated the effect of the evidence adduced in holding that the respondents have established that the word "Aspirin" at the time of the application had been given to the world by the applicant as exclusively descriptive of the article and that at that date the word was in fact a word in common use as such, then he was indubitably right in his conclusion that the entry ought to be expunged as having been made without sufficient cause.

In considering this question it is not a little important to remember that the onus is upon the respondents. Many decisions might be cited in support of this, but it will be sufficient to mention two: *Cheeseboro's Case* (1); *Wellcome v. Thomson* (2). It is for the respondents to establish to the satisfaction of the tribunal of fact that for the reasons relied upon the trade-mark was registered "without sufficient cause"; that is to say, it is for the respondents to show that "Aspirin" had not been adopted as a distinctive name in the relevant sense, but was a descriptive name in current use designating the compound to which the appellants seek to apply it as a trade name. If, as Stirling L.J., says in the case last cited, any doubt exists, the doubt must be resolved in favour of the trade-mark. The respondents have not, I think, acquitted themselves of this onus.

The evidence bearing directly on the state of affairs in 1899 is, as might be expected, very meagre, but there is a mass of evidence derived from the practice of the trade from 1900 or 1902 to 1915, and from medical and pharmaceutical literature published during that period, and from this evidence I draw the conclusion that during that period, to the medical profession, to the wholesale dealers and to manufacturers, "Aspirin" was known as a trade name for acetyl salicylic acid, and a trade name owned by the Bayers. There is a good deal of ground, no doubt, for the contention that during the later part of the same period "Aspirin" in a loose way was often used as designating the product itself; but nevertheless I think the evidence does

(1) [1902] 2 Ch. 1 at pages 8 and 9. (2) [1904] 1 Ch. 736 at page 757.

establish the proposition that during this period, among the classes of persons I have mentioned, "Aspirin" was always known to be, and was recognized as, the trade name of the Bayers.

Important evidence is given by wholesale dealers to the effect that Bayers' product, and Bayers' product only, was sold by them under the name of "Aspirin," down to the time when, during the war, the stock of Bayers' product became exhausted. In their price lists, acetyl salicylic acid was listed at one price and "Aspirin" at another price, the price of "Aspirin" being very much greater, some of the witnesses say four or five times as great, as the price of acetyl salicylic acid. The evidence of Mr. Grant, the Canadian manager of Parke, Davis & Company, and of Mr. Lang, the Canadian manager of Burroughs Wellcome, should be mentioned specially. Parke, Davis & Company did not manufacture acetyl salicylic acid in Canada. They acquired the compound from various sources and compressed it into tablets for the retail trade. It was first bought under the name of "Aspirin" in 1906 from the Bayer Company of Germany, and in 1908 acetyl salicylic acid was bought under that name. Down to 1916, when the stock of the Bayer product became exhausted, they listed in their price lists "Aspirin" and acetyl salicylic acid. Since then they have listed only acetyl salicylic acid. Mr. Grant says that "Aspirin" was recognized as the trade name of the Bayers and scrupulously respected as such. Out of 45,000,000 tablets compressed by them for the Canadian market, only 6,000,000 have been composed of the Bayer product. These have been listed and sold as "Aspirin," the remainder being listed and sold as acetyl salicylic acid, at a much lower price. Mr. Lang says that Burroughs Wellcome Co. from 1906 have listed and sold in Canada tabloid aspirin. These tablets were made exclusively from the Bayer product of acetyl salicylic acid. They sold acetyl salicylic acid during the same period in tabloid form under their own trade name, "Xaxa." Since 1915 they have struck Aspirin from their price list, and replaced it by their own manufacture of acetyl salicylic acid, under a trade name of their own, "Empirin." Other witnesses are quite explicit in the same sense. These witnesses agree

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that the distinction was well recognized in the trade, as indeed it could hardly fail to be, having regard to the difference in price.

The respondents rely chiefly upon the evidence of retail dealers, some of whom say that aspirin and acetyl salicylic acid were used convertibly; that they were accustomed to order acetyl salicylic acid from the wholesalers and get it under the name "Aspirin"; that when aspirin was prescribed, acetyl salicylic acid was used to fill the prescription. They also say that in the "over the counter trade," from about 1908 onwards, customers did not distinguish between aspirin and other products. This, however, must be observed, the evidence given by the wholesale dealers referred to shows that when aspirin was ordered from them, aspirin and aspirin only was supplied except in the few cases where it was plain that what was really wanted was acetyl salicylic acid, and not necessarily aspirin. With hardly an exception, the wholesale dealers who gave evidence say that they did not sell acetyl salicylic acid, other than the Bayer product, under the name of aspirin. Moreover, all of the retail dealers but one purchased from Parke, Davis & Co., and had Parke, Davis & Co's. price lists, and must have known that aspirin was sold at a much higher price than other manufactures of acetyl salicylic acid. The practice of the other large dealers was similar. It is highly improbable, if, indeed, it is at all credible, that a dealer to whom the distinction between aspirin and acetyl salicylic acid was of no importance would knowingly order aspirin and pay the higher price for it, or that the distinction was not perfectly well understood by the retail dealers, as well as the wholesale dealers. Moreover, the price lists filed show in nearly half of them aspirin distinguished from acetyl salicylic acid, with widely differing prices. In the others, aspirin alone is given, but at prices which, when compared with the others, suggest, in a large number of these, that it is the Bayer product which is indicated. As to prescriptions, a majority of prescription druggists undoubtedly do say that they used the product of any manufacturer to fill a prescription. About one-third of them, however, declare that they used the Bayer product so long as it was available. Most of the retailers say that their first knowledge of acetyl salicylic acid was of the Bayer pro-

duct, which they received in one-ounce packages of powder, marked "Bayer & Co.," and "Aspirin." Many of these witnesses say that very shortly afterwards, almost simultaneously, they acquired a knowledge of other manufactures of acetyl salicylic acid, while the remainder, with two or three exceptions, say that they acquired that knowledge from two to three years afterwards. There is another observation which must be made with regard to the evidence of these witnesses: It is quite plain that a marked change took place after the commencement of the war, and especially after the cancellation of the British trade-mark and the expiry of the Hoffman patent. From that time on, in England and the United States, as well as in Canada, the free use of the word "Aspirin" no doubt greatly expanded; in Canada the German company was still the registered owner of the trade-mark and could not, of course, maintain during the war an action for infringement; and all the witnesses were speaking under impressions derived from the experiences of the preceding five to eight years. Allowance must be made for this; indeed, all the evidence of these witnesses must be read in light of it. Even then it should be observed that one of the respondents' witnesses, Henry Willis, who has been in business for twenty-two years in Quebec and is one of the Board of Commissioners of the Pharmaceutical Society, says that every druggist knows that "Aspirin" is only a trade name or coined name, applied to acetyl salicylic acid. The conclusion which I draw from the evidence given from the practice of the wholesale dealers, the book of publications and the price lists, is, as I have stated above, that "Aspirin" was understood to be a distinctive name for the Bayer product; that other producers recognized it as such, and adopted their own distinctive names; that, generally, the distinction must have been known to the medical profession. In the early years, that is to say before 1908, it must also, I think, have been recognized by the retail dealers. Although there is some disagreement, there is a preponderance of evidence by such dealers pointing to the year 1900 as marking the beginning of the period when acetyl salicylic acid began to be widely known to the trade in Canada. As I have said, these witnesses usually say that it was through the Bayer

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product, and under the name "Aspirin," that acetyl salicylic acid was first brought to their attention.

As already observed, the onus is upon the appellants to establish their contention that at the date of registration, in the year 1899, "Aspirin" was a term descriptive of the compound acetyl salicylic acid, and as such, incapable of being registered as a trade-mark. The general recognition of the name as the trade name of the Bayers by the classes of persons specially interested in the subject over a considerable period of years beginning soon after registration, coupled with the lapse of time, greatly augments the weight of the presumption which the respondents must overcome.

There is some evidence that acetyl salicylic acid was imported from Switzerland under the name "Aspirin," but the source of production is not identified, and the evidence as to date is very vague and unreliable. Two witnesses mentioned the year 1898 as the year of their first acquaintance with the word "Aspirin" as designating a.s.a. The testimony of these witnesses is most unsatisfactory, and there is not a scrap of documentary or other evidence to support their recollection. The only label of the earlier years which is connected with a European product other than Bayers' is one of the year 1904, a label for the product of a Swiss firm in Bâsle; and on it the word "Aspirin" does not appear. Generally it may be said, as to the evidence by retail witnesses who speak of sales of acetyl salicylic acid, other than the Bayer product, under the name "Aspirin," that besides the difficulty of drawing anything like a confident conclusion as to dates, there was the circumstance that few of the witnesses saw the drug so labelled in the original package, and the original source of supply is consequently left in doubt. The evidence is altogether too vague and unsatisfactory to form the basis of a judicial decision that the respondents have established the use of the name as a descriptive name prior to registration in 1899 or have established that the appellants' predecessors were not the first to adopt and use "Aspirin" as a trade name.

In deciding that, at the time of the application the name "Aspirin" was descriptive of the thing in such a way as to exclude distinctiveness in the pertinent sense, the learned judge bases his view mainly upon the Hoff-

man patent. The fact that the patent having been granted in the year in which application for the Canadian trademark was made, appears to the learned judge to be conclusive against the appellants in two ways: First, as establishing conclusively the fact that the name "Aspirin" was at the date of the application descriptive of the drug in such a way as to exclude distinctiveness; and secondly, as bringing into operation a supposed rule of law that in such circumstances the appellant is in point of law precluded from asserting proprietorship of the name.

Neither in the application for the Hoffman patent nor in the specification is there any reference to the word "Aspirin." The patent is a patent for acetyl salicylic acid. Even in the United States, the territory in which the patent ran, I do not think it would have been theoretically impossible for the patentee to assert and maintain his right to the exclusive use of "Aspirin" as a trade name. The practical difficulty, of course, might have been insuperable, but if they could have succeeded in controlling the use of the word "Aspirin" and the signification attached to it by the public generally in such a way that, while signifying acetyl salicylic acid, it at the same time connoted the fact that it was made by the patentee—in other words, if he had succeeded in controlling the use of the word in such a way that in the minds of people seeing the word, it denoted acetyl salicylic acid, made by them—I do not know why, at the expiration of the patent, he should not be still entitled to say that this word was his word. Parker J., said in *Burberry v. Cording & Co.* (1)

I do not agree with the argument that a word cannot be at the same time both descriptive and distinctive.

If "Aspirin" had been the only word which could be used for the purpose of denoting the patented article, the respondents' contention might have been well-nigh unanswerable. But here we are confronted by a very different state of facts. Both in the application and in the specification, the name given to the patented compound is "acetyl salicylic acid," and the word "Aspirin" nowhere appears. During the currency of the patent, as already observed, "acetyl salicylic acid" was constantly used as descriptive of the

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article. In the British Pharmacopœia, for example, aspirin is not mentioned. In the Encyclopædia Britannica (1911), aspirin is only mentioned as one of a number of trade names; and where, as here, the patent runs in a limited territory, and that a foreign territory, while the article is an article known the world over by a designation other than the alleged trade name, the argument relied on seems to have little cogency.

In the *Vaseline Case* (1) which apparently did not attract the attention of the learned trial judge at all, there was a patent in the United States, and during the life of it the patented product was produced in England, not only by the owner of the patent, who sold it under the name of "Vaseline," which he had given to it in his American patent, but by others, and it was sold under different names; and it was held that the name was not incapable of being owned as a trade name. By Cozens Hardy L.J., as well as by the other Lords Justices, the question whether or not "Vaseline" had become the name of the article in such a way as to exclude the possibility of using it distinctively as the product of the manufacturer, and whether the manufacturer, by attaching it to the patented article in his specification, had precluded himself from claiming a title to it as a trade name, were treated as questions of fact. Whether on the facts that case was rightly or wrongly decided is of very little importance here. It is conclusive against the contention that, by virtue of the fact alone that the appellant's predecessors had patented the article in the United States, the appellant is precluded from claiming the exclusive right to use the word here as a distinctive name.

I turn now to the important question of the authority of the Exchequer Court under section 42 of the Trade-Marks Act, which is as follows:

42. The Exchequer Court of Canada may, on the information of the Attorney General, or at the suit of any person aggrieved by any omission, without sufficient cause, to make any entry in the register of trade-marks or in the register of industrial designs, or by any entry made without sufficient cause in any such register, make such order for making, expunging or varying any entry in any such register as the court thinks fit; or the court may refuse the application.

2. In either case, the court may make such order with respect to the costs of the proceedings as the court thinks fit.

3. The court may in any proceedings under this section, decide any question that may be necessary or expedient to decide for the rectification of any such register.

The authority to expunge entries in the register arises from this section, and from this section alone; and in order to bring a case within the section it must, it would appear, rest upon the allegation that the entry sought to be expunged is an "entry made without sufficient cause." On behalf of the appellants it is contended that the jurisdiction arises only when it appears that the entry was one which, on the facts existing at the time it was made, can be held to have been made without sufficient cause. On behalf of the respondents it is contended, and the learned trial judge has held, that although a trade-mark has been properly registered if, after the registration, a state of facts comes into existence and it can truly be said that, on that state of facts, the trade-mark is one which ought not to be on the register, then there is jurisdiction to expunge it under this section. The learned trial judge relies upon some observations of Lindley M.R., in a case of *In re Batt & Co.* (1). In that case Romer J., before whom the application came in the first instance, found as a fact that the trade-mark in dispute had been placed upon the register by a person who had in fact no intention to use it as a trade-mark at all; and on the principle that it is a condition of the right to register a trade-mark that there should be a user in fact or a *bona fide* intention to use the trade-mark as such, he held that the trade-mark had not been properly registered, and that the entry ought therefore to be expunged. This was decided upon the authority of *Edwards v. Dennis* (2). In the Court of Appeal Romer J's. findings on the facts were affirmed and his judgment was upheld on the principle just mentioned. The Master of the Rolls, however, speaking for the court, dealing with sec. 90 of the English Act of 1883, which corresponds in all pertinent respects with sec. 42 of the Canadian Act, said that the court was not disposed to put a narrow construction on the expression, "entry made without sufficient cause in the register," nor to read it as if the word "made" were the all-important word, and as if the words, "made without sufficient cause,"

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were, "made without sufficient cause at the time of registration," so as to be confined to that precise time. He added:

If any entry is at that time on the register without sufficient cause, however it got there, it ought, in our opinion, to be treated as covered by the words of the section. The continuance there can answer no legitimate purpose; its existence is purely baneful to trade, and in our opinion in the case supposed, the court has power to expunge or vary it.

This is, of course, a very weighty opinion, and it was unquestionably one of the grounds of the decision, but there was an appeal to the House of Lords, and on that appeal, while the judgment was affirmed upon the ground on which the judgment of Romer J., was based, it is a fair conclusion I think, from the language of Lord Halsbury, that their lordships were by no means convinced that the principle laid down in the passage cited above from the judgment of the Court of Appeal was one which ought to have the assent of their lordships. The learned trial judge is evidently under a misapprehension as to what occurred in the House of Lords, because he states or implies that the passage in the judgment of the Master of the Rolls which I have epitomized was approved by the Lord Chancellor and the Law Lords.

In England, by the Trade-Marks Act of 1905, specific authority was given to the court on the application of any aggrieved person to remove a registered trade-mark from the register on the ground that it was registered by the proprietor or his predecessor without any *bona fide* intention to use it, and there is in fact no *bona fide* use of it in the goods in respect to which it has been registered, or on the ground that there has been no *bona fide* use of any such connection within five years immediately preceding the application. And there is general authority to remove any entry wrongfully remaining on the register. This legislation, it will be observed, (in a limited degree only) applies the principle laid down by Lindley M.R., in the passage quoted above. But I have been unable to discover any satisfactory evidence that the views expressed by the Master of the Rolls in *Batt's Case* (1) have been accepted as enunciating a rule which can be derived from a proper interpretation of the statute law as it stood under the Act of 1883. In the fifth edition of Kerly on Trade-Marks it is stated, at p. 344, that

(1) [1898] 2 Ch. 432.

no order was made, it is believed, under the earlier Acts, for the removal of a trade-mark originally rightly registered,

and there appears to be a concurrence of rather weighty opinion that on an application under the Act of 1883 to remove a mark from the register, the question whether the mark was entitled to registration must be decided as at the date when registration was effected. Sebastian on Trade-Marks, p. 634; *Wood v. Lambert* (1); *Barlow & Jones v. Johnson & Co.* (2); *In re Appolinaris Co.* (3); *In re Bovril T.M.* (4); *In re Burroughs Wellcome Co.* (5). Whatever be the rule in other cases, particularly in cases of non-user—that is to say, where there has not been any user or where there has been no user in connection with the goods in respect of which the mark is registered—it seems clear that loss of distinctiveness because of the trade-mark becoming descriptive after registration, by reason of causes arising in the ordinary course of trade, is not a ground for rectifying the register under sec. 42.

There are some observations of Lord Parker, then Mr. Justice Parker, which may properly be read in this connection: First, I refer to his judgment in *Philippart v. Whiteley* (6):

Under the principles of law applicable to trade-marks before any legislation on the subject, no mark was protected unless at the time of the alleged infringement it was being used for the purpose of distinguishing, and did distinguish, the goods of the owner from the goods of other people. By reason of the difficulty, if not the impossibility, of taking a mark off the register when once it has been properly put on under the Acts, it became possible for a trader to cease using his registered mark for its legitimate purpose as a trade-mark without losing the benefit of his registration. Indeed, if he could identify his mark in the public mind with the article sold, it was to his advantage so to do, for he could thus, by preventing the sale of the article under the name by which it was known to the public, obtain a practical monopoly. I am inclined to think that the Act of 1905 has in part provided a remedy for this indirect result of trade-mark legislation. For by virtue of the definition clause a registrable mark must, at the date of the application for registration, if not used at any rate be intended to be used for the purpose for which alone, prior to the Acts, the courts would have given a mark protection; and on the principle of *In re Batt & Co's. Trade-Marks* (7), the intention of the application for registration may be gathered from his subsequent conduct;

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(1) 32 Ch. D. 247.

(2) 7 Cut. P.R. 395, 400.

(3) [1891] 2 Ch. 186 at page 230.

(4) [1896] 2 Ch. 600.

(5) [1904] 1 Ch. 736.

(6) [1908] 2 Ch. 274 at pp. 285-6.

(7) [1898] 2 Ch. 432.

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and again it may be that s. 37 will be construed as enabling the courts to remove a mark which has ceased to be used, or has never been used, for the legitimate purposes of a trade-mark.

Then, in *The Gramophone Company's application* (1) there is this passage:—

None of the trade-marks Acts have provided machinery for taking a mark off the register if once it has been properly put on, and it is quite unnecessary in an action for infringement of a registered mark to prove that such mark still remains distinctive of the goods of the registered proprietor. It may, therefore, be to the interest of the registered proprietor of a word mark that the word should lose its distinctiveness so far as the public are concerned and become the popular name for the article. He thus obtains a practical and perpetual monopoly of the article itself, other manufacturers being precluded by the mark on the register from selling their goods under the name by which they are commonly known. To induce the public to adopt a catching word as the name of the article to which it is applied, especially if the article be comparatively new, it is only necessary to advertise the article on a sufficiently large scale under that name, and this can be done by any rich corporation. Such a procedure would, or might, have been fatal to any remedy based upon common law rights, but does not affect the value of a registered mark the distinctiveness of which is assumed and need never be proved. Indeed, no evidence to prove that a registered mark was no longer distinctive would be in any way relevant. The old action for infringement of a common law trade-mark was based only on the duty of the court to prevent fraud and deceit, and the loss of distinctiveness was, therefore, fatal to its success. It is, however, one thing to put a word mark on the register and then proceed to induce the public to use it as the name of the article to which it is applied, and quite another thing to adopt a word already used to denote a particular article, and then proceed to identify it among the trade with the goods of a particular manufacturer, relying on such identification as a reason for registration.

And again, on p. 437, he observes that a registered trade-mark cannot be taken off the register, though it has ceased to be used for the legitimate purpose of a trade-mark and has become merely the name of an article.

In *Burberry v. J. C. Cording Co.* (2), Lord Parker (then Parker J.) reverts to the subject in these words:—

With the example before them of a foreigner who, by the judicious choosing of a likely word, the word "vaseline," by registering it under the Trade-Marks Act, and by subsequently advertising and using it as the name of the preparation from petroleum to which it was applied, has secured a practical monopoly in that preparation in the United Kingdom, it is not unlikely that the ingenuity of manufacturers or traders should be devoted to devising a similar mode of procedure in the case of their own goods, for a monopoly thus obtained may be more valuable than any patent. It is well to remember, however, that apart from registration under the Acts, this mode of procedure may have its own disadvantages. Apart from those Acts, it is dangerous for a trader to allow the word he

(1) [1910] 2 Ch. 423 at pp. 436-7. (2) 26 Cut. P. R. 693 at p. 708.

chooses to become the popular name of the article to which it is applied, and it is dangerous to choose a descriptive word. If the word is descriptive or becomes the name of the article, it will be difficult, if not impossible, to prove that it is distinctive of his own goods or that there will be any deception in its use by others, and apart from the Trade-Marks Acts, the right of any one to the exclusive use of a word is always limited by the possibilities of its use by others without any risk of deception.

My conclusion is that *Batt's Case* (1) has not been considered an authority for the proposition for which it is cited, and having regard to what occurred in the House of Lords, I think we are not strictly bound by it. *Hack v. The London and Provident Building Society* (2).

On behalf of the respondent it is suggested that the rights of the respondent are not limited by the language of sec. 42. Sec. 23 of the Exchequer Court Act is invoked. It is argued that the effect of this section is to give an unlimited discretion to the court to correct the register. The section itself does not profess to deal with substantive law; it is an enactment conferring jurisdiction; and the rule by which the court is to be guided in exercising its jurisdiction is, in cases such as that now before us, to be found in sec. 42 of the Trade-Marks Act. The proceeding is a statutory proceeding, and the right of the respondent is a special statutory right, and the conditions of the right must be sought in the terms of the enactment out of which it arises.

What I have said has an important bearing upon the only remaining contention I think it necessary to discuss, that, namely, the respondent was entitled to succeed on the ground that the registered trade-mark had been abandoned; first, because for many years, to the knowledge, and inferentially with the acquiescence of the appellant's predecessors, the name "Aspirin" had been used by the druggists and the public as descriptive of the drug acetyl salicylic acid without any connotation connecting it with the proprietors of the trade-mark as producers or sellers; secondly, because of various dealings with the trade-mark since 1913 and public advertising by the respondents since 1919, and because of the action of the respondents in obtaining certain trade-marks in the year 1920.

With respect to all these contentions there is, I think, the insuperable objection that sec. 42 of the Trade-Marks

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(1) [1898] 2 Ch. 432.

(2) 23 Ch. D. 103 at p. 112.

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Act confers no authority to give effect to them in a proceeding for expunging an entry in the register. I will not repeat what I have already said, but it is proper to observe that *Bowden Wire Co. v. Bowden Drake Co.* (1), a decision upon which the respondents largely rely, appears to have proceeded upon the authority given by sec. 35 of the Act of 1905; an authority which, as already mentioned, is much more comprehensive than that under sec. 42. In the Court of Appeal (2) Lord Sumner (then Hamilton L.J.) emphasizes the circumstance that the application is an application under sec. 35, a circumstance which is also mentioned in the argument of Sir Alfred Cripps, at p. 586.

The first argument advanced by the respondents in support of their theory of abandonment is, I think, completely answered by what I have already said. The observations of Parker J., in the cases above cited, are sufficient to refute any suggestion that the fact that the name "Aspirin" became in the minds of the general public descriptive is in itself satisfactory evidence of an intention to abandon the trade-mark. And these observations, moreover, establish, in my opinion, that in the existing state of law the facts relied upon cannot constitute a proper ground for expunging the trade-mark from the register.

As to the second contention, it has already been observed that the assignment from the German company to the New York company was only registered in 1919. During the whole of the period of the war the German company was the registered proprietor of the trade-mark and, as mentioned above, obviously during that period could not have maintained an action for infringement. In point of fact, therefore, there would appear to be, to put it at the lowest, a great deal of difficulty in inferring from the free use of "Aspirin," which no doubt did occur during that period as a name descriptive of acetyl salicylic acid, any intention on the part of the proprietors of the trade-mark to abandon their rights. The learned trial judge observes upon the fact that during this time the proprietor was an American company which refused to furnish aspirin; but in the absence of some evidence as to the real owners of the

(1) 31 Cut. P.R. 385.

(2) 30 Cut P.R. 580 at p. 594.

business of this company that circumstance can be regarded as of very little significance; and it is to be noted in this connection that, as above mentioned, in December, 1918, the Alien Property Custodian of the United States sold the shares of the New York company. Having regard to the order on the subject of industrial property made pursuant to the Treaty of Peace in 1920, the respondents cannot, I think, gain any advantage from the occurrences during the period of the war relied upon by the learned trial judge.

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Then it is argued that the assignment to the New York company in 1913, and again the assignment to the Canadian company in 1920, had the effect of separating the ownership of the trade-mark from the ownership of the goodwill which, on the principle of *Bowden's Case* (1), gives, it is said, a right to require the cancellation of the trade-mark. I have already mentioned that this case proceeded on the authority given by sec. 35 of the Act of 1905. Then the principle of *Bowden's Case* (1) is, that under that section the registered proprietor of a trade-mark who, representing to the public by registering the mark and retaining it on the register, that the goods bearing the mark are goods manufactured and sold by him, and who does nevertheless enter into an arrangement by which he precludes himself from using the mark to distinguish his own goods, while authorizing another to use it for distinguishing his manufacture, is thereby wrongfully misusing the rights conferred upon him by the Act, and his trade-mark may be expunged as one which is wrongfully remaining on the register. In the House of Lords the principle is affirmed. The gist of the offence was, as Lord Loreburn says:—

It is enough that they, the registered proprietors, enabled or allowed people who were not registered for it to use the trade-mark on a substantial scale for their make of a description of goods dealt with habitually in the same class of business.

The speeches of the Law Lords are to the same effect. I think there is no evidence to support a conclusion that any such offence has been committed by the appellants or their predecessors. It is entirely consistent with any evidence in the record that the New York Company and the German company were under a common control at the time

(1) 31 Cut. P. R. 385.

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of the assignment in 1913. There is no evidence that in the commercial sense there was any separation of the proprietorship of the trade-mark from the ownership of the business, including the goodwill of the business. The sale of the shares of the New York company by the Alien Property Custodian cannot, I think, affect the matter. The whole of the business and assets of the New York company, including its goodwill and trade-marks, came under the control of the purchaser of the shares. There is nothing to show that production was not carried on in New York. Nor, again, can we on the evidence attach any importance to the assignment in 1920 to the Canadian company. The shares of the Canadian company were owned by the New York company. There was common control of the New York company and the Canadian company, and again, in substance, no such severance as that struck at by the decision in *Bowden's Case* (1) and the cases which preceded it.

As to the conduct of the appellants in 1919 and 1920, which establishes, in the opinion of the learned trial judge, an intention to abandon their rights, his view can best be gathered from one or two paragraphs of his judgment, which I quote:—

Looking into this literature and advertising campaign of the objecting party, the new Canadian company, one is primarily struck with the total absence of the word "Aspirin" appearing by itself. Numerous samples of such advertising have been produced as Exhibit No. 19, and from the perusal of this very literature is found an admission of the general existence of the drug "Aspirin" as distinct from the "Aspirin" that is being sold by the objecting party.

Taken at random, one finds one sample stating: "There is only one genuine 'Aspirin'"—and that genuine Aspirin has Bayer cross and that indeed is accompanied by a label showing a round tablet with the word BAYER written perpendicularly and horizontally within the circle. There can only be one meaning resulting from such language, and that is there exists some other "Aspirin" besides the one sold by us with our trade-mark of the Bayer cross, and that these advertisements claim that the "Aspirin" manufactured and sold by Bayer is better and preferable, from their own standpoint, from the other "Aspirin" on the market, manufactured or sold by anybody else.

And these samples which are numerous and varied but all to the same effect, are in the aggregate a distinct and definite manifestation of the real and intentional abandonment of the use of the word "Aspirin" alone and by itself, as registered, and further, a declaration or notice to the public that in future they intend to use the word as the name of the drug but

with their own name attached thereto to show it has been manufactured by them.

This intention is further manifested in a tangible and open manner by, I may say, the objecting party in 1919. Indeed, on the 8th August, 1919, the Bayer Co., Inc., of New York, registered two new trade-marks: one registered in Register No. 105, folio 24895 (Exhibit No. 96), and the other in the same register but under folio No. 24896 (Exhibit No. 95). These trade-marks also registered by the Bayer Co. of New York in August, 1919, were respectively assigned to the present objecting party, the Bayer Co., Ltd., of the city of Toronto, on the 15th May, 1920.

The trade-mark registered under folio No. 24895 is a specific trade-mark to be applied to the sale of synthetic coal-tar remedies, chemicals, medicines and pharmaceutical preparations of every kind and description, and which consists of the word "BAYER."

The other trade-mark under folio No. 24896 is also a specific trade-mark to be applied to the sale of synthetic coal-tar remedies, chemicals, medicines and pharmaceutical preparations of every kind and description, and which consists of a conjunction of letters in the form of a cross having four arms of equal length, the said letters being "BAYER," arranged horizontally and vertically at right angles in the form of a cross, the letter "Y" forming the centre of such cross.

It is quite significant, indeed, that these two trade-marks should be taken and registered with respect to synthetic coal-tar remedies. Aspirin is a coal-tar drug.

These two new trade-marks can readily be applied to coal-tar drugs, and ever since 1919, by reference to Exhibit No. 19, it will be seen that they were used with the word "Aspirin." The only deduction and inference to be drawn from the fact of getting these two new trade-marks and using them ever since 1919, as shown by Exhibit No. 19, in union and with the trade-mark for the word "Aspirin" alone, in 1899, is a clear manifestation of the intention of the objecting party (presumably acknowledging it has no right to) not to use the word "Aspirin" by itself, but to associate it, as it has done, with both trade-marks taken out in 1919 and assigned to it in 1920. The label with the combined words of "Bayer" and "Aspirin" never appeared on the Canadian market until 1919.

First, as to the advertising, I find myself unable to accept the view that the public announcements that the only "genuine Aspirin" is Aspirin sold under a given label, manifest a "real and intentional abandonment" of the appellant's right in the word "Aspirin" as registered. If "Aspirin" denotes and distinguishes acetyl salicylic acid made by the registered proprietors, which is the claim involved in the maintenance of the name on the Trade-Mark Register, then the assertion that their manufacture of acetyl salicylic acid is the only genuine Aspirin is strictly and literally true. The assertion is only one way of affirming their claim to the exclusive use of the word in connection with acetyl salicylic acid. If, on the other hand, the appellant has no such rights, and if the word "Aspirin"

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has acquired *droit de cité* as descriptive of the product as a chemical compound or article of commerce, then the assertion that its make is the only genuine aspirin is only a rather discreditable and futile puff, if not patently untruthful.

As to the trade-marks, I cannot agree that in applying for and obtaining registration of other trade-marks for coal-tar products the appellant was necessarily disclosing an intention to abandon their rights in relation to "Aspirin"; nor do I think that their conduct in so doing in the circumstances is a satisfactory foundation for inferring the existence of such an intention.

The appeal should therefore be allowed and the petition dismissed with costs.

MIGNAULT J.—The situation graphically depicted by Parker J. (afterwards Lord Parker of Waddington) in the *Gramophone Case* (1), would aptly describe that which, according to the evidence, exists to-day with respect to the drug "aspirin." The only difference—but of course it is a vital one—is that in the *Gramophone Case* (1) this situation preceded the application for registration of the trade-mark, whereas in this case it is subsequent thereto, so that the problem now under consideration is the converse of that dealt with in the *Gramophone Case* (1). It is shewn that since a.s.a. was put on the market, while the wholesale and probably also the retail trade has associated the word "aspirin" with the manufacture of the owners of the trade-mark, the public—by which I mean those who purchase from retail druggists in what has been described as an "over the counter trade"—looks on "aspirin" as the name of a popular drug, without any reference to a particular manufacturer. Such a situation, which, in the *Gramophone Case* (1) was fatal to the application for registration, as a trade-mark, of the word "gramophone," is not, the appellant contends, for it was subsequent to registration, a sufficient cause to have the registration of its trade-mark "aspirin" expunged from the register.

The appellant's proposition is that the question as to the distinctiveness of its trade-mark should be formulated as

(1) [1910] 2 Ch. 423.

follows: Was the word "aspirin" distinctive of the manufacture of the registrant at the date of registration? It may be observed that the distinctiveness of a registered trade-mark is assumed in the sense that the onus of proving that it was not, when registered, a distinctive trade-mark, is upon any person questioning its validity. So here the onus is on the respondent, the petitioner, of shewing that the word "aspirin" was not distinctive at the date of registration. That date, in my opinion, is the only one to be considered in such an inquiry, and the situation which subsequently developed, and the fact that now the trade-mark may have lost its distinctiveness in the eyes of the public, are not reasons for deciding that the registration, when made, was not a proper registration.

Bearing this in mind, we find that, at the date of registration, the drug itself, "acetyl salicylic acid," which will be more conveniently referred to as "a.s.a.," was a comparatively newly discovered drug, and the German manufacturers coined the fancy word "aspirin" to distinguish their manufacture. When this word was registered in Canada, it was not in connection with "a.s.a." or any particular drug, but it was a specific trade-mark to be applied to the sale of pharmaceutical preparations. The feature of specific as opposed to general trade-marks is, I understand, peculiar to the Canadian trade-mark Act, and under such a registration the word "aspirin" could have been used in connection with the sale of pharmaceutical preparations of various kinds. But from the first it appears to have been exclusively applied to the drug "a.s.a." And there is a preponderance of evidence that with the trade, particularly the wholesale trade, "aspirin" was understood as meaning the "a.s.a." manufactured by the Bayer company. The two terms "acetyl salicylic acid" and "aspirin" co-existed and were employed for the same drug, and what is rather significant from the point of view of distinctiveness is that the Bayer product was sold under the name of "aspirin," at from two to three times the price of "a.s.a." There was obviously something in the name, as the uninformed public found to its cost.

I do not think therefore that the respondent has made out a case of improper registration.

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On the issue of abandonment, its evidence seems much stronger; but its misfortune is that section 42 of the Canadian Act, unlike section 35 of the English Act of 1905, does not provide for the removal from the register of marks which, although entitled to registration when the trade-mark was obtained, can be said to be "wrongly remaining on the register." I am not dealing here with defences to an action for infringement, but with an application for the removal of the trade-mark from the register. And whatever effect, if any, abandonment and non-user may have as against an action for infringement, a point on which it is unnecessary to express an opinion, I do not find that section 42 has provided for the removal from the register of a trade-mark, properly registered, by reason of subsequent abandonment or non-user.

The respondents rely on the dictum of Lindley M.R., in the *Batt Case* (1), that if an entry is at any time on the register without sufficient cause, however it got there, it ought to be treated as covered by the words of the section. It was not, however, necessary in that case to place this construction on section 90 of the English Act of 1883, similar to our section 42, for the trial judge had found that there was no *bona fide* intention to use the mark at the time the registration was effected, and when the case went to the House of Lords (2), the dictum in question was not mentioned, although the decision was affirmed on the facts. I have been unable to read this meaning into section 42 of the Canadian Act.

All this shews that a practically perpetual monopoly is secured to the owner of a trade-mark validly registered although in the eyes of the public it has come to signify the thing itself and not the manufacturer. The appellant company has no exclusive right to the use of the word "aspirin" in Great Britain and the United States, but this judgment will give it in Canada a monopoly of the sale of "a.s.a." when sold under the name of "aspirin." In that way a registered trade-mark, which has become descriptive by reason of dealings with the public or an advertising campaign, is more valuable than a patent the life of which is limited. Such a situation could well be considered by Parliament.

(1) [1898] 2 Ch. 432, at p. 441.

(2) [1899] A.C. 428.

On the whole I think the appeal should be allowed and the petition dismissed. The appellant is entitled to its costs throughout.

MALOUIN J. (dissenting).—I would dismiss this appeal with costs for the reasons stated by Mr. Justice Audette in the Exchequer Court.

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MACLEAN J.—These proceedings were commenced by the respondent as petitioner, under the provisions of sec. 42 of the Trade-Marks and Designs Act to expunge from the register the word "Aspirin" registered as a specific trade-mark by the appellant's predecessors in title in April, 1899. The history of the title of this registered mark has already been stated and I need not repeat it, and it appears as well in the judgment of the learned trial judge.

The respondent's principal contention is that this trade-mark was originally made without sufficient cause, and alternatively that if the mark ever had any validity, it has since ceased to be a trade-mark and should now be expunged. The appellant submits that it is a valid and subsisting trade-mark, and particularly urges as the important consideration, the question whether or not at the time of registration the word "Aspirin" was properly registered, and if so the appellant submits it cannot now be removed from the register even if it has since become to denote to the public the name of a chemical compound, and not to distinguish the article itself as manufactured by the proprietor of the registered trade-mark. This I think reveals the substantial issue, although other and perhaps quite important points have been put before us.

The case is not without its difficulties both as to the law and the facts, and the latter are before us in confusing abundance. I confess that at first I was much impressed by the conclusions of the trial judge, and the submissions of the respondent's counsel, but a later review of the authorities and the evidence, leads me to the conclusion that the appeal should be allowed.

The substantial issue for determination in my opinion is, whether the word "Aspirin" at the time of registration in Canada as a trade-mark, was also adopted as the name of the patented chemical compound, acetyl salicylic acid, or descriptive of it; or whether it was a mark proposed to be

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used in connection with certain goods, for the purpose of distinguishing the goods of the proprietor of such mark, and further, if this registered mark has subsequently ceased to be used for the legitimate purposes of a trade-mark, and has owing to one cause or another become known to the trade or the public as the name of the article itself, may it now be expunged from the register.

Under our Trade-Marks and Designs Act a specific trade-mark, when registered, shall endure for the term of twenty-five years, but may be renewed by the proprietor for further twenty-five year periods. The Minister in whose department is administered the Trade-Marks and Designs Act may refuse registration if he is not satisfied that the applicant is undoubtedly entitled to the exclusive use of such trade-mark, or if it resembles a trade-mark already issued, or if it is calculated to deceive or mislead the public, or if the mark does not contain the essentials necessary to constitute a trade-mark properly speaking. Then section 42 which authorizes proceedings for the rectification of the register is as follows:—

42. The Exchequer Court of Canada may, on the information of the Attorney General, or at the suit of any person aggrieved by any omission, without sufficient cause, to make any entry in the register of trade-marks or in the register of industrial designs, or by any entry made without sufficient cause in any such register, make such order for making, expunging or varying any entry in any such register as the court thinks fit; or the court may refuse the application.

3. The court may in any proceedings under this section, decide any question that may be necessary or expedient to decide for the rectification of any such register. 54-55 V., c. 35, s. 1.

There are no other provisions in this statute providing for rectification of the register. It is contended that this section provides no machinery for expunging or varying any trade-mark except one registered originally without sufficient cause, and that the validity of a trade-mark is to be determined as and of the date of registration.

The statute which concerns us here is an old one; sec. 42, having been enacted in 1891, did not I think anticipate the trend of trade-mark uses and practices of recent years, and the influence of modern advertising in converting, perhaps, a word, being a proper trade-mark when registered and distinguishing merely the goods of the proprietor from the goods of another, into a word denoting to the public mind the name of the article itself. No pro-

vision seems to have been made for removing a mark from the register when gradually or suddenly, by lawful business processes and influences, it has grown to become the popular name of the article, and would have been refused registration had the application for registration been made when the word had taken in its later significance.

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There can be but one moment when an entry is made; it is not by any legal fiction, or in fact, a continuing process. It appears to me that "entry" and "without cause" must be read to mean a ministerial act synchronising with an existing set of facts in law or in fact fatal to the validity of a trade-mark, and not severed by time from the genesis of that set of facts. If the "cause" putting the trade-mark without the spirit of the statute develops subsequent to the "entry," the "entry" would have no relation to the "cause," and one could hardly say it was an entry made without cause, but rather a registration which possibly on the grounds of public policy should be removed, but for which at the present time the statutes makes no provision. I think the phrase "entry made without cause" was intended when enacted to bear the construction I give it.

Under the English Trade-Marks Act of 1883, the Court of Appeal expressed the view that an order could be made to remove from the register a trade-mark even although the original registration was proper. In the *Batt Trade-Mark Case* (1), Lindley M.R., delivering the judgment of the court and referring to the words "entry made without sufficient cause" said:—

If any entry is at any time on the register without sufficient cause, however it got there, it ought in our opinion to be treated as covered by the words of the section.

The motion was to remove from the register a trade-mark not registered by the proprietor with a *bona fide* intention of using it, and it was found that the proprietor never had any intention to use the mark. As pointed out in the judgment, in the view taken by the court of the facts, the decision of the point was not necessary to the decision of the case. The judgment was affirmed in the House of Lords but no decision was given on this point. I do not consider this a decision binding upon that point, nor was

(1) [1898] 2 Ch. 432.

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it so regarded in England. It is perhaps significant that since then there has been express legislation providing for the removal from the registry of trade-marks registered without *bona fide* intention to use, or where there is not a *bona fide* user of the same, and up to that time no order had ever been made for the removal of a mark originally rightly registered. In the *Batt Trade-Mark Case* (1) the defendant would seem to have been registering trade-marks to cover contingent needs, and at the time of entry had no *bona fide* intention of user. Possibly, in such case, a portion of the evidence to establish that absence of *bona fide* intention of user at the time of entry, would be properly extracted from the subsequent course of action of the defendant and not limited to his intentions at the time of registration.

A great number of English decisions were submitted to us by both sides in support of their several positions. Having in mind the then existing English statutes upon trade-marks it appears to me, after a perusal of such authorities, that throughout them all is to be found the assertion of the principle, that the validity of a registered trade-mark is to be determined as and of the date of registration. Any taint of impropriety as a registerable mark then attaching adheres, and may always be invoked, in any proceedings to expunge. From such judicial authorities it is also to be inferred that if a mark was at the time of registration a proper one, and within the terms of the statute, it cannot be expunged without express legislative authority, even if in the course of time it takes on that quality which, if existent at the time of registration, would make it an improper entry. The uniformity of decisions in this direction is very marked. In fact our attention has not been directed to any decision in the English courts expressly deciding to the contrary.

This view of the law is, I think, expressed with great clarity and force by Parker J. in the *Gramophone Case* (1). Here the court was considering an application to register as a trade-mark the word "Gramophone." It was admitted on behalf of the applicant that the word had some direct reference to the character or quality of the

(1) [1910] 2 Ch.D. 423.

goods in respect of which it was proposed to be registered. The name "Gramophone" had been given to a patented talking machine in 1882 to distinguish it from phonographs or graphophones which operated a cylinder record, as opposed to disc records operated by the gramophone. Parker J. concluded from the evidence that the word "gramophone" had direct reference to the character of the goods, and while at the start the word was used to denote a particular sort of article, and the word while still retaining its original signification had become so popularized owing to wide advertising by the manufacturing company that it came to denote the article, and that the applicant used the word as the name of the article and not to distinguish the article when made by it from the same article made by others. He refused the application to register on the ground that the name by which an article is popularly known ought not to be admitted to registration as a trade-mark for that article. In other words he held that the word was not at that date, the date of the application, a proper trade-mark for registration. It is however the discussion by Parker J. of the case where a registered trade-mark is later adopted by the public as the name of the article which is of interest. He said:—

It may be asked, and was in effect asked at the trial, why such words as, for example, "pianola" or "vaseline" should be on the register as trade-marks if "gramophone" were refused registration. The answer is not far to seek. None of the Trade-Mark Acts have provided machinery for taking a mark off the register if once it has been properly put on, and it is quite unnecessary in an action for infringement of a registered mark to prove that such mark still remains distinctive of the goods of the registered proprietor. It may, therefore, be to the interest of the registered proprietor of a word mark that the word should lose its distinctiveness so far as the public are concerned and become the popular name for the article. He thus obtains a practical and perpetual monopoly in the article itself, other manufacturers being precluded by the mark on the register from selling their goods under the name by which they are commonly known. To induce the public to adopt a catching word as the name of the article to which it is applied, especially if the article be comparatively new, it is only necessary to advertise the article on a sufficiently large scale under that name, and this can be done by any rich corporation.

It is, however, one thing to put a word mark on the register and then proceed to induce the public to use it as the name of the article to which it is applied, and quite another thing to adopt a word already used to denote an article, and then proceed to identify it among the trade with the goods of a particular manufacturer, relying on such identification as a reason for registration. For the purpose of putting a mark on the register

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distinctiveness is the all-important point, and in my opinion, if a word which has once been the name of an article ought ever to be registered as a trade-mark for that article, it can only be when the word has lost, or practically lost, its original meaning

That a registered mark cannot be taken off the register, even though it has ceased to be used for the legitimate purpose of a trade-mark and has become merely the name of an article, is, I think, no reason for allowing one trader to register and secure a monopoly in what is already the name of an article although every trader in the kingdom might for one reason or another have already recognized or been willing to recognize such monopoly.

This appears to me incontrovertible and conclusive reasoning, and is entirely applicable to the case now before us, having in mind our statute. Upon the findings of fact made by Parker J. clearly the word was not a proper one for registration. In similar circumstances under our statute the Minister would have been justified in refusing registration. It is one thing, as that learned judge said, to put a word mark on the register and induce the public to adopt it as the name of the article, but it is another to adopt a word already used to denote a particular article, and then proceed to identify it among the trade with the goods of a particular manufacturer, relying on such identification as a reason for registration. In other words this decision is to the effect that "Gramophone" might have been a registerable word mark if at the time of application for registration it was not the name of and did not denote the article itself.

In re Woodward's Trade-Marks (1) was decided in 1915. Here one part of the proceedings was to expunge the trade-mark "Gripe Water." Eve J. found that the word mark had become in one sense public property, and for some years had been used as descriptive of the article, and said that if the present time was the moment of time at which he was to decide if the mark was distinctive of the goods, he could see substantial reasons for removing the registration. He held, however, that the moment was the moment of registration, and that it had not been shewn that the trade-mark at that time was not distinctive.

The *Linoleum Case* (2) is much relied on by the respondent. In reality it decided exactly what was decided in the *Gramophone Case* (3). Here a new substance

(1) 32 Cut. P.R. 173.

(2) [1877] 7 Ch. D. 834.

(3) [1910] 2 Ch. D. 423.

having been invented the name of Linoleum was admittedly given to it by the patentee, and it never had any other name. The plaintiff, in this case, also used a trade-mark containing the word linoleum and the action was to restrain the use of that word as applied to floor-cloth, the patent having expired. The court held that the plaintiff having invented a new subject matter, used merely the name Linoleum as distinguishing that subject matter, but did not use the word to distinguish the subject matter as made by them, from the same subject matter as made by other persons. I construe this case to decide that when the trade-mark was registered it was not properly made at the time, because it was not a distinctive mark, but was the admittedly adopted name of the article itself and therefore not properly registerable. The same principle was laid down in the later case of *Redaway v. Barnham* (1), by Lord Hershell, who said:—

Where a patentee attaches a particular name to the production he patents, that name becomes common property as the name of the patented article. It possesses indeed no other name. That name would be applied to it by all persons desiring to purchase the article. It is not descriptive of the production of a particular manufacturer but of the article itself by whomsoever it is manufactured.

It is always a question of fact what falls within the principle decided in these cases. If, clearly, an invented name is the name of an article, it cannot properly be registered as a trade-mark, but that fact must be established. This would not appear to be in conflict with the principle laid down by Parker J. in the *Gramophone Case* (2) above referred to.

That the view expressed by Parker J. in the *Gramophone Case* (2) represented the accepted jurisprudence in England, on the point of the statute there providing no machinery for expunging a mark which was originally a proper registration, is to be inferred from enabling legislation enacted in 1919. The Trade-Marks Act, 1919, provides that where in the case of an article or substance manufactured under any patent in force, a word trade-mark registered is the name or only practical name of the article or substance so manufactured, all rights to the exclusive use of such trade-mark shall cease upon the ex-

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piration or determination of the patent, and thereafter such word shall not be deemed a distinctive mark and may be removed by the court from the register, on the application of any person aggrieved. By another provision of the same statute the only practical name or description of any single chemical element, or single chemical compound as distinguished from a mixture, is prohibited from registration, subject to certain provisions.

The American authorities cited by the respondent are not I think helpful. A part of the appeal case is the finding of an officer of the United States Patent Office upon an application of the United Drug Company to cancel in that country the registration of the word "Aspirin" as a trade-mark, which application was granted in 1918. The United States Trade-Mark Act (1905) provides that if it appears that

the registrant was not entitled to the use of the mark at the date of his application for registration thereof, or that the mark is not used by the registrant, or that it has been abandoned,

the commissioner of patents may cancel the registration. The words "used by the registrant" have been construed by the United States courts and by the United States Patent Office to mean "used as a trade-mark" and the official known as the Examiner of Interferences found that it was not so used upon the evidence submitted. The distinction between the United States Patent Act and our own statute on the same subject is, of course, obvious, and altogether the findings of the United States Patent Office in this application are not of assistance here.

In the *Bovril Case* (1) the action was to expunge the word "Bovril" from the register. The trade-mark was registered on November 2, 1886, and the question was whether the word "Bovril" was at that date a distinctive "fancy word not in common use." It was admitted that the word was new and was one that had never been heard of before. The plaintiff contended the word was a highly descriptive word, the defendant contending that the real question was whether the word was descriptive at the date of registration. In rendering judgment Lindley J. said:—

I think it is eminently and purely a question of fact. Now I ask myself this: Supposing that a jury were asked to say whether on November 2, 1886 Bovril was a fancy word not in common use, and supposing they said upon a direction from the judge, which I think it would be the duty of the judge to give, that if they were of the opinion that it really intelligibly described the thing sold it would not do, could they with that direction reasonably say it was not a fancy word not in common use? I do not think they could.

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That really expresses my own way of looking at the substantial point in this appeal. The question is one of fact. I do not think the evidence supports the contention that the word "Aspirin" at the date of registration was descriptive of Acetyl Salicylic Acid, and to the trade or the public denoted that article, and by that name. If in this respect the situation has since changed in so far as the public is concerned, it did not I think substantially occur until some years after the registration. At least the respondent has failed to show, in my opinion, that at the time of registration the mark was not distinctive. If at that time the registrant secured by statute a right to a proper trade-mark the statute and not the courts should deprive him of it.

In the view I take of the law I need only inquire if, at the time of registration, the word "Aspirin" was a proper and valid trade-mark. In my opinion the respondent has failed to prove that at the time of registration the word was not a proper and valid trade-mark. It is not necessary for me to quote from the evidence. In the first place Acetyl Salicylic Acid was the name given to the patented article, and before the patent a chemical compound by that name was not unknown to the chemist. The patent was limited only to the United States, and the article was manufactured in other countries during the life time of the patent in the United States, and sold to the public under various word marks, or names, and is so being sold to-day in Canada and elsewhere. For many years after the registration of aspirin, to manufacturing chemists, wholesale druggists, chemists and physicians, there was a chemical compound known as Acetyl Salicylic Acid, and aspirin was known to them as the Bayer production of that compound. The evidence supports this conclusion, and it would be difficult to imagine such not being the fact.

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The same section of the public, in Canada, would no doubt to-day, 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 trade-mark 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. However, I am not obliged to decide whether the word aspirin now denotes to any section of the public the name of an article, but if that were in point of fact my conclusion I do not see how the mark could be expunged, or its exclusive use by its proprietors in any way limited, because there is no authority for so doing in the statute. It is unlikely the omission was accidental, but rather that Parliament did not anticipate, when the enactment was made, the effect of much advertising upon a portion of the public.

It is contended also that this trade-mark has been lost by non-user and abandonment and the period referred to is 1913 to 1919. Mere disuse does not amount to abandonment, and abandonment is a question of intention. If a proprietor of a trade-mark ceases to have an intention of dealing in the goods for which the mark is registered, that would establish abandonment so far as such goods were concerned. I think one may safely conclude that no such in-

tention of abandonment has been established in evidence, on the part of the appellant or its predecessors. The fact is that during the war it was not possible for the owners of the mark to manufacture or sell the product but that is not evidence of intention of abandonment. The war period must be disregarded altogether in an inquiry as to whether or not there was intention of abandonment. That there was an intention of abandonment is not proven, nor can it be inferred from the evidence, and I think it is quite an improbable assumption. Then, abandonment is also claimed by the respondent on account of the dealings between the predecessors of the appellant and the tablet makers, in which the manufacturing chemists were permitted to manufacture the crystals into tablets, with the trade-mark in question placed thereon. The purpose of a trade-mark is to indicate that the goods are of the make of the proprietor of the mark, and the tablets were in reality but a manipulation of the form only of the goods purchased from the proprietor of the mark. It appears to me that, in this case, it was quite in harmony with the real purposes of the mark to permit its use upon the tablets made by the manufacturing chemists, and in the absence of an agreement to the contrary I think the tablet manufacturers would have the right of user of the mark. There would be an implied licence for so doing. Any one using the owners' mark on the owners' goods would hardly be infringing nor would it in any respect be deception. The wholesaler or retailer of goods purchased from the maker might, I think, safely print labels which are the trade-marks of the maker of the goods, if for cause they had to be replaced.

The only other point to which I shall refer is the advertising in 1919 and 1920, and the registration of the word Bayer as a mark to be applied to pharmaceutical preparations, which it is claimed is indicative of an intention of abandonment. In respect of the laudatory advertising from which we are asked to infer abandonment, it is to be observed that the war had a destructive effect for one reason or another upon the appellant's position in the market. The inference I draw from this advertising is that the appellant was determined, even at a considerable cost, to regain its lost ground, and the advertising negatives the inference of abandonment. In the circumstances I do not

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think we are called upon to examine microscopically this advertising in order to discover an intention of abandonment. Conceivably the adoption of a new mark might be evidence of abandonment of an old mark. It is not clear to me that because an owner of a word mark adopts a second mark that he has waived his rights under the other. The nature of the user of each or both would have to be known before any judicial determination could be made upon the matter, and therefore I do not think there is sufficient evidence before us to conclude that from adoption of the new mark we are to infer an abandonment of the mark "Aspirin."

With great respect therefore I think the appeal should be allowed.

Appeal allowed with costs.

Solicitors for the appellant: *Osler, Hoskin & Harcourt.*

Solicitors for the respondent: *Brown, Montgomery & McMichael.*
