

BETWEEN:

LYSOL (CANADA) LIMITED.....PETITIONER; ¹⁹³² Sept. 19 & 20.
Nov. 14.

AND

SOLIDOL CHEMICAL LIMITED...OBJECTING PARTY.

Trade-mark—"Lysol" and "Lysotab"—Calculated to deceive—Descriptive word—Expunging—Burden of proof.

The petitioner, owner of the trade-mark "Lysol" which was registered in 1890 and renewed in 1915 for twenty-five years, asks that the trade-mark "Lysotab" be expunged from the Register for the statutory reasons. The owner of the latter mark contended that "Lysol,"

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- being the name given to the product by the patentee thereof, was therefore descriptive, was an improper trade-mark and should never have been registered.
- The Court found, on the evidence, that the word "Lysol" was properly registered, was a valid trade-mark and that "Lysotab" was calculated to deceive and mislead the public, and ordered that it be expunged.
- The Court also held that the burden of establishing that the registration was improperly made was upon the Objecting Party herein; and particularly in this case where the trade-mark had continued on the Register, and in use, for over forty years subsequent to its registration.
2. That where a person has invented and patented a new substance and gave to it a new name, and during the continuance of the patent had alone made and sold the substance by that name, there being in question no registered trade-mark of the same name during the life of the patent, he would not be entitled to the exclusive use of that name after the expiration of the patent, the name being descriptive of the substance itself. That in such cases it is a question of fact whether or not the name is descriptive of the article itself.

PETITION by the petitioner herein to have the trade-mark of the Objecting Party expunged as calculated to deceive the public.

The action was tried before the Honourable Mr. Justice Maclean, President of the Court, at Ottawa.

*R. S. Smart, K.C.*, and *A. W. Langmuir, K.C.*, for petitioner.

*R. D. Moorehead, K.C.*, *A. E. Honeywell, K.C.*, and *H. W. Alles* for objecting party.

The facts and questions of law raised at the trial are stated in the reasons for judgment.

THE PRESIDENT, now (November 14, 1932), delivered the following judgment:

The objecting party registered in June, 1929, as a specific trade-mark, the word *Lysotab*, to be applied to the sale of chemical substances used for agricultural, horticultural, veterinary and sanitary purposes.

The petitioner carries on the manufacture and sale, in Canada, of a disinfectant compound, and in connection with the sale of which article the registered trade-mark *Lysol* is applied. On July 18, 1890, the partnership concern of Schulke and Mayr, of Hamburg, Germany, manufacturing chemists, registered in Canada the word mark *Lysol*, to be applied to the sale of disinfectants. This mark was re-

newed on July 18, 1915, for a further period of twenty-five years. The petitioner, by assignment, is now the proprietor of that mark. On April 25, 1928, the petitioner registered the word *Lysol* as a specific trade-mark to be applied to the sale of disinfectants, shaving cream, soaps, toilet articles and preparations, and pharmaceutical preparations. The first registered word mark *Lysol* has therefore been continuously on the register of trade-marks in Canada, and in actual use I understand, for over forty years.

The petitioner seeks to expunge the registered mark of the objecting party, the word *Lysotab*. The objecting party contends that the petitioner's mark, *Lysol* was not properly registrable as a trade-mark in that the word was at the time of registration the name that was given to an article similar to that manufactured and sold by the petitioner, by one Dammann, who, in an English patent, gave the name *Lysol* to the substances to be made under that patent; that the mark is descriptive; and that the mark is now *publici juris*.

It will be convenient to begin by stating that on May 8, 1889, a German patent issued to one Dammann, a citizen of Germany, and which related to a process of rendering tar-oils completely soluble in water. In 1889, Dammann procured a patent in France relating to the same subject matter. On January 20, 1890, Dammann applied in England for a patent of the same invention and on that date he filed a provisional specification. The complete specification was left on Oct. 15, 1890, and the patent was accepted on January 10, 1891. The provisional specification states:

My invention relates to a process for rendering tar-oils completely soluble in water and to the manufacture of new commercial products by addition of certain substances thereto.

At the end of the provisional specification the following words appear:

I propose to call my new products *Lysol* or *Lysoline*.

The complete specification states:

My invention relates, firstly, to a process by which I render tar-oils completely soluble in water and produce tar-oils containing halogens, sulphur, nitrates, or phosphorous, and soluble in water; secondly, to these novel soluble products themselves which for the sake of brevity I call *Lysol* or *Lysoline*.

The principal part of the case of the objecting party, as already stated, is based on the contention that in the pro-

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visional and complete specifications of Dammann, the name *Lysol* was given by the patentee to the articles to be made under his patented processes, and that therefore the word *Lysol* was always descriptive of such articles, or the name of such articles, and therefore not properly registrable as a trade-mark. I should mention that in the case of the German and French patents no name such as *Lysol*, or any other, was mentioned by the patentee to designate any product or substance made under his patent. The English patent expired in 1900. Dammann never applied for a Canadian patent.

As already stated the word mark *Lysol* was first registered in Canada on July 18, 1890, by Schulke and Mayr. Obviously, it could only be for the most conclusive reasons that the petitioner should now be deprived of that trade-mark in Canada. Though not in chronological order I might next refer to registrations of the same mark made in the United States, by Schulke and Mayr, in 1895 and 1906 respectively. In each case the word *Lysol* was registered to be applied generally to drugs and chemicals, but particularly to disinfectants and anti-septics; in each case the applicant affirmed in the application for registration that the mark had been continuously used in the business of Schulke and Mayr since 1899; the latter application fixed the date as of July 15, 1889. The partnership firm of Schulke and Mayr, I might add, commenced to exist on April 15, 1889. On April 15, 1890, Schulke and Mayr registered at Hamburg, as a trade-mark, the word *Lysol* inside a white circle which was within a blank triangle, to be applied to disinfectants and anti-septics. It seems that it was not then permitted by law for a German national to register a word alone as a trade-mark, and hence the reason for associating the word with the circle and triangle. It might be appropriate here to point out that in 1890, there appeared in a German medical journal an article by one Dr. Schottelius, a Professor of Freiburg University, who stated that two bottles filled with a liquid and marked respectively *Lysol* II and *Lysol* III, had been submitted to him by Schulke and Mayr. In the year book of a German State Institution for the Sick, of 1889, there appeared an article by one Dr. Simmonds who stated that

a substance which was recently recommended by Dr. Schottelius, *Lysol*, seems to satisfy all requirements of an effective disinfectant.

So it would appear that Schulke and Mayr had adopted the trade-mark, *Lysol*, sometime in 1889, for disinfectants. On July 7, 1890, Schulke and Mayr registered the mark *Lysol* in England, to be applied to disinfectants; in the same year they registered the same mark in France. The mark was undoubtedly used in England to denote the goods of Schulke and Mayr, and it remained on the register there down till October, 1914, when as a war measure it was voided. There is no suggestion that any other manufacturing chemists sold in England, prior to 1914, any disinfectant under the trade name of *Lysol*, but subsequent to the voidance of the mark, the same began, in one form or other, to be used there by others. The goods of Schulke and Mayr, prior to October, 1914, were being imported into England by one Zimmerman, the agent of Schulke and Mayr.

Two other points should perhaps be mentioned, because reference was made to them at the trial, though I do not think anything really turns upon either. In June, 1891, there was organized in France a company known as Société Française du Lysol, having for its object the acquisition of Dammann's French patent rights, and the Schulke and Mayr trade-mark, *Lysol*, registered in France. The evidence regarding this transaction is somewhat confusing, yet, I think it is only susceptible of the meaning that Dammann transferred his rights under his French patent, and Schulke and Mayr their trade-mark registered in France, to the new company, which was to exploit the patent and the mark in France, and its Protectorates. The other point is the following. In 1893, Schulke and Mayr induced the Société Française du Lysol to apply for registration of the word *Lysol*, as a word mark only, in Germany, which they themselves could not then do, but which, by some international convention, the French company might do. It is not necessary or useful to go into the details of this matter, but in effect what was done was to enable Schulke and Mayr to secure the use of the registration of the word mark *Lysol*, in Germany, and without explaining how this was done, it is sufficient to say it was done, and, I think, for the benefit of Schulke and Mayr. When the legal formalities had been complied with Schulke and Mayr had the sole use of the

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mark in Germany, and the French company retained no rights whatever in the mark there, nor did it sell its products in Germany under that mark.

The first point for decision is whether or not, at the date of registration in Canada, the word *Lysol* was properly placed on the register of trade-marks. If it was then properly registered as a trade-mark it is still a valid registration. *The Bayer Co. v. American Druggists Syndicate* (1). The burden of establishing that the registration was improperly made in 1890 rests, in my opinion, upon the objecting party, particularly in a case where the trade-mark has continued on the register, and in use, for over forty years subsequent to registration. As was said by Stirling L.J., in the *In re Chesebrough's Trade-Mark "Vaseline"* (2):

It is manifestly unreasonable to expect that the owners of a registered trade-mark should preserve evidence of the way in which it was used at and prior to the time of registration for a long period, in this case of more than twenty years subsequent to registration.

Upon the facts before me I do not think it can properly be said, that at the date of registration, the petitioner's mark was intended, in Canada, not to indicate an article put up by Schulke and Mayr, but one manufactured according to the processes of Dammann's patent. It is more than probable that the mark *Lysol* was first adopted by Schulke and Mayr, to identify the disinfectant compound sold by them, and to distinguish their disinfectant from that made by others; they and Dammann were evidently in close business relations from the start, and the fact is, I understand, that Schulke and Mayr acquired the German patent, and it would be natural that they should adopt a mark to indicate their manufacture of articles made under Dammann's patented process; and if they acquired the rights of Dammann under the English patent, which also appears to be the fact, it was natural that they should adopt the same mark in England, and they apparently used the mark in that country for fourteen years after the expiration of the patent without any question as to its validity, and except for the incidence of war the mark would probably have continued on the register of trade-marks there. There is no evidence before me that Dammann ever manufactured or sold anywhere any substance or product according to the

(1) (1924) S.C.R. 558.

(2) (1902) 2 Ch. D. 1 at p. 9.

processes indicated in his English patent, or that he ever used the word *Lysol* in Canada, or elsewhere, to denote the name of any article made under his English patent. To say, as did Dammann in his English patent, that he proposed to call his patented product *Lysol*, is not evidence that this in fact was ever done, or that anywhere the public associated any disinfectant made and sold under the name of *Lysol*, with Dammann, or with the processes of manufacture described in his patent. A name is not given to a newly invented substance merely by saying in a patent that it is proposed to give to that substance such and such a name. Trade-mark law cannot be made by that process. If it were shown that Dammann having invented and patented a new substance gave it a new name, and during the continuance of the patent had alone made and sold the substance by that name, there being in question no registered trade-mark of the same name during the life of the patent, he would not be entitled to the exclusive use of that name after the expiration of the patent, the reason for that being that the name was then in fact descriptive of the substance itself and therefore not registrable as a trade-mark. That is the *Linoleum Mfg. Co. v. Nairn (The Linoleum Case)* (1), which was decided before there was enacted in England any Trade Marks Act, which, I think, is always important to remember. In all such cases it is a question of fact whether or not the name was descriptive of the article itself, and if it was, then, if an application is made to register that name as a trade-mark it should be refused, or, as in the *Linoleum Case*, if an action is brought to restrain others from using the name the same would fail. The principle would obviously be just as applicable if the article in question was not the subject matter of a patent.

I think it is to be presumed that the word *Lysol*, always indicated, in Canada, an article manufactured by Schulke and Mayr, or their successors, and not an article manufactured according to the processes described in Dammann's patent, or the article which Dammann said he proposed to call *Lysol* in his English patent and which could not possibly have been known in Canada at the time of the registration of the petitioner's mark. It would be impossible to

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(1) (1878) 7 Ch. D. 834.

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hold, upon the evidence before me, that the mark was registered and used, in Canada, otherwise than to denote the goods of Schulke and Mayr. The case was put to me by counsel for the objecting party on the footing that the mark was at all times since its registration descriptive, and therefore void, so the issue is not whether the mark once distinctive, had become descriptive, but whether at the date of registration it was descriptive.

I was referred to the New Zealand case of *De Meric Ltd. v. Lysol Ltd.* (1). But the decision there turned altogether upon the validity of the assignment of the trade-mark in question. The South African case, *The Drug Club et al v. Lysol Ltd.* (2), is more in point, but the Court there declined to express any opinion upon the point whether the word *Lysol* was a name given by Dammann to describe a new product or substance discovered by him, but they held, that prior to 1914, the word *Lysol* had, in South Africa acquired a distinctive meaning as signifying the particular article manufactured by Schulke and Mayr, that is to say, if originally the word was descriptive it had by subsequent user become distinctive in South Africa of the goods of Schulke and Mayr and the validity of the registered mark *Lysol* was upheld. But that is not quite the case under consideration. There is no evidence here that the petitioner's mark, even if it was once descriptive in Canada, had by long user become distinctive of the goods of the petitioner. The case was presented by counsel for the objecting party, as I have already said, on the footing that the mark was always descriptive and therefore void from the date of registration, and the petitioner did not attempt to set up the case that though its mark was originally descriptive it had become distinctive. There is no evidence whatever that in Canada, the petitioner's trade-mark was descriptive in that it was generally known as the name of the article itself. The presumption is that when the registration was made it was a valid one, and that presumption has not been repelled. I am therefore of the opinion that the petitioner's trade-mark *Lysol*, was at the time of registration properly made and that it is still a

(1) (1926) N.Z.L.R. 221.

(2) (1924) S.A.L.R. (Transvaal Prov. Div.) 614.



valid trade-mark. The only question remaining for consideration is whether the mark of the objecting party should be expunged.

As already stated, the objecting party has registered the word *Lysotab*, and this mark the petitioner seeks to expunge on the ground that it is a colourable imitation of and resembles its mark, and is so similar thereto as to be calculated to deceive or mislead the public, and to cause goods to which the same would be applied, to be sold as and for the goods of the petitioner. The objecting party now manufactures in England a disinfectant tablet, under the unregistered trade name of *Lysotab*, and it is admitted that it is its intention to manufacture or sell the same tablet in Canada, if the validity of its registered mark here in question is sustained. The objecting party applied to register the word *Lysotab*, in England, in 1929, and its application was there opposed by the Pharmaceutical Society of Great Britain, and their opposition was based upon the ground that *Lysol*, a liquid disinfectant, was in common use in the drug trade there, and, I should observe, that then the word *Lysol* was publici juris in England. This application was refused and in the decision of the Assistant Comptroller it is stated:

The word *Lysotab* is clearly formed by the elision of the final "l" from the word *Lysol* and the combination of the remaining letters of that word with the abbreviation "tab." The letters "Lyso" constitute the principal and characteristic part of the word *Lysol* and would I think be readily recognized as referring in the combined word to that substance, while the whole word *LYSOTAB* differs but slightly from the words *Lysol* tab and would I have no doubt by chemists and others be taken to mean *Lysol* tablet.

I think these words are here applicable. I think it is a fair inference that the use of the word *Lysotab* by the objecting party would be calculated to mislead the public. There would seem to me no reason why the objecting party should not be able to obtain another registration which would as well serve its purposes.

The petitioner therefore succeeds in its claim to have the registered mark of the objecting party expunged, with the usual consequence as to costs.

*Judgment accordingly.*

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