

*Judgment of the Lords of the Judicial Committee
of the Privy Council on the Appeal of
Cochrane v. Macnish and Son, from the
Supreme Court of Judicature of Jamaica,
delivered 29th February 1896.*

Present :

LORD HOBHOUSE.

LORD MACNAGHTEN.

LORD MORRIS.

SIR RICHARD COUCH.

[Delivered by Lord Morris.]

Under the firm of Cantrell and Cochrane the Appellant Sir Henry Cochrane who was formerly in partnership with a person named Cantrell but is now trading on his own sole account carries on the business of a manufacturer of aerated and mineral waters in Dublin and Belfast.

The principal part of the business of the firm is the production of soda water for consumption at home and abroad. The sales in the United Kingdom are very large; the export trade seems to be larger still.

In 1877 the firm registered in England a trade mark for soda water having the words "Club Soda" as its prominent and distinguishing feature. Their soda water with this mark became known both in the trade and by the public as "Club Soda." It was advertised ordered and invoiced as such. The result was that the term "Club Soda" came to mean Cantrell and Cochrane's soda water and nothing else.

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From the year 1887 the firm have been in the habit of shipping Club Soda to Jamaica. In the three years 1890, 1891 and 1892 the export to Jamaica amounted to 28,000 dozen.

In the early part of 1892 the Appellant was informed for the first time that the Respondents Messrs. McNish and Son were selling soda water in Jamaica as Club Soda. He then applied for registration in Jamaica in accordance with the Registration of Trade Marks Law 1888 (Law 17 of 1888) and an amending Act Law 6 of 1889. Under the Law of 1888 the proprietor of an English trade mark is entitled as of course to register it in Jamaica on lodging with the Registrar a certified copy of the entry in the English register. On obtaining registration the Appellant through his solicitors in Jamaica requested the Respondents to discontinue the use of the term "Club Soda" in connection with their soda water manufactured in the Island. They declined to do so and then this action was brought.

The Respondents' case was that the words "Club Soda" in their label were not borrowed from the Appellant's label at all. They were agents they said for the sale of some American whisky called Club Whisky and so the term suggested itself to them when they began to make soda water in 1890. They insisted that their labels and advertisements were not calculated to deceive or to lead any purchaser to believe that the soda water which they sold was soda water of the Appellant's manufacture. They further submitted that in any event the Appellant was disentitled to relief by reason of certain statements contained in his label or trade mark which they alleged to be false and misleading.

The action came on for trial on the 16th of

April 1894 before Northcote J. acting as Chief Justice. His Honour gave judgment for the Defendants with costs. He found that the words Club Soda had at the time of the commencement of the action acquired in the trade the meaning of soda water made by the Plaintiff. But he held that the Defendants although they had made use of the word Club which he said was probably "a material part of Plaintiff's trade mark as it communicated that name to his goods" had successfully distinguished their soda water from that of the Plaintiff and had made the distinction perfectly clear.

On appeal to the Supreme Court Northcote J. adhered to the view which he had expressed in his judgment at the trial. The other members of the Court Lumb J. and Jones J. concurred with Northcote J. in holding that the words "Club Soda" meant soda water made by the Plaintiff. But they were both of opinion that those words as used by the Defendants were calculated to deceive and that ordinary purchasers or consumers of soda water would be misled although the two labels were so dissimilar that the one could not be mistaken for the other. They held however that the Plaintiff was not entitled to relief by reason of his having attached to his trade mark a statement which they considered to be a misrepresentation.

As regards the first point on which there are concurrent findings and on which the evidence appears to be abundant and uncontradicted the learned Counsel for the Respondents were not in a position to dispute the conclusion arrived at in the Court below. Nor was there much to be said in regard to the second point. It is quite true that no one could mistake McNish's label for Cantrell and Cochrane's and there is little or no probability that anyone in the trade would be

deceived by the words Club Soda on McNish's label. But that is not enough. As the learned Judges who formed the majority in the Court of Appeal observed the acting Chief Justice did not sufficiently consider the danger to the consumer. In the case of casual consumers the probability of deception is obvious. People who ask for soda water at a restaurant or call for soda and whisky over the counter do not at any rate as a rule handle the bottle or examine the label. Their Lordships have no hesitation in agreeing with the Court of Appeal that the use of the words Club Soda by the Respondents is calculated to deceive. So far their Lordships agree with the Supreme Court.

Then comes the question Has the Appellant disentitled himself to the protection of the Court by reason of the representations which he has made in connection with his trade mark ?

The trade mark of the Appellant as registered in England and in Jamaica is a rectangular label with a broad band formed by parallel lines running diagonally from the lower corner on the left hand to the upper corner on the right. On this band are printed within inverted commas so as readily to catch the eye the words "Club Soda." Underneath in brackets are the words "specially prepared." In the triangular space above the band are arranged the words "Cantrell and Cochrane's Super Carbonated" and in the triangular space below the words "Works—Dublin and Belfast." As the trade mark is actually used the label containing the trade mark proper has a narrow border on each side bearing the words "Registered Trade Mark," and there is a margin or border below on which are printed the words "Manufactured in Ireland by H. M. Royal Letters Patent." The question turns on the meaning of those words.

Construed grammatically they have really no meaning. The majority of the learned Judges in the Supreme Court held that they amounted to a representation that the composition or ingredients of the article offered for sale by the Appellant as Club Soda were protected by an existing patent. The learned Counsel for the Respondents urged this view upon the Court and contended strenuously that any person reading the Appellant's label would suppose that he was invited to buy a patented article. They argued moreover that by this representation persons would or might be deterred from engaging in the manufacture of soda water. As the composition and manufacture of soda water are matters of common knowledge there does not seem much ground for apprehension on that score. And it is at least open to doubt whether the word patent as applied to soda water would be a complimentary or attractive epithet. To some the term would perhaps convey the idea that the article was not the genuine thing but a substitute prepared in accordance with the specification of some ingenious patent. At any rate it is to be observed that the Appellant has never attempted to connect the word patent with the name of the article which he makes. The words which have given rise to this controversy are not to be found in any of his advertisements or even in all his show cards. Still they are no doubt used as an advertising puff and as an attractive embellishment of his trade mark and they do certainly represent that there is a patent of some sort connected with or used in his manufacture. The Appellant and his manager were called upon for an explanation. Their explanation was this. With some slight exceptions they said we use nothing but patented

machinery in the manufacture of our soda water and for our most important machine we have an exclusive license in Ireland; the words were intended to mean "manufactured in Ireland by means of patented machinery." Considering that it is common ground that in the manufacture of soda water there is no secret and frequently no soda and that all that is required as one of the Respondents says is care and cleanliness that does not seem an unreasonable or unnatural explanation. There is no suggestion to be found in the evidence (which has certainly not been unduly limited or curtailed) tending to throw doubt on that explanation or to show that anybody has been or could be misled by words on which so much labour and attention have been spent in argument and to which apparently little or no importance is attached elsewhere. The Appellant's trade is an honest trade. And their Lordships are not prepared to hold that by reason of some words not designed to mislead and at most equivocal the Appellant has been guilty of a misrepresentation which disentitles him to relief.

The Respondents erred unwittingly at first. But as they persisted in their error after their attention was called to the fact that they were infringing the Appellant's rights their conduct in the eye of the law amounts to fraud and they must be held responsible for the consequences.

Their Lordships will therefore humbly advise Her Majesty that the Judgment of the Supreme Court ought to be reversed with costs and that the Appellant is entitled to judgment with costs awarding an injunction to restrain the Respondents from infringing his trade mark by the use of the words "Club Soda" or any words calculated to lead to the belief that soda water manufactured by them is soda water of the

Appellant's manufacture and from selling or offering for sale as Club Soda any soda water not manufactured by the Appellant.

The Respondents will pay the costs of the appeal.

