

24, 1977

JUDICIAL COMMITTEE OF THE
IN THE PRIVY COUNCIL

No. 30 of 1975

O N A P P E A L

FROM THE COURT OF APPEAL OF TRINIDAD AND
TOBAGO

B E T W E E N:

KENNETH FREDERICK PATTRON
(Trading as "THE CARIBBEAN DAILY
NEED CHEMICAL WORKS")

Appellant
(Defendant)

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- and -

COLGATE PALMOLIVE LIMITED
COLGATE PALMOLIVE (TRINIDAD) LIMITED

Respondents
(Plaintiffs)

CASE FOR THE RESPONDENTS

Record

1. This is an appeal by the leave of the Court of Appeal of Trinidad and Tobago (Hyatali C.J., Phillips and Corbin JJ.A) granted on 3rd March 1975 from a decision of that Court (Hyatali C.J., Corbin and Rees JJ.A) given on 3rd April 1974 upholding an appeal from a decision of the High Court of Justice of Trinidad and Tobago (Malone J.) given on 14th February 1972.

p.118

p.73

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2. The Respondents (the original Plaintiffs) are respectively a Canadian company and their Trinidadian subsidiary. They are hereinafter together called "Colgate" and individually "Colgate Palmolive" and "Colgate Trinidad".

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Colgate form part of a world-wide group of companies ultimate control of which is a United States company. The Appellant (Defendant) is an individual who trades as "The Caribbean Daily Need Chemical Works". He is hereinafter called Mr. Pattron.

3. Colgate sue Mr. Pattron for infringement of two registered trade marks and passing off. The registered marks are respectively the word "Colgate" registered in Trinidad under number 387 and a label incorporating as a prominent part thereof the word "Colgate" registered under number 811. Both such registrations cover, inter alia, toothpaste and there is no challenge to their validity. The claim in passing off is based upon the established reputation in Trinidad in the word "Colgate" and in the get-ups in which "Colgate" toothpaste has been sold in Trinidad. Colgate's complaint arises from Mr. Pattron's use of the word trade mark "Tringate" and from his adoption of certain features of get-up used in conjunction with that word. 10 20

4. The facts are short and not in dispute. Indeed Mr. Pattron called no evidence. Furthermore this appeal raises no questions of law. The sole issue is whether the appraisal of the facts by the Court of Appeal (in individually considered judgments) is correct. 30

pp.77 to 98

5. The essential facts are accurately summarised in the Judgment of Hyatali C.J. who found, as a principal fact, that in Trinidad an ordinary purchaser would be likely to conclude that the prefix "Trin" as part of a brand name was a derivative of Trinidad and that "Tringate" toothpaste was a toothpaste made in Trinidad. Hyatali C.J. summarised the remainder of the facts as follows : 40

p.88. 1.8
p.88. 1.13

p.95. 1.1

(1) The word "Colgate" was the surname of a person and not a word descriptive of the character and quality of a product;

p.95. 1.4

(2) As such the word "Colgate" was long associated with and had been the brand name for Colgate Palmolive's toothpaste sold in the country for upwards of 35 years;

- (3) "Colgate" toothpaste had a well-entrenched reputation as such in this market; p.95. 1.7
- (4) The word "Colgate" and the label bearing the word were validly registered as the trade marks of Colgate Palmolive; p.95. 1.9
- 10 (5) The mark "Colgate" was printed in white in a distinctive script against a red background on the boxes in which Colgate's ordinary toothpaste in tubes was sold and against a red, white and blue background on the boxes in which their fluoride toothpaste in tubes was sold; p.95. 1.11
- (6) The distinctive script was an outstanding feature of their trade marks even though no proprietary right therein existed or was claimed; p.95. 1.17
- 20 (7) Mr. Pattron in January 1970 introduced into the local market a toothpaste manufactured by him and put up in boxes bearing the name "Tringate" toothpaste; p.95. 1.20
- (8) The word "Tringate" was printed in white in a distinctive script closely similar to or almost identical with the distinctive script in white projecting the word "Colgate" in the boxes in which Colgate Palmolive's ordinary toothpaste was sold; p.95. 1.24
- 30 (9) The colours red, white and blue, were employed to compose the "Tringate" label and to portray the get up of the boxes and the tubes containing Mr. Pattron's toothpaste; p.95. 1.29
- (10) The same colours but of a brighter hue were employed to compose the "Colgate" label and to portray the get-up of the boxes in which Colgate fluoride toothpaste was sold; p.95. 1.33
- 40 (11) The last syllable in each of the two words "Tringate" and "Colgate" was not only identical in sound but was written in distinctive script in white, identical with each other save that the script of the former was larger than the latter. p.95. 1.36
6. An issue arose before the trial Judge as to

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whether Colgate could adduce evidence that, in Trinidad, the prefix "Trin-" was used by other manufacturers for certain locally made products to denote that fact. He held that such evidence could not be adduced, but nevertheless correctly arrived at the principal finding aforementioned. Accordingly the admissibility of the evidence is no longer an issue in the case.

7. The Court of Appeal held, upon the above, facts, that Mr. Pattron's use of "Tringate" and of the name and get-up concerned were each likely to lead to confusion or deception. They accordingly found both infringement and passing off. Colgate contend that those conclusions are correct and in accordance with the settled principles of law relating to infringement and passing off.

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8. As to infringement, the statutory provision in force is Section 5 (1) of the Trade Marks Ordinance No. 11 of 1955. This is in substance the same language as Section 4 (1) of the United Kingdom Trade Marks Act 1938. A Defendant infringes when he uses in the course of trade a mark "identical with or so nearly resembling the registered mark as to be likely to deceive or cause confusion". The comparison is between the registered mark and the mark used by the Defendant, in the present case between "Colgate" and "Tringate". Colgate contend that a fair inference from the facts is that many people in Trinidad, upon seeking the new product "Tringate" will either be deceived into believing that there is or wonder whether there is a connection, between that new product and the maker of the product they well know under the name "Colgate". In particular people are likely to think or suspect that "Tringate" is short for "Trinidad Colgate" or "Trinidadian Colgate".

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9. Mr. Pattron relied in the Courts below, inter alia, upon the fact that no instance of actual confusion was proved by Colgate. But it is well settled that absence of such evidence is in no way conclusive one way or the other in determining whether a deceptive resemblance exists. In the instant case the absence of proved instances of confusion is of particularly little significance. This

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10 is because such instances are most unlikely to have come to light. "Tringate" toothpaste was on sale for only 9 months and upon an unknown but minimal scale. Moreover, in the nature of things a customer who was deceived might well not know that fact, and therefore never mention the point. Further, even a customer who was deceived and discovered, it, is hardly likely to bother to follow the matter up, even with the shop where he bought the toothpaste, let alone with Colgate. Finally, if confusion had been reported to Mr. Pattron such confusion would not have come to the attention of the Court since Mr. Pattron elected not to give evidence.

20 10. The legal principles relating to passing off are again well settled. They cannot be better stated than in the words of Lord Parker of Waddington in A.G. Spalding & Bros. v. A.W. Gamage Ltd. (1915) 32 R.P.C. 273 at p.284:

30 "The basis of a passing-off action being a false representation by the defendant, it must be proved in each case as a fact that the false representation was made. It may, of course, have been made in express words, but cases of express misrepresentation of this sort are rare. The more common case is, where the representation is implied in the use or imitation of a mark, trade name, or get-up with which the goods of another are associated in the minds of the public, or of a particular class of the public. In such cases the point to be decided is whether, having regard to all the circumstances of the case, the use by the defendant in connection with the goods of the mark, name, or get-up in question impliedly represents such goods to be the goods of the plaintiff, or the goods of the plaintiff of a particular class or quality, or, as it is sometimes put, whether the defendant's use of such mark, name, or get-up is calculated to deceive".

40 11. It follows that in passing off Colgate can rely not only upon the deceptiveness of the name "Tringate" but also upon all the other factors relating to the manner in which "Tringate" was sold. In particular Colgate rely upon:

- (i) the similarity of script;

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- (ii) the use of a map of Trinidad to reinforce the "Trinidadian Colgate" impression generated by the name;
- (iii) the use of the expression "New U.S.A. Formula" which suggests some kind of connection with the United States and perhaps also that the product is a new version of an older product;
- (iv) the similarity of colours between the Tringate pack and that used for Colgate fluoride. 10

The combined effect of all these factors must, it is submitted, lead to the inference that deception is likely.

12. Accordingly it is submitted that the decision of the Court of Appeal was correct and this Appeal should be dismissed for the following among other

R E A S O N S

- 1. BECUASE, in Trinidad, "Tringate" is confusingly similar to Colgate's registered trade mark "Colgate" and therefore is an infringement thereof. 20
- 2. BECAUSE the use by Mr. Pattron of the word "Tringate" in the script and with the get-up concerned is passing off
- 3. BECAUSE the Court of Appeal was right

T. H. BINGHAM Q.C.

ROBIN JACOB 30

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