
<p>1924 *Oct. 21. *Nov. 11.</p>	<p>CHANNELL LIMITED AND ANOTHER (PLAINTIFFS)</p>	}	APPELLANTS;
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AND

<p>M. A. ROMBOUGH AND ANOTHER (DEFENDANTS)</p>	}	RESPONDENTS.
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ON APPEAL FROM THE COURT OF APPEAL FOR BRITISH
COLUMBIA

Trade-mark—Common descriptive word—Right to exclusive use—Trade-Mark “O’Cedar.”

A person cannot obtain an exclusive right to use, by registering it as a trade-mark, a word in common use as a descriptive word of the character and quality of the goods in connection with which it is used.

The registration of such a word as “O’Cedar” as a trade-mark does not prevent the use by another person of the word “Cedar” as applied to goods manufactured for a similar purpose.

Judgment of the Court of Appeal (33 B.C. Rep. 452) affirmed.

*PRESENT:—Anglin C.J.C. and Idington, Duff, Mignault, Newcombe and Rinfret JJ.

APPEAL from the decision of the Court of Appeal for British Columbia (1), affirming the judgment of the trial judge (2) and dismissing the appellants' action for damages for alleged infringement of a trade-mark.

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The appellants manufacture a polish and mop which they distinguish by a combination of a letter and word, "O'Cedar," for which they have a trade-mark. The respondents, before the institution of the action, were manufacturing and selling similar articles under the name of "Cedar," and since the commencement of the action, under the name of "Cedarbrite." The appellants claim that this is an infringement of their trade-mark.

Geo. F. Henderson K.C. for the appellants.

R. M. Macdonald for the respondents.

The judgment of the majority of the court (Anglin C.J.C. and Duff, Mignault, Newcombe and Rinfret JJ.) was delivered by

MIGNAULT J.—The appellants' action is against the respondents who carry on business under the firm name of Dust Control Company, the latter company being also a defendant. The appellants claim to be the owners of the trade-mark "O'Cedar" registered both in Canada and the United States as applied to the sale of furniture polish, polish mops and dusters. They allege that the respondents have infringed their trade-mark by the use of the word "Cedar" as applied to the same products, and that since the commencement of the action they have also infringed it by using in the same connection the word "Cedarbrite." They further pretend that the respondents are fraudulently passing-off their goods as and for the appellants', by employing the same words on similar articles and similar packages. They ask for an injunction, the destruction of the respondents' polishes, mops and oils, and claim damages or, in the alternative, an account of profits.

The defence denies the passing-off and alleges that the appellants' so-called trade-mark is invalid, being a descriptive and not an arbitrary or fanciful name, and consequently not registrable as a trade-mark.

(1) [1924] 33 B.C. Rep. 452; (2) [1924] 33 B.C. Rep. 65;
[1924] 2 W.W.R. 28. [1923] 3 W.W.R. 1041.

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The learned trial judge found against the appellants on the issue of passing-off and also came to the conclusion that the name "O'Cedar" was descriptive of a quality of the appellants' goods and did not constitute a valid trade-mark. The appellants' action was dismissed and the judgment was unanimously affirmed by the British Columbia Court of Appeal. The appellants now seek the reversal of these two judgments.

On the issue of fraudulent passing-off, while at first sight the similarity of the name used by the respondents to the trade name of the appellants may seem to furnish some foundation for the suggestion that the respondents are seeking to pass off their goods for those of the appellants, the evidence appears to support the conclusion of the learned trial judge that the appellants have failed to make out a sufficient case. The respondents' witnesses all say that there has been no confusion between the goods of the respondents and those of the appellants. Certainly no fraudulent intention has been brought home to the respondents, and there is only one instance where a purchaser asking for "O'Cedar" polish was given "Cedar" polish, and this was the act of an independent dealer who does not appear to have been in any way connected with the respondents.

Before this court, the argument centred chiefly on the question whether "O'Cedar," as applied to polishes and mops, is a valid trade-mark and is infringed by the use of the words "Cedar" or "Cedarbrite" in connection with the same description of goods.

The evidence is that the Channell Chemical Company, a Chicago corporation, first used the word "O'Cedar" in connection with a polish manufactured by it in 1907. It registered the word in 1912 in the United States and in 1913 in Canada, as a specific trade-mark. Channell Limited is an Ontario company and by an assignment in 1915 obtained the right to use the trade-mark in Canada. There is no doubt that the appellants have spent considerable sums of money in advertising their goods under the name "O'Cedar." The respondents do not appear to have carried on business outside of British Columbia, and their operations in that province are not on a considerable scale.

Both the appellants and the respondents scent their polishes and their mops with the oil produced from the cedar leaf, the proportion of this oil to the mineral oil composing the polish being one per cent. of the mixture. The inference that the name of "O'Cedar" or "Cedar" was suggested by the odour of oil of cedar does not seem an unfair one, for this scent was featured by both parties in selling their goods, and the respondents also recommended it as being a repellent for insects.

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In 1913 one Trail, then the husband of the respondent Madeline Rombough, began manufacturing a polish under the name of "oil of joy," and subsequently described it as "Cedar polish." Trail is now dead and, as this action was taken in September, 1922, there is no evidence available as to his motive which the appellants suggest was to avail himself of the reputation they had secured for their goods by their extensive advertising. Madeline Rombough, the widow, took over the business under her husband's will and disposed of it to a concern which failed to fulfil its obligations, so that the business, carried on under the style of "Dust Control Company" came back to her. She married the respondent, Marshall Anson Rombough, who as her manager carries on the business for her.

It appears by the testimony of one James O. R. Newman, a dealer during a number of years in janitors' supplies and requisites, that prior to 1917 other manufacturers made polishes or similar goods under the name of "Cedar," such as "Imperial cedar polish," and that he himself sold a product he called "Cederolia spray," one of the ingredients used being oil of cedar. His testimony shows that this oil, which is not useful as a polish, was employed on account of its peculiar odour, and probably as a preservative against insects. And for this reason the word "cedar" may have been a convenient name to designate polishes having this odour as well as mops saturated, as are the mops of the parties, with oil of cedar.

We think it is clear that the word "cedar," being a word in common use, could, notwithstanding the registration of the trade-mark "O'Cedar," be employed for the sale of goods of which the oil of cedar was a component part. It would be in this connection a word descriptive of a quality or of the character of the goods.

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It does not appear necessary to refer to many authorities in support of this proposition. They are quoted in abundance in the judgments under appeal. That a word in common use as the name of a thing cannot be appropriated as a trade-mark is shown by the decision of the Judicial Committee in *Standard Ideal Co. v. Standard Sanitary Mfg. Co.* (1). As was said in that case, a common English word having reference to the character and quality of the goods cannot be an apt or an appropriate instrument for distinguishing the goods of one trader from those of another. And the mere prefixing of the letter "O" to such a word as cedar certainly does not make it so distinctive that registration gives to the appellants the right to complain of the use of it by another manufacturer to describe a polish whereof oil of cedar is one of the ingredients.

Mr. Henderson argued that the word "cedar" used in the trade-mark in question had acquired a secondary meaning as signifying the appellants' goods. We have carefully read the evidence and can find nothing in support of this contention. No doubt the trade knew that the appellants were manufacturing a polish under the name "O'Cedar," as they were aware that other manufacturers were using the word "cedar," but there is nothing here to indicate that the latter word as used had become in any way distinctive of the appellants' goods.

We can see no sufficient reason to disturb the judgment under appeal and would therefore dismiss the appeal with costs.

IDINGTON J.—I am of the opinion that this action was properly dismissed by the learned trial judge for reasons assigned by him; and that the appeal therefrom by the appellants was properly dismissed, unanimously, by the Court of Appeal for British Columbia for the respective reasons assigned by the several judges giving written reasons therefor.

I, therefore, think this appeal should be dismissed with costs.

Appeal dismissed with costs.

Solicitor for the appellants: A. H. MacNeill.

Solicitors for the respondents: Bird, Macdonald, Bird & Collins.