A TREATISE

ON THE

LAW OF TRADE-MARKS.

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WITH

THE TRADE-MARKS REGISTRATION ACT OF 1875,
AND THE LORD CHANCELLOR'S RULES.

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NOTE TO SECOND ISSUE.

SINCE the publication of this work the law of Trade-Marks has undergone an important alteration, by the passing of the Trade Marks Registration Act of 1875 (*a*). The Act itself and the Lord Chancellor's Rules, framed in pursuance of its provision, will be found in the Appendix to the present issue of the book. The provision of sec. 2, making registration equivalent to the public user of the mark, will necessarily diminish the importance of those cases in which the questions of duration, and extent of user have constituted the chief consideration in the judgments (*b*).

The Act does not come into full operation until the 1st of July, 1876, after which date no proceedings can be instituted to prevent the infringement of any trade-mark unless such trade-mark shall have been previously registered in accordance with the provision of the Act.

Many of the principles relating to the transfer and assignment of trade-marks are necessarily modified by, and must be taken in conjunction with, the provision of sec. 2, which enacts that a trade-mark shall only be capable of transmission in connection with the goodwill of the particular business. A provision which seems rather like substituting one difficulty for another; as the goodwill of a business is by no means always a matter of easy determination. With reference to the transmission of trade-marks, should be consulted also the Lord Chancellor's Rules from 23 to 29 (*c*).

It is perhaps to be regretted that the former practice of the court of equity of recognising the individual rights of separate owners of the same trade-mark at the same time, should have received the express sanction which it has in Rule 29.

It is carrying the protection of owners of trade-marks too far, to the detriment of other interests equally important, namely, the security of the purchaser of the goods. Out of six parties entitled to the goodwill of a business, one may be a person with whom no one would think of dealing intentionally; and yet he is to be expressly sanctioned and protected in sending his goods

(*a*) 29 & 30 Vict. c. 91, See Appendix, *post*, p. 171.
(*b*) *Vide* page 80, *et seq.* And cases there cited.
(*c*) *Vide* Appendix, pp. 183-5.

for sale, with the same mark as the goods of the other five, who may be manufacturers of superior skill.

In connection with the cases cited in Chapter IV. should be considered also a recent decision of Vice-Chancellor Malins, in the case of Raggett *v.* Findlater (*a*), as further illustrating the limits within which descriptive words can be entitled to protection as trade-marks. In that case the bill was filed by the plaintiff to obtain protection for the exclusive use of the word 'nourishing' as applied to the manufacture of stout. The bill stated that the plaintiff had devoted himself to the study of improving and bringing such stout to perfection, and rendering the same a wholesome and nourishing beverage. That he had discovered a mode by means of which his stout was rendered easier of digestion and more nourishing than other stout; and that such stout was known to the public and asked for by them as 'Nourishing Stout.'

Upon these facts, and apart from other considerations with which the question was involved, the Vice-Chancellor adopted and laid down the principle that such a word as a mere English adjective, describing the quality of the material, was not, and could not be a trade-mark from the use of which other persons dealing in the same article could be excluded.

In the course of the case another question of some importance presented itself, but did not constitute ultimately any part of the judgment of the Court.

The bill contained a statement that the plaintiff's stout was manufactured by him after a manner peculiar to himself, and that in that respect it was a different article from the stout sold by other dealers. That allegation was afterwards withdrawn, and in fact it appeared that Messrs. Truman, Hanbury, & Co. supplied the plaintiff from the same vats as they did other people.

Supposing an allegation of this kind to be substantiated by the facts, and the article itself not to be the subject of a patent, it may in a future case be a difficult question to determine how far such a circumstance will support, or militate against, a plaintiff's case: for the reason that other persons who have fairly discovered the ingredients, would have a right to make the article, and vend it by the only name by which it could be recognized by the public. In other words, the plaintiff's allegation would identify the name with the nature of the article itself, and not with his own manufacture, which latter would be the true contention in support of a trade-mark.

(*a*) L. R. 17 Eq. 29.

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TRADE-MARKS.

CHAPTER I.

FIRST PRINCIPLES OF PROTECTING TRADE-MARKS.

THE branch of the law relating to the protection of trade-marks may be considered as analogous or supplementary to the laws affecting the rights of patentees and owners of copyright; the latter securing to an inventor for a limited time the exclusive right to the manufacture and sale of a particular article of his own invention, or the exclusive right of multiplying and selling copies of some literary work; and the former securing to any person engaged in commerce the right to sell goods, whether of his own invention or not, with his own name or trade-mark attached to them; not for a limited time only, but as long as he, or, in some cases, his successors, continue to carry on the same description of business. If a man be the inventor of the articles in which he deals, he may of course, by adopting the proper means, avail himself of both these methods of protection, but otherwise, the law of trade-marks alone will not protect him in the exclusive sale or manufacture of any description of merchandize, but only in the exclusive right to sell merchandize of that description, with the representation that the goods emanated from him.

A clear appreciation of the distinction between patents and trade-marks is highly important, because in many cases there is great difficulty in affording the required protection to a trade-mark without creating privileges which could only result from a patent, or which would in some instances amount practically to a monopoly. Perhaps the best general distinction to bear in mind is, that whatever value attaches to a patented article, attaches only to the article itself or its mode of manufacture, and is independent of any particular manufacturer or vendor, while the value of a trade-mark is independent of the article itself, which may be dealt in as an article of commerce by any one, and consists entirely in the reputation of the particular individual who makes or sells it.

The general principle applicable to trade-marks is stated by Lord Cranworth to be, that any one who has adopted a particular mode of designating his manufacture has a right to say, not that other persons shall not sell exactly the same article, better or worse, or an article looking like it, but that they shall not sell it in such a way as to steal his trade-mark and make purchasers believe that the article is his manufacture (*a*).

These two branches of law secure to a trader all the benefit which he has a right to derive from his own skill and ingenuity, or his personal character and reputation. It is obvious that in any commercial community, without the advantage of some such protection, the progress of improvements in arts and manufactures could only be effected by slow degrees. Personal aggrandisement, the most powerful incentive to personal exertion, would be too doubtful a prospect to induce the sacrifice of unnecessary time or labour, or the risk of any considerable amount of

(*a*) *Farina* v. *Silverlock*, 6 De G. M. & G. 218.

capital, merely for the sake of improving any particular article of commerce.

The importance of these principles so far as they affected the rights of original inventors was first recognised by the legislature in the Statute of Monopolies, 21 Jac. 1. c. 3.

That Act was passed for the purpose of suppressing the practice which had gradually become more and more common during the two preceding reigns, of the Crown granting monopolies in certain branches of manufacture to particular individuals. It contained a clause especially enabling the Crown to grant letters patent to first inventors, for the exclusive sale or manufacture of the article of their invention for a limited number of years.

The law for the protection of trade-marks is of much more recent development, especially as it is now administered in courts of equity, being almost exclusively the growth of the last seventy or eighty years, and affords an interesting illustration of the process by which, in those courts, a few principles at first doubtful and disputed may be expanded into a complete system of jurisprudence.

That a branch of law relating so exclusively to the interests of the commercial part of the community, should not be developed until after those interests had become an important subject for protection at common law, was of course perfectly natural, and to be expected, but the reason is not quite so clear why its importance should only have been recognised, so long after the protection of traders and merchants had in other respects formed an important subject for the consideration both of the courts of law and of the legislature.

That the necessity of giving to persons engaged in trade some means of securing the exclusive benefits of their own personal reputation for skill had been felt at a com-

paratively early period, is clear from the fact that a case decided at common law as long ago as the reign of Elizabeth is reported in 4 Popham's Reports, where an action was brought by a clothier against another for having fraudulently adopted a mark used by the plaintiff to denote cloth of his own manufacture.

This case of *Southern* v. *How* is thus reported in 1 Pop. 144: "In 22 Eliz. an action upon the case was brought in the Common Pleas by a clothier, that whereas he had gained great reputation for his making of cloth, by reason whereof he had great utterance to his benefit and profit, and that he had used to set his mark to his cloth, whereby it should be known to be his cloth, and another clothier perceiving it used the same mark to his ill-made cloth on purpose to deceive him, and it was resolved the action did well lie."

From the report of this case some doubt appears to exist as to whether the action was brought by the person who bought the cloth or by the trader who claimed the exclusive right to the use of the mark; and no doubt any purchaser who had been defrauded by such a false representation would have a right of action against the person who had so deceived him, but such an action would have nothing to do with the peculiar form of remedy with which we are at present concerned, namely that by the owner of the mark. Although fraud is the essence of the action at common law, the remedy being an action on the case for deceit, there is, in this application of the remedy the remarkable feature that the deceit or falsehood upon which the action is based is one practised upon another person than the plaintiff, and by means of which he himself, although he suffers an injury, has not been actually deceived. It has been said "that a fraudulent misrepre-

sentation occasioning damage, the falsehood whereof the person to whom it is made has no means of detecting, is actionable" (*a*).

When it is said generally that a fraudulent misrepresentation is actionable, the right of action is assumed to rest in the person who has suffered injury by being imposed upon.

A fraud in law is committed where a representation is made which the party knows to be untrue, and which is calculated from the mode in which it is made to induce another to act on the faith of it *so that he may incur damage;* the intention to defraud being presumed from the act of misrepresentation (*b*); but the difficulty in applying any *dicta* of this nature to this peculiar form of action is, that the plaintiff has not in these cases incurred damage through according belief to the falsehood. But after this, no further attempt to protect this description of property appears to have been made until the case of *Blanchard* v. *Hill* (*c*) in equity, in the year 1742, in which case Lord Hardwicke seems to have expressed a strong opinion that there was no authority for granting an injunction to restrain any such act as the one complained of, and that it was impossible that any such suit could be maintained in a court of equity.

The only other cases in which the question appears to have been raised before the beginning of the nineteenth century were the cases of *Singleton* v. *Bolton* in 1783, and *Webster* v. *Webster* in 1791, in both of which cases the possibility of a court of law or equity having jurisdiction for the protection of an exclusive right to a trade-mark was undoubtedly recognised.

(*a*) Comyns' Dig. 'Action on the Case for Deceit,' A 9.
(*b*) *Polhill* v. *Walter*, 3 B. & Ad. 114. (*c*) 2 Atk.

The truth is, that during the whole of this interval, and particularly during the seventeenth and part of the eighteenth centuries, although the protection of trade formed a subject of almost paternal care on the part of the legislature, and was continually becoming of more and more importance in the courts of law, the principles upon which the necessity for according their protection was recognised were entirely opposed to that which at the present day is the fundamental one upon which the law of trade-marks is based.

Probably the pernicious system of granting monopolies to individuals in particular branches of manufacture, which had been arbitrarily adopted by the Crown during the sixteenth and early part of the seventeenth centuries, had done much to engender a strong feeling of suspicion against all attempt made by one individual to restrain the exercise by others of a similar trade to his own. Monopolies were always an illegal assumption of authority by the Crown, and were regarded with utter detestation by the people. Their evils were intolerable, and of a nature to make themselves felt by the humblest and poorest classes of the community, and the methods used to enforce them were, if possible, more insupportable than their natural and inevitable consequences. It is very natural, then, that for some time after their express abolition by the statute of James the First, there should have remained, both in the minds of the public and in the courts of law, a strong disposition to regard with distrust any proceeding, the object of which was to place restriction upon the manufacture or business of an individual trader.

Even in *Blanchard* v. *Hill*, in which the subject-matter of the suit had once been the subject of a monopoly, which, of course, had ceased to exist, although protection was only

sought for the exclusive use of a trade-mark, Lord Hardwicke seems to have thought it impossible to grant an injunction without incurring a risk of countenancing the old system which had been condemned and declared illegal.

But besides the difficulty which Lord Hardwicke seems to have felt in distinguishing between the enjoyment of the exclusive right to a trade-mark and the enjoyment of a monopoly, he said that he knew of no instance in which the court had granted an injunction to restrain one trader from using the mark of another, and that it would be of mischievous consequence to allow such a remedy; and denied the force of the objection that the trader was injured by loss of custom; that is, injured in the sense of sustaining '*injuria*' as well as '*damnum*,' and said that there was no more weight in the objection than there would be in one innkeeper setting up the same sign as another.

But it must be remembered that in the case of an inn the identity of the house depends entirely upon its locality, and its business could not be illegally prejudiced by another house with the same sign setting up at anything like a moderate distance. If the rival house were opened within two or three doors, so that customers might be deceived into mistaking one for the other, it is apprehended that this would be an interference with the trade of the original house that a court of equity would be willing to restrain. Indeed in the case of *Howard* v. *Henriquez* (*a*), in America, protection was granted to the owner of an hotel to restrain such an improper use of his trade-mark.

Lord Hardwicke, moreover, refused to entertain the argument that the defendent was taking away the plaintiff's customers, insisting upon his right to do so.

(*a*) 3 Sand. S. E. 722.

But although any man has a perfect right to take away the customers of another if he can, he must take care that no act of his own will lead the customers to think that they are not so taken away.

A trade-mark may be said to be any symbol, or mark, or name, or other indication, which when affixed to goods offered for sale in the market would convey to the minds of purchasers the impression that those goods were the manufacture of some person or firm, or some particular place. By the expression "other indication" is intended such other modes of conveying this impression to the public as may consist of, for instance, any peculiar mode of tying bundles of goods, or of peculiarly shaped bottles or boxes, or any other circumstance connected with the sale of the goods which has been always exclusively associated with the plaintiff's manufacture or business.

From the extreme variety of forms which a trade-mark is capable of assuming, it can hardly be made the subject of a concise definition. It is almost impossible to conceive of any symbol, or mark, or name, or combination of such marks or names which may not, under proper circumstances, be entitled to protection as a trade-mark.

In *Gout* v. *Aleploglu* (*a*) the word "warranted" put on the article in Turkish letters was protected as a trade-mark, because the article being offered for sale in England the word "warranted" in Turkish letters would be unintelligible, and no more than an arbitrary symbol.

A peculiar and original system of numbering the spools upon which thread was wound to indicate the quality of the thread, the system being different from that in use among other makers, was held capable of being protected as a trade-mark (*b*).

(*a*) 6 Beav. 69. (*b*) *Ainsworth* v. *Warmsley*, L. R. 1 Eq. 518.

A trade-mark is not of the same nature as a patent or copyright and much less does it retain any characteristics which might be supposed to have attached exclusively to a monopoly.

With respect to its ownership by an individual it only retains its peculiar privileges in the possession of that individual whilst it is affixed to goods of that particular class to which he has been in the habit of applying it.

As regards the application of it to any other description of goods, he has no more interest in its use than any other member of the community.

The distinction between a trade-mark and copyright is well explained in the judgment of Lord Cranworth in *Farina* v. *Silverlock* (*a*). In that case a suit was brought by the owner of a trade-mark which consisted of a label used for the purpose of being fastened to bottles of Eau de Cologne manufactured by the plaintiff, to distinguish Eau de Cologne of the plaintiff's manufacture. A bill was filed to restrain the defendant, a printer, from printing and selling labels similar to those of the plaintiff. The evidence shewed that the labels, after being printed and sold by the defendant, might be afterwards affixed to bottles of Eau de Cologne really manufactured by the plaintiff, or bottles containing Eau de Cologne of some other manufacturer. An injunction was granted by the court, but on appeal the Lord Chancellor refused to affirm this decision, and retained the bill, giving leave to the plaintiff to bring such action as he might be advised at law. Subsequently, the plaintiff having brought an action, and succeeded in obtaining a verdict, the injunction was granted by the court.

In giving judgment, Lord Cranworth said: "This is not

(*a*) 1 K. & J. 509; 6 De G. M. & G. 214.

properly described as copyright, because it is no right at all unless it can be said to exist only, and be tested by, its violation. It seems to me clear that any man who has got any of the Eau de Cologne of Johann Maria Farina and has not got a label, might employ any printer he thought fit to engrave for him a stamp the exact counterpart of that used by the plaintiff. Then there is no copyright in it. All that the law restrains a person from doing is, from selling the article which is not the manufacture of Johann Farina with the label of Johann Farina upon it. But if it be an article manufactured by Johann Farina, he must not complain that it is sold with something on it to represent his trade-mark. The gist of a trade-mark in an action at law would be this: that he sold as and for the manufacture of the plaintiff something that was not his manufacture, and this supposed label is put upon it in order to make it more apparent that it is his manufacture. Therefore, I think it is clear that any man, if he be capable of printing and engraving, may print and engrave for himself a label being a copy or colourable imitation of the plaintiff's, and put it on any Eau de Cologne that was the Eau de Cologne of the plaintiff's" (*a*).

In the case of the *Leather Cloth Company* (*Limited*) v. *The American Leather Cloth Company* (*Limited*) (*b*), the same learned judge remarked: "The right to a trade-mark is a right closely resembling, although not the same as, copyright. The word 'property,' when used in regard to an author's right to the productions of his brains, is used in a sense very different from what is meant by it when applied to a house or a watch. It means no more than that an author has the sole right of printing, or otherwise multiplying, copies of his work.

(*a*) See also *M'Andrew* v. *Bassett*, 33 L. J. (Eq.) 561. (*b*) 35 L. J. (Eq.) 53.

The right which a manufacturer has to the use of a trade-mark is the exclusive right to use it for the purpose of indicating where, or by whom, or at what manufactory the article to which it is applied was made."

The first principle upon which the courts of law and equity have interfered for the protection of trade-marks appears to be, that one man shall not be allowed to sell his goods as the goods of another.

In the exercise of this jurisdiction by the courts, two other principles are necessarily involved: the prevention of fraud upon the public, and the protection of the property of the plaintiff; because when a man is selling goods of his own manufacture as the goods of another, he does in fact violate both these principles of right. He is defrauding his customer by inducing him to purchase something different from that which he thinks he is buying, and he is injuring the property of the plaintiff by palming off inferior goods as the manufacture of the plaintiff, and by diverting to his own pocket profits to which the plaintiff was legally entitled; and whether he do this with the deliberate intention of deceiving, or merely accidentally, is, in a court of equity, immaterial.

In *Farina* v. *Silverlock* (*a*); the Lord Chancellor observed: "The right is a right on the part of a person designating his goods by a particular trade-mark, to prevent anybody else from selling wares which are not those manufactured by the plaintiff with that trade-mark, in order to mislead the public, and so incidentally to injure the person who is the owner of the trade-mark."

From this it would rather seem that the first consideration in a court of equity is the prevention of a fraud upon the public; and to a great extent this will be found

(*a*) 26 L. J. (Eq.) 11, 790.

to be always the case; because, although as regards the position of a plaintiff in a court of equity, he himself can only claim protection against an injury done to his own property, still whatever property he can be said to have in his trade-mark, consists only in the security which the public have that they are not defrauded by any one in respect of its use. In other words, the public, relying upon the assurance that the article was of the plaintiff's manufacture, would buy the thing in preference to another, and would be willing to pay, probably, an increased price for its superior quality, and as soon as this assurance ceases, this extra demand and increased value, which constitute the plaintiff's property in this respect, will disappear. Still, the prevention of a fraud upon the public will not of itself justify a plaintiff in seeking the protection of the court, unless his own property is endangered by the wrongful act of the defendant.

From the case of *Batty* v. *Hill* (*a*), we see that the protection of the public from fraud will not, by itself, entitle the plaintiff to an injunction.

In that case the plaintiff and defendant were both makers of pickles, and the plaintiff having obtained a prize medal at the Exhibition of 1862, stamped the word "prize medal" on his bottles. The defendant, without having obtained a medal, falsely printed the same words on his labels. Sir W. P. Wood remarked: "The defendant has superadded then to his labels this representation, which the plaintiff has also added to his; the difference being, that the representation is true on the part of the plaintiff, false on the part of the defendant. On that point there arises, as I have said, a presumption against the defendant; but he must be held entitled to use those

(*a*) 1 H. & M. 369.

labels, false though they be, if they do not interfere with the plaintiff's rights."

In *Clark* v. *Freeman* (*a*), the court would not interfere to restrain the defendant from selling pills of his own make as "Sir J. Clarke's Consumption Pills," Sir J. Clark being a physician of great eminence and repute, the court holding, that although the defendant was practising a gross fraud upon the public, and that it was a libel to impute to a physician of eminence the manufacture of quack medicine, yet as Sir J. Clark had not sold pills with his own name attached, he could not claim the protection of the court, as against an infringement of a trade-mark.

Also in *Hall* v. *Barrows* (*b*), it was said by Sir John Romilly, citing Lord Loughborough in *Webster* v. *Webster*: "Lord Loughborough refused the injunction, and stated that fraud on the public is no ground for a plaintiff coming into this court; that is, as I understand it, by a person who has no interest in the subject-matter by which the fraud is committed. And this is in accordance with the constant principle prevailing both at law and equity, that is, although the courts will discountenance and do nothing to assist any false representation, still they do not deal with the general interest of the public, having no property in the subject-matter, or the suit must be at the suit of the Attorney-General."

Although there can be no doubt at the present day that the true ground for the interference of a court of equity for the protection of a trade-mark is, with respect to the plaintiff, property and the protection of property, there may be found in the cases, expressions by many eminent judges which appear to indicate the existence

(*a*) 12 W. R. 305. (*b*) 32 L. J. 551.

of a doubt whether the jurisdiction of the court was not based upon the prevention of fraud in the defendant, rather than the protection of the property of the plaintiff.

That in most of the judgments in these cases there should occur reflections upon and allusions to the fraud of the defendant is very natural; partly, because in most instances where a close resemblance exists between the two trade-marks, that resemblance is obviously the effect of design rather than of accident, and partly, because fraud on the part of the defendant, though not an essential ingredient in the right to an injunction, is often an important element in the consideration of the costs. Still, although at common law, proof of a fraudulent design on the part of the defendant is essential, in a court of equity the entire innocence of the defendant will not deprive the plaintiff of his right to an injunction, provided the court be satisfied of the general resemblance of the two marks.

At law, the proper remedy is by an action on the case for deceit; and proof of fraud on the part of the defendant is of the essence of the action; but a court of equity will act upon the principle of protecting property alone, and it is not necessary for the injunction to prove fraud on the part of the defendant, or that the credit of the plaintiff is injured by the sale of an inferior article.

The injury done to the plaintiff in his trade by loss of custom is sufficient to support his title to relief (*a*).

In *Burgess* v. *Hill* (*b*), the Master of the Rolls said: "The case is this. The plaintiffs have a right to a particular label: that right is interfered with by the de-

(*a*) *Edelston* v. *Edelston*, 1 De G. M. & G. 196; 9 Jur. 478.
(*b*) 26 Beav. 266.

fendant, but it being impossible for the plaintiff to tell to what extent his right is interfered with, he applies to the court to restrain his interference. I fully believe the defendant did not know he was doing wrong, and that he believed he had a right to sell this article. But it is a very old and very necessary legal maxim, that *ignorantia juris neminem excusat.* It is impossible to allow a person to escape from his liability when he has injured the rights of another on the plea that he acted in ignorance of that person's rights."

Also in *Hall* v. *Barrows* (*a*), Lord Westbury, referring to the case of *Millington* v. *Fox,* said: "This case not only shews that the name of the first maker may become in time a new sign of quality, but is very important as establishing the fact that the jurisdiction of this court in the protection of trade-marks rests upon property, and that fraud in the defendant is not necessary for the exercise of that jurisdiction."

Also *per* Malins, V.C., in *Wotherspoon* v. *Currie* (*b*): "These matters, I should say, do not depend upon intention. A man may issue a label or trade-mark like another's, with the most innocent intention possible, yet the law is settled that if, in truth, the mark is such that it is calculated to mislead, the use will be prohibited in this court."

And in *Millington* v. *Fox* (*c*), *per* Lord Cottenham: "I see no reason to believe in this case, that there has been a fraudulent use of the plaintiff's trade-mark. It is positively denied by the answer; and there is no evidence to shew that the defendants were ever aware of the existence of the plaintiff as a company manufacturing steel. . . . In short, it does not appear to me, that there

(*a*) 33 L. J. 204. (*b*) 18 W. R. 564. (*c*) 3 Milne & Craig, 338.

was any fraudulent intention in the use of the marks That circumstance, however, does not deprive the plaintiffs of their right to the exclusive use of those names" (*a*).

Although the jurisdiction of a court of equity rests upon property, it has been frequently said by many eminent judges that there is no property in a trade-mark; and this upon reflection will appear to be perfectly consistent, because, although property is protected by the injunction, that property is not the ownership of the symbols which constitute the trade-mark, but that which is the result of the exclusive right to apply them to a particular class of goods.

In the application of them to goods of any other description the owner has no more right than any one else, and consequently no exclusive right at all.

This is very clearly put by Lord Westbury in *Hall* v. *Barrows* (*b*): "It is true that in some cases are found *dicta* by many eminent judges, that there is no property in a trade-mark, which must be understood to mean that there can be no right to the exclusive ownership of any symbols or marks universally in the abstract; thus, an ironfounder who uses a particular mark for his manufacture in iron, could not restrain the use of the same mark when impressed upon cotton or woollen goods; for a trade-mark consists in the exclusive right to the use of some name or symbol as applied to a particular manufacture, and such exclusive right is property."

Also, *per* Lord Westbury in *The Leather Cloth Company* (*Limited*) v. *American Leather Cloth Company* (*Limited*) (*c*): "It is correct to say that there is no exclusive ownership of the symbols which constitute a trade-mark apart from

(*a*) See also *Welch* v. *Knotts*, 4 K. & J. 751.
(*b*) 12 W. R. 322; 33 L. J. (Eq.) 204. (*c*) 35 L. J. 53.

the use or application of them; but the word "trade-mark" is the designation of marks or symbols when applied to a vendible commodity, and the exclusive right to make such user or application is rightly called property."

In cases where the word constituting the trade-mark is preceded by the name of the maker or owner of the mark, some difficulty appears to exist in applying strictly the principle of equity on which these cases depend, namely, that a man shall not sell his goods as the goods of another, and a right more closely analogous to the nature of an actual property in the mark itself may be traced. Because, when a man, in the position of a defendant, has always been in the habit of affixing openly his own name to his own goods, whether with or without other *indicia*, it seems hard to hold that he has been passing off his goods as the goods of another.

Nevertheless, the courts have several times restrained the use of a plaintiff's trade-mark under such circumstances, and there can be little doubt that such a course will be followed in future.

In *Perry* v. *Truefitt* (*a*), the Master of the Rolls was of opinion that this question should be decided at common law before granting an injunction.

In that case the plaintiff having manufactured and sold, for a considerable time, a greasy mixture for the hair, which he called Medicated Mexican Balm, the defendant manufactured and sold another greasy compound, whether containing the same ingredients or not did not appear, with the name Truefitt's Medicated Mexican Balm. The Master of the Rolls said, he thought the defendant intended cautiously to guard against selling the stuff alleging it to be the manufacture of the plaintiff, and that

(*a*) 6 Beav. 75.

the defendant thought that by applying the name of Truefitt he prevented any imputation on him that he was selling Perry's article, but that the question should be properly left to a jury to determine his legal right.

In a more recent case of *Braham* v. *Bustard* (*a*), the plaintiff having invented a species of soap, and denominated it "Excelsior White Soft Soap," the defendant manufactured and sold other soap as Bustard & Co.'s "Excelsior White Soft Soap." Vice-Chancellor Page Wood made the following order to restrain the defendant: "Restrain the defendant from selling, or advertising, or exposing for sale any soap under the name of 'Excelsior White Soft Soap,' or any words so contrived as to lead to the belief that the article sold by the defendant is the plaintiff's manufacture."

So also in *Kinahan* v. *Bolton* (*b*), the plaintiff sold whisky as Kinahan's LL Whisky, and the defendant commenced selling whisky as Bolton's LL Whisky; notwithstanding the distinct use of their names by both parties the court granted an injunction to restrain the use of the letters LL by the defendant.

In *Ford* v. *Foster* (*c*) the plaintiff, who was a maker of shirts, was in the habit of selling his shirts as "Ford's Eureka Shirts," and it was urged on behalf of the defendant that as the plaintiff had always marked his shirts as "Ford's Eureka Shirts," and as the defendant had only adopted the term "Eureka," it was impossible that the public could be deceived by such means. This objection was overruled on appeal by the Lords Justices, on the ground that the word "Eureka" so used was the mark by which the public would be influenced in purchasing the shirts. "It is quite obvious," said Mellish, L.J., "that although he

(*a*) 1 H. & M. 456. (*b*) 15 Ir. R. 75. (*c*) 7 L. R. Ap. 613.

adds the word 'Ford' for the purpose of enabling people to come to him, and in order to tell them when you buy a Eureka shirt you must buy it of Ford, yet a large number of persons who read these advertisements would be attracted by, and remember, the word 'Eureka,' and would wholly forget the word 'Ford.'"

CHAPTER II.

STATUTORY AND COMMON LAW REMEDIES.

THE remedies available to a person whose trade-mark is being infringed are, by filing a bill in equity, by bringing an action on the case for deceit at common law, by prosecution under the Merchandise Marks Act, and by indictment for obtaining money under false pretences.

In the case of *Reg.* v. *Smith* (*a*) an indictment was drawn against J. Smith for forgery under the following circumstances. It appeared that one Borwick, the prosecutor, manufactured baking-powder and egg-powder, which powders he invariably sold wrapped up in papers with a printed description and his name. Smith procured ten thousand wrappers to be printed very nearly similar to Borwick's. In these wrappers he enclosed powders of his own, which he sold as Borwick's powders. He was indicted and convicted for forgery. It was held by the Court of Criminal Appeal that the conviction was wrong.

"I agree," said Willes, J., "in the definition of forgery at common law, that it is the forging of a false to represent a genuine document. That does not apply here, and it is quite absurd to suppose that the prisoner was guilty of ten thousand forgeries as soon as he got the wrappers from the printer; and if he had distributed them over the whole earth, and done no more, he would have com-

(*a*) *R.* v. *John Smith*, 8 Cox, Crim. Cas. 32.

mitted no offence. The fraud consists in putting inside the wrappers powder which is not genuine, and selling that. If the prisoner had had one hundred genuine wrappers and one hundred not genuine, and had put genuine powder into spurious wrappers, and spurious powders into genuine wrappers, would there have been any forgery in that? This is not one of the two different kinds of instruments which may be made the subject of forgery. It is not made the subject of forgery simply by the assertion of that which is false. In cases like the present the remedy is well known: the prosecutor may if he pleases file a bill in equity to restrain the defendant from using the wrapper, or he may bring an action at law for damages, or may indict him for obtaining money under false pretences: but it would be straining the law to hold that this was forgery."

In *Reg.* v. *Dundas* (*a*) an indictment for false pretences was sustained by evidence that the prisoner had sold to the prosecutor blacking which he asserted to be "Everett's Premier," and which bore a label nearly, but not precisely imitating Everett's labels, the said blacking not being "Everett's Premier," but a spurious manufacture of his own. In his charge to the jury Mr. Justice Erle remarked, that it was of little consequence whether the man's name was Everett, as he had stated, or not; for even if it were, and he went about the country and offered blacking for sale as "Everett's Premier," representing it to be the well-known article of that name, and knowing it was not so, and intending to cheat the prosecutor by passing upon him a spurious article as the true one, his conduct was equally fraudulent (*b*).

(*a*) 6 Cox, Crim. Cas. 380.
(*b*) See also *Reg.* v. *Bryan*, 7 Cox, Crim. Cas. 312.

In 1862 was passed the Merchandise Marks Amendment Act, with the object, as stated in the preamble, of amending the laws relating to the fraudulent marking of merchandise, and to the sale of goods falsely marked, for the purpose of fraud. The provisions of the Act are directed principally against the forging or counterfeiting any trade-mark with intent to defraud; the applying a genuine or forged trade-mark with intent to defraud to anything not being the manufacture of any person denoted or intended to be denoted by such trade-mark; and the applying any genuine or forged trade-mark with intent to defraud to anything not being the peculiar or particular description of manufacture denoted or intended to be denoted by such trade-mark: those offences, together with a similar application of a forged or genuine trade-mark to any cask, or case of any description, containing an article, being made misdemeanours.

By section 5 it is enacted, that "every addition to, and every alteration of, and also every imitation of any trade-mark, which shall be made, applied, or used with intent to defraud, or to enable any other person to defraud, or which shall cause a trade-mark with such alteration or addition, or shall cause such imitation of a trade-mark, to resemble any genuine trade-mark so or in such manner as to be calculated or likely to deceive, shall be and be deemed to be a forged or counterfeited trade-mark, within the meaning of this Act; and every act of making, applying, or otherwise using any such addition to, or alteration of, a trade-mark, or any such imitation of a trade-mark, as aforesaid, done by any person with intent to defraud, or to enable another person to defraud, shall be, and be deemed to be, a forging and counterfeiting a trade-mark, within the meaning of this Act."

The following definition of a trade-mark, is given in the first section:

"The word 'mark,' shall include any name, signature, word, letter, device, emblem, figure, sign, seal, stamp, diagram, label, ticket, or other mark of any other description; and the expression 'trade-mark' shall include any and every such name, signature, letter, device, emblem, figure, sign, seal, stamp, diagram, label, ticket, or other mark as aforesaid, lawfully used by any person to denote any chattel, or (in Scotland) any article of trade, manufacture, or merchandise, to be an article or thing of the manufacture, workmanship, production, or merchandise of such person, or to be an article or thing of any peculiar or particular description made or sold by such person, and shall also include any name, signature, word, letter, number, figure, mark, or sign which in pursuance of any statute or statutes for the time being in force relating to registered designs is to be put or placed upon, or attached to, any chattel or article during the existence or continuance of any copyright, or other the right acquired under the provisions of such statutes or any of them."

In the interpretation of this section there is some doubt as to the meaning to be ascribed to the word "lawfully" as it is there used.

There can be little doubt that a man could not be said to be lawfully using a mark to denote his goods if he applied, in contravention of the provision of section 2 (*a*), to an inferior description of goods a mark which he had been in the habit of affixing to goods of a superior quality of his own manufacture.

Neither could the use be said to be lawful if any part of

(*a*) *Vide* Act, Appendix.

the prosecutor's label contained, in violation of sections 7 and 8, any fraudulent statement respecting the number, quantity, measure, or weight of the article or chattel, or any *fraudulent* representation that the chattel was the subject of any existing patent, copyright or privilege.

And in answer to a prosecution under this Act, there seems no reason why a defence should not be set up that the trade-mark as used by the prosecutor was in itself a colourable imitation of a mark already and previously adopted by another person; and a further difficulty might be felt in determining whether the evidence in support of such defence ought to shew a fraudulent piracy on the part of the prosecutor, or merely such an accidental resemblance as a court of equity would restrain. The prosecutor, in such a case, could not be said to be lawfully using it, and the prosecution would be based upon the definition of a trade-mark. In section 12 it is provided that in any indictment, information, conviction, pleading, and proceeding against any person for any misdemeanour or other offence against the provisions of the Act, in which it shall be necessary to allege or mention an intent to defraud, it shall be sufficient to allege or mention that the person accused of having done such act, did it with intent to defraud, without alleging or mentioning an intent to defraud any particular person.

Still, an intention to defraud some one is necessary, but though necessary, not sufficient, without shewing the existence of the alleged trade-mark; and a trade-mark not being a chattel, has no existence so long as any doubt is felt as to its proper ownership.

Another question in connection with the meaning of the word "lawfully" in the above definition is, whether it is

to be understood as referrring to a use of the mark which is so far lawful that it could not be restrained by another, or whether it is intended to apply to such a use of the mark as would be considered lawful in a court of law or equity.

It is difficult to imagine that the legislature intended to protect by a criminal procedure property which in a civil court would have no existence at all.

And when it is considered that the existence of this description of property often depends upon equitable principles the application of which requires very great discrimination, it will readily be seen that questions may be constantly arising before a bench of magistrates which such a tribunal would be obviously unfitted to determine.

As in the case of *Morgan* v. *M'Adam* (*a*), where the plaintiffs took out summonses against the defendants under the Act for the infringement of the plaintiffs' mark; on the hearing of which the defendants objected that the plaintiffs, by reason of the improper use of the term "patent" as part of the designation of their goods, were disentitled to the protection of the statute, and the summonses had to be dismissed.

In an edition of the Act published in 1862, with notes and comments by Mr. H. Poland, the learned writer has expressed his opinion, that although a court of equity will not interfere in certain cases, it does not follow that the trade-mark is not lawfully used; that is, in the sense in which the word "lawfully" ought to be interpreted in the above definition:

"That where goods have become known in the market by a particular mark, which contains such false statements that a court of equity will not protect its use, it could

(*a*) 36 L. J. 228.

scarcely be successfully contended that it is not lawfully used within the meaning of the Act, when proceedings are instituted by or on behalf of the Crown against a person who has forged such trade-mark, or wrongfully applied it with intent to defraud."

In every case in equity since 1862, where misstatements in the trade-mark itself, of a nature calculated to deceive a purchaser, have been shewn to exist, the courts have, on that ground, refused to interfere to protect the plaintiff, by granting an injunction; and in a recent case of *Ford* v. *Foster*, Lord Justice Mellish has expressed a very strong opinion that, notwithstanding the authority of *Sykes* v. *Sykes*, the existence of a gross misrepresentation embodied in the trade-mark itself would preclude the recovery of damages in an action at common law. It is still doubtful whether that opinion of the learned judge, being *obiter dictum*, would overrule the decision of *Sykes* v. *Sykes* in respect of the improper use of the word "patent," under similar circumstances; but his lordship's opinion is very decided that a gross misstatement in the trade-mark itself would be sufficient answer to an action at law; and that where the trade itself was fraudulent no action would be maintainable.

Should this *dictum* of Lord Justice Mellish be correct, it follows that in such a case, a person claiming the right to use the mark has absolutely no property in it, either in law or equity, and consequently no exclusive property in it at all.

Can it be said then that he is lawfully using it to denote any article to be an article or thing of his own manufacture, workmanship, production, or merchandise, when he must be supposed to know, on the principle that *ignorantia juris neminem excusat*, that he is claiming a

right for the maintenance of which the law will not afford him any protection?

The intention of the legislature in framing the Act, clearly was not to create a new description of trade-mark, the imitating of which should be a misdemeanor, but to provide a simpler and more efficient remedy for such trade-marks as were recognised by law at that time.

Moreover, the existence of a misstatement in the trade-mark is not the only question which may be involved in the consideration of the meaning of the word "lawfully" in this definition. Questions of some difficulty may, and in fact often do arise, as to how far the mark in question may have become in course of time *publici juris*, so that a court of law or equity would not, for that reason, restrain its use by a defendant; or the trade-mark may have been the subject of an assignment or transfer, and a doubt may be raised whether the mark was one which could properly be made the subject of a legal transfer. Supposing any such points to be insisted upon on behalf of a defendant in a proceeding under this Act, would it be sufficient answer to say, that he had with fraudulent intent imitated a mark of some sort, and that it was no matter whether the mark was an exclusive one or not?

If the selling of goods with false representations marked upon them, with intent to defraud, had been all the legislature intended to deal with, no definition of a trade-mark would have been requisite at all; and the provisions of sections 7 and 8, concerning the sale of goods with false statements as to their number, weight, quantity, or place or country of manufacture, might have been extended, so as to include false representations of any other description.

In the 2nd and 3rd sections of the Act it is provided,

that in the event of any person being convicted of forging or counterfeiting a trade-mark, or falsely applying a forged or genuine trade-mark, he shall be guilty of a misdemeanor, and shall forfeit to Her Majesty every chattel and article belonging to such person to which he shall have so unlawfully applied any such trade-mark, or forged or counterfeited trade mark, and any instrument in the possession or power of such person by means of which any such trade-mark or forged and counterfeited trade-mark shall have been applied, and also any instrument in the possession or power of such person for applying such trade-mark as aforesaid. As the articles or chattels upon which the mark has been unlawfully applied may be in many cases of considerable value, the forfeiture of them would often be a very serious element in the punishment, but the confiscation of an article of such trivial value as an instrument adapted for the manufacture or the application of a trade-mark, could hardly be intended as a substantial addition to the consequences of a conviction, which may result in a term of imprisonment for any period not exceeding two years; and it is difficult to resist the conclusion that, in the construction of those clauses and in giving, under section 21, to a court or judge, during the process of a suit at law or in equity, the power to make an order for the inspection of any manufacture or process carried on by the defendant, and every instrument in the possession of the defendant, used, or capable of being used, for the producing or the application of the trade-mark in question, the framers of these sections considered that after a conviction or verdict against a defendant there should be in the possession or continued use of such instruments something of an illegal nature, as there would be in the possession by any person of an instrument or engine for

the manufacture of counterfeit coin, or the printing of Bank of England notes.

Now it is perfectly clear that both at common law and in equity and under these sections the fraudulent act, against the perpetrator of which proceedings are taken, is not the making or printing of the mark itself, but the application of it to one particular species of goods; and although it is against the *forging* of a trade-mark that the provisions of this Act are directed, the forgery should not consist in the printing of the labels in question, but in affixing them, when made, to bottles or packages containing the spurious article.

And even in the case of such things as peculiarly-shaped bottles, used by the plaintiff or prosecutor to contain materials of his manufacture, although bottles precisely similar were made by another person, there would be no forgery of a trade-mark until the bottles had been used in the sale of some substance similar to the plaintiff's manufacture.

There does not appear, therefore, to be any meaning in depriving a defendant of articles which he may put to a perfectly legitimate use in any way, except one, that he thinks proper.

The courts of common law and equity having concurrent jurisdiction in cases of trade-marks, a person seeking redress for injuries sustained through a piracy of his mark may at his option either bring an action on the case for deceit, or may file a bill in equity praying for an injunction to prevent the continuance of the injury; or he may first obtain a verdict at law, and then apply to equity for an injunction to render his legal right more secure.

The proceedings at law and equity in cases of this de-

scription are not, however, equally convenient, nor are the remedies provided respectively by verdict and decree equally efficacious. At common law a plaintiff cannot succeed in obtaining a verdict without alleging and proving a wilful fraud on the part of the defendant, proof of which is immaterial in a court of equity, and as the injury to the plaintiff's business is as great whether the trespass of the defendant be intentional or not, it is clear that the remedy which must be applicable in either case is safer and more easily adopted. Moreover, by a decree in equity the plaintiff may obtain an injunction to restrain the repetition of the wrongful act complained of, accompanied in many cases by an inquiry into damages, or an account of the profits made by the defendant in consequence of the trespass, whereas by the verdict of a jury he can generally only obtain an award of damages to compensate him for past injuries.

It is provided now by the Merchandise Marks Act, 1862, section 21, that in any suit at law or in equity against any person for forging or counterfeiting a trade-mark, in which the plaintiff shall obtain a judgment or decree against the defendant, the court shall, or may, upon giving judgment for the plaintiff, award a writ of injunction to restrain the defendant from committing or repeating any offence or wrongful act of the like nature as that of which he shall have been convicted by such judgment.

By the Common Law Procedure Act, 1854, section 79, it is provided that in all cases of breach of contract or other injury, the party injured may, in like case and manner as thereinbefore provided with respect to mandamus, claim a writ of injunction against the repetition or continuance of such breach of contract or other injury, or the committal of any breach of contract or injury of a like kind, coming

out of the same contract or relating to the same property or right; and by section 80 of the same Act it is enacted that the writ of summons shall be of the same form as the writ of summons in any personal action; but on every such writ or copy thereof there shall be indorsed a notice that in default of appearance, the plaintiff may, besides proceeding to judgment and execution for damages and costs, apply for and obtain a writ of injunction.

Upon this condition being complied with, power is given to the court or judge, under section 82, upon an *ex parte* application of the plaintiff, at any time after the commencement of the action, to grant or deny a writ of injunction upon such terms as to such court or judge shall seem reasonable and just; so that it seems that the only only additional power to grant an injunction accorded to a court of law under section 21 of the Merchandise Marks Act would be in cases where the writ of summons had not been indorsed in the manner above specified.

The most important cases decided at common law are: *Sykes* v. *Sykes*, 3 B. & C. 541; *Blofield* v. *Payne*, 4 B. & Ad. 410; *Morison* v. *Salmon*, 2 M. & G. 385; *Crawshay* v. *Thompson*, 4 M. & G. 357; *Singleton* v. *Bolton*, 3 Doug. 293; *Farina* v. *Silverlock*; *Rodgers* v. *Nowill*, 5 C. B. 109.

Although a court of equity will in many cases at once interfere by injunction to restrain an injury to the plaintiff's trade by the piracy of his trade-mark, still it must be remembered that in making use of that authority, its jurisdiction is only ancillary to the legal right of the plaintiff, and is exercised to make a clear legal title of the plaintiff more effectual. So that unless the plaintiff's title to the exclusive use of the mark at common law be accurately determined, the court will as a rule put the

party applying for relief in equity upon establishing that right, before granting an injunction.

In the case of *Molley* v. *Downman* (*a*) Lord Cottenham said: "The court, when it interferes in cases of this sort, is exercising a jurisdiction over legal rights; and although sometimes in a very strong case it interferes at once by injunction, yet in a general way it puts the party upon asserting his right by trying it in an action at law. If it does not do this, it permits the plaintiff, notwithstanding the suit in equity, to bring an action. In both cases the court is only acting in aid of, and is only ancillary to, the legal right. I can hardly conceive a case in which the court will at once interfere by injunction and prevent a defendant from disputing the plaintiff's legal title."

Also in *Farina* v. *Silverlock*, *per* the Lord Chancellor: "The plaintiff's equity is founded on the jurisdiction of the court to give relief in the shape of preventive justice, in order to make more effectual a legal right, the legal right here being a right to have a particular trade-mark to designate a commodity."

In the case of *Welsh* v. *Knott* (*b*) the injunction was refused, and at the end of his judgment the Vice-Chancellor said: "Looking to the authority of Lord Cranworth in *Farina* v. *Silverlock* (*c*), I think I cannot refuse the plaintiff's liberty to bring an action, this being a case in which there may have been an unlawful as well as a lawful user."

And in *Hall* v. *Barrows* (*d*): "The true ground of this court's jurisdiction is property, and the necessity for interfering is by reason of the inadequacy of the legal remedy."

(*a*) 3 Mylne & Craig, 14.
(*b*) 4 K. & J. 753.
(*c*) 6 D. M. & G. 217.
(*d*) 12 W. R. 322; 33 L. J. (Eq.)

The principles on which, in doubtful cases, parties are referred to an action at law before granting an injunction, are well explained by Lord Cottenham in *Stevens* v. *Keating* (*a*): "I have, in common with other judges, of whom Lord Eldon was one, frequently expressed my opinion that in doubtful cases great care ought to be taken by this court not to grant an injunction which is at all likely to prove unfounded; because if it turn out to be unfounded, you are doing an irreparable injury to the party restrained, whereas by withholding it you may be permitting some injustice, but certainly not an injustice at all equal to that which you are doing by improperly granting it. That rule is confined, however, to cases where there is a serious doubt in the mind of the judge as to whether the title to an injunction is made out or not; for if the court sees that there is a clear case for injunction, it would be absurd to say Go to law and prove that which you have already proved here, before I grant an injunction."

As was remarked by Lord Langdale in *Croft* v. *Day*: "There are cases in which the injunction is granted at once; there are cases like that of the Mexican Balsam, in which the injunction is refused until the plaintiff has established his title at law. In short, in such cases there must be a great variety of circumstances, and the court must deal with each case according to the nature of its peculiar circumstances.

Also in *Bacon* v. *Jones, per* Lord Cottenham: "When a party applies for the aid of the court, the application for injunction is made either during the progress of the suit or at the hearing; and in both cases I apprehend great latitude and discretion are allowed to the court in dealing with the application.

(*a*) 2 Phill. 334.

"When the application is for an interlocutory injunction, several courses are open: the court may at once grant the injunction *simpliciter*, without more; a course which, though perfectly competent to the court, is not very likely to be taken where the defendant raises a question as to the validity of the plaintiff's title; or it may follow the more usual, and, as I apprehend, more wholesome practice in such a case, of either granting an injunction, and at the same time directing the plaintiff to establish his legal title, or of requiring him first to establish his title at law, and of suspending the grant of an injunction until the result of the legal investigation has been ascertained, the defendant in the meantime keeping an account. Which of these several courses ought to be taken, must depend entirely upon the discretion of the court according to the case made.

"Again, the court may at the hearing do that which is the more ordinary course; it may retain the bill, giving the plaintiff the opportunity of first establishing his right at law. There still remains a third course, the propriety of which must also depend upon the circumstances of the case, that of at once dismissing the bill." (*a*)

Where the question of equitable assistance depends on the legal right (*b*), and the legal right is denied by the answer, the plaintiff may move for leave to try the legal right without asking for an injunction in the meantime; but where the plaintiffs without moving for an injunction went into evidence in equity, and at the hearing of the cause, the court being of opinion that the evidence did not establish the plaintiff's right to an injunction, but shewed that the defendants had used the mark in question in a manner which might lead purchasers to understand

(*a*) *Bacon* v. *Jones*, 4 M. & Cr. 436. (*b*) *Rodgers* v. *Nowill*, 6 Hare, 325.

falsely that the goods were manufactured by the plaintiff, gave the defendants the option of either having the bill dismissed against them without costs, or of having the right tried at law.

The bill being retained for a year with liberty to plaintiffs to bring an action at law, the action was brought and the plaintiff recovered a verdict. The court granted an injunction, but refused to allow the plaintiff the costs of the evidence in equity.

Sir L. Shadwell, V.C., was of opinion in *Rodgers* v. *Nowill* (*a*) that where the court retained the bill, giving the plaintiff leave to bring an action and make the best case he could, it still had jurisdiction to direct such admissions to be made as would secure a fair trial of the question at law, as well as where the court directed an issue or an action.

A court of equity will not interfere by injunction to restrain a defendant from using the particular style or title adopted by the plaintiff, unless perfectly satisfied that the plaintiff's right to the title could be maintained in the action at law, even if the fraudulent intention or *animus* of the defendant be perfectly clear (*b*).

In the earlier cases, such as *Perry* v. *Truefit*, *Pidding* v. *How*, and *Flavell* v. *Harrison*, and, indeed, up to the passing of Sir John Rolt's Act in 1862, the proper course when a doubt arose in a court of equity, was to retain the bill and send the plaintiff to law to establish his legal title by the verdict of a jury, or at least to allow him to bring such action at law as he might be advised, implying that if he brought his action and succeeded in it he could then come back to equity and be entitled to an injunction, as being the ancillary remedy which a court of equity gives

(*a*) 6 Hare, 337. (*b*) *Purser* v. *Brain*, 17 L. J. 141.

for the further protection of the legal right, which the plaintiff would then have successfully asserted to be in him (*a*).

Since the passing of Sir John Rolt's Act in 1862, in cases where any doubts arise in a court of equity as to the validity of the plaintiff's title at law, the duty of resolving those doubts on common law principles, as well as of afterwards considering the propriety of applying the equitable remedy of injunction to make the legal right more effectual, devolves upon the judges in equity; and the legal right being determined in his favour he is in the same position as if before the passing of that Act he had gone to law, established his right and had come back to equity for protection (*b*), so that the plaintiff's legal title rests upon the same principles as before 1862, the difference being, that it is now determined by equity judges instead of a common law court. The 1st section of Sir John Rolt's Act enacts: "In all cases in which any relief or remedy within the jurisdiction of the said Courts of Chancery respectively is or shall be brought in any cause or matter instituted or pending in either of the said courts, and whether the title to such relief be or be not incident to or dependent on a legal right, every question of law or fact cognisable in a court of common law, on the determination of which the title to such relief or remedy depends, shall be determined by or before the said court."

The plaintiff's title to relief in equity being thus dependent upon his right at common law, it is important to consider the principles by which his legal title is ascertained, so far as they have been determined in the cases reported. The original ground for interference is, as

(*a*) *Ford* v. *Foster*, L. R. 7 Ch Ap. 613.
(*b*) *Per* James, L.J., *Ford* v. *Foster*.

stated by Wilde, C.J., in *Rodgers* v. *Nowill* (*a*), the same at common law as in equity, to prevent any man from palming off his own goods as the goods of another. The real question is, whether the law will protect a manufacturer from having goods fraudulently palmed off upon the world as goods made by him, when in truth they were not so.

All the cases at common law shew that fraud on the part of the defendant must be alleged in the declaration and proved at the trial, that is, fraud in the sense that the piracy complained of was committed with the intention of deceiving, as alleged in the declaration. To entitle the plaintiff to recover, it is not enough that the defendant adopted means calculated to deceive, but the jury must be satisfied that the defendant did the acts complained of with that intention. *Per* Coltman, J., in *Crawshay* v. *Thompson*: "It appears to me that an intention to deceive is a necessary ingredient in this case. The intention is for the jury, and fraud must be made out by proof of an intention existing in the mind of the party that the iron should pass off as the iron of the plaintiff." It has been held also at common law that proof that the plaintiffs gave notice to the defendants that the acts committed by them were calculated to deceive purchasers, and called upon them to desist from them, was not sufficient evidence of a fraudulent intention on the part of the defendants, even as to the use of the marks by them after the receipt of such notice (*b*).

It is properly a question for the jury to decide whether the defendant's mark bears such a close resemblance to the plaintiff's as to deceive the unwary, and to injure the sale of the plaintiff's goods (*c*). Where a defendant was

(*a*) 5 C. B. 109. (*b*) *Crawshay* v. *Thompson*, 4 M. & G. 377.
(*c*) *Crawshay* v. *Thompson*, 4 M. & G. 377.

proved to have fraudulently invaded the plaintiff's rights by imitating his trade-mark and affixing it to goods of his own make, and selling the goods thus marked, and the declaration alleged that the defendant's goods were greatly inferior to the plaintiff's, it was held that the plaintiff was entitled to recover some damages for the invasion of his right, though he did not prove special damage, or that the defendant's goods were inferior in quality (*a*).

Where a declaration alleged that the defendant sold the goods as and for the goods of the plaintiff, and it appeared in evidence that the persons who bought the goods of the defendant, being retail dealers, knew by whom they were manufactured; but the defendant used the plaintiff's mark, and sold the goods so marked in order that his customers might, and in fact they did, resell them as and for goods manufactured by the plaintiff, it was held that this evidence supported the declaration (*b*).

Where plaintiff and defendant were both selling medicine under the name of a third person, the original inventor, and no evidence was given of the defendant having sold it as if prepared by the plaintiff, Lord Mansfield held that no action would lie (*c*).

Very few authorities can be found at common law in which the abstract title of the plaintiff to protection, as against any infringement at all, has been called in question. Among the earlier cases, almost the only one in which such a question appears to have arisen, was the case of *Sykes* v. *Sykes* (*d*), in which an objection was raised by

(*a*) *Blofield* v. *Payne*, 4 B. & Ad. 410; *Rodgers* v. *Nowill*, 5 C. B. 109.
(*b*) *Sykes* v. *Sykes*, 3 B. & C. 541. (*c*) *Singleton* v. *Bolton*, 3 Doug. 243.
(*d*) 3 B. & C. 542.

the defendants to the improper use of the word "patent" in the plaintiff's trade-mark.

The effect of such a misstatement in a court of equity will be found fully discussed hereafter; but for the present it may be observed that the principle that those who seek for protection in equity must come with clean hands, is one which has been frequently acted upon in cases of this description; that is to say, a plaintiff will not be entitled to any relief in equity if his own case be found to contain elements the probable result of which would be to effect a fraud upon others. So that if a trader bring his trade-mark to a court of equity, and pray for an injunction to restrain another from the improper use of it, it would be a sufficient answer to the bill that the court cannot protect him against the injury complained of without affording him greater facilities for practising deception upon others; as if his trade-mark be found to contain a palpable misrepresentation of some important fact, of such a nature as to convey to the mind of the purchaser an exaggerated or entirely erroneous idea as to the character or value of his goods, *that* will disentitle him to relief in a court of equity.

Now when a misrepresentation of this description is an essential part of the trade-mark itself, and is sufficiently clear to come within the scope of cases already decided in equity, there is no doubt that the court will at once refuse an injunction and dismiss the bill (*a*). But unless it be tolerably clear that these conditions exist, and if there be any doubt as to the probable effect of the misstatements complained of, the court will not adopt this course without first ascertaining what would be the effect of such misstatement upon the plaintiff's title at common law. Assuming the misrepresentation to be of this doubtful

(*a*) *Leather Cloth Co.* v. *American Leather Cloth Co.*, 33 L. J. 199.

character, and that its legal effect is to be decided on common law principles, it will be convenient to consider the question from three different points of view.

The misrepresentation may be so entirely an element of the trade-mark and be so inseparable from it, that the right to set it before the public may form part of the right sought to be protected by the suit. It may be closely associated with, and invariably accompany, the trade-mark, in the manner of an advertisement, without forming part of the actual subject of dispute; or it may be so entirely collateral to the trade-mark as not necessarily to affect the judgment of purchasers who might be influenced by the trade-mark; as in the nature of an advertisement, quite separate and only referring to the same article.

Upon two of these cases it seems impossible to find any authority at common law directly in point. But the judgment of Lord Justice Mellish in *Ford* v. *Foster* (a) is most valuable for the purpose of throwing light upon this subject generally, and is in some respects an authority for the future determination of the question at law.

In *Ford* v. *Foster* the misrepresentation alleged was distinctly collateral, and both James, L.J., and Mellish, L.J., held that the duty devolved upon them of determining the effect which this would have upon the plaintiff's title at common law. In giving judgment Mellish, L.J., said: "If the false representation was in the trade-mark itself (though I cannot find that the point has ever been raised or decided in a court of common law), I have a pretty clear opinion that it would be held that the fact of the trade-mark itself containing a false representation would be an answer to an action at common law.

(a) L. R. 7 Ch. Ap. 613.

"In an action at law the declaration always begins by setting out that the plaintiff has used for a considerable length of time a certain trade-mark, and that his goods have become known by that mark, and it in substance sets up that in this way, his goods being known in the market by this mark, the plaintiff has acquired an exclusive right to the use of the mark. It appears to me that according to the rule *ex turpi causa non oritur actio*, if the trade-mark contains a false representation, a representation calculated to mislead the public, a man cannot by using that which is itself a fraud obtain an exclusive right, or, indeed, any right at all. I think it right to hold that that would be an answer in a court of law. I may observe that *Sykes* v. *Sykes* was the only case where the article was described as a patent article. The word patent was in the trade-mark itself. The article had been a subject of a patent, and there was no imputation that there was any fraud in calling the article patent. All the world might know, and probably did know, that the right to the patent had expired. There was nothing to shew that there was any intention to mislead the public. The word was simply used as a description of the article. I am of opinion, then, that it would be held at law that if the trade-mark itself contains any false representation no action could be maintained for its use. So, also, if the trade was a fraudulent trade I have no doubt that an action could not be maintained; and here I may observe that in some of the earlier cases as, *Perry* v. *Truefit*, and *Pidding* v. *How*, there was very good reason for supposing that that the trade itself was a fraud. I have no doubt at all that where the trade itself is a fraud this would be an answer to an action at law for the invasion of a trade-mark. But where, as in this case, the trade is a perfectly

innocent trade, and the trade-mark a perfectly honest trade-mark, I am clearly of opinion that there is no common law principle upon which it is possible to hold that the fact of the plaintiff having been guilty of some collateral fraud could be an answer to an action brought by him. It would be plainly impossible to plead at law as a justification for the defendant's committing the fraud that the plaintiff had committed a fraud upon some one else. It is absurd to say that this would be an answer at law. It is true that in this case the bills containing the false representation are proved to have been given to the defendants themselves; but there is not the slightest reason for supposing that they were ever deceived by them. I think they knew perfectly well that there never was a patent for these shirts; and they do not even pretend that they were deceived.

"I am, therefore, clearly of opinion, and I do not think there can be any doubt about it, that the fact that these false representations were made to some of the public, would be no answer at all to an action. Indeed, there would be this great difficulty to be solved: How much misrepresentation must be made in order that it might be an answer to an action?

"Is it to be said that if a man had (whether that would not apply to a certain extent in equity I do not say) on one single day issued an advertisement containing a false representation, therefore all his rights were gone? That would seem to be very wrong; and not only so, but it it would be very difficult to say, when the fraud is not in the trade carried on, how far the misrepresentation must go, to what extent it must be carried, before it would be an answer to an action or suit. I am of opinion, therefore, that an action at law could have been maintained in this

case. Then we are in the same position now as if before Sir John Rolt's Act (which altered the rule of this court), an injunction had been refused with leave to the plaintiff to bring any action at law which he might be advised, and that action had been tried and a verdict obtained by the plaintiff, and he were now before the court for injunction."

It appears, therefore, from this judgment of Lord Justice Mellish, that in his lordship's opinion a false representation in the trade-mark itself would be a sufficient answer to an action at common law, and that if the trade itself were fraudulent it would not be allowed to form the basis of an action either, but that a misstatement merely collateral, even if there be evidence to shew that it must have come to the knowledge of the defendants, cannot be set up as a defence to an action.

With respect to the collateral misrepresentation, his lordship's expression of opinion on that point, besides being entitled to all the weight which would attach to the expression of any opinion from so learned an authority, as it constitutes an important part of the ground on which the judgment of the court was given in *Ford* v. *Foster*, would necessarily be a binding authority for the future determination of the point at common law; but with respect to his lordship's observations upon the effect at common law of a misstatement contained in the trade-mark itself, though, as emanating from the same learned source, they are entitled to as much respect, yet being uttered as *obiter dicta*, they do not necessarily entail the same judicial consequences. His lordship says on this point: "If the false representation was in the trade-mark itself (though I cannot find that this point has ever been raised or decided in a court of common law), I have a pretty clear opinion that it would be held that the fact of

the trade-mark itself containing a false representation would be an answer to an action at law."

And shortly afterwards occur the remarks on the case of *Sykes* v. *Sykes*, quoted above. Any opinion in opposition to that of the learned judge can of course only be entertained after much hesitation, and with great reluctance; but it is submitted that a reference to the case of *Sykes* v. *Sykes* will shew that the ground of the decision in that case is hardly in accordance with the view taken of it by the Lord Justice.

The Lord Justice said: "The article was called 'Sykes' Patent,' but there had been originally a patent, and there was no imputation that there was any fraud in calling the article patent." Now a perusal of *Sykes* v. *Sykes* seems to shew that there never had been in any proper sense of the word any patent at all; that is, any valid patent, because although an attempt had been made by the inventor to protect his article by a patent, still on the first occasion when that right was called in question that patent was declared invalid, in consequence of a defect in the specification, so that he was claiming a privilege to which in fact he never had any right at all; and if an imputation of fraud or the absence of such an imputation had been called in question, surely it must have been held by any court, competent to consider the question, as one of wilful deception, that the plain duty of an honest man on discovering that he has been unwittingly deceiving his customers and the public, would be to take every step in his power to eradicate the false impressions from their minds that his own statements had created. But the reports of the case rather tend to shew that no such consideration formed any part of the ground on which the judgment of the court rested.

The part of the case bearing upon this point is reported as follows in 3 B. & C. 542:—

"It was contended for the defendants that the plaintiffs could not maintain this action, for that one of the defendants being named Sykes he had the right to mark his goods with that name, and also had as much right as the plaintiff to add the word 'patent,' the patent granted to the latter having been declared invalid. The learned judge overruled the objection, as the defendant had no right so to mark his goods *as and for* the goods manufactured by the plaintiff, which was the allegation in the declaration."

To this extent, then, it is submitted, that if a similar objection should be raised again in a court of common law, the decision of *Sykes* v. *Sykes* might be successfully urged as authority for overruling it.

A person cannot at common law obtain damages against another for the piracy of his trade-mark or his name, or generally his style of describing his business, without alleging in his declaration, and, of course, proving in his evidence, that he has himself actually transacted business under that name or style.

In *Lawson* v. *The Bank of London* the declaration alleged that the plaintiff was the first person who had established a bank by or under that name, and had established the said bank at great expense, and caused the name to be published and affixed to the offices of the said bank, so that the same might be seen and known by the public; and had caused prospectuses of the said bank to be printed and circulated with the same name and title of the 'Bank of London' thereon; and that the said bank was commonly known by the name of, and was the only bank known as the 'Bank of London,' whereby the

plaintiff had acquired and was acquiring great gains and profits.

It then proceeded to allege that the defendants, intending to injure the plaintiff in his said bank, and the said business in his said bank, afterwards and while his said bank was the only bank named or styled 'The Bank of London,' wrongfully and fraudulently established another bank in London, under the name, style, and title of 'The Bank of London,' in imitation of and representing the said bank of the plaintiff, and wrongfully and fraudulently transacted business at the said bank so established by the defendants under the said name, and under false colour and pretence that the same was the bank established by the plaintiff, and thereby the plaintiff had been prevented from carrying on his business at the said bank by him established so fully and successfully as he would otherwise have done, and had been deprived of profits; and that by means of the premises divers persons were induced to believe, and did believe, that the bank so established by the defendants was the bank called 'The Bank of London' established by the plaintiff. It was held that this declaration did not disclose a good cause of action, as it did not aver that the plaintiff had ever actually carried on the business of a banker (*a*).

(*a*) *Lawson* v. *Bank of London*, 18 C. B. 84.

CHAPTER III.

MISREPRESENTATIONS IN EQUITY,

As a general rule any false statement or misrepresentation on the part of the plaintiff of a nature calculated to deceive the public, will in a court of equity deprive him of his right to protection.

Where any doubt exists as to the probable effect of such misrepresentation, he will be, as we have seen, referred back to his legal title, before the court will refuse or grant his application, but where his mark contains a misstatement, whether wilful or not, obviously calculated to deceive purchasers, that will be held sufficient to deprive him of his right to an injunction (*a*).

A misrepresentation merely collateral, and contained in advertisements and circulars unconnected with the label in question and only referring to the same subject, will not be sufficient to disentitle a plaintiff to relief in a court of equity (*b*).

It has been held that the puffing advertisements printed upon the labels sold with such things as Holloway's pills and ointment, although palpably untrue and absurd, as, for instance that the medicines will cure all the diseases in the

(*a*) *Leather Cloth Co.* v. *American Leather Cloth Co.*, 35 L. J. (Ch.) 53.
(*b*) *Ford* v. *Foster*, L. R. 7 Ch. Ap. 613.

world, need not of necessity amount to such a misrepresentation as to deprive a plaintiff of the protection of the court against a fraud of another trader (*a*). And this probably for the reason, that as no one ever does attach credence to such exaggerated puffing no one could by any possibility be deceived.

In *Perry* v. *Truefit* (*b*) the plaintiff was the maker and vendor of some greasy substance for the hair which he sold under the name of "Perry's Medicated Mexican Balsam," the substance never having been near Mexico at all, and with a label containing among other things the following statement, the whole of which was untrue, that "this admirable composition was made from an original recipe of the learned Von Blumenbach, and was recently presented to the proprietor by a near relation of that illustrious physiologist." This misrepresentation was sufficient to deprive the plaintiff of his right to injunction until he had established his title at law.

With this case should be compared the case of *Holloway* v. *Holloway*, *Pidding* v. *How* (*c*), and some observations of Mellish, L.J., in *Ford* v. *Foster*, who, in referring to *Perry* v. *Truefit*, said: "If the trade was a fraudulent trade I have no doubt that an action could not be maintained. And here I may observe that in some of the earlier cases, such, for example as *Perry* v. *Truefit*, *Pidding* v. *How*, there was very good reason for supposing that the trade itself was a fraud. The object of the trader in *Perry* v. *Truefit* was to sell under the description of 'Mexican Balm' some horrid stuff that had never come from Mexico at all, but which

(*a*) *Holloway* v. *Holloway*, 13 Beav. 213.
(*b*) 6 Beav. 76; See also *Pidding* v. *How*, 8 Sim. 477.
(*c*) 13 Beav. 210.
(*d*) 8 Sim. 477.

was puffed, and said to be composed of some extraordinary fine herbs to be procured only in Mexico."

In *Holloway* v. *Holloway*, decided eight years after *Perry* v. *Truefit*, a puffing advertisement of a somewhat similar character, and equally devoid of truth and probability, was held not to be a fatal objection to the plaintiff's claim; and some ingenuity is required in appreciating any substantial difference in principle between the two cases, both in respect of the advertisements and also in respect of the fraudulent nature of the trade. The opinion of the Lord Justice in *Ford* v. *Foster*, however, seems to indicate that the courts would in future avoid, as much as possible, giving protection to any such trade or to any such false advertisements.

In fact, the position of a plaintiff in equity in such a case as *Holloway* v. *Holloway* is too anomalous for that case to be much relied on; as he has to say in effect, not only that he has been guilty of a gross misstatement, but that he has told falsehoods so utterly improbable that there is no chance of any one believing them.

In all probability no person who buys such articles ever does believe the statements placed round bottles of hair grease, or the puffs of quack medicines, but it does not lie in the mouth of the vendor to say so after he has published them on the chance of deceiving some one at least, and, moreover, it is hardly to be supposed that credulity is capable of such nice distinctions as to repose confidence in the one case and refuse credence in the other.

In the case of the Leather Cloth Company, Lord Westbury said: "I cannot receive as a rule, either of morality or equity, that the plaintiffs are not answerable for a falsehood because it is so gross and palpable that no one is likely to be deceived by it. If there is a wilfully

false statement, I will not stop to inquire whether it is too gross to mislead"(*a*).

Generally, the improper use of the word "patent," in a trade-mark attached to an article which is not the subject of any valid patent at all, will be held to disqualify the plaintiff for relief in equity, but always subject to the discretion which the court will exercise of considering whether the word really is used in such a way as to be calculated to deceive or not; for often the word, though not strictly true, may be used as part of the usual designation of the article, as in the case of such a thing as patent leather, and not practise a deception upon any one (*b*).

In *Morgan* v. *M'Adam* (*c*) the plaintiffs were manufacturers of plumbago or black lead crucibles. The defendant was also a manufacturer of such crucibles, and the bill sought to prevent the defendant from using as the designation of his business the style of the "Patent Plumbago Crucible Company," and to restrain the defendant from selling his crucibles as patent plumbago crucibles. The mode of manufacturing the plaintiff's crucibles was a secret which they had purchased from Messrs. J. Dixon & Co., a firm established in the United States. Although the word "patent" was used by the plaintiff, the manufacture was not the subject of any patent either in England or America. It was held that the plaintiff could not maintain a bill to prevent others from pirating their designation. The judgment of Vice-Chancellor Wood affords a good illustration of the principles upon which these cases are decided: "What the

(*a*) 33 L. J. 203.
(*b*) *Morgan* v. *M'Adam*, 36 L. J. 228.
(*c*) 36 L. J. 228.

court must consider is this: How far in protecting the plaintiff in assuming a title to which he has no right, the public are likely to be deceived. If they are, he must be considered in the light of a person making a representation without reasonable grounds for believing it to be true, and the person who does this is placed in the position in the eye of the law of committing a fraud."

Also, "All that the court has to determine is—has the plaintiff, who comes here to seek relief, any ground whatever to ask the court to assist him in the protection of that right which he sets up? If the court finds it to be a right founded upon a fraud, and certainly this is such, the court says it cannot assist a person in carrying on a fraud."

In *Flavell* v. *Harrison* (*a*), which was a motion for injunction to restrain the defendant from using the plaintiff's name in advertising and selling certain unpatented kitchen ranges, invented by plaintiff's father, and named by him "Flavell's Patent Kitchener," the same learned judge observed: "The plaintiff rests his case upon the title which he has acquired to this particular manufacture, and the name it has acquired with the public, which name he states in his bill to be "Flavell's Patent Kitchener." Now it appears, that neither the plaintiff nor his father, the original inventor, ever had any patent for the article, and that it was, in fact, never patented. This circumstance brings the case within the principle of *Perry* v. *Truefit*, and the plaintiff by using this title misleads the public. Everybody knows that patented articles are dearer, and purchasers therefore more readily give a higher price for them than they would if the articles were open to unrestrained competition. It is true that in a

(*a*) 22 L. J. 866.

case before Lord Eldon, his lordship is reported to have said that although there was not in reality any patent, an action might be maintained where the name had been used; but in the case to which I allude a patent had been taken out and never recalled. The description in that case therefore had been originally true, and had not been finally decided to be wrong."

In *Edelsten* v. *Vick* (*a*), the plaintiffs represented the original patentees of Taylor's "Solid-headed Pins," an article the patent for which had expired, and it was held that they had a right to be protected in the use of the labels by which their pins were distinguished; there having been a continuous use of the same style of labels printed from the same blocks, which had been employed during the continuance of the patent right, and that this continuous use of it conferred the right.

In this case it was said: "I am particularly anxious that it should be understood that all persons applying to this court for its extraordinary interposition by way of injunction, should shew that they themselves have not been guilty of any fraud or misrepresentation; and that if they have made any representations to the public, they must shew that such representations have not been made without foundation or with fraudulent intent. If, therefore, in this case, there never had been any patent granted for the manufacture of these pins, or if, after the term of the patent had expired the plaintiff had taken up the use of the word 'patented' as descriptive of their manufacture, and had first circulated the labels in that form, I should probably have thought that the case came within this ground of objection to the interference of the court. But here that was not so; for the blocks for

(*a*) 11 Hare, 78.

the labels had been made during the existence of the patent, when the representation was perfectly true.

"The plaintiffs became the proprietors of the rights of the original patentees, and of the blocks, labels, and other property; and those labels, which, as the external demonstrations of the article, had acquired a certain value and had attracted a certain amount of confidence, they had continued to use. It is no doubt much to be preferred that no representation should be used which is not strictly true; but if in a case in which the goods have become known by a description which was originally accurate in every part, I were to hold that the continued use of this description disentitled the party to the assistance of the court, it would be going much farther than I did in refusing to interfere by injunction where the plaintiff had adopted and used the word 'patent' untruly and without foundation" (*a*).

In cases where the article has been formerly the subject of a valid patent, two circumstances of considerable weight in the plaintiff's favour undoubtedly exist. In the first place, as the appellation of "patent" was adopted and used by him with perfect truth in the first instance, he cannot well be supposed guilty of any deliberate intention to deceive in merely continuing that use after the patent had expired; and, secondly, as the article had been known in the market for years in connection with the term "patent" as part of its designation, there is, *primâ facie*, strong ground for assuming that the discontinuance of that name would induce many purchasers to doubt whether the article in question was the article they had been accustomed to deal in, and so effect an injury to the plaintiff's business, which he ought not to be required to

(a) *Flavell* v. *Harrison*, 10 Hare.

inflict on himself; but there are both reason and authority for saying that the courts will not be determined by the mere fact of there having been originally a valid patent or not, but will consider whether, under all the circumstances of the case, the continued use of the term is calculated to deceive.

In the *Leather Cloth Company* v. *American Leather Cloth Company*, Lord Kingsdown, in commenting on the decisions of Vice-Chancellor Wood in *Flavell* v. *Harrison*, and *Edelsten* v. *Vick*, said: "If the word 'patent' be not so used as to indicate the existing protection of a patent, but merely as part of the designation of an article known in the market by that name, then I agree that such use is lawful. In that case nobody is meant to be deceived or is deceived. A patent may have expired fifty years ago, and yet the name of patent may have become attached to the article, and be used in the trade as designating it. But if the trade-mark represent the article as being protected by a patent, when in fact it is not so protected, I cannot think that it can make any difference whether the protection never existed or has ceased to exist."

In *Marshall* v. *Ross* (*a*), the plaintiffs were flax spinners and thread manufacturers at Leeds, and had been in the habit for forty years of affixing an embossed stamp to the wrappers of their first quality thread, containing among other things the expression, "patent thread." On motion to restrain the defendant from the use of the trade-mark, it was held that although the thread was not the subject of any existing patent, the misrepresentation was not of such a nature as to deprive the plaintiff of his right to protection.

(*a*) L. R. 8 Eq. 651.

In giving judgment, James, V.C., said: "There has been a clear imitation of the plaintiff's mark, and it appears to me that I can grant them the relief which justice requires without interfering with the decision of the House of Lords in the case of the *Leather Cloth Company*; for the word 'patent' may be used in such a way as not to deceive the public. It is here stated in the bill, and verified by affidavit, that the term 'patent' has been used in the trade for many years past, and is the name by which thread of a certain class is known by manufacturers and in the trade. It has in fact become a word of art. I am therefore only following the principle of decided cases, for here there has been no such misrepresentation, designed or undesigned, as to deprive the plaintiffs of their right to protection."

In *Chappell* v. *Davidson* the question at issue was the alleged fraudulent imitation by the defendant of the title-page of a song; and the defence was set up that the plaintiffs had been guilty of such misrepresentation in their title-page as to disentitle them to the protection of the court. It appeared that the song consisted of new words by George Linley, set to an old American air, in which there was no copyright. There were on the title-page in small print the words, "written by George Linley." And in the work itself his name was printed in the corner without anything more, and in a place where it might lead to the inference that he was the author of the music. George Linley being well known as a composer as well as a poet, it was urged on the part of the defendants that this was an attempt to lead the public to believe that the music as well as the words were the production of George Linley. *Per* Wood, V.C.: "I think that the inference from this circumstance of an intention

to mislead is too faint, whatever degree of suspicion I may have on the subject, to hold that there was a direct misrepresentation to the public when every word stated is perfectly true, and all that I can found my suspicion upon is something inferentially suggested to the mind" (*a*).

Selling mixed coal under the name of Wallsend, even if it appears to be the case that all the original collieries which bore that name have been worked out, will not be considered a misrepresentation to the public, as purchasers do not attach a definite meaning to the word, but would understand by it any good coal from the northern districts (*b*).

Where a plaintiff had been in the habit of affixing the same label to two descriptions of goods, both belonging to the same class of manufacture, but differing in quality, and the label contained statements which were true as applied to goods of one description, but false when applied to the other, the court refused an injunction to restrain an alleged piracy of the plaintiff's trade-mark. Nor would it seem to be material that the misrepresentations in the label, when applied to goods of the second kind, were so palpable as not to be likely practically to lead purchasers to mistake one class of goods for the other (*c*).

By the 2nd section of the Merchandise Marks Act, it is enacted that any person who, with *intent to defraud*, or *enable another to defraud*, any person, shall apply, or cause or procure to be applied any trade-mark, or any forged or counterfeited trade-mark, to any chattel or article not being the peculiar description of manufacture, workmanship, production, or merchandise denoted or intended to be

(*a*) 2 K. & J. 123. (*b*) *Lee* v. *Haley*, 18 W. R. 181.
(*c*) *Leather Cloth Co. (Limited)* v. *American Leather Cloth Co. (Limited)*, 32 L. J. 199.

denoted by such trade-mark, or by such forged or counterfeited trade-mark, shall be guilty of a misdemeanour.

A case is put by the Master of the Rolls in *James* v. *James* (*a*). Taking the circumstances as they actually occurred in that case, His Honour put the case of a man who has invented a medicine which he makes from a secret recipe, and sells with his own name, as James's Ointment, and leaves it to his executors or assigns, who carry on the business, and sell the medicine with the announcement that theirs is the only genuine James's Ointment. So long as they are in the exclusive possession of the secret by which the ointment is concocted, such an announcement is made with perfect truth and propriety; but suppose another man to discover or be possessed of the recipe by legitimate means, and make and sell the medicine, as he has a perfect right to do, the article not being the subject of any patent, and advertise his as the only genuine ointment. In this state of things the question arises,—could either party file a bill to restrain the other from the use of this assertion? This point is not expressly determined by the Master of the Rolls, but it may be inferred from the rules by which all these cases are governed, that if the assignees of the original inventor could be held to mean by the word "genuine" that their ointment was made after the recipe of the inventor and no more, and by the word "only" that they were his only legitimate successors in business, they might be protected in the use of the name, but otherwise it can hardly be considered as anything but a misstatement to assert that their medicine is the only genuine, after they have lost the power of keeping the manufacture of it exclusively in their own hands; and for the same reason it would seem

(*a*) 11 L. J. 357.

that the use of the same words under these circumstances by the successors in business of the first inventor should be held to be a sufficient misstatement to disentitle them to protection as against third persons, who might be, even wrongfully, making use of their name as a trade-mark, because all the objections which attach to the improper use in a trade-mark of the word "patent" as a descriptive term, apply with equal force to such a description as this, both being in effect equivalent to an assertion that purchasers could only obtain the article properly made from the inventor or his assignees, and thereby assuming for it a value to which it has no right.

Although the court will not be made the medium of a mere puffing advertisement, still if the plaintiff have a right of sufficient value to induce others to pirate it the court will interfere to prevent him from being cheated (*a*).

The 38 Geo. 3, c. 78, enacted, That no person shall print or publish any newspaper until an affidavit or affidavits made and signed as after mentioned, shall be delivered to the commissioner of stamps. That such affidavit or affidavits shall specify the real or true names, additions, descriptions, and places of abode of all the persons who are intended to be the printers and publishers of the newspaper, and all the proprietors of the same, if the number of such proprietors, inclusive of the printer and publisher, does not exceed two; and in case the same shall exceed two, then of two of such proprietors, inclusive of the printer and publisher, and also the amount of the proportional shares of such proprietors in the property of the newspaper, and likewise the true description of the building wherein such paper is intended to be printed, and likewise the title of such paper.

(*a*) *Braham* v. *Bustard*, 1 H. & M. 455.

In *Prowett* v. *Mortimer* (*a*) the objection that the plaintiff had not complied with the provisions of the above Act was held by Vice-Chancellor Stuart not fatal to an application by the plaintiff for an injunction to restrain the defendant from publishing another paper as an imitation and continuation of the plaintiff's. One ground for this decision was, that the defendant himself, having for years officiated as printer and publisher and sub-editor of the paper before the plaintiff purchased it, and while the provisions of the Act were not being complied with, had himself acted in contravention of the statute, and that he knew that he had been going on without any alteration in the registry in printing and publishing such newspaper, although there had been a change in the ownership of the property.

The learned judge further held that, as the right of the plaintiff had been acquired under a power of sale in a mortgage deed, and as the Act of Parliament proceeded on the ground of high public policy, that the public should know who were the proprietors of works of this description, it would be a straining of the Act and its language to hold that a person could not sue under the circumstances of the case, and to say that the right to property acquired as this had been, was not entitled to the protection of the court unless the person who sued was a registered proprietor.

In *Harmer* v. *Westmacott* (*b*) the objection was allowed where the plaintiff had been a party to a fraudulent affidavit, representing another party as the proprietor of the newspaper, and consequently relief was not granted.

(*a*) 2 Jur. N. S. 417.

(*b*) 6 Sim. 284.

CHAPTER IV.

NAMES 'PUBLICI JURIS.'

A TRADE-MARK should either directly or by its reputation in the market indicate to purchasers that the goods upon which it is placed have been manufactured by some particular firm or individual or at some particular place. It should, in fact, be an assurance to the public that they are reaping the benefit of some person's superior skill, or the peculiar local advantages of some place; and it will often happen that a mark which at its first adoption by the owner, and for some time afterwards, really did convey such a meaning, has, either from the negligence or licence of the owner, come to be understood as no more than descriptive of the particular class of goods upon which it is placed, and from this cause, or from lapse of time or other circumstances, has become a name *publici juris*, and as such open to all the members of the community equally.

As was said by the Lord Chancellor in *Hall* v. *Barrows* (*a*): "But it must be borne in mind that a name, though originally the name of the first maker, may in time become a mere trade-mark or sign of quality, and cease to denote, or be meant as indicating, that any particular person is the maker. In many cases, the name of a maker affixed to a manufactured article continues to be

(*a*) 33 L. J. Ch.) 201.

used for generations after the death of the individual who first affixed it. In such cases the name is either accepted in the market as a brand of quality, or it becomes the denomination of the commodity itself, and no longer indicates that the article is the manufacture of any particular person." (See *Millington* v. *Fox*.)

Also *per* Mellish, L.J., in *Ford* v. *Foster* (*a*): "There is no doubt, I think, that a word which was originally a trade-mark, to the exclusive use of which a particular person or his successor in trade may have been entitled, may subsequently become *publici juris*, as in the case recently before us of 'Harvey's Sauce.' It was admitted there that, although that had been originally the name of the sauce made by a particular individual, it had become *publici juris*, and that all the world were entitled to call sauce 'Harvey's Sauce,' if they pleased. What then is the test by which it is to be decided whether a word which was originally a trade-mark has become *publici juris?* I think the test to be this, whether the use of the word still continues to deceive the public, or any part of the public; whether the use of it by any other person than the original user may still have the effect of inducing the public to buy goods not made by him under the supposition that they are his goods. If the word or mark has become of such universal use that nobody can be deceived by the use of it, then no one can be induced from the use of it to believe that he is buying the goods of the original owner. If it has become as public as that, then, however hard it may seem to be on the trader, yet practically, as the right to a trade-mark is simply a right to prevent the owner of it being cheated by other persons' goods being sold as his goods, through the fraudulent use

(*a*) L. R. 7 Ch. Ap. 613.

of the trade-mark; as that is the nature of the right, if the mark has ceased to deceive anybody, the right itself must be gone."

This for several reasons is likely to be the case where the article in question is at first the subject of a valid patent, because during the existence of the patent the value of the article depends more upon the mode of its manufacture than the personal skill of any one maker, and that more particularly where, from the licence of the patentee, there are several persons legally competent to make and sell it; so that unless a patentee adopt and keep to himself some name or mark for the thing patented, separate and distinct from the usual name of the thing, he may find at the expiration of his patent that what he seeks to protect as a trade-mark is understood to be nothing more than the name of the article.

In illustration of this we may consult the case of the Wheeler and Wilson Sewing Machine Company (*a*).

The plaintiffs were an American company, incorporated in 1854 for the purpose of manufacturing sewing-machines and other articles, and a particular kind of sewing-machine, of which Messrs. Wheeler and Wilson, two of the original members of the company, had been patentees under a patent which expired in 1866.

The plaintiffs filed a bill to restrain the defendant from holding himself out to the public as their agent, and also from selling machines other than the plaintiff's under the title of "Wheeler and Wilson's Sewing Machines."

The first part of the bill is foreign to the present inquiry; but on the second part it was held by Vice-Chancellor James that the name Wheeler and Wilson on a sewing-machine was descriptive merely of the character

(*a*) 39 L. J. (Eq.) 36.

of the machinery, and not equivalent to an assertion that the machine was of the plaintiff's manufacture.

In giving judgment, the learned judge made the following remarks: "It seems to me that the name, 'Wheeler and Wilson machine' has come to signify the thing manufactured according to the principle of that patent. That being so, I cannot restrain anybody after the expiration of that patent from representing his article as being the article so patented.

"A man cannot prolong his monopoly by saying, 'I have got a trade-mark in the name of a thing which was the subject of a patent,' and therefore to that extent I think the plaintiffs are not entitled to relief."

It is not to be inferred from this decision that a man necessarily cannot acquire a right to use the name of a patented article as a trade-mark, but that such a right is not a necessary incident to the patent, and he must satisfy the court that the name had acquired and retained such a character, and is not used as merely descriptive.

In 1847 Baron Liebig discovered and published a process for making an extract of meat. The extract was made extensively at the Royal Pharmacy, Munich, and sold there with the permission of Baron Liebig as Liebig's "Extract of Meat" from 1861 to 1864. It became generally known in Germany and other countries as "Liebig's Extract of Meat," which term was also used as a term of art in scientific treatises. In 1864 Baron Liebig granted to the Fray Bentos Company the right of using his name in connection with the extract of meat manufactured by them. The plaintiff bought the business and property of the Fray Bentos Company, and by deed-poll in 1866 Baron Liebig granted to them the exclusive right and privilege of using his name in connection with the extract

manufactured by them. The defendants, who had previously sold extract manufactured by the Fray Bentos Company in 1866, began to sell "Liebig's Extract of Meat," manufactured by a Mr. Tooth, in Australia, after Liebig's process. A bill being filed by the plaintiffs to restrain the use of the term, "Liebig's Extract of Meat," it was held that, the terms having been used as a term of art to designate a well-known process long before 1861, the defendants were fully justified in using it, and the bill was dismissed with costs (*a*).

The distinction between the right to a trade-mark and the right to the exclusive manufacture of a patented article is further illustrated by the case of *Canham* v. *Jones* (*b*).

There the plaintiff was a manufacturer of a certain medicine, not patented, made from a recipe which was a secret; and the defendant made and sold medicine, not as and for the medicine of the plaintiff, but which he alleged was as good as the plaintiff's. In refusing an injunction to restrain the defendant the Vice-Chancellor said: "If this claim of monopoly can be maintained without any limitation of time it is a much better right than that of a patentee; but the violation of the right with which the defendant is charged does not fall within the cases in which the court has restrained a fraudulent attempt to invade another man's property, to appropriate the benefit of a valuable interest in the nature of a good-will, consisting in the character of his trade or production established by individual merit; the other representing himself to be the same person and his trade or production the same, as in *Hogg* v. *Kirby* (*c*) combining imposition on the public with injury to the individual. This is not

(*a*) *Liebig's Extract of Meat Co.* v. *Hanbury*, 17 L. T., (N. S.) 298.
(*b*) 2 V. & B. 220.
(*c*) 8 Ves. 215.

the sort of case. The observation is correct, that the bill stating the defendant's medicine to be spurious, asserts it not to be the same as the plaintiff's. The defendant does not hold himself out as the representative of the plaintiff, but merely represents that he sells, not the plaintiff's medicine, but one of as good a quality. He is at perfect liberty to do so. If any exclusive right to this medicine ever existed it has long expired."

In *Eidsten* v. *Vick* (*a*) the Vice-Chancellor said: "It was said that when a patent expired it was open to the public at large to adopt the description of the article by which it had become known to the world, and to use the label by which the articles made by the plaintiffs had been theretofore distinguished. It does not, however, follow because upon the expiration of the patent the article and known description became open to all, that, therefore, all would be entitled to use the label by which the patentees had been accustomed to distinguish their goods. The public may have acquired confidence in that particular label, and that confidence may have given a value to it which the patentees may be entitled to have protected after the expiration of the patent." Although the question does not appear to have been ever expressly decided, it would seem clear that during the existence of a patent, although other persons may have licence from the patentee to make the patented article and sell it under the proper descriptive name, still the original maker might even, as against such assignees, claim an exclusive right to any particular designation he may have adopted for himself as a trade-mark.

In considering the subject of patents in reference to trade-marks there are three distinct cases to deal with.

(*a*) 11 Hare, 85.

First, when the article in question is the subject of a valid existing patent; secondly, where the article has been the subject of a patent which has expired; and thirdly, where the thing has never been the subject of any existing patent whatever.

In the first case, if a man invent and patent an article, which, as an article of commerce, is entirely new, and send it into the market for sale with his name or any mark attached to it as a trade-mark, it is clear that so long as his patent remains in force any rival trader who makes and sells a similar article similarly marked violates two of his rights at the same time, viz., his patent right to the exclusive manufacture and sale of the patented article, and his exclusive right to the use of the name or mark as a trade-mark to denote the thing as being of his own make; one right expiring with the patent, and the other, under certain circumstances, extending as long as he continues the manufacture and sale of the article in question. Thus if, for example, he sell the thing, as, say, Smith's Patent Corkscrew; then so long as the patent lasts, as he is the sole legitimate maker of the corkscrew, any one who sells a similar article under the same name will be inducing a purchaser to believe that he is buying the manufacture of the first inventor and patentee, and would be infringing his right to a trade-mark. But it is clear from authority that if he have only adopted such a term as the word "patent" to designate his own make he will not, after the expiration of his patent, be entitled to the exclusive use of that description *per se* as a trade-mark. And the case of Wheeler and Wilson's Sewing Machine is authority for saying that after a lapse of time, and under circumstances depending on the nature of the particular case, any other mode of designation he may

have used *may* be held as only descriptive of the nature of the thing, and not indicative, as a trade-mark, of its being his own manufacture.

To be secure he should adopt some mode of expression which is obviously intended as a trade-mark, apart from all connection with his patent right; and then, when he can no longer restrain the manufacture of his invention by other makers, he can still continue to reap the benefit of his own reputation.

But if instead of inventing a new article he invent and patent a process of machinery for making an article already well-known in commerce, he must be more particular in his selection of a mark to designate his own manufacture; because during the continuance of his patent he is exposed to the danger of piracy in two ways. As he cannot restrain the sale of the actual article by others, a rival trader may clandestinely make it by means of his invention without licence from him, thereby infringing his patent right; or may sell the thing, and represent falsely, that it is made by the process of the patentee, which would be an infringement of his trade-mark.

If instead of either of the preceding cases he invent and patent a process for arriving at some natural product, his position will be slightly different. If before his invention the natural product in question has been known as an article of trade, but from its expense or the difficulty of procuring it, has been of little commercial value, he cannot patent the article but can patent the process, and may for a time enjoy the monopoly in the sale of the thing itself (*a*), a monopoly liable to be destroyed as soon as any other person discovers an available process for arriving at the same product.

Where a man invents and patents a process for the ex-

(*a*) 9 Jur. 322.

traction or manufacture of some natural product, although his process is protected by virtue of the patent, he cannot prevent other persons from selling the same product under the same name unless he adopts some original or fanciful appellation in addition as a trade-mark.

In *Young* v. *Macrae* (*a*) the plaintiff had obtained letters patent for a process for obtaining, by the distillation of bituminous coals, paraffine, and also an oil containing paraffine, and filed a bill to prevent the defendants from selling under the name of "paraffine oil," or "American paraffine oil," any oil or similar product that had not been manufactured by the plaintiff or their licensees. Injunction refused, on the ground that the term "paraffine oil" was not a new name invented by the plaintiff, and which could be used by them as a trade-mark, but was a natural title, which must inevitably be applied to the same article by whatever process it was produced.

As to the distinction between a trade-mark and a natural appellation, Sir W. P. Wood said: "I have not the least doubt that if the plaintiff has invented a fanciful and ridiculous name, and the more ridiculous the better for his purpose, and has used it for eight or ten years in his trade, that then the court will take care that nobody else shall use it.

"A man cannot take out a patent for a natural substance, but he may take out a patent for arriving at that natural substance, and he may christen it, putting aside all other people having called it by that name.

"Take the case of beet-root sugar.

"Suppose a man gets a patent, which he might well do, for extracting sugar from beet-root and he says, 'I will call it "beet-root sugar," and he goes on manufacturing it,

(*a*) 9 Jur. 322.

say, for ten years, nobody else having found out another way of extracting sugar from beet-root; of course, therefore, during that ten years he would be the only person who extracted sugar from beet-root, and in that sense you may say that the term "beet-root sugar" has been used by him; and when the term "beet-root sugar," was used it would be known that it was the sugar of the patentee.

"It does not become a trade-mark, but it gets fixed to his sugar, because nobody else could make it. Then another man discovers a second process by which he extracts sugar from beet-root, and not wishing to patent it he calls it "beet-root sugar;" may he not call it beet-root sugar because the other gentleman for ten years has been the manufacturer of it and sold it as such? I think the question of the fancifulness of the name is a question whether it is taken by way of trade-mark or not.

"It is just as if a man discovered an oil from walnuts, and called it walnut oil. If another man discover another way of extracting oil from walnuts, just as in the case I put of beet-root sugar, he must call it walnut oil. There is no other name by which he can call it."

See also *Ingram* v. *Stiff* (*a*); *Clement* v. *Maddick* (*b*).

Where from the negligence of the owner, or lapse of time, or any other cause, a name has ceased to be looked upon as a trade-mark, and has become *publici juris*, still, as the owner remains entitled to have his trade protected from fraud he may by any small and distinctive addition to the name or mark, such as the word "original," again render the mark so altered entitled to protection as a trade-mark.

In *Cocks* v. *Chandler* the plaintiff was the successor in business of one James Cocks, who many years ago invented

(*a*) 5 Jur. (N. S.) 941.

(*b*) 5 Jur. (N. S.) 532.

a sauce which he called "Reading Sauce," which name was afterwards applied by many other manufacturers to sauces of their own make. Having lost his right to the exclusive use of the term "Reading Sauce" by acquiescence in this practice, he adopted the title "Original Reading Sauce," in order to distinguish his own sauce from the Reading Sauces of other makers. On a bill being filed to restrain the defendant from using the word "original," an injunction was granted by the Master of the Rolls, on the ground that he treated the use of the word "original" by the defendant as simply a device to induce the public to believe that the defendant was selling sauce made according to the recipe of the plaintiff (*a*).

It is worthy of remark that in this case the respective labels of the plaintiff and defendant were in other respects substantially different in appearance.

A. discovered a medicine which he termed "chlorodyne," a name invented by himself as a fancy title, and not previously known in the medical profession. B. advertised for sale a medicine which he called "chlorodyne," and sold as B.'s chlorodyne. A. filed a bill against B., but did not press it to a hearing, and obtained an order dismissing it with costs. B. subsequently advertised his medicine as "original chlorodyne," asserting that he was the first inventor. Upon motion for injunction in a second bill by A. to restrain B. from the use of the word "original," it was held that although A. by dismissing his former suit had abandoned all right to the exclusive use of the word "chlorodyne," he would have been entitled to restrain B. from selling his medicine as "original chlorodyne," if he had adduced evidence that any one had been misled by the title into buying B.'s instead of A.'s (*b*).

(*a*) 40 L. J. 576. (*b*) *Brown* v. *Freeman*, 12 W. R. 205.

From the case of *M'Andrew* v. *Bassett* (*a*) it appears that there may be an exclusive right to the use of a trade-mark, although consisting of the name of a foreign province from which the raw material was produced, and from which other persons might also procure similar materials in the raw or manufactured state.

Per Wood, V.C.: "The case is put thus by the bill and affidavits, and thus far it is not questioned that previous to this mark being used the juice had been imported from Anatolia; the name had not been used but the juice had been imported. It is not as if a new article of commerce had been invented in this sense, that a new country had produced it, and a name being required for it, it was called by the name of the country from which it came. That is not so, because the juice had come from Anatolia before and the name had not been given to it; nobody wanted to designate the place, and nobody had used this name Anatolia as designating the place from which the juice came. It is not like the case which I myself put of there being a district which is the only district from which a well known wine, such as Burgundy, is imported, and the first importer calls it Burgundy; though he may have stamped Burgundy upon his corks for twenty years he cannot prevent any one else from calling a wine produced in Burgundy by the name of the place from whence it was imported."

With the case of *M'Andrew* v. *Basset* should be compared the case of *Wotherspoon* v. *Currie* (*b*).

In this case the plaintiffs had for some years carried on the business of manufacturing starch at a place called Glenfield, which, as appeared from the evidence, was an obscure hamlet of about sixty inhabitants near Paisley,

(*a*) 33 L. J. 561. (*b*) L. R. 5 H. L. 508.

and at which no other manufactory of starch had ever been established. The plaintiffs were always in the habit of selling their starch in packets with a label containing the words "Glenfield Patent Double-refined Powder Starch," at the top, and the starch so labelled was known generally in the trade as Glenfield Starch, and also as starch manufactured by the plaintiffs. But in comparing the case with *M'Andrew* v. *Basset* it must be borne in mind that there was not, and never had been, any other starch manufactory at the place except the plaintiffs, and if there were any local advantage connected with the name it was practically a monopoly enjoyed by the plaintiffs.

After a time the plaintiffs removed their works to another place, also near Paisley, called Maxwelltown, where their works became known as Glenfield Starch Works, and their starch was still sold as Glenfield Starch.

The defendant Currie was a starch and corn manufacturer, carrying on his works at Paisley; his place of residence had been for many years at Glenfield, in fact, during the whole of the time that the starch works of the plaintiff had been carried on there.

In 1868 the defendant obtained possession of a small part of the plaintiffs' former premises at Glenfield, and began making starch in them. In 1869 the plaintiffs discovered that starch manufactured by the defendant was sold by him as starch manufactured by Currie & Co., but with the words "Glenfield Starch" printed on the labels.

They accordingly took proceedings against him in the Court of Session, and obtained an interdict prohibiting him from using the words "Glenfield Starch" affixed to any starch sold by him in Scotland.

They afterwards filed a bill in Chancery to prevent him from so describing his manufacture in England.

The motion for the injunction came before Vice-Chancellor Malins, who made the order as prayed (*a*). On appeal Lord Justice James discharged the order for an injunction (*b*); but on appeal to the House of Lords this decision of the Lord Justice was reversed and that of the Vice-Chancellor confirmed.

Taking into consideration the fact that at the time of the alleged infringement of the plaintiffs' mark the defendant was actually engaged in the manufacture of starch at Glenfield, and that the plaintiffs had removed their place of business to another locality, this decision undoubtedly carries the principle on which courts of equity grant injunctions in these cases to the fullest extent.

It was distinctly understood and expressly stated, both by Lord Hatherley and Lord Chelmsford, that what the plaintiff asked for in the prayer of the bill was an injunction to restrain the use of the word "Glenfield" upon packets of starch manufactured by the defendant: and the injunction granted was to restrain the respondent from using the word "Glenfield" in connection with his starch, and from manufacturing and selling his starch as "Glenfield Starch," and from doing any act or thing to induce the belief that starch manufactured by him or for him was "Glenfield Starch," or starch manufactured by the plaintiffs.

The ground for this, given by Lord Westbury was, that long antecedently to the operations of the defendant the word "Glenfield" had acquired a secondary meaning in connection with a particular manufacture; that, in short, it had become the trade denomination of the starch made by the appellants; that it was wholly taken out of its ordinary meaning, and in connection with starch had acquired that peculiar secondary signification, and there-

(*a*) 18 W. R. 562. (*b*) 18 W. R. 943.

fore in connection with starch had become the property of the plaintiffs.

In considering this judgment of Lord Westbury, however, it should be remembered that the evidence, so far as it applied to the point, went rather to negative the existence of any local advantages peculiar to the manufacture of starch at Glenfield; and that, supposing such local advantages to have had any existence, and to have been disclosed by the evidence, his lordship would hardly intend to prevent any manufacturer who was honestly availing himself of such facilities from publicly announcing that fact to the world by using the name of the place of manufacture *per se*; supposing, that is, that the mode of using it did not disclose an attempt to copy the general aspect of the plaintiff's trade-mark.

With *Andrew* v. *Bassett*, and *Wotherspoon* v. *Currie*, should also be compared the case of *Radde* v. *Norman* (*a*), which was an interlocutory application for an injunction to restrain the use of the words, "Leopoldshall Kainit," by the defendant upon rock salt sold for the purpose of being used as manure.

In this case the original salt was of a kind called "Kainit," produced from a mine at Leopoldshall, in the duchy of Anhalt, in Prussia, and which, from containing a large percentage of sulphate of potash, was peculiarly valuable as a manure. The ducal government granted the exclusive right of exporting the salt from these mines to one Gustav Ziegler, and in 1870 Gustav Ziegler transferred that right to the plaintiff, Otto Radde. In pursuance of this power, the plaintiff did actually import to this country, and for the space of a year advertised and sold this particular species of salt as the "Genuine Leopoldshall Kainit."

(*a*) L. R. 14 Eq. Cas. 348.

The plaintiff having discovered that the defendants were selling salt with the description "Kainit (Leopoldshall)," applied to the court for an injunction to restrain the defendants from using the words "Leopoldshall" or "Leopoldsalt," or any colourable imitation of the word "Leopoldshall," in connection with kainit brought into the market by them; and generally from doing any act or thing representing or calculated to induce the belief that the kainit offered for sale by the defendants was the product of the "Leopoldshall" mines, or was the kainit imported by the plaintiff into this country. Under these circumstances, his Honour thought the plaintiff's title was sufficiently made out to justify the court in granting an interlocutory injunction, omitting from the order the words, "the product of the Leopoldshall mines," having regard to the fact that there was strong reason for supposing that the defendants had not acted in ignorance of the plaintiff's title; but expressing some doubt whether that title would have been sufficiently established as against a person who had acted in ignorance of the plaintiff's claim, and who had offered for sale or sold "Leopoldshall Kainit," which he had lawfully got into his possession with good reason to believe that it was what he described.

Still these cases are hardly sufficient to disclose how far the court would be disposed to go in interfering to prevent the use of the name of a place or district, where the name itself indicated some peculiar merits in the product, apart from any manufacturing process peculiar to the plaintiff, and where the defendant has subsequently discovered some other spot in the same district, and properly described by the same name, from which a material of the same quality can be extracted. As for instance, in the case of *Radde* v. *Norman*, if the name

"Leopoldshall," instead of being the name of a mine, were the name of a place in which the plaintiff had possession of a mine, for some time the only mine capable of producing the given material, and the defendant had subsequently discovered another mine of equal merit in the same place; under these circumstances, could it be said that the plaintiff could, by any continued user of the name, though for a time that use might be peculiar to himself, be enabled to restrain the use of the name by another person, who might subsequently qualify himself to attach that designation to his own merchandise with an equal degree of truth?

In *M'Andrew* v. *Bassett* the licorice juice which formed the subject-matter of the suit had been known for years as an article of commerce, but had never been distinguished by the name of the place of its production, "Anatolia," until that designation was applied by the plaintiff to some of the juice from Anatolia, after it had been subjected to a process of mixing peculiar to his own business.

Besides which, the name "Anatolia" when used only to indicate that the juice came from that place, would be merely descriptive of an article recognised by the trade, as being of a decidedly inferior quality.

In *Wotherspoon* v. *Currie* there was clearly no local advantage peculiar to the place, Glenfield, and no assignable reason for the defendant's setting up his business in that village, except the hope of being able to derive some benefit from the plaintiff's previously acquired reputation.

In *Radde* v. *Norman* the word "Leopoldshall" being the name of a mine and nothing else, could not with propriety be applied to any salt which was not the product

of that particular spot. A condition of things such as we are now supposing to exist would probably come within the spirit of the decision in the case of *Young* v. *Macrae* (*a*), in which it was held that a title could not be acquired to the exclusive use of the name of a natural product, without the addition of some fanciful appellation peculiar to the plaintiff's trade. The same reasoning applying with equal force to either case;—that the defendant subsequently starting in the same business would by force of circumstances be compelled to advertise his own goods by the only name which would convey an adequate idea of their peculiar qualities and virtues.

In the case of *The Colonial Life Assurance Company* v. *The Home and Colonial Life Assurance Company* (*b*) a suit was brought to restrain the defendant from using the above designation. The Master of the Rolls, in refusing the injunction, said: "But if a company which does colonial business cannot call itself 'Colonial,' it is obvious that, under a species of assertion that the word 'Colonial' is symbolical, the plaintiffs might prevent every other person from using it as descriptive of his trade. It is obvious that such a claim cannot be maintained; it would establish a monopoly in the use of the words 'Home' and 'Colonial.' Such a contention has never been advanced before. You may find in the directory the 'London Assurance Company' and the 'London and Liverpool Assurance Company,' the 'Law Life Company' and the 'Equity and Law Life Company' where the same words are used in both cases. So you have the 'Times' and the 'Hereford Times;' but no one ever supposed that the 'Times' newspaper could apply for an injunction."

A fancy name used as a trade-mark may have become

(*a*) 9 Jur. 322. (*b*) 33 Beav. 548.

publici juris as between the wholesale manufacturers of the article and the retail sellers of the article to which the name is attached, and yet there may be an exclusive right in the use of the word, as between the general public and the retail dealer.

When F. had manufactured shirts which he called "F.'s Eureka Shirts," and it appeared that the particular shape of the shirt, not being the subject of a patent, could be, and, indeed, actually was, adopted and made by other wholesale makers, the question arose whether the word "Eureka" affixed to these shirts would indicate that they were made by F., or merely that they were made according to the Eureka patterns, and so had become a name *publici juris*. After examination of the evidence it was determined that the term "Eureka" had become *publici juris* as between wholesale and retail dealers in the trade to such an extent that by the use of it in trade circulars issued only to retail dealers, such retail dealers would not be likely to be deceived, nor would be induced to buy shirts not made by F. under the impression that they were buying F.'s shirts; but that a considerable portion of the public, that is to say the people who actually wear the shirts and buy them for the purpose of wearing them, would be liable to be deceived by the use of the word "Eureka," especially when fixed in the same part of the shirts where F. had been accustomed to place his mark. An injunction was accordingly granted to restrain the defendant, a wholesale maker, from issuing boxes or packages containing shirts with the mark "Eureka" on them, or using the mark or title "Eureka" upon shirts not of the plaintiff's manufacture, and from affixing any label, or card, or mark, containing the word "Eureka" upon shirts not of the plaintiff's manufacture, but leaving the defendant at liberty to advertise his shirts as

'Eureka" shirts by means of circulars and advertisements addressed to retail dealers only (*a*).

The Collins Company were edge tool manufacturers in the United States, and had long used certain stamps and labels to distinguish their tools, and they charged the defendants with having fraudulently used and imitated their trade-mark and label, and with selling articles of their own manufacture in large quantities to various persons in England and elsewhere, marked and labelled like the goods of the plaintiffs, for the purpose of passing them off as being such goods; and the bill charged the loss already and that which would be hereafter sustained by the plaintiffs by a continuance of this practice on the part of the defendants, and prayed for an account of profits on such fraudulent sales, the delivery up of all stamps and labels imitating those of the plaintiff, and an injunction to restrain them from the use of such stamps and labels in future (*b*).

The objection was raised by demurrer on behalf of the defendant that the plaintiffs being an American company without an establishment in this country, and having never, even according to their own allegations, manufactured or sold goods here, had no right to a trade-mark in England; that they could not be defrauded by the use of their trade-mark by another person in England; and that in their own country they might sue any person who there sold goods so as to interfere with their trade.

The demurrer, however, was disallowed on the ground that the right to sue was a personal right, and that being so the party injured had a right to his remedy against the wrongdoer in the country where he resided, no matter where the injury might have been done.

(*a*) *Ford* v. *Foster*, L. R. 7 Ch. Ap. 613. (*b*) 3 Jur. (N.S.) 929.

The following remarks occur in the judgment of the court in this case:

Fraud is the true foundation of the jurisdiction in these cases; and if a man has been in the habit of using a particular mark for his goods for a long time, during which no one else had used a similar mark, the adoption of the same mark by another can only be with a fraudulent design, and any fraud may be redressed in the country in which it is committed, whatever may be the country of the person who has been defrauded.

From this we are led to infer that the decision of the court was based upon the fraud of the defendant. Still as in other cases the jurisdiction of the court is held to rest upon the property of the plaintiff, and is independent of any imputation of fraud on the part of the defendant, it may be assumed that in similar cases protection would be granted where no suspicion of fraud existed, provided that the mark of the plaintiff was such as would be entitled to protection in the country where he was carrying on his trade.

No property can be acquired in a trade-mark without an actual publication and offering for sale in the market of the articles stamped with it; in the language of several learned judges it must be a vendible article in the market. It is not sufficient that a man should make the goods and invent the mark, or even stamp the mark upon the goods, unless he offer the goods so stamped for sale. Neither is it sufficient if he shew that he has expended money in the manufacture of the goods, or has announced his intention of publishing them by means of public advertisements.

In the case of *Maxwell* v. *Hogg* (*a*), Hogg in 1863 registered an intended new magazine by the name of

(*a*) 6 L. R. 2 Ch. 315.

"Belgravia," and Maxwell, in ignorance of this, projected in 1866 a magazine with the same name, and incurred much expense in preparing and advertising it by that name, as about to appear in the month of October. Hogg hearing of this, made hasty preparations with his own magazine, and succeeded in producing his first number in September. Maxwell's first number appeared in October. It was held by the Lords Justices, on appeal, that Maxwell's advertisements and expenditure did not give him any exclusive right to the title "Belgravia."

Per Lord Justice Turner: "That expenditure upon a work not given to the world can create, as against the world, an exclusive right to carry on a work of this description, seems to me a proposition quite incapable of being maintained. It never, so far as I am aware, has been thought that any such equity exists. Then if the expenditure alone will not confer a title, will the advertisements do so? Such an advertisement is nothing more than an announcement on the part of the plaintiff of his intention to publish in the following October a work under a given title. Can that be considered as constituting in him an equitable title, or, indeed, any title to the name under which that work is to be published. He does not by his advertisements come under any obligation to the public to publish the work, and therefore the effect of holding the advertisements to give him a title would be, that without having given any undertaking or done anything in favour of the public, he would be acquiring a right against every member of the public to prevent their doing that which he himself is under no obligation to do, and may never do.

Also, *per* Lord Justice Cairns: "The question then reduces itself to this. Can property of that character

which is had in a trade-mark be acquired in a name before the vendible articles bearing the name have been actually put upon the market for the purpose of sale? It is admitted that the case is a new one, and that there is no case precisely in point, but it must be admitted that the *dicta* in equity are opposed to the idea that such a bill as this can be maintained, and the case of *Lawson* v. *The Bank of London*, and all the definitions which have been given in this court of the nature of the right to protection in the case of trade-marks, seemed to me opposed to the idea that protection can be given where there has not been an actual sale or offering for sale of the article to which the name is to be attached. In the case of *Lawson* v. *The Bank of London* (*a*), a declaration was held bad which alleged that the plaintiff had established a bank, and called it the Bank of London, but which did not go on to affirm that the plaintiff had ever conducted any banking business under that title.

But although an actual publication and offering for sale of the goods marked is considered necessary, yet, according to recent cases the courts will not take upon themselves to say what length of time is required for the plaintiff to acquire reputation as the maker of the goods. In the case of *M'Andrew* v. *Bassett* (*b*), a user of the mark for a period of about six weeks was held sufficient to support the plaintiff's title.

In giving judgment in this case Lord Westbury said: "I have been much pressed by the defendant's counsel to declare that there was not sufficient time between the termination of the month of July and the 13th September following to acquire a right of property in this particular trade-mark. The substance of the argument of the de-

(*a*) 18 C. B. 84. (*b*) 10 L. T. (N. S.) 145.

fendants is this, that supposing the court interferes on the ground of property in a trade-mark, that property must be regarded as the offspring of such an antecedent user as will be sufficient to have acquired for the article stamped general notoriety and reputation in the market, and that the property cannot be held to exist until the fact of that general use and that notoriety and reputation have been proved to exist. Now I am by no means called upon to determine when, for the first time, property in a trade-mark may be said to exist. The elements of the right to that property may be represented as being the fact of the article being in the market as a vendible article, with that stamp or trade-mark at the time the defendants imitated it. The essential qualities for constituting that property would probably be found to be no other than these; first, that the mark has been applied by the plaintiffs properly; that is to say, that they have not copied any other person's mark, and that the mark does not contain any false statement; secondly, that the article so marked is actually a vendible article in the market; and thirdly, that the defendants, knowing it to be so, have imitated the mark for the purpose of passing in the market articles of a similar description."

And in *Hall* v. *Barrows* the Master of the Rolls said: "But provided the trade-mark has been originally invented by a manufacturer, and continuously and still used by him to denote his own goods when brought into the market and offered for sale, then, I apprehend, although the mark may not have been invented a week, and may not have acquired any reputation in the market, still his neighbours cannot use that mark. Were it otherwise, and were the question to depend entirely upon the time the mark had been used, or the reputation of it had been

acquired, a very difficult, if not an insoluble inquiry would have to be opened in every case, namely, whether the mark had acquired in the market a distinctive character, denoting the goods of the person who first used it."

CHAPTER V.

TRANSFER.

It being a necessary incident of a trade-mark that it should indicate the goods upon which it is stamped to be the manufacture of some place, firm, or individual, it follows that it will not necessarily, after assignment, carry with it, when used by an assignee, all the privileges which attached to it when it was in the possession of the original owner. Although as between the vendor of a business with the trade-mark and the purchaser, the transaction may be complete and binding on both parties; still as between the transferee and third parties, he will not in all cases acquire all the rights which the transferor has abandoned, and he may find that he has only purchased a right which the act of transfer has rendered entirely valueless. Whether a trade-mark be rightly described as property or not, there is no doubt that it retains so far the character of property as to be generally capable of transfer, either by sale, or devise, or devolution of law, *unless*, in the hands of the assignee, it would convey *falsely* to the minds of the public the impression that it still accompanied some personal skill or local advantage, with which it had in fact ceased to have any connection.

This is well explained by Lord Cranworth in the *Leather Cloth Co.* (*Limited*) v. *American Leather Cloth Co.*

"But I further think that the right to a trade-mark (a) may in general, treating it as property, or an accessory to property, be sold and transferred upon a sale and transfer of the manufactory or goods on which the mark has been used to be affixed, and may be lawfully used by the purchaser. Difficulties may arise where the trade-mark consists merely of the name of the manufacturer. When he dies, those who succeed him (grandchildren, or married daughter, for instance), though they may not bear the same name, yet ordinarily continue to use the same name as a trade-mark, and they would be protected against any infringement of the exclusive right to use that mark. Nor would the case be necessarily different if instead of passing into their hands by devolution of law, the manufactory were sold and assigned to a purchaser. The question in every such case must be whether the purchaser, in continuing the use of the original trade-mark, according to the ordinary usages of trade, would be understood as saying more than that he was carrying on the same business as had been formerly carried on by the person whose name constituted the trade-mark."

Instances will readily suggest themselves of trade-marks so associated with personal skill or local advantage as to be obviously incapable of transfer; such for instance as the name of an eminent medical man, or writer, or composer; or the names of such places as Burton or Bradford, enjoying peculiar local advantages.

And a multitude of marks, applied to every description of business, can be noticed in advertisements every day, most of which are capable of being, and many of which actually have been, the subject of a valid transfer.

Though a man may have a property in a trade-mark in

(a) 35 L. J. 53.

the sense of having a right to exclude any other trader from the use of it in selling the same description of goods, it does not follow that he can, in all cases, give another person the right to use it, or to use his name. If an artist or an artisan has acquired, by his personal skill and ability, a reputation which gives to his works in the market a higher value than those of other artists or artisans, he cannot give to any other person the right to affix his name or mark to their goods, because he cannot give to them the right to practise a fraud upon the public.

By the usage of trade, the name of a firm is not understood to be confined to those who first adopted it, but to extend to and include persons who had afterwards been introduced as partners, or partners to whom the original partners have transferred their business. The name of the firm continues to be used long after the original traders have died, or have ceased to have any interest in the business. If a manufacturing house uses the name of the firm, and stamps the name of the firm upon its goods, though the name of the firm no longer represents the same persons as at first, it is no fraud upon the public.

For the same reason, the use of the old trade-mark of the firm by the new partners or their successors is no fraud upon the public. It is only a statement that the goods are the goods of the firm whose trade-mark they bear (*a*).

But although in a great number of instances no objection could be raised to the transfer of a trade-mark, cases must frequently occur in which the validity of the transfer is involved in a considerable degree of doubt.

In *Hall* v. *Barrows* (*b*) the Master of the Rolls attempted to lay down a broad distinction between trade-marks of a personal, and trade-marks of a local character,

(*a*) *Leather Cloth Co.* v. *American Leather Cloth Co.* (*b*) 32 L. J. 518.

that is, between trade-marks pointing to an individual as the maker of the goods, and trade-marks pointing to a place as the place of manufacture; establishing this criterion as a basis for determining the question, considering marks of the first description to be incapable, and the last properly capable of assignment.

And, no doubt, as between marks which can only be understood as referring to the actual maker of the articles, and marks which refer to nothing but the place of manufacture, the distinction thus drawn may be perfectly just; but between these two extremes will be found a multitude of cases in which the superficial character of the mark has become from lapse of time and other causes quite illusory, as in the cases of Child's night lights, Palmer's candles, Wheeler and Wilson's sewing machines, and also of a great number of banking houses, which still retain the names of the original parties long after the businesses have ceased to have any connection with any individual of that name.

In giving judgment the Master of the Rolls said: "These trade-marks are commonly of one or other of two descriptions: either they denote the spot where certain articles are manufactured, or they denote the person by whom they are manufactured. It is essential to point out the distinction that exists between the two different sorts of marks already noticed, namely, the marks which denote the place where the goods are manufactured, and nothing more, and those which on the other hand denote the person who manufactures them and nothing more."

Acting upon the distinction thus laid down, and considering that the mark in question was of too personal a character to be made the subject of a sale with the partnership stock, his Honour decided that it was not competent to give the purchaser the right to use the

letters constituting the mark; but that the exclusive right to use them remained with the surviving partner.

On appeal this decision was reversed by the Lord Chancellor, who made the following remarks:—

"The Master of the Rolls is of opinion that the right to use local trade-marks may be sold with the manufactory or works to which such marks refer; but that the right to use personal trade-marks ought not to be sold, because the use of them by any other person than the persons denoted by the trade-mark would be a false representation to the public. But it must be borne in mind that a name, although originally the name of the first maker, may in time become a mere trade-mark or sign of quality, and cease to denote, or be current as indicating, that any particular person is the maker" (*a*).

The difficulty of determining this question by any rule of general application is curiously illustrated by the judgments of Lord Westbury and the Master of the Rolls in *Hall* v. *Barrows;* because, besides expressing his inability to assent to the general distinction between local and personal marks, as laid down by the Master of the Rolls, his Lordship, even had he indorsed that proposition, ultimately came to a directly opposite conclusion as to which category the mark then under consideration should be placed in, his Honour considering the mark as personal and the Lord Chancellor as local; and it is submitted that a test which broke down on its first application by such eminent authorities, is not likely to prove of very general utility.

The case of *Motley* v. *Downman* (*b*), which was much relied upon by the Master of the Rolls in framing this

(*a*) 33 L. J. (Ch.) 204; *Millington* v. *Fox*, 3 M. & C. 338.
(*b*) 3 Mylne & Craig, 1.

rule, was very peculiar in some respects. It was there shewn that the manufacture of tin plates marked M. C. had been carried on for a great number of years at the same works, under a succession of different owners. The plaintiff, the last lessee of the premises, had left them some years before filing his bill, the premises being for the greater part of the intervening time empty, and had started another manufactory, forty miles off, where he made use of the old trade-mark. It was held that he could not restrain new lessees of the old manufactory from making use of the old trade-mark, on the ground that the mark in question had come to indicate to purchasers that the tin plates were made at the original manufactory, and not by any individual maker in particular.

Also in *Bury* v. *Bedford* (*a*), *per* Lord Justice Turner: "But without going the length of saying that a mark may not in some cases be so completely personal as of necessity to import that the goods sold under it have been manufactured by a particular individual, and that the assignability of such a mark may not be open to objection on that ground, although the objection would, as it seems to me, apply rather to the use of the mark assigned than to the power of assigning it, I think that all cases of this description depend upon their particular circumstances. Much must, I think, depend upon the nature of the mark and the mode in which it has been used. It is evident that a mark, although it may in some respects indicate the person by whom the goods were made, may refer much more closely to the place of manufacture than to the person of the manufacturer; and it is not less evident that a mark, although personal in its inception, may, from

(*a*) 33 L. J. 469.

the mode in which it has been used, have become appropriated to goods manufactured at particular works."

In *Bury* v. *Bedford* (*a*) an assignment of a trade-mark is thus described by the Master of the Rolls: "Consider the meaning of an assignment of a trade-mark. It is nothing more than that the assignor allows the assignee the right to use the trade-mark. There is no other meaning to the word 'assignment.' The assignment may be effected by an instrument more or less formal, but the thing is actually assigned at the moment when some other person than the original owner is permitted to use this trade-mark for a shorter or it may be for a longer period of time."

The facts in *Bury* v. *Bedford* were these: J. B., while trading as a manufacturer, acquired the right to use a particular corporate trade-mark containing the letters J. B. He subsequently entered into partnership, and, by the articles then executed, it was agreed that the trade-mark should be a partnership asset, and that it should be lawful for the parties thereto at the end of the partnership to use the mark for the remainder of their lives, either alone, or in partnership with any other persons. The firm having fallen into difficulties, all the assets and all the estate and effects joint and separate of the partners were assigned to trustees, who subsequently assigned to H. B. the assets of the old firm, including all the right which they could assign of using the trade-mark. It was held by the Master of the Rolls that J. B. was entitled to use the mark himself, or to allow any person in partnership with him to use it; but that an injunction must be granted to restrain J. B. from granting the use of the trade-mark to any person not in partnership with him.

On appeal it was held by Lord Justice Turner that the

(*a*) 32 L. J. 741.

plaintiff H. B. was entitled to the exclusive use of the mark, and an injunction was granted accordingly to restrain J. B. from using the mark (*a*).

From the above remarks of the Master of the Rolls and from his Honour's judgment in this case, it would appear that where a person is possessed of a trade-mark which by its nature is one properly capable of assignment, he has power not only of transferring his whole interest in the mark to another, but of imparting, as it were, some of his interest to another while retaining the same himself as against the public. Or perhaps he would be said more correctly to possess the power of doubling the interest in the mark by transmitting the whole of it to another and retaining no less himself. Neither is there anything in the appeal to the Lords Justices to controvert this position, as their Lordships' judgment did not deal expressly with this point.

Also in *Southern* v. *Reynolds* (*b*), where two brothers each inherited a trade-mark from their father, and carried on business separately at different establishments, the right of each as against third persons to the exclusive use of the mark was expressly recognised; and the same principle was adhered to in *Dent* v. *Turpin*, where plaintiff and another person who carried on distinct trades at different places of business had derived from a common ancestor their respective businesses and the right to use the name of Dent as a trade-mark, it was held that after infringement of their name either party might sue alone for injunction and delivery up of the articles so marked, and for account of profits made by defendant out of articles so marked, and for payment to the plaintiff of such part of such profits as the plaintiff should be entitled to (*c*).

(*a*) 33. L. J. (Ch.) 465. (*b*) 12 L. T. (N. S.) 75.
(*c*) *Dent* v. *Turpin*, 2 J. & H. 139.

By following these decisions we are led to the conclusion that the rule of the courts of equity upon this part of the subject is consistent with the multiplication of a right to a trade-mark, provided the mark be capable of transfer at all. But upon this state of things two questions suggest themselves. How far is this process of sharing the right to be carried, and how is the practice to be reconciled with the principles generally laid down for protecting trade-marks?

Could it be said that any number of descendants might each in this respect inherit the privileges of a common ancestor? There is no authority for saying at what point a line should be drawn, but it is apprehended that the principle is not capable of any great extension; indeed, even in *Dent* v. *Turpin* it was regretted by the court that the two parties had not made some substantial difference in their mode of marking their goods. But further than this, the jurisdiction of a court of equity in respect of trade-marks is based upon the principle that when a person comes to seek for protection against an infringement of his mark, he is understood to say in effect: "This mark placed upon my goods is, or ought to be, an assurance to the public that in buying these goods they are paying for the superior quality of the work done at my establishment." What is his position, then, in a court of equity when it appears that the mark in question has ceased to have that meaning attached to it?

Indeed, in the case of *Batty* v. *Hill* (*a*), the court seems to have thought that the possibility of the right being shared by others would be fatal to the claims of either.

However fraudulent the act of the defendant may be shewn to be, it is settled that fraud alone is not sufficient

(*a*) 1 H. & M. 264.

to give jurisdiction to the court, unless the mark in question possess all the qualities of a trade-mark. No doubt the cases above cited constitute the rule of the court so far as they extend, but it is submitted that for these reasons their application may be expected to be strictly limited.

In connection with this part of the subject it may be useful to refer to some remarks of Lord Westbury in *The Leather Cloth Company* v. *American Leather Cloth Company* (*a*): "The representation which the defendant is supposed to make, that his goods are the goods of another person is not actually made otherwise than by his appropriating and using the trade-mark which such other person has the exclusive right of using in connection with the sale of some commodity; and if the plaintiff has an exclusive right so to use any particular mark or symbol, it becomes his property for the purposes of such application, and the act of the defendant is a violation of such property, corresponding with the piracy of copyright or infringement of a patent. I cannot therefore assent to the *dictum* that there is no property in a trade-mark It is correct to say that there is no exclusive ownership of the symbols which constitute a trade-mark apart from the use or application of them, but the word 'trade-mark' is the designation of marks or symbols when applied to a particular commodity, and the *exclusive* right to make such use or application is rightly called property."

These observations of his Lordship will afford us some assistance in appreciating the possible nature of a trade-mark after it has been shared by three or four different assignees.

Whatever property there may be in a trade-mark, is, as

(*a*) 32 L. J. (N. S.) 721.

Lord Westbury says, not in the marks or symbols, but in the exclusive application of them to the sale of some particular commodity. That exclusive application must, if the phrase have any meaning at all, be an application from which every other person is excluded. It is not merely that a plaintiff's property in a mark exists only when the mark is affixed to particular goods, but the application should be an exclusion in the sense of belonging exclusively to the individual who claims protection.

Otherwise the whole meaning and object of protecting this description of property is in danger of being lost sight of altogether. The analogy between a violation of such property, and a violation of copyright or patent right must not be carried too far. A purchaser of a patent article neither wants, nor, as a rule, obtains, any assurance that the article he buys is made by one person more than another, but that it was made according to the patent process, and that it is the patented article, and it cannot matter to him if there be fifty licensees legally entitled to make it, provided it be made in the proper manner; but the purchaser of an article with a trade-mark affixed does rely upon the additional assurance that the value of the thing purchased is enhanced by the skill of the maker or the excellence of a particular plant of machinery, and in all probability is willing to pay a higher price accordingly; and it is the value of this assurance on the part of the customer which constitutes the property sought to be protected by the trader. What becomes of his property, then, when he cannot say that any single purchaser was not relying on the skill of any one out of some half-dozen other proprietors of the trade-mark?

In cases where a partnership has been formed and the partnership articles have contained no provisions as to the

disposal of the stock-in-trade in the event of a dissolution of partnership, the consideration of the disposal of the trade-mark, and also the goodwill of the business, has at various times given rise to much difference of opinion between authorities of very great weight. In the earlier cases reported, the question seems to have arisen first in connection with the goodwill, and chiefly as to whether it should or should not be taken and dealt with as part of the partnership assets.

In *Hammond* v. *Douglas* (*a*), a case decided in 1800, the Lord Chancellor, Lord Rosslyn, was of opinion that upon a partnership without articles the goodwill survived, and a sale of it could not be compelled by the representative of the deceased partner; being the right of the survivor which the law gives him to carry on the trade; that it was not partnership stock of which an executor could compel division.

In *Crawshay* v. *Collins* (*b*), in 1808, Lord Eldon expressed some doubt upon this point, and seemed to be of opinion that upon a partnership being dissolved by bankruptcy of one of the partners, the assignees of the bankrupt were entitled, beyond an account and distribution of stock, to a participation in subsequent profits made by the other partner.

And again, in *Lewis* v. *Langdon* (*c*), in 1835, a decided opinion was expressed by Sir L. Shadwell, in accordance with the views adopted in *Hammond* v. *Douglas*, that when two partners carried on a business in partnership together under a given name, that during the partnership it was the joint right of both of them to carry on the business under that name, and that upon the death of one of them

(*a*) 5 Ves. 539. See also *Webster* v. *Webster*, 3 Swans. 490.
(*b*) 15 Ves. 218. (*c*) 7 Sim. 425.

the right which they before had jointly becomes the separate right of the survivor.

This question of the proper destination of the good-will of a business, together with the kindred question of the right to use the trade-mark of a partnership, in the absence of express stipulation on the point in the partnership articles, is well explained by the elaborate judgments of the Master of the Rolls and Lord Westbury in *Hall* v. *Barrows* (*a*).

In that case a firm consisting of three partners for many years used the letters B.B.H. (being the initials of the three partners' names) with a device as a brand for goods manufactured by them, and on one partner dying the use of the brand was continued by the survivors. In 1858 one of the survivors died, under circumstances which in the opinion of the court entitled his executor to have the business sold as a going concern.

Under these circumstances the defendant, who was the surviving partner, considered that the goodwill of the business survived to him, and that he was entitled to the exclusive use of the trade-mark, while the plaintiff insisted that the goodwill and trade-mark ought to be taken into account in estimating the value of the testator's share, and that they ought to be sold together with the premises as a going concern.

His Honour held that the device in question was not of a character to be properly made the subject of a sale, and that the right of using such a device as to induce the public to believe that the works were still carried on under the management of the firm or their surviving partners, could not be given to the purchaser; but that all the goodwill that might attach to the spot where the

(*a*) 32 L. J. 548; 33 L. J. 324.

works are carried on could be sold, and the purchaser might have the benefit of that species of habit which would induce customers to deal with persons who carried on business at the spot. On appeal to the Lord Chancellor the defendant agreed by his counsel to accept and take all the stock belonging to the partnership at a valuation according to the construction which the court should put upon the word "stock." Lord Westbury accordingly directed that the order for sale made by the Master of the Rolls should be reversed, and declared that the words "stock belonging to the partnership," included the partnership business and works, with all premises and machinery and apparatus attached thereto, and all the stock-in-trade, implements, tools, and other property belonging to the business; and also that the exclusive right to use the trade-mark of the partnership was part of the property of the partnership, and ought to be included in the valuation; and that the goodwill of the partnership ought also to be valued on the footing of the surviving partner being at liberty to set up and carry on the same business as the partnership.

The decision of the Lord Chancellor in this case is in accordance, as far as it goes, with the judgment of Lord Justice Turner in *Bury* v. *Bedford*, who said in deciding that case: "The case rests, as it seems to me, upon the simple question, whether upon the formation of a partnership with a person entitled to the benefit of a trade-mark, the trade-mark does not in the absence of express provisions relating to it become an asset of the partnership; and in my opinion it does, for the whole trade is carried into the partnership, and the trade-mark is but an element of the trade."

When the stock-in-trade of a business and the goodwill are sold, and the partnership articles contain no stipu-

lation to the contrary, the name as a trade-mark may be sold as well. If they be not sold, but one partner takes the whole at a valuation, the name would be an item in the valuation. But if they choose to divide the partnership assets between them, each is at liberty to use the name just as he did before (*a*).

With *Banks* v. *Gibson* should be compared the case of *Scott* v. *Rowland* (*b*), where on a dissolution of partnership between S. and R., on which all the property of the partnership was bought by R., and paid for at a valuation, but no express mention was made of the goodwill, and S. was living and not a bankrupt; it was held that R. was not entitled to use the name of S. in the style of the firm.

In giving judgment in this case, and in commenting upon the case of *Banks* v. *Gibson*, Vice-Chancellor Wickens seems to have concurred in the opinion that where the partnership has been dissolved by the death or bankruptcy of one partner whose name has formed part of the partnership designation, the name of the deceased or insolvent partner might still be retained as a trade-mark with the partnership assets.

A comparison of the cases, therefore, leads to the conclusion that, in the absence of express stipulation in the partnership articles, and subject to the conditions inseparable from any assignment of a trade-mark, as that it should not result in a deception or fraud upon purchasers, after the decease of one partner, the goodwill and trade-mark, whether consisting of the names of the partners or not, would go with and form part of the partnership assets; and that after a dissolution of partnership an outgoing partner, upon the sale of his share of the assets, would be entitled to an injunction to restrain

(*a*) *Banks* v. *Gibson*, 34 L. J. 592.

(*b*) 20 W R. 508.

the future use of his name as part of the designation of the firm, but that the purchaser would, with the exception of the retiring partner's name, be entitled to all the benefit attaching to the goodwill and continued use of the trade-mark.

Where a partner in a firm, whose name was the only name that appeared in the partnership designation of John Douglass & Co., sold his share and interest in the partnership with the stock and goodwill, he was restrained from setting up a similar business by himself in such a way as to indicate that he was continuing the business of the original partnership, although in styling his new business as "late" John Douglas & Co., he was using no one's name but his own (*a*).

He would not have been restrained from setting up a similar business under his own name next door, provided he did not represent it as a continuation of the old one (*b*).

The sale of a trade with the goodwill will not prevent the vendor's setting up again a similar business without express covenant; but, upon the principle that no one may represent his own business to be the business of another, he will not be allowed to set up again the trade with any representation that he is continuing the identical business, the goodwill of which he has sold (*c*); but it has been said that if without express covenant a vendor should stand by and give encouragement, generating a confidence that he would not engage in such a trade; inducing other people to involve themselves; that on the ground of that conduct the court might interpose.

In the cases of *Shakle* v. *Baker* (*d*), *Cruttwell* v. *Lye* (*e*), and *Kennedy* v. *Lee* (*f*), Lord Eldon laid down the rule

(*a*) *Churton* v. *Douglas*, 1 John. 188.
(*b*) Ib.
(*c*) *Cruttwell* v. *Lye*, 17 Ves. 342.
(*d*) 14 Ves. 468.
(*e*) 17 Ves. 335.
(*f*) 3 Mer. 452.

that an assignment of the goodwill of a business *simpliciter* meant no more than the assignment of the right to carry on the business in the premises occupied by the former firm, and the consequent chance of old customers being attracted to the same premises.

These *dicta* of Lord Eldon are commented on by Vice-Chancellor Wood in *Churton* v. *Douglas* (*a*). He said: "Goodwill, I apprehend, must mean every advantage, every positive advantage if I may so express myself, as contrasted with the negative advantage, of the late partner not carrying on the business himself, that has been acquired by the old firm in carrying on its business, whether connected with the premises in which the business was previously carried on, or with the name of the late firm, or with any other matter carrying with it the benefit of the business.

"It would be absurd to say that where a large wholesale business is conducted, the public are mindful whether it is carried on at one end of the Strand or the other, or in Fleet Street, or in the Strand, or any place adjoining, and that they regard that and do not regard the identity of the house of business, namely the firm."

It appears from this case that one incident of the assignment of the goodwill of a business is the right to restrain the use of the name of the old firm by any other than the assignees, in such a manner as to represent to the public that any business other than the one assigned is the identical business of the old firm. The use of the name being treated, as Sir William P. Wood puts it, as the use of a trade-mark.

On the authority of *Churton* v. *Douglas*, as well as *Cruttwell* v. *Lye*, it is clear that although in the absence

(*a*) 1 John. 188.

of express covenant to the contrary, the assignor of the goodwill has a right to set up again in a similar business, next door if he like, still he must, in the exercise of that right, use the greatest precaution not to make it appear that he has succeeded to the identical business he has sold.

"The authorities," says Sir W. P. Wood (*a*), "are conclusive upon this point, that the sale of the goodwill of a business without more, does not imply a contract on the part of the vendor not to set up again in a similar business himself. I use the expression '*similar* business' purposely, in order ot distinguish the case I am supposing from one where, as here, the vendor seeks to set up again the identical business which he has professed to sell. Upon the sale of the goodwill of a business the vendor is not precluded from carrying on a precisely similar business, with all the advantages he may be able to acquire from his own industry and labour, and from the regard people may have for him; and that in a place, next door for example, to the very place where the former business was carried on. And upon the authorities it is settled, that if the purchaser wishes to prevent that step being taken, it is his fault if he does not insert provisions to that effect in the deed."

Goodwill has been defined to be every advantage that has been acquired by the old firm in carrying on its business, whether connected with the premises in which the business was previously carried on, or with the name of the old firm (*b*).

Assignment of the goodwill of a business does not necessarily give the assignee the right to use the name of the assignor (*c*).

(*a*) 1 John. 188. (*b*) *Churton* v. *Douglas*, John. 174.
(*c*) *Scott* v. *Rowland*, 20 W. R. 508.

Where plaintiff and defendant carried on business in partnership under the name of R. & W. Scott; and by agreement for dissolution of partnership it was agreed that either party might carry on business separately, but not under the name of the old firm; and R. Scott made over his business at N. and G. to the defendants, who, in their premises at G. made use of the inscription "Scott & Nixon, late R. & W. Scott of N.;" the court granted an injunction to restrain the defendants from the use of such an inscription, as it amounted to a representation that they had succeeded to the business of the original firm (*a*).

Where a business is sold the entire goodwill and right to use the trade-mark pass to the purchaser without any express mention being made of them in the deed of assignment, and the court will restrain any subsequent attempt on the part of the vendor to retain either for his own use (*b*).

In substance there is no difference between the sale of the goodwill of a business by a person in trade and the sale of it by his assignees in bankruptcy. When a person becomes bankrupt, the goodwill becomes an asset of the estate, and the assignees have a right to sell everything. It seems to be settled that if the goodwill of a man's business is sold, he has no right to represent himself as carrying on that business which he has sold, nor to use its trade-marks, or to represent himself as the continuer of the business (*c*).

In a recent case it has been held by the Master of the Rolls that after the sale of a business as a going concern, together with the goodwill, the vendor is not at liberty not merely to start a similar business and represent it as a continuation of the identical one he has sold, but he will not be allowed, either personally or by agents, by letter

(*a*) *Scott* v. *Scott*, 15 L. T. (N. S.) 143.
(*b*) *Shipwright* v. *Clements*, 19 W. R. 599.
(*c*) *Hudson* v. *Osborne*, 21 Law Times, 387.

or circulars addressed exclusively to the customers of the original business, to solicit their custom and draw them away from the vendees (*a*).

Upon the decease of one partner a decree being made for the sale of the business as a going concern, it was proposed to sell to any purchaser the right to hold himself out as the successor of the firm of Samuel J. & Sons: Held that the particulars of sale ought to explain that the surviving partner, William J., had still a right to carry on the same business in the same town in his own name (*b*).

In *Hine* v. *Last*, where the plaintiffs filed a bill to protect a trade-mark which they had formerly been jointly entitled to in conjunction with a deceased partner, the Vice-Chancellor seems to have been of opinion that the right to the mark might at the time of filing the bill be shared with the plaintiffs by the personal representatives of the deceased partner (*c*).

Two persons, sons of one father who had originated the manufacture of Broseley Pipes, and designated them as Southern's Broseley Pipes, on the death of their father manufactured at Broseley, but at separate establishments, and for their separate benefit, pipes of a like character; one of the brothers instituted a suit to restrain the use of the trade-mark, the other declining to join in the suit. It was held that one brother might alone file a bill for an injunction and account (*d*).

And in *Dent* v. *Turpin*, in which the same principles were involved as in *Southern* v. *Reynolds*, it was held that each plaintiff had an equity in respect of the wrong done to himself to restrain the use of the trade-mark by the

(*a*) *Labouchere* v. *Dawson*, 41 L. J. 427.
(*b*) *Johnson* v. *Hellaby*, 34 Beav. 63.
(*c*) 10 Jur. 106, 1845.
(*d*) *Southern* v. *Reynolds*, 12 L. T. (N. S.) 75.

defendant, and to have it erased from the article on which it had been wrongfully impressed, without giving any proof of special damage (*a*).

When a man has learnt a trade secret from his employer, and practised it after his employer's death, selling the article under the old name, he will not acquire such a right to the exclusive use of the name as a trade-mark as will be protected by a court of equity (*b*).

When a trader, possessed of the exclusive right to a trade-mark entered into partnership, and the partnership articles contained a condition that after dissolution of partnership each should retain for his separate benefit the right to make use of the mark, and the firm becoming afterwards involved in difficulties, the partnership assets were made over to trustees for the benefit of the creditors, it was held that under that deed not only the joint estate but also the separate estate, and consequently the separate right of each partner to the trade-mark passed to the trustees (*c*).

The owner of a trade-mark and his agent cannot sue jointly, although the name of the agent appear on the trade-mark (*d*).

By virtue of various Acts relating to the Cutlers' Company (21 Jac. 1, c. xxxi.; 31 Geo. 3, c. lviii.; 41 Geo. 3, c. xcvii.; 54 Geo. 3, c. xcix.) that company is empowered to grant trade-marks to freemen of the company, and by the last Act to persons not free of the company. A trade-mark granted by the company under the last-mentioned Act to a non-freeman of the company is assignable (*e*), but there is some doubt as to the assignability of a mark granted to a freeman.

(*a*) 2 J. & H. 139. (*b*) *Hovenden* v. *Lloyd*, 18 W. R. 1132.
(*c*) *Bury* v. *Bedford*, 33 L. J. 469. (*d*) *Delondre* v. *Shaw*, 2 Sim. 237.
(*e*) *Bury* v. *Bedford*, 33 L. J. 469.

CHAPTER VI.

INFRINGEMENT.

ASSUMING that there is nothing in the nature of the mark, or the circumstances attending its publication, to disentitle it to the protection of the court, and that it contains all the elements necessary to qualify it for protection in any case, the next question to consider is, what degree of similarity will be considered sufficient to justify the court in interfering by injunction to restrain the use of similar marks by another trader. And, first, it must be premised, as, indeed, might be expected where the subject of the piracy is capable of assuming an almost infinite variety of shapes, that no fixed rule can be laid down by which to determine whether or not a mark is a sufficiently close imitation of another to be liable to restraint. Each case, with the aid of the cases analogous to it reported in the books, must depend upon its own peculiar circumstances, a trifling variation in which will often be found to exercise material influence upon the result.

As was said in *Franks* v. *Weaver* (*a*) by the Master of the Rolls: "Nobody has been able to define what fraud is, it is so multiform: in this case it consists in the crafty adaptation of these words in such a manner as to make it

(*a*) 10 Beav. 803.

appear that the thing sold is prepared by the plaintiff. If the defendant imagines that because the similarity is not so great but that people may possibly find out the difference, or because the label does not contain the name of George Franks, or because the preparation is sold in bottles of a different size and form, that therefore he does not come within the scope of these decisions, he is under a great misconception."

It being already determined that the existence of a fraudulent intention on the part of the defendant is not a material part of the question in a court of equity, the main thing to be taken into consideration is, whether such an inspection of the defendant's mark taken as a whole, and having regard also to the mode of affixing it to the goods, and to all the circumstances attending its use, as a purchaser of ordinary intelligence exercising a proper amount of caution might be expected to bestow upon it, would lead him to suppose that he was buying the manufacture of the plaintiff.

By such an inspection is not implied the careful examination which a suspicious person would bring to bear upon it, and still less is intended that which would be bestowed by a person engaged in the business and acquainted with the usages of the trade; nor is it intended to exclude from the protection of the court persons who are habitually unwary; for whom, indeed, such protection may be presumed to be generally required.

In *Glenny* v. *Smith* (*a*) it was said by Vice-Chancellor Kindersley: "But further than this, it is not the question whether the public generally, or even a majority of them, are likely to be misled, but whether the unwary, the heedless, the incautious portion of the public would be

(*a*) 11 Jur. (N. S.) 964.

likely to be misled. And I think that not a very inconsiderable portion of the public may be safely so described."

But with this should be compared the judgment of Lord Cranworth, in *The Leather Cloth Company* v. *American Leather Cloth Company*, from which it appears that the maxim, "*vigilantibus non dormientibus leges subserviunt*," is not to be lost sight of; and even an unwary and incautious person must be expected to bestow some attention upon the mark when purchasing an article.

And in the same case, *per* Lord Cranworth, we find: "The gist of the complaint in all these cases is, that the defendants, by placing the plaintiff's trade-mark on goods manufactured by the defendants, have induced persons to purchase them, relying on the trade-mark as shewing them to be of the plaintiff's manufacture. This necessarily supposes some familiarity with the plaintiff's trade-mark."

Still it should be remembered that where the name of the maker forms part of the mark, or where the mark contains anything equivalent to an assertion that the goods were made by the plaintiff, this familiarity is not necessarily implied.

To obtain the protection of the court it is not essential that the two marks should resemble each other so closely as to deceive a person observing them with ordinary care when placed side by side (*a*). In *Seixo* v. *Provezende* Lord Cranworth said: "If the question turned upon the inquiry whether a person having a cask of the plaintiff's and a cask of the defendant's placed side by side, could mistake one for the other, there could be no doubt as to the result, for the two marks are altogether different. But that is

(*a*) *Seixo* v. *Provezende*, L. R. 1 Eq. 192.

not the question, or not the sole question. It is obvious that in these cases questions of considerable nicety may arise as to whether a mark adopted by one trader is or is not a colourable imitation of the mark of another trader complaining of its use, and it is hardly necessary to say that to entitle a person to relief it is by no means necessary that there should be absolute identity."

It has been said, however, that where the two marks are not identical, proof of a fraudulent intention on the part of the defendant must be given to entitle the plaintiff to relief (*a*).

From the case of *Seixo* v. *Provezende* it appears that the fact of the separate statements and details in a trade-mark being separately true and correct, will not justify a defendant in combining them into a colourable imitation of the plaintiff's mark.

The plaintiffs in this case were wine-growers, and had been in the habit of distinguishing wines grown by them with the following brands: The figures of a crown and eagle, with the letters B.S. (meaning Baron de Seixo) on the head of the cask, and a crown with the word Seixo, and the year of the vintage, at the bung-hole.

The defendants marked their casks with the figure of a crown and the letters C.B., and the words Seixo de Cima (meaning upper Seixo) and the date on the head of the cask, and a crown with the letters C.B., and the words Seixo de Cima at the bung-hole. It was contended that the defendant had a right to use the words Seixo de Cima, as his quinta was situated, as well as the plaintiff's, in a district the whole of which was properly described by the word Seixo; and also that he had a right to the use of a coronet, as being a grandee of

(*a*) *Wotherspoon* v. *Currie*, L. R. 5 H. L. 519, *per* Lord Chelmsford.

Portugal. Lord Cranworth said: "Even assuming the truth of what is contended by the defendants, that part of their vineyards are known by the name 'Seixo,' that does not justify them in adopting a device or brand the probable effect of which, is to lead the public, when purchasing their wine, to suppose that they are purchasing wine from the vineyards of the plaintiff."

Also in *Franks* v. *Weaver* (*a*) it was said by Lord Langdale: "It is very true that if any one compares the plaintiff's wrappers with the label used by the defendant he will find a very considerable difference—the difference is even striking; but it is not by similarity of form or the mode of printing that we can get to any result in this case. Again, if anybody critically reads the advertisement of the defendant he will find that he does not, in direct terms, apply the encomium given to the plaintiff's preparation to his own; he does not even say that the preparation sold by him is made by the plaintiff; and yet for all that nobody could look at these things without observing that the name and testimonials of the plaintiff are so craftily employed as to be well calculated to produce in the minds of ordinary readers the impression that the mixture made and sold by the defendant is the same as that to which these testimonials are applicable: that is to say, the mixture or solution of the plaintiff."

In *Shrimpton* v. *Laight* (*b*), where it was urged on the part of the defendant that the evidence of persons in the trade went to shew that the two labels in question were easily distinguished, Sir John Romilly, M.R., said: "I think this is a plain colourable imitation of the plaintiff's trade-mark. The way in which the court deals with these cases is, not to see whether manufacturers them-

(*a*) 10 Beav. 297. (*b*) 18 Beav. 164.

selves would distinguish them, but whether the public, who may be more easily misled, would probably be deceived."

Proof of persons being actually deceived is not necessary before applying to the court, if the court is of opinion that there is on the whole such a general resemblance between the two marks that ordinary purchasers would mistake one for the other; but cases of actual deception being the best evidence of such general resemblance a plaintiff will be held justified in delaying for a reasonable time his application to the court for the purpose of fortifying himself by procuring them.

In *Lee* v. *Haley* (*a*) Lord Justice Giffard said: "But when you come to look at the question of delay, each case must necessarily depend upon its own particular circumstances. Now the first thing to be observed in cases of this description is this, that it would not be safe for a plaintiff to come into this court until he could establish actual cases of deception, because you would be for ever trying hypothetical cases, and you would have a number of people brought forward to say, and probably truly, that the thing done was not calculated to deceive." Also *per* Bacon, V.C., in *Isaacson* v. *Thompson* (*b*): "I quite concur that a plaintiff is not compelled to rush into court; he is not to come into court with an imperfect case when by reason of delay he may make his case more complete."

Nevertheless, though there be no proof of actual deception, if the similarity be obvious, want of such proof will not be of any consequence (*c*).

(*a*) 39 L. J. (Ch.) 284. (*b*) 41 L. J. 101.
(*c*) *Chubb* v. *Griffiths*, 35 Beav. 127; *Lee* v. *Haley*; *Hookham* v. *Pottage*, 26 L. J. 757.

The court will not restrain the use of a trade-mark on the ground of general similarity, if it is different in the part to which a customer would look to see whose manufacture he was purchasing (*a*).

In *Blackwell* v. *Crabb* the two labels presented many points of resemblance, and could not have been distinguished at a short distance; but an injunction was refused because it was a case in which a purchaser would satisfy himself, not by the general appearance of the label, but by the name of the maker upon it.

It was said in *Croft* v. *Day* (*b*): "It is perfectly manifest that two things are required for the accomplishment of a fraud such as is here intended. First, there must be such a general resemblance of the forms, words, symbols, and accompaniments as to mislead the public; and secondly, a sufficient distinctive individuality must be preserved, so as to procure for the person himself the benefit of that deception which the general resemblance is calculated to produce. To have a copy of the thing would not do, for though it might mislead the public in one respect it would lead them to the place where they would be sure to get the genuine article an imitation of which is improperly sought to be sold."

In *Day* v. *Binning* (*c*) both plaintiffs and defendant were manufacturers of blacking, and the latter sold his blacking in bottles which not only resembled the bottles used by the plaintiffs but were labelled in a similar manner; the only difference between the two labels being that the label of the plaintiffs described their blacking as manufactured by Day & Martin, whilst that of the defendant described his blacking as equal to Day &

(*a*) *Blackwell* v. *Crabb*, 36 L. J. 504.

(*b*) 7 Beav. 85, *per* Lord Langdale. (*c*) 1 C. P. Coop. 489.

Martin's. The words "equal to" were printed in very small type. An injunction was granted *ex parte* to restrain the defendant from using any labels in imitation of those of the plaintiff.

Where a plaintiff seeks to restrain a printer from printing his labels and selling them to third parties, the bill must contain an averment that there have been sales of a spurious article with these labels attached; but the bill need not contain an averment that the defendant sold the labels for the purpose of being put on a spurious article. It is sufficient that the bill states that the defendant is manufacturing that which is known to be the trade-mark, which the plaintiff has a right to use, and the use of which upon the goods of a third party would be a fraud upon the plaintiff; and that the defendant is selling such labels to every one who asks for them, and is thus scattering over the world the means of enabling persons to commit frauds upon the plaintiff, and that such frauds have been committed; that is a sufficient averment to entitle the plaintiff to an injunction (*a*).

Where a wharfinger having the custody of goods marked with a counterfeit brand, upon receipt of notice that an injunction was about to be applied for, refused to deliver the goods to the holder of the dock warrants, the court upon bill filed restrained an action for damages for the non-delivery, commenced by the holder of the warrants against the wharfinger (*b*).

Irrespective of a copyright the courts recognise and will protect an author's exclusive right to attach his own name as a trade-mark to works of his own composition,

(*a*) *Delondre* v. *Shaw*, 2 Sim. 240; *Farina* v. *Silverlock*, 1 K. & J. 515.
(*b*) *Hunt* v. *Maniere*, 34 Beav. 157.

and will restrain other parties from selling spurious works with an author's name on them (*a*).

At the instance of the proprietor of a newspaper or periodical the court will grant an injunction to restrain another person from publishing another paper purporting to be a continuation of the plaintiff's, or entitled in such a way as to lead the public to purchase it as a continuation of the plaintiff's (*b*).

In *Prowett* v. *Mortimer* the plaintiff had purchased a paper called the "Britannia" with the purpose of combining it and publishing it together with another periodical called the "John Bull" as the "John Bull and Britannia Paper." After the incorporation of the two the defendant published a paper which he called the "True Britannia," in imitation and as a continuation of the "Britannia."

The objection being raised on the part of the defendant that the plaintiff had so dealt with his property as to abandon his right to the exclusive use of the title, it was said by Vice-Chancellor Stuart: "That the purchaser of property of this description if he acquired an absolute dominion over the property, had a right to use it in any lawful way in which he might consider it to be of the most advantage to himself; and he knew of no case in which he might be prevented from enjoying this property in combination with any other property of the same description. That it might be so enjoyed was plain. What the plaintiff had purchased he had a right to continue under a certain name. In respect of the mode in which the plaintiff used his property, he saw no reason whatever to say that he had lost his right to have it pro-

(*a*) *Lord Byron* v. *Johnston*, 2 Mer. 29.

(*b*) *Hogg* v. *Kirby*, 8 Ves. 220; *Longman* v. *Winchester*, 16 Ves. 269; *Prowett* v. *Mortimer*, 2 Jur. (N. S.) 414.

tected against the acts of another who was illegally diminishing its value and depriving him of the full benefit of it. . . . The notice published by the defendant had the effect of inducing subscribers to trade with the 'True Britannia' as a continuation of the old paper which the plaintiff had purchased, and the advertisers had been dealt with in a similar manner. The defendant had no right to deal with advertisers and subscribers as if for the 'Britannia' in the manner alleged, but only so as not to interfere with the plaintiff's right."

Where a workman in plaintiff's employ had surreptitiously acquired a knowledge of the plaintiff's recipe without its being imparted to him by his employer, the court granted an injunction to restrain him from imparting his knowledge and from making and vending the medicines by means of the recipe (*a*).

In *Seeley* v. *Fisher* (*b*), where four editions of a literary work had been published in the author's lifetime, and the work was revised by the author again for a fifth edition, which was published after his death by his representative, and the defendant published in monthly numbers an illustrated series of the fourth edition, with an advertisement on the wrapper of the number to the effect that all additional matter contained in any edition subsequent to the fourth was spurious and of no value, this allegation was held to be no subject for injunction, though it might be for action, as being a libel or disparagement of the plaintiff's edition.

The right to sell his goods in his own name, and to claim protection in the use of his name as a trade-mark, are rights which belong to every member of the

(*a*) *Yovett* v. *Winyard*, 1 J. & W. 394.
(*b*) 11 Sim. 582. See *James* v. *James*, 41 L. J. 353.

community; subject always to the contigency that another individual of the same name may at any time start in the same description of business and make use of that name openly in his trade; and if a Mr. Smith or a Mr. Brown chooses to rely upon his name as a trade-mark he may find it a very inadequate security.

Of all the devices that may be adopted as trade-marks a man's own name is the most obvious and the most natural. It often spontaneously acquires the character of a trade-mark without the exercise of any such intention on the part of the owner; who may be merely pursuing the course of conduct most natural to a trader, and never dreams of attaching any legal consequences to his act until he finds his rights invaded by the fraudulent use of his name by another.

The unrestrained character of the right of every man to use his name openly and honestly in his business must, of course, detract from its value as a trade-mark, because a person of the same name cannot be hindered in the enjoyment of the same privilege by the mere accident of another man of that name having preceded him. This remark, however, must be limited to a man's right to use his name *simpliciter*; and it does not follow that he will be allowed to use it in any way he thinks fit.

Although a court of equity will never interfere to prevent a man from opening a shop in his own name, it will restrain his right so far as to forbid him to use his name in a particular way. There is no case in which the courts have granted an injunction to restrain a man absolutely from trading in his own name, but there are many cases in which an injunction has been granted to restrain a man from opening a shop or selling his goods with his name affixed in such a manner as to mislead and

deceive the public and wrongfully to deprive another trader of the benefit of his reputation and skill.

What circumstances will be held sufficient to justify the interference of the court must of course depend entirely upon the nature of each case as it arises, and the combination with which a man's name may be advertised to the public are too various to be made the subject of a definite classification. The same principle which governs all the cases of infringement of trade-marks, that no man shall sell his goods as the goods of another, will determine the courts in restraining a man in the use of his name, subject, it would seem from the cases, to the distinction that in these cases much greater care will be taken in framing the injunction to interfere as little as possible with a man's mode of conducting his business consistently with preventing the fraud or injury complained of. This will appear from the judgment of the Master of the Rolls in the case of *Croft* v. *Day*.

"My decision does not depend upon any peculiar or exclusive right the plaintiffs have to use the names of Day & Martin, but on the fact of the defendants using those names in connection with certain circumstances, and in a way calculated to mislead the public and to enable the defendant to obtain at the expense of Day's estate a benefit to himself to which he is not in fair and honest dealing entitled. Such being my opinion I must grant the injunction restraining the defendant from carrying on that deception. He has a right to carry on the business of a blacking manufacturer fairly and honestly, he has a right to the use of his own name. I will not do anything to debar him from the use of that or any other name calculated to benefit him in an honest way, but I must prevent him from using it in such a way as to deceive

and defraud the public, and obtain for himself at the expense of the plaintiffs an undue and improper advantage" (*a*).

All the decisions shew that a trader's right to use his own name is not to be interfered with without the strictest necessity, and it may be doubted whether proof of a fraudulent intention on the part of the defendant is not essential, thus forming an exception to the usual ground for granting an injunction.

In the case of *Burgess* v. *Burgess* the plaintiff was the manufacturer of fish sauce which he denominated, "Burgess's Essence of Anchovies," the manufactory being at 107 Strand. The defendant, plaintiff's son, William Harding Burgess, after being for many years in business with his father, upon the occasion of a disagreement left him, and set up in business at 36 King William Street, City.

The defendant had written up over his door, "W. H. Burgess, late of 107 Strand," and sold fish sauce in bottles similar in shape and size to those used by the plaintiff, with wrappers and labels bearing a general resemblance to the plaintiff's, with the words, "Burgess's Essence of Anchovies."

Vice-Chancellor Kindersley granted an injunction to restrain the defendant from writing over his door, "Late of 107 Strand," but refused an injunction to restrain him from selling Burgess's Essence of Anchovies in the manner described. On appeal this decision was affirmed by Lords Justices Turner and Knight Bruce. In giving his decision Lord Justice Turner said: "It is clear to me that no man can have any right to represent his goods as the goods of another; but in all cases of this nature it must be made out that the defendant is selling goods as the goods of another. Where a person is selling goods under his own

(*a*) *Croft* v. *Day*, 7 Beav. 84.

name and another person not having that name uses it, it is clear that he so uses it to represent the goods sold by himself as the goods of another; but where the person has the same name it does not follow that because the defendant is selling the goods under his own name, and it happens that the plaintiff has the same name, he is selling goods as the goods of the plaintiff."

Also *per* Knight Bruce, L.J., "All the queen's subjects have a right if they will to manufacture and sell pickles and sauces, and not the less so that their fathers have done so before them. All the queen's subjects have a right to sell them in their own name, and not the less so that they bear the same name as their father."

The use of the name of another manufacturer, whether done *scienter* or not, is an interference with his business which the court will interfere to restrain, on the ground that the defendant is endeavouring to pass off the goods of his own or some one else's manufacture as the goods of the plaintiff (*a*).

In *Ainsworth* v. *Walmsley* the plaintiffs were makers of thread of considerable repute, and sold usually their goods with labels attached to each end of the spool on which the thread was wound and packed in boxes, the labels and boxes bearing his name. Defendants bought from Messrs. H. & S. a quantity of thread which had been, as they were informed and led to believe, part of the stock of another firm, John Wreford & Co., whose stock had been sold off. The spools had "Wreford & Co." on them. This thread the defendants sold to a retail dealer with the assurance that Wreford & Co. had bought it from Ainsworth, and that the thread was Ainsworth's manufacture.

The peculiarity in the case is that the goods were sold

(*a*) *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 525.

with merely a verbal assurance, and stamped with a name of another person and not of the plaintiff. And the remarks of the learned judge indicate that but for this obvious inconsistency the transaction would have been an interference with the rights of the plaintiff sufficient to justify the interference of the court. "I do not for one moment agree with the argument urged by the defendants' counsel, that it would have been lawful for the defendants to have sold this thread in skeins to Mrs. Fell (the retail dealer) saying it was Ainsworth's thread. That would have been a distinct misrepresentation which would have given them an advantage they would have had no right to derive. But in this case the statement disclosed the circumstance that the article had passed through the hands of another manufacturer."

It is said that when a person is selling an article in his own name, fraud must be shewn to constitute a case for restraining him from so doing on the ground that the name is one in which another has been long selling a similar article (*a*). It is submitted that the cases bearing upon this point hardly go the length of supporting this proposition.

Where the act complained of is the selling of goods by the defendant with his own name, the same as the plaintiffs, and nothing more, fraud on the part of the defendant is impossible, as the act is essentially an innocent and proper one; unless it were possible to impute fraud to the defendant on the ground that, having already the same name as the plaintiff, he had adopted the plaintiff's business or trade with a dishonest intention of profiting by the plaintiff's reputation, an imputation which would of course not be listened to in a court of justice.

But if it is sought to prevent the defendant using the

(*a*) Law of Injunctions (Joyce), p. 328.

name in combination with other *indicia*, even where the name is the only thing that could be considered as a trade-mark, as for instance the name printed in peculiar colours or letters, or vertically or diagonally, it is not so easy to see on what ground such a case should not come within the principle of protecting property by which the courts are usually governed. In *Burgess* v. *Burgess* (*a*), which is a very strong, perhaps, the strongest, case in point, what Lord Justice Knight Bruce said was: "If any circumstance of fraud had accompanied and were continuing to accompany the case, it would stand very differently; but the only ground of complaint is the great celebrity which during many years has been possessed by the elder Mr. Burgess's 'Essence of Anchovies.'" No doubt if fraud had accompanied the case, it would have formed an important ingredient, and might have been conclusive, but this does not say that the absence of fraud was conclusive the other way. In fact the ground of the decision is shewn by Lord Justice Turner immediately afterwards: "I concur in the opinion that the motion should be refused. It is clear that no man can have any right to represent his goods as the goods of another; but in all cases of this kind it must be made out that the defendant *is* selling his goods as the goods of another."

Although when a man commences selling goods openly in his own name the presumption that he does so innocently is strongly in his favour, still when a trader assumes a name not his own for the purpose of selling goods with it, and it appears that another man of the same name has preceded him in the sale of the same description of goods, the presumption against him of fraud in so doing is almost irresistible.

(*a*) 22 L. J. 678.

Where a person is selling goods under his own name, and another person not having that name is using it, it is clear that he so uses it to represent the goods sold by himself as the goods of another (*a*). Nor is the presumption of a fraudulent intention against him less if instead of at once assuming a name to which he has no right, he were to take into partnership a man of the same name as the plaintiff, so as to bring the use of the plaintiff's name by himself within the strict letter of the truth.

In *Southern* v. *Reynolds* (*b*) the plaintiff was a maker of tobacco pipes at Broseley in Yorkshire, which pipes were known as Southern's Broseley pipes, and had considerable reputation. The defendant, a pipe-maker in London, went to Broseley and made application for some one of the name of Southern to assist him in the manufacture of his pipes. He afterwards sold his pipes with the name of Southern's Broseley outside the boxes containing them. Vice-Chancellor Wickens held that this was a fraudulent use of the plaintiff's name to induce persons out of the trade to believe they were buying the pipes of the plaintiff's manufacture, and granted an injunction in the terms of the prayer of the bill, with an account of profits, and an inquiry as to damages and costs of suit.

In *Schweitzer* v. *Atkins* (*c*) the plaintiff sold a preparation of cocoa labelled "Schweitzer's Cocoatina." The defendant Atkins had been in plaintiff's employ, and afterwards entered into partnership with a man named Otto Schweitzer, and the two traded together under the name of Otto Schweitzer, Atkins, & Co." They sold packets of cocoa labelled "Otto Schweitzer, Atkins, & Co.'s Cocoatina" the packets and labels having a general

(*a*) *Burgess* v. *Burgess*, *per* Turner, L.J. (*b*) 12 L. T. (N. S.) 75.
(*c*) 37 L. J. (Ch.) 847.

resemblauce to the plaintiffs. It was held that this was a fraudulent and colourable imitation; and injunction was granted accordingly. In giving judgment Malins, V.C., said: "If nothing but what was fair was intended by the defendant I think the new firm might have been called Atkins & Schweitzer instead of Otto Schweitzer, Atkins, & Co. It is clear beyond a doubt to my mind that the object of putting the names in that order was to enable the defendant with apparent truth to imitate the plaintiff's trade-mark."

The inventor and proprietor of a secret recipe for the manufacture of any description of goods can assign and devise the secret, and the right to use his trade-mark with the name of the article, but cannot, nor can his assignees, prevent any person who has discovered the secret from making the article, and asserting that it is made according to the recipe of the original inventor, if the person have acquired his knowledge of the secret without fraud or breach of trust, and avoids making any intimation that he is the successor of the original maker (*a*). If, however, the possession of the secret had been obtained by fraud or breach of an agreement, the court would at the instance of the owner restrain him from making use of it.

In the case of *James* v. *James* (*b*) one Lieutenant Robert James had been the inventor and maker of a certain horse blister, known as Lieutenant James's Blister, the recipe for which was a secret but not patented.

The secret and the business were assigned to R. J. James and James James. It appeared that R. J. James, the defendant, and the son of James James, was occasionally employed by his father in the manufacture, and thus learnt the secret. Lieutenant James, the original inventor

(*a*) *Canham* v. *Jones*, 2 V. & B. 220. (*b*) 41 L. J. 353.

died in 1865, and after his death R. J. James, in conjunction with Mr. Vernon Southee, manufactured the article and sold it under the name of Lieutenant James's Blister, in pots very similar in form and size to those used by the plaintiff, and labels on the side of the pots containing directions for use almost identical in terms with those of the plaintiff, and a label on the top of each pot with a trade-mark of a horse's head; with the words "manufactured by Robert James, grandson of the inventor, and made by him for Lieutenant James in his lifetime." At the bottom of the label "Robert James" as the facsimile of the signature of the original inventor. A bill for injunction prayed that the defendants might be restrained from selling any ointment under the name of Lieutenant James's Horse Blister, or in pots or circulars which were a colorable imitation of the plaintiff's.

The following order was made by the Master of the Rolls. Restrain the defendant from using the name of Robert James singly, instead of Robert Joseph James or R. J. James; also from stating or inserting in his advertisement or circular any words or expressions asserting or suggesting that the ointment manufactured and sold by the plaintiff is spurious and not genuine."

In giving judgment the Master of the Rolls said: "I am of opinion that a person having discovered a valuable invention and not having patented it, any person who has discovered the ingredients (I am not talking of the case of a breach of trust, a species of fraud, and the like) but any one who has discovered the ingredients fairly may use the ingredients, and may use the name of the person who invented them, not in his lifetime, so as to suggest that they were made by him, but after his death as in this case, and in the case of the Reading Sauce, and in the case of

James's Fever Powder; any person who can make out that he has fairly acquired the prescription may sell the article and any person may buy it.

"So when Lieutenant James makes a valuable blister for horses, as soon as he dies that becomes a matter of commercial trade, and any person may make Lieutenant James's blister for horses after that time provided he has got the proper prescription for that purpose fairly and properly. Any one who in the course of his business has ascertained how it is made, and chooses to state to the public he has learnt how Lieutenant James's blister for horses is made, I am of opinion is entitled to publish himself as making Lieutenant James's blister for horses, provided he does not say anything to shew that his article is made by the person to whom Lieutenant James has left his property."

The use of the words, "not in his lifetime," in the above extract, by the learned judge, in the way in which they are used, might convey an impression that a person possessed fairly of the knowledge of the secret could not in the lifetime of the inventor use it for his own benefit. That impression is of course erroneous. All that the Master of the Rolls meant was, that in this case, for instance, the ointment could not have been made and sold by another person as Lieutenant James's ointment simply, without carefully guarding against the inference that the ointment so sold was actually made by the inventor. All that is meant is that whereas in Lieutenant James' lifetime the use of his name, *per se*, would convey that impression to the mind of a purchaser, yet after his death, or after a lapse of time depending upon the circumstances of the case, it would come to mean no more than that the ointment was made according to his recipe.

In the case of *Lazenby* v. *White* (*a*), in which the subject of litigation was Harvey's Sauce, Lord Justice James said: "'Harvey's Sauce' not being in itself a trade-mark, of course it was open to anybody of the name of Lazenby to manufacture Harvey's Sauce, and say it was made by Lazenby, and to call it Lazenby's 'Harvey Sauce.' To that extent the Master of the Rolls has adopted the view of the defendant, but thought the defendant was not at liberty to use a label which was calculated to deceive the public into the belief that the defendant's sauce was the sauce of the plaintiff, and that he was not entitled to represent that his sauce was the 'original sauce,' or the 'original Lazenby's Sauce,' because in truth that was to represent it in another form as being the plaintiff's."

Where A. introduced into the market an article which, though previously known to exist, was new as an article of commerce, and sold it as A.'s Excelsior White Soft Soap, and acquired reputation therefrom, B. was restrained from selling a similar article as B.'s Excelsior White Soft Soap (*b*).

It is not necessary, in order to give a right to an injunction, that a specific trade-mark should be infringed; it is sufficient that the court should be satisfied that there was, on the whole, a fraudulent intention of palming off the defendant's goods as those of the plaintiff. But the imitation must be calculated to deceive; and where there was no proof that any one had been deceived, and a material part of the plaintiff's mark had been omitted, the court, notwithstanding strong circumstances of suspicion, refused to interfere (*c*).

The court will not interfere to prevent the defendant

(*a*) 41 L. J. 354.

(*b*) *Braham* v. *Bustard*, 1 H. & M. 447; *Young* v. *Macrae*, 9 Jur. 322.

(*c*) *Woolam* v. *Ratcliffe*, 1 Hem. & Mill. 295.

from selling goods with a false representation, on the ground of fraud only, unless such falsehood is an infringement of a right vested in the plaintiff.

Both plaintiff and defendant were manufacturers of pickles, and plaintiff had obtained a prize medal at the Exhibition of 1862. The court refused to interfere to prevent the defendant from falsely placing upon bottles of his own pickles the words, "Prize Medal, 1862," on the ground that the plaintiff's goods had not acquired any reputation abroad in connection with the words, "Prize Medal," and that there was nothing to shew that people buying pickles under that name would suppose they were buying the plaintiff's (*a*). In consequence of this decision the Exhibition Medals Act was passed in 1862 to prevent this particular description of fraud.

Where the printer of a newspaper died and bequeathed to his widow the benefit of the trade, subject to the trust of maintaining and educating her family; and the widow, having formed an attachment to the man who was engaged as foreman in the business, set him up in the same business, and gave him the use of the types and letterpress, &c., for publishing the same paper; the court held this to be a gross breach of trust, which could be restrained by injunction (*b*).

A declaration alleged that the plaintiff was employed by the defendant to make certain articles, and the defendant fraudulently directed the plaintiff to place on each of the said articles a mark which was the trade-mark of R.; and that the plaintiff did so innocently, and was thereby subjected to a chancery suit at the suit of R., which he had to pay a large sum to compromise. It was held by the Court of Queen's Bench that as the equity

(*a*) *Batty* v. *Hill*, 1 H. & M. 264. (*b*) *Keene* v. *Harris*, 17 Ves. 338.

suit could have been prosecuted by R. successfully for an injunction and account, the declaration shewed a good cause of action (*a*).

A man who has been in the employ of a firm of repute, has a right, on setting up in business for himself, to inform the public of the fact, and to derive all the benefit he can from so doing, but he must be careful not to make the announcement in such a way as to lead to the impression that he has succeeded to the business of his employers. In *Glenny* v. *Smith* (*b*) it was said by Vice-Chancellor Kindersley: "There is no question that if a person has been in the employ of a firm of reputation, and sets up for himself, he has a right in every way he thinks proper (provided it is entirely consistent with truthfulness) to communicate to every member of the public that he has had the advantage of being in such service, and may appropriate to himself some of the benefit arising from the character and reputation of his late employers."

"But it is obvious that it behoves him in so doing to take special care that it is done in such a manner as not to deceive purchasers, and one of the obvious modes of doing it, is not to let the name of the employer appear upon the shop front without his own appearing with it."

Where plaintiff was a manufacturer of a peculiar kind of ink, which he sold in bottles with labels of different colours, and with the words, "Stephen's Blue Black," in white capital letters of large type on a blue ground; and defendant also sold ink in bottles of a similar size, and with labels of a similar appearance, with the words, "Steelpen's Blue Black," also printed in white capital

(*a*) *Dixon* v. *Fawcus*, 9 W. R. 415.

(*b*) 13 L. T. (N. S.) 11; *Hookham* v. *Pottage*, 26 L. T. 755; *Williams* v. *Osborne*, 13 L. T. (N. S.) 498.

letters on a blue ground; it was held that this was a mere colourable imitation of the plaintiff's mark, intended to deceive purchasers (*a*).

The plaintiff, an old established tradesman, took the defendant into partnership, and the business of the firm was carried on under the name of H. & P. By a decree the partnership was dissolved, and it was ordered by the court that the plaintiff should continue in possession of the shop, stock, business, and assets of the partnership. Shortly afterwards, the defendant set up in the same line of business in a shop seven doors from the plaintiff's shop, and on the same side of the street. The court held, upon evidence, that the acts of the defendant were calculated to deceive, and granted a perpetual injunction restraining him from painting the name of the plaintiff on his shop, or from otherwise using the name of the plaintiff in such a manner as to lead to the belief that the defendant was carrying on his former partnership with the plaintiff (*b*).

The defendant might have been allowed to take a shop exactly like the plaintiff's, and fit it up, if he thought fit, in a manner exactly like the plaintiff's; but not to put up the plaintiff's name over the shop in any way calculated to lead purchasers to the belief that they were entering the shop of the plaintiff.

A circular had been issued by parties who had been recently in the employ of the plaintiffs, a firm of manufacturing engineers, informing the public that they, the defendants, had commenced business on their own account and made precisely the same goods as their former employers, with great improvements in the same, and could sell them at a much reduced price, as being satisfied with smaller

(*a*) *Stephens* v. *Peels*, 16 L. T. (N. S.) 145.
(*b*) *Hookham* v. *Pottage*, 20 L. T. 755.

profits. The circular, moreover, was worded in such a way as to lead to the impression that the former firm had ceased to carry on business; and four persons swore that they derived that impression from a perusal of the circular (*a*), and that but for the circular they would have gone to the plaintiff's firm: Held that the statements contained in the circular led to the inference that the machinery made by the plaintiffs could only be obtained at a cheaper rate from the defendants, and that it could no more be obtained from the plaintiff; and that such representations were a fraud upon the public and the trade; and an injunction was granted accordingly.

A trader will be restrained from holding himself out as being in business with another trader, or from using circulars tending to lead the public to suppose that he has succeeded to the business of another trader (*b*).

The name of the editor is not a necessary part of the title of a journal. In the absence of express contract to that effect the court will not restrain the owners of a journal from publishing it without the name of the editor (*c*).

In *Knott* v. *Morgan* (*d*) an injunction was granted to restrain the defendant from running an omnibus having upon it such names, words, and devices as to form a colourable imitation of the words, names, and devices on the omnibuses of the plaintiff.

Where the defendant had been in the habit of selling fireworks not made by the plaintiff in boxes of the plaintiff's with the plaintiff's name outside, and an attempt was made

(*a*) *Stevens* v. *Paine*, 18 W. R. 600.

(*b*) *Harper* v. *Pearson*, 3 L. T. (N. S.) 547; *Edgington* v. *Edgington*, 11 L. T. (N. S.) 299.

(*c*) *Crooks* v. *Petter*, 6 Jur. (N. S.) 1131.

(*d*) 2 Keen, 213.

to shew that the defendant had in his possession certain superfluous boxes of the plaintiff's that had contained the plaintiff's fireworks, and that the imitation fireworks were never placed in the plaintiff's boxes until after they were sold, the court expressed much doubt as to whether such a course could have been considered legal (*a*).

M. agreed with S., the lessee of the Revere House, a public-house, to keep good horses, carriages, and driver on the arrival of certain trains, to convey passengers to the Revere House, and in consideration thereof S. agreed to employ M. to convey all the passengers from the Revere House to the station, and authorized him to put upon his coaches and the caps of his drivers, the words "Revere House." A similar agreement previously existing between S. and B. had been terminated by mutual consent; but B. still continued to use the words "Revere House" as a badge on his coaches and the caps of his drivers, although requested not to do so by S.; and his driver called "Revere House" at the station, and diverted passengers from M.'s coaches into B.'s. In an action on the case, brought by M. against B. for using the said badge and diverting passengers, it was held that M. by his agreement with S. had an exclusive right to the use of the words "Revere House," for the purpose of indicating that he had the patronage of that house for the conveyance of passengers; that if B. used those words for the purpose of holding himself out as having the patronage and confidence of that establishment, and in that way to induce passengers to go into his coaches rather than the plaintiff's, this would be a fraud on the plaintiff, and a violation of his rights, for which an action would lie, without proof of actual specific damage; and that he would be entitled to recover such damages as the jury upon the whole evidence

(*a*) *Barnett* v. *Leuchars*, 13 L. T. (N. S.) 495.

should be satisfied he had sustained, and not merely for the loss of such passengers as he could prove to have been actually diverted from his coaches to the defendant's (*a*).

Where the plaintiff's trade-mark consisted of an anchor, and the defendants used the device of an anchor surmounted by a crown, the court held that this was a colourable imitation and calculated to deceive (*b*).

M. was proprietor and publisher of the "Birthday Scripture Text Book," a work brought out in two different sizes. P. for some time bought of M. copies of this work for sale, but afterwards published a work of his own entitled "The Children's Birthday Text Book," of precisely similar size and form to the smaller of M.'s books. It was held that M. was entitled to an injunction to restrain the use of the words "Birthday Text Book" in the title of P.'s book, and also to restrain P. from binding or ornamenting his book so as to be but a colourable imitation of M.'s (*c*).

On an application for an interlocutory injunction by the publisher of "Punch" against the publishers of a new journal called "Punch and Judy," with a different frontispiece, different price and different day of actual publication, to restrain them from using the word "Punch" in the name of their journal there being also a comic paper named "Judy;" it was held the circumstances did not justify the court in granting the injunction (*d*).

(*a*) *March* v. *Billings*, 7 Cush. 322 (Amer.).
(*b*) *Edelsten* v. *Edelsten*, 9 Jur. 474.
(*c*) *Mack* v. *Petter*, 20 W. R. 964.
(*d*) *Bradbury* v. *Beeton*, 39 L. J. 57.

CHAPTER VII.

REMEDY.

THE owner of a trade-mark who seeks the protection of the court, must use due diligence in making the application.

What conduct on the part of a plaintiff will constitute due diligence must of course depend upon the circumstances of his case; but delay or acquiescence will undoubtedly, in many cases, deprive him of the protection of the court.

In order to prove acquiescence by a firm in the piratical use of their trade-mark, knowledge of such use must be proved; and that is not accomplished by the proof of publication of advertisements, which would have been an invasion of the rights of the firm, if these advertisements have been issued not steadily and uniformly, but interchangedly with other advertisements in some respects similar, but not infringing the rights of the firm (*a*).

Acquiescence for a length of time by the plaintiff in the defendant's use of the trade-mark will disentitle the plaintiff to relief in a court of equity. Though a warning advertisement addressed to the public may be a sufficient protest, still if there be evidence to shew direct knowledge

(*a*) *Kinahan* v. *Bolton*, 15 Ir. R. 75.

of the piracy, the court may object to the plaintiff delaying to apply for injunction (*a*).

In *Beard* v. *Turner* (*b*) the plaintiff laid by for two years before filing his bill for injunction, having seen the defendant's label at the exhibition side by side with his own.

In giving judgment Wood, V.C., said: "I confess that if a person sees the identical thing done of which he complains, two years before he files his bill, he places himself in a position which is fully within the authorities cited. The principles laid down are well known, that if you induce another to lay out money by keeping back a right which you intend at some future time to assert, you induce him to incur serious expenditure. If you allow considerable expenditure to be made, you are not allowed afterwards to question the title of the person who has made that expenditure. But suppose you wish to profit by that act, of which you say you have a right to complain, and shall at some future period complain of, then I apprehend the court will say you must come here at once; for this reason, that you ask in the bill for an account of profits the defendant has made by the sale of these goods. I know of no instance in which the court has given relief with reference to trade-marks, except on a prompt application."

This judgment should be compared with the decision of the same learned judge in *Harrison* v. *Taylor* (*c*), where the plaintiff had also delayed two years, but appeared to have cautioned the defendants against persisting in the infringement of the mark.

His Honour said: "Upon the question of delay no doubt the plaintiff ought to have filed the bill sooner, but

(*a*) *Kinahan* v. *Bolton*, 15 Ir. R. 75; *Braham* v. *Bastard*, 1 H. & M. 448.
(*b*) 12 L. T. (N. S.) 746. (*c*) 11 Jur. 408.

the defendants had persevered in the use of the mark after being cautioned.

"The plaintiff having delayed so long before coming to the court would have no account of profits. The defendants would have a month's time to discontinue the mark, but must pay the costs."

Where a trader has acquiesced in an infringement of his trade-mark for a considerable time, his representatives will be unable to restrain it after his death.

The presumption that he has acquiesced is not rebutted by his having only published advertisements warning the public not to deal with the rival trader: he must intimate to him that he is perpetrating an unlawful act (*a*).

A plaintiff's right to an interlocutory injunction is not destroyed by delay, if he have merely waited with a reasonable hope of an accommodation being effected, and the defendant have not incurred expense or injury by the delay (*b*).

Where a publication infringing the plaintiff's right had been published for some time before the application, and knowledge of it had not been actually brought home to the plaintiff, the court postponed the order for injunction to allow the plaintiff to bring further evidence by affidavit to shew that none of them were aware of the piracy at an earlier date (*c*).

Where it appeared that the plaintiff had, to a certain extent, slept upon his rights, and had not been vigilant in ascertaining who were the parties injuring his trade, and also that he had been guilty of making false representations by means of advertisements, although such misrepresentations were held not sufficient to deprive him of

(*a*) *Hovenden* v. *Lloyd*, 18 W. R. 1132. (*b*) *Lee* v. *Haley*, 18 W. R. 181.
(*c*) *Chappell* v. *Sheard*, 2 K. & J. 122.

his right to injunction, and there was no evidence of any specific loss, it was held that the plaintiff was not entitled to an account for six years, but only as far back as the filing of the bill (*a*).

Where the plaintiff commenced a suit to restrain the use of the term "Chlorodyne" by the defendant, and afterwards dismissed the bill and paid the costs, it was held, in a subsequent suit connected with the same subject, that the plaintiff by so doing had abandoned his right to the exclusive use of the word "Chlorodyne" (*b*).

Where the plaintiffs had obtained an injunction to restrain the defendant from using one of twelve trade-marks, which they stated were all their peculiar marks, all such marks consisting of the same name with various additions; and the defendant after the decree had entered into a partnership bearing the name which was the principal part of the prohibited mark; and that partnership used the prohibited mark for five years without interruption from the plaintiffs: the court refused to commit (*c*).

Where an injunction has been granted to restrain the piracy of a trade-mark, a defendant will be liable on breach of such injunction to a committal for contempt, even if he be one of a firm all the members of which are not before the court, and if the defendant relies upon the plea of acquiescence by the plaintiff he must make out a case amounting almost to such a licence to do the act enjoined against, as would entitle him to maintain a bill against others for doing the same thing. The party ought to shew such acquiescence as would suffice to create new right in him (*d*).

(*a*) *Ford* v. *Foster*, 20 W. R. 822. (*b*) *Browne* v. *Freeman*, 12 W. R. 305.
(*c*) *Rodgers* v. *Nowill*. (*d*) *Rodgers* v. *Nowill*, 3 De G. M. & G. 618.

In *Isaacson* v. *Thompson* the right to an interlocutory injunction was lost by delay in filing the bill for nine or ten months since the discovery of the user.

The plaintiff carried on business at 170 Regent Street as a milliner under the style of Madame Elise. His wife's name was Elise, and she formerly managed the shop as assistant to Miss Jane Clark, and was known in the trade as Madame Elise. The defendant opened a shop at 252 Regent Street early in 1870, and on the facia was painted Mdlle. Louise. In November, 1870, he opened his shop at 210 Regent Street. On the shop front the name "Ellis" was put up and on the facia, 'Agnes Ellis.' The plaintiff complained that the user of these names in business led people to believe that they were the shops of Madame Elise. And he adduced evidence of several mistakes having happened, the first of which came to his knowledge early in January 1871, and the last in July 1871. Under these circumstances the injunction was refused on the ground of delay in filing the bill; Vice-Chancellor Bacon saying: "It is one of the most wholesome rules that a person who comes for the extraordinary relief of an injunction should come speedily. I have listened to all that has been said about the difficulty of collecting evidence and the necessity of having more than one instance, but, considering the nature of the case, and that the main complaint of the plaintiff is that there is such a similarity between the external appearance of the two shops, and such a similar sounding of the names that people are liable to be deceived; the very slight evidence of fact would have justified him, if he had been right in other respects, in asking for an injunction at a much earlier period."

The right to an account of the profits made by the defendant, by the sale of the goods marked with the spurious

trade-mark is incidental to the right to an injunction; the account being limited to profits made within the previous six years.

In taking the account, however, a man will not have to account for every species of profit made during the six years, but only to so much as is properly attributable to the user of the mark (*a*); nor will bad debts be charged as profits (*b*); but he cannot charge the plaintiff with the cost of making the goods in respect of which the bad debts have been incurred.

In *The Leather Cloth Company* v. *Hirschfield* (*c*) the plaintiff had obtained an injunction against the use of their trade-mark by the defendants, and an inquiry as to damages. They did not prove direct damage, and could not shew to what extent their trade-mark had been used, but claimed damages equal to all the profits made by defendants on all sales of cloth so marked.

Wood, V.C., holding that they were not entitled to damages, said: "The inquiry was as to the damage that had been done. There was no declaration of right in the decree. It was quite clear the plaintiffs were mistaken in their rights. They would have had a right to ask for an account of profits, but they had chosen to take the alternative right of asking for an inquiry as to damages sustained by them."

Where an injunction has been granted, the court will, if the petitioner require it, compel the defendant to give an account of sales (*d*); and where a decree has been granted directing the defendant to account for all goods sold by him with a particular stamp thereon, he is compellable to

(*a*) *Cartier* v. *Carlisle*, 31 Beav. 292.
(*b*) *Edelsten* v. *Edelsten*, 10 L. T. (N. S.) 780.
(*c*) 13 L. T. (N. S.) 427.
(*d*) *Kinahan* v. *Bolton*, 15 Ir. R. 75.

disclose the names of all persons to whom he has sold any such goods; and if he is unable to give such information precisely, he may then (but not otherwise) be required to disclose the names of all persons to whom he has sold any goods which he will not swear positively to be unstamped (*a*).

Where the defendants were under an order to produce documents, it was held that they were not bound to disclose the names of their customers, nor the prices at which they bought and sold the goods they exported; but they must state the names of the places to which they exported goods and the name of the writer of any letter addressed to them by a former partner of their own, and in every case in which they admitted using one of the marks claimed by the plaintiff, the other marks used in combination therewith (*b*).

When one of a line of trade-marks had been disclosed in the order-book, the rest of the line must be disclosed also (*c*).

A. having infringed B.'s trade-mark on a blistering ointment manufactured by A., it was agreed between them that all claims in respect of such invasion, not only with respect to A., but to include all parties who might have purchased ointment from him, should be settled and discharged by the payment of a sum of money, and B. undertook to execute a release of all claims and demands in respect of the above infringement. Before the agreement A. had sold large quantities of ointment to different persons, who after the agreement sold it with B.'s trade-mark; and suits were commenced against them by B. for injunctions. A. thereupon sued B. for specific

(*a*) *The Leather Cloth Co.* v. *Hirschfield*, 1 H. & M. 295.
(*b*) *Carver* v. *Pinto Leite*, L. R. 7 Ch. 90. (*c*) Ib.

performance of the agreement to execute the release, and to restrain B. from proceeding in the several suits: Held that the agreement was confined to sales by A. and all other persons to whom he had sold the ointment prior to the agreement; and did not authorize a sale by the latter after the agreement (*a*).

It was held in *Rollins* v. *Hinks* (*b*) that there is no such *primâ facie* presumption of the validity of a patent as to entitle a patentee by publishing threats of proceedings for infringement to injure a rival's trade, without by substantive proceedings establishing the validity of the patent.

In this case the defendants supposing themselves, (whether rightly or wrongly was not before the court as a matter for decision,) to be the patentees of an article, sent a letter to the plaintiff, threatening to take legal proceedings against him if he persisted in selling the article in question as he had announced his intention of doing, and subsequently sent to a large number of persons in the trade circulars warning them against purchasing these articles from the plaintiff, and threatening to sue for damages if they did, in consequence of which the plaintiff was unable to obtain any orders from customers. An interval from October to January after this having elapsed without the defendants having taken any steps against the plaintiff for the alleged infringement of the patent, the plaintiff filed a bill to restrain the continued publication of these advertisements. In granting the injunction Vice-Chancellor Malins said: "Now, then, do the defendants believe in the validity of their patent? If they do, this circular may be in good faith. If they do not, then it is wanting in good faith, and closely bordering upon fraud; because knowing, or having reason to believe, that their patent is invalid they

(*a*) *Oldham* v. *James*, 13 Ir. R. 393. (*b*) 41 L. J. 358.

go on issuing their intimidating advertisements, and so alarm the public as to destroy the plaintiff's trade.

"The plaintiff, as far as I can see, has every probability of carrying on a large trade in those articles if it were not for the circular. Ought his trade to be destroyed by men who will not bring their claim to a test? If they do believe in their claim to the patent they cannot have a better defendant to sue than the plaintiff in equity. Why do they not bring their action? They have been threatening ever since October, and now in January, three months and a half afterwards, no action has been brought, nor will they undertake to bring an action within a limited time."

Although it does not appear that a question analogous to this with respect to an alleged title to a trade-mark has ever been actually decided in a court of equity, it may be inferred, from the identity of the principles involved in either case, that a man would be restrained from injuring the business of another by continual threats of legal proceedings for an alleged infringement of his trade-mark, if he did not within a reasonable time have recourse to substantive legal steps to establish his own title to the mark in question.

It is not necessary that proof should be given of persons having been actually deceived, and having bought goods with the defendant's mark, under the belief that they were the manufacture of the plaintiff, provided the court be satisfied that the resemblance is such as would be likely to cause one mark to be taken for the other (*a*).

Nevertheless proof that persons have been deceived is an important consideration, and will often determine the court when otherwise there would be some doubt (*b*).

(*a*) *Edelsten* v. *Edelsten*, 9 Jur. 479.
(*b*) *Browne* v. *Freeman*, 12 W. R. 305.

The injury done to the plaintiff in his trade by loss of custom is sufficient to support his title to relief. Neither will the plaintiff be deprived of remedy in equity, even if it be shewn by the defendants that all the persons who bought from them goods bearing the plaintiff's trade-mark were well aware that the goods were not of the plaintiff's manufacture (*a*).

The court will not notice negotiations antecedent to the suit, except in cases of bad faith, unless they amount to a release or binding agreement with respect to the causes of action (*b*).

If other parties are necessary for any part of the relief prayed, that is sufficient to sustain a demurrer for want of parties, and it is no answer to such demurrer to say that that part of the relief may be waived at the hearing.

In *Dent* v. *Turpin* the defence set up was by demurrer for want of equity and want of parties, on the ground that the alleged injury was done to one of the firm who succeeded to Dent's business as much as to the other, and that as the injury was joint, relief could only be obtained by joinder of all the parties injured; and that at any rate a separate account ought not to be decreed in each case, or the defendants would be made liable twice for the same injury by having to give accounts for the whole in two separate suits. The court decided that each party had a separate right to relief in respect of the wrong done him, and directed a proportion of profits made to be paid to the plaintiff (*c*).

Where a decree had been made at the hearing for a perpetual injunction, and the defendant appealed, and applied to have the hearing advanced, it was held that

(*a*) *Edelsten* v. *Edelsten*, 9 Jur. 479. (*b*) Ib.

(*c*) *Dent* v. *Turpin*, 2 J. & H. 139; *Weller* v. *Baker*, 2 Wills. 414; *Corylon* v. *Lithebye*, 2 Wms. Saund. 115.

as irreparable injury might result to the defendant, the hearing might be advanced (*a*).

The determination of the costs of the suit is a matter entirely in the discretion of the court, which in the exercise of that discretion will take into consideration all the circumstances of the case, of a nature to create an impression either favourable or unfavourable to either party; the court having power to allow to plaintiff or defendant the whole costs of the suit, or to order each party to pay his own, or to distribute them in such a way as may appear best to meet the justice of the case.

As a first principle upon which to act, it may be assumed that the party who succeeds in the suit is entitled to be reimbursed as to the costs, unless any circumstances in the conduct of either party induce the court to dispose of them otherwise. This is well explained by Lord Cottenham in *Millington* v. *Fox* (*b*): "The question of costs in Chancery is left to the discretion of the court. That discretion ought, as far as possible, to be exercised according to some principle, and I am much disposed as a general rule to make the costs follow the result; because however doubtful the title may be, or however proper it may be to dispute it, it is but fair that the party who has the right should be reimbursed, as far as giving him the costs of the suit can reimburse him. But then there is another object which the court must keep in view, namely to repress unnecessary litigation, and to keep litigation within those bounds which are essential to enable the parties to vindicate and establish their rights. . . . For what, then, is the suit prosecuted? Why, simply for the sake of the account, and that is so small that the plaintiffs abandon it at the hearing. Here there has been

(*a*) *Lazenby* v. *White*, 19 W. R. 291.

(*b*) 3 M. & C. 338.

a very expensive suit, with no possible object but the account, which, when the case comes on for hearing, the plaintiff's counsel very properly abandons. Now, under these circumstances, I think that a great deal of useless litigation has been carried on, and a great deal of unnecessary expense incurred. It strikes me therefore that this is a case in which the court is repressing useless litigation by refusing the plaintiffs the costs of the cause."

Where a person is innocently infringing the trade-mark of another, the owner of the mark has a right, immediately upon discovering the piracy, to file a bill to restrain it without giving any previous notice, and the best course open to the defendant, unless he means to dispute the bill, is to submit to an injunction and pay the costs. If he neglect to do this he will generally, unless the plaintiff should prejudice his own position by insisting upon more than he has a right to demand, be liable to pay the costs of any subsequent litigation.

In *M'Andrew* v. *Bassett* Lord Westbury said: "If upon the first notification of their having done wrong to the plaintiffs the defendants had offered to give up the practice, and had entered into an engagement for that purpose, the question of costs would have deserved much consideration."

Although, upon first ascertaining that his trade-mark is being pirated by another, a trader has a right at once to file a bill against the trespassers and to demand the payment of costs up to that time, without making any previous application to him to desist from continuing the piracy, yet the practice of applying to the defendant in an amicable way before commencing litigation is more in accordance with the spirit of natural justice, and has always been viewed with favour by the courts; in some cases the court having gone so far as to regret that no

rule prevailed in equity to make it compulsory upon a plaintiff to adopt that course.

Moreover, in cases where the injunction is granted, the absence of an application previous to filing the bill may form an important item in considering the question of costs.

In *Chappell* v. *Davidson* (*a*), Wood, V.C., said: "With regard to costs there would have been a great difference if the defendant had done all that it was competent for him to do. If when served with the interim injunction he had said, 'If you had applied to me not to do what you now seek to restrain me from doing, I should have been perfectly ready to have acceded to your request, and as you do not do so, if the interim injunction is granted I shall ask for my costs,' there would have been a good deal to have been urged on the part of the defendant, there having been no application previously made to him.

"But now that he comes forward and insists upon his right to publication, such an argument is at an end, and the question must be tried on his right. He has never made any offer to desist from publishing, and I am obliged to try it as I should try any other case where no previous application has been made."

Also, in *Upmann* v. *Elkan*, the Master of the Rolls said: "I assume, then, in addition that the person so applied to is innocent and ignorant of the fraud. It is his duty at once to give all facilities to the person injured for that purpose. If after that, the person injured file a bill, though he will be entitled to all that he asks in the shape of relief, as he might have got it all without suit, he will not get from the defendants the costs of the suit, and he may have to pay them.

(*a*) 2 K. & J. 129.

"I do not mean by this to lay down that the plaintiff, by which I mean the person whose trade-mark is fraudulently imitated, may not file a bill without making any inquiry at all, for it has never been laid down that a plaintiff entitled to relief must before filing a bill apply to the defendant and ascertain previously whether he will do without suit all that is required; though such a rule might and probably would be a very useful one, and I remember Sir J. Wigram regretting that no such rule prevailed. But the person at whose order the goods stood can only stop the further prosecution of the suit by applying to the plaintiff and consenting to do voluntarily all that he asks compulsorily."

In *Burgess* v. *Hills* (*a*), where the defendant had acted innocently, and desisted upon receiving notice of the plaintiff's right, the Master of the Rolls said: "All the cases cited shew that up to the time when notice was given the plaintiffs were entitled to their costs, which being refused by the defendants, it became necessary for the plaintiffs to incur the further expense of bringing the cause to a hearing to obtain them."

And in *Burgess* v. *Hately* (*b*), where the defendant acted innocently, and the plaintiff without giving any notice filed a bill, it was held that he was entitled to the costs of suit.

In *Millington* v. *Fox* (*c*) the plaintiffs having filed a bill to restrain the defendants from using certain trade-marks, and for an account of profits made by the sale of goods so marked, obtained an *ex parte* injunction. On the same day the plaintiffs received a letter from the defendants' solicitor, in which defendants stated that they had never used the marks since they were aware that they were

(*a*) 26 Beav. 218. (*b*) 26 Beav. 249. (*c*) 3 M. & C. 338.

private property; and that they did not intend to use them again; and offered to compensate the plaintiffs for any injury they might have sustained. The plaintiffs, however, prosecuted the case to a hearing. The Lord Chancellor, although he made the injunction perpetual, refused the plaintiffs their costs.

An order being made for an interim injunction to restrain an alleged infringement of a trade-mark, the defendant, to prevent further litigation, offered to give an undertaking in the terms of the prayer of the bill, and to pay the plaintiff's costs as between attorney and client, but refused to accede to another condition to publish an apology in the newspapers. An order for perpetual injunction being made, the court refused to allow the plaintiff's costs (*a*).

With reference to this also should be consulted the case of *Williams* v. *Osborne* (*b*), in which Wood, V.C., appears to have expressed the opinion that before the court would interfere to prevent one trader from making use of the name of another, it requires to be satisfied not only that the course taken by the defendant is calculated to deceive the public, but that representations have been made to him by the plaintiff that it will have that effect.

In *Millington* v. *Fox*, which was decided in 1838, it seems to have been tacitly assumed by Lord Cottenham that although the defendants had infringed the plaintiff's trade-mark innocently, and although his Lordship acquitted them of all fraudulent intent, that they were still entitled to demand an account of profits as a matter of right, and only deprived them of costs because they had brought the cause to a hearing for the sake of an account too small to be worth prosecuting. And as recently as *Cartier* v. *Carlisle* (*c*)

(*a*) *Hudson* v. *Bennett*, 12 Jur. 519. (*b*) 13 L. T. (N. S.) 498.
(*c*) 31 Beav. 292.

a defendant was held by the Master of the Rolls to be liable in equity for an account of profits, although the defendant at the time of the user might have been ignorant of the right, or even of the existence of the plaintiff. This doctrine as to the account must now undoubtedly be considered obselete and overruled by the decisions in *Moet* v. *Couston* and *Edelsten* v. *Edelsten*.

In *Edelsten* v. *Edelsten* (*a*) it was held by Lord Westbury, that the question whether the defendants had used the plaintiff's trade-mark in ignorance of the plaintiff's right was material with reference to the extent of the relief to be granted. For though it is well founded on reason and settled by authority, that if A. has acquired property in a trade-mark which is afterwards adopted and used by B. in ignorance of A.'s right, A. is entitled to an injunction; yet he is not entitled to any account of profits, or compensation, except in respect of any subsequent user by B., after he became aware of the prior ownership by A.

If an owner of a trade-mark asks for an injunction to which he is entitled, together with an account of profits to which he is not entitled, and the defendant offers to submit to a perpetual injunction, each party paying his own costs, and the plaintiff brings the cause on for hearing, the court, holding both parties in the wrong, will give no costs to either side.

In *Moet* v. *Couston* (*b*) the plaintiff, after the answer of the defendant had been filed, offered to stay all proceedings on payment of profits and cost. The defendant offered to submit to a perpetual injunction, each side paying its own costs, but refused to give an account of profits. The court held that as the defendant had acted innocently in the first instance, and had desisted from the piracy upon

(*a*) 1 De G. J. & S. 199. (*b*) 33 Beav. 578.

receipt of notice, the plaintiff had no right to demand an account of profits, and had by so doing forfeited his right to costs.

The Master of the Rolls said: "I have always held that where the plaintiff is entitled to an injunction, that right carries with it the right to the costs of suit. I have held in several cases—particularly in *Burgess* v. *Hills*—that this was the right of a plaintiff. The course usually adopted by a defendant, when he finds he cannot resist a suit, is to pay the costs and submit to an injunction, and then the matter is at an end. But the case here is very different, for the plaintiffs never limited their demand to the costs and injunction, but they asked and insisted on an account of profits. If they had merely asked for a decree and costs they would have been entitled to have a decree in their favour with costs. But they have asked something more than they are entitled to, and the case is therefore different."

Where a person knowingly commits a piracy upon a trade-mark he may generally be compelled to give an account of profits.

(*a*) Where part of the plaintiff's proceedings were unnecessary, as where the bill contained an allegation to the effect that certain marks used by the defendant were private marks of the plaintiff, and it appeared that they were used in the trade merely as signs of quality, and it was contended that the whole suit was vexatious, on the ground that the plaintiff before filing his bill ought to have applied to the defendant to obtain the recognition of his rights in an amicable manner, the court held that the plaintiff was entitled to found and establish his right by a suit, the general costs of which would be allowed

(*a*) *Pierce* v. *Franks*, 10 Jur. 25.

him, but such extra costs, if any, as had been incurred by the plaintiff's superfluous allegations would not be allowed.

Although proof of a fraudulent intention on the part of the defendant is not essential to the jurisdiction of a court of equity, to the extent that absence of such proof will not deprive a plaintiff of his right to relief against an injury done to his property; still where the act of the defendant was committed under such circumstances as to lead to the conclusion that his intention was to commit a fraud upon the plaintiff, the existence of such presumption against him will be important, both with respect to the injunction and the subsequent distribution of the costs of the suit between the parties.

As in the case of *Woollam* v. *Ratcliff* (*a*), where an injunction was refused, it was said: "The question of costs turns upon the consideration of whether Ratcliffe has or has not acted *bonâ fide* in the matter. I find much in the case raising considerable doubts on this point, but I also find conduct on his part leading to a contrary conclusion. I must give him the benefit of the doubt."

Circumstances will often appear upon a comparison of the two labels which will raise an almost irresistible inference of fraud against the defendant, as, for instance, the use of a peculiar form of wrapper like the plaintiff's, or adopting a peculiar and complicated method of packing or tying up in bundles, or any such combinations of colours, type, figures, letters, or numbers as would bear a general resemblance to the plaintiff's labels and could not have been the result of accident (*b*).

Fraud will not be presumed unnecessarily, nor will the

(*a*) 1 H. & M. 263, *per* Wood., V.C.

(*b*) *Croft* v. *Day*, 7 Beav. 84; *Holloway* v. *Holloway*, 13 Beav. 209; *Gleany* v. *Smith*, 11 Jur. (N. S.) 964; *Edelsten* v. *Vick*, 11 Hare, 84.

court intend fraud where it appears that the act of the defendant may have been perfectly innocent (*a*).

The fact that an article was offered for sale to a person who asked for the plaintiff's has been held strong evidence of fraud, although the article was not expressly represented to be the plaintiff's article (*b*).

When a defendant's servant, without the personal knowledge of the defendant, placed tickets with the plaintiff's name upon parcels of cloth of a quality inferior to the plaintiff's and made by another person, the court would not allow that the defendant was not both legally and morally liable. He was bound to know what had been done by his servants, and could not come before the court in the position of a person who had acted innocently.

Per Lord Romilly: "This is what the defendant should have done: the moment the bill was filed he should have said, 'Take a decree in the terms you ask and I will pay your costs.' It is impossible for him to say he is not liable to pay the costs. This case is quite distinct from *Millington* v. *Fox*. It is quite distinct from the case of *Nunn* v. *D'Albuquerque*, where the defendant said, 'I was not at all aware of the patent; and the moment I heard of the patent I gave up all the goods I had manufactured; I will undertake not to do it any more; I will pay the costs, and I will also pay you the profits I have made.' If after such an offer a plaintiff brings the case to a hearing it is a case of oppression, for what more could he get.

"That is not so in this case; very far from it. Accordingly I must make a decree as asked for with costs, up to and including the hearing. But I strongly advise the plaintiffs not to ask for an inquiry as to damages. The

(*a*) *Delandre* v. *Shaw*; 2 Sim. 237; *Farina* v. *Silverlock*, 6 D. M. & G. 214: *Spottiswoode* v. *Clark*, 2 Ph. 156.

(*b*) *Leather Cloth Co.* v. *American Cloth Co.*, 1 H. & M. 295.

burden of proof lies on him, and he will have to pay the cost of the inquiry if he does not prove any damage. . . . It is impossible for a man to say he does not know what his servant does. This sort of thing is never done personally by the parties in any case; it is always done by some servant or agent. They are bound to know what their agents do, and if they do not know they are responsible just the same as if they did" (*a*).

Where there was not a sufficiently clear and distinct representation that the goods sold by the defendant were the goods of the plaintiff to justify the court in granting an injunction, yet as the conduct of the defendants was such as to justify the plaintiffs in having a complete investigation of the whole case, the bill was dismissed without costs (*b*).

A bill alleged that the defendant sold brushes on which the name of the plaintiff was stamped, and prayed for an account and injunction. The plaintiff directly after the filing of the bill obtained the usual injunction. The defendant by his answer stated that he had only sold two such brushes, when he believed that he had sold them to agents of the plaintiff; that he had no intention to sell them to the injury or without the leave of the plaintiff; and that if the plaintiff had made any application to him he would have undertaken never to stamp any articles with the plaintiff's trade-mark. The plaintiff set the cause down on the answer of the defendant without entering into evidence; and, waiving the account, asked for a perpetual injunction: Held that there had not been any unnecessary litigation on the part of the plaintiff, and he was entitled to an injunction and costs of suit (*c*).

(*a*) *Targew* v. *Ward*, 21 L. T. 480.
(*b*) *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 527.
(*c*) *Pierce* v. *Franks*, 15 L. J. 122.

In cases of a trivial character where the injury has been very slight, the court, although it may grant an injunction, will often refuse to give the plaintiff any costs. As was said in *Barnett* v. *Leuchars* (*a*), *per* Stuart, V.C.: "As the injury sustained has been so very slight I shall say nothing about costs, as I am not disposed to encourage cases of this description."

Where goods fraudulently marked with a trade-mark are sent to innocent consignees for the purpose of being forwarded by them as agents to other parties, it is the duty of the consignees the moment they receive notice of the fraud from the owners of the trade-mark to offer all redress to which he is entitled, and to supply all possible information in their power. If they neglect this they will be liable to an injunction and to all the costs up to that time.

In *Upmann* v. *Elkan* (*b*) the defendants, who were agents in London for forwarding goods, had consigned to them some boxes of cigars marked with a forged trade-mark like the plaintiffs', for the purpose of being forwarded by them to other persons. The plaintiffs on making this discovery applied to Messrs. Elkan, who were, as it appeared from the evidence, not aware that the brands were false. Messrs. Elkan offered to give the name of the consignor, and to send back the boxes or to erase the brands, but refused to disclose the names of the parties to whom the cigars were to be delivered, stating that such information would be useless.

In giving judgment Lord Hatherley said: "It has been argued that the plaintiffs were not entitled to any injunction against the defendants, who had been guilty of no offence, being merely carriers receiving goods, which

(*a*) 13 L. T. (N. S.) 495. (*b*) L. R. 7 Eq. Cas. 133.

though fraudulently marked were not for their own use, nor to be sold by them for their own benefit, but were received merely for the purpose of transmitting them to the persons to whom they were consigned.

"I cannot conceive a doctrine more dangerous or mischievous, or more fatal to the authority of the court with respect to trade-marks. If that argument prevailed, any persons being abroad, as was the case in this instance, and minded to commit frauds upon an English trade-mark, could easily do so by sending their different consignments together to persons in the position of the defendants, who appear to be respectable agents and warehousemen, thereby committing an injury in a way most convenient for themselves and very mischievous to the persons entitled to the benefit of the trade-mark.

"It was the business of Messrs. Elkan the moment the complaint was made to give all proper information. They say they were innocent, and I hold them to be innocent of any part of this contrivance on the part of the consignor; but still it was their duty from the first moment to give all possible information and to offer all redress, and the question is whether they did so."

The owner of a trade-mark obtained an injunction to restrain a dock company from parting with certain imported goods, to which their trade-mark had been fraudulently affixed. It appeared that the dock warrants had been indorsed for value to a person innocent of the fraud. It was held that upon undertaking to remove the trade-marks the indorsee was entitled to have the injunction dissolved without costs (*a*).

Where the circumstances of a case would by themselves have induced the court to dismiss the bill without costs;

(*a*) *Ponsardin* v. *Pelo*, 33 L. J. (Ch.) 371.

and it further appeared to the court that the bill had been filed too hastily, and that a letter written by the defendants should have been answered by the plaintiffs before filing the bill, and the defendants had after the filing of the bill given a larger undertaking than the court could have compelled; the bill was dismissed with costs (*a*).

(*a*) *Williams* v. *Osborne*, 13 L. T. (N. S.) 498.

APPENDIX

APPENDIX.

SPECIAL STATUTORY PROVISIONS.

The statutes 21 Jac. 1, c. 21; 31 Geo. 3, c. 58; 41 Geo. 3, c. lxvii; 54 Geo. 3, c. cxix; 23 Vict. c. xliii, relate to persons in Hallamshire, and within six miles' compass of the same, who make knives, blades, scissors, shears, sickles, cutlery, and other wares of ir[illegible]d steel.

They incorporated the persons exercising the above trades as the Company of Cutlers in Hallamshire. By the former Acts, a person not being a freeman of the company could not carry on any of the above trades in Hallamshire, or within six miles of it, except by the licence of the company. By the Act 54 Geo. 3, c. cxix. this was repealed; and by the last Act, any person may become a freeman of the company on payment of 20*l*. The company were empowered to grant trade-marks to a freeman of the company; and in 1814 it was enacted, that any person, whether a freeman or not, might take out a mark on payment of a 40*s*. fee, with an additional fee of 3*l*. if the mark had ever been assigned to some one else.

By 13 Geo. 1, c. 26, s. 30, persons counterfeiting the mark or name of a linen manufacturer in Scotland are liable to forfeit 100*l*. to the manufacturer, to be recovered before two or more justices of the peace, or any magistrate within any borough.

By 5 & 6 Wm. 4, c. 83, s. 7, any one who improperly uses the name of a patentee, or designates his article as a patent, is liable to a penalty of 50*l*.

The Act 59 Geo. 3, c. 7, authorizes the makers of knives, and articles with cutting edges, to stamp them with the form of a hammer if they are forged by hammer, and prohibits the use of the mark if they are not.

This Act also forbids the stamping on such articles of words indicating other than the true quality thereof, and prohibits the use of the words "London" or "London made" upon similar goods not made in the city of London, or within twenty miles of it.

The statute 53 Geo. 3, c. 115, s. 9, makes penal the counterfeiting of proof-marks upon gun-barrels; and the statute 7 & 8 Vict. c. 22, prohibits the counterfeiting of the hall-marks upon gold and silver plate.

The Hop Act, 29 Vict. c. 37, prohibits the fraudulent marking of pockets of hops with respect to their place of growth, quality, age, weight, and value.

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25 & 26 Vict. c. 88.

An Act to amend the Law relating to the fraudulent marking of Merchandise. [7th August, 1862.]

WHEREAS it is expedient to amend the laws relating to the fraudulent marking of merchandise, and to the sale of merchandise falsely marked for the purpose of fraud: Be it therefore enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords spiritual and temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

Construction of words.

1. In the construction of this Act the word "person" shall include any person, whether a subject of Her Majesty or not, and any body corporate or body of the like nature, whether constituted according to the law of this country or of any of Her Majesty's colonies or dominions, or according to the law of any foreign country, and also any company, association, or society of persons, whether the members thereof be subjects of Her Majesty or not, or some of such persons subjects of Her Majesty and some of them not, and whether such body corporate, body of the like nature, company, association, or society be established or carry on business within Her Majesty's dominions or elsewhere, or partly within Her Majesty's dominions and partly elsewhere; the word "mark" shall include any name, signature, word, letter, device, emblem, figure, sign, seal, stamp,

diagram, label, ticket, or other mark of any other description; and the expression "trade-mark" shall include any and every such name, signature, word, letter, device, emblem, figure, sign, seal, stamp, diagram, label, ticket, or other mark as aforesaid lawfully used by any person to denote any chattel, or (in Scotland) any article of trade, manufacture, or merchandise, to be an article or thing of the manufacture, workmanship, production, or merchandise of such person, or to be an article or thing of any peculiar or particular description made or sold by such person, and shall also include any name, signature, word, letter, number, figure, mark, or sign which in pursuance of any statute or statutes for the time being in force relating to registered designs is to be put or placed upon or attached to any chattel or article during the existence or continuance of any copyright or other sole right acquired under the provisions of such statutes or any of them; the word "misdemeanor" shall include crime and offence in Scotland; and the word "court" shall include any sheriff or sheriff substitute in Scotland.

Forging a trade-mark or falsely applying any trade-mark with intent to defraud, a misdemeanor.

2. Every person who, with intent to defraud, or to enable another to defraud, any person, shall forge or counterfeit, or cause or procure to be forged or counterfeited, any trade-mark, or shall apply, or cause or procure to be applied, any trade-mark or any forged or counterfeited trade-mark to any chattel or article not being the manufacture, workmanship, production, or merchandise of any person denoted or intended to be denoted by such trade-mark, or denoted or intended to be denoted by such forged or counterfeited trade-mark, or not being the manufacture, workmanship, production, or merchandise of any person whose trade-mark shall be so forged or counterfeited, or shall apply, or cause or procure to be applied, any trade-mark or any forged or counterfeited trade-mark to any chattel or article, not being the particular or peculiar description of manufacture, workmanship, production, or merchandise denoted or intended to be denoted by such trade-mark or by such forged or counterfeited trade-mark, shall be guilty of a misdemeanor, and every person so committing a misdemeanor, shall also forfeit to Her Majesty every chattel and article belonging to such person to which he shall have so unlawfully applied, or caused or procured to be applied, any such trade-mark or forged or counterfeited trade-mark as aforesaid, and every instrument

in the possession or power of such person, and by means of which any such trade-mark or forged or counterfeited trade-mark as aforesaid shall have been so applied, and every instrument in the possession or power of such person for applying any such trade-mark or forged or counterfeit trade-mark as aforesaid, shall be forfeited to Her Majesty; and the court before which any such misdemeanor shall be tried may order such forfeited articles as aforesaid to be destroyed or otherwise disposed of as such court shall think fit.

Applying a forged trade-mark to any vessel, case, wrapper, &c. in or with which any article is sold or intended to be sold, a misdemeanor.

3. Every person who, with intent to defraud, or to enable another to defraud, any person, shall apply or cause or procure to be applied any trade-mark or any forged or counterfeited trade-mark to any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing in, on, or with which any chattel or article shall be intended to be sold or shall be sold or uttered or exposed for sale, or intended for any purpose of trade or manufacture, or shall enclose or place any chattel or article, or cause or procure any chattel or article to be enclosed or placed in, upon, under, or with any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing to which any trade-mark shall have been falsely applied, or to which any forged or counterfeited trade-mark shall have been applied, or shall apply or attach or cause or procure to be applied or attached to any chattel or article any case, cover, reel, ticket, label, or other thing to which any trade-mark shall have been falsely applied, or to which any forged or counterfeited trade-mark shall have been applied, or shall enclose, place, or attach any chattel or article, or cause or procure any chattel or article to be enclosed, placed, or attached, in, upon, under, with, or to any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing having thereon any trade-mark of any other person, shall be guilty of a misdemeanor, and every person so committing a misdemeanor shall also forfeit to Her Majesty every such chattel and article, and also every such cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing as aforesaid in the possession or power of such person; and every other similar cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing made to be used in like manner as aforesaid, and every instrument in the

possession or power of such person, and by means of which any such trade-mark or forged or counterfeited trade-mark as aforesaid shall have been applied, and also every instrument in the possession or power of such person for applying any such trade-mark or forged or counterfeit trade-mark as aforesaid, shall be forfeited to Her Majesty, and the court before which any such misdemeanor shall be tried may order such forfeited articles as aforesaid to be destroyed or otherwise disposed of as such court shall think fit.

Selling articles with forged or false trade-marks after 31st December, 1863, penalty equal to value of article sold, and a sum not exceeding 5*l.* nor less than 10*s.*

4. Every person who, after the thirty-first day of December, one thousand eight hundred and sixty-three, shall sell, utter, or expose either for sale or for any purpose of trade or manufacture, or cause or procure to be sold, uttered, or exposed for sale or other purpose as aforesaid, any chattel or article, together with any forged or counterfeited trade-mark, which he shall know to be forged or counterfeited, or together with the trade-mark of any other person applied or used falsely or wrongfully or without lawful authority or excuse, knowing such trade-mark of another person to have been so applied or used as aforesaid, and that whether any such trade-mark or forged or counterfeited trade-mark as aforesaid, together with which any such chattel or article shall be sold, uttered, or exposed for sale or other purpose as aforesaid, shall be in, upon, about, or with such chattel or article, or in, upon, about, or with any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing in, upon, about, or with which such chattel or article shall be so sold or uttered or exposed for sale or other purpose as aforesaid, shall for every such offence forfeit and pay to Her Majesty a sum of money equal to the value of the chattel or article so sold, uttered, offered, or exposed for sale or other purpose as aforesaid, and a further sum not exceeding five pounds and not less than ten shillings.

Additions to and alterations of trade-marks made with intent to defraud to be deemed forgeries.

5. Every addition to and every alteration of and also every imitation of any trade-mark which shall be made, applied, or used with intent to defraud or to enable any other person to defraud, or which shall cause a trade-mark with such alteration or addition, or shall cause such imitation of a trade-mark to resemble any genuine trade-mark so or in such manner as to be calculated or likely to deceive, shall be and be deemed to be a false, forged, and counterfeited trade-mark within the meaning

of this Act; and every act of making, applying, or otherwise using any such addition to or alteration of a trade-mark or any such imitation of a trade-mark as aforesaid done by any person with intent to defraud, or to enable any other person to defraud, shall be and be deemed to be forging and counterfeiting a trade-mark within the meaning of this Act.

Any person who, after 31st December, 1863, shall have sold an article having a false trade-mark to be bound to give information where he procured it.

6. Where any person who, at any time after the thirty-first day of December, one thousand eight hundred and sixty-three, shall have sold, uttered, or exposed for sale or other purpose as aforesaid, or shall have caused or procured to be sold, uttered, or exposed for sale or other purpose as aforesaid, any chattel or article, together with any forged or counterfeited trade-mark, or together with the trade-mark of any other person used without lawful authority or excuse as aforesaid, and that whether any such trade-mark, or such forged or counterfeited trade-mark as aforesaid, be in, upon, about, or with such chattel or article, or in, upon, about, or with any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing in, upon, about, or with which such chattel or article shall have been sold or exposed for sale, such person shall be bound, upon demand in writing delivered to him or left for him at his last known dwelling-house or at the place of sale or exposure for sale by or on the behalf of any person whose trade-mark shall have been so forged or counterfeited, or used without lawful authority or excuse as aforesaid, to give to the person requiring the same or his attorney or agent, within forty-eight hours after such demand, full information in writing of the name and address of the person from whom he shall have purchased or obtained such chattel or article, and of the time when he obtained the same; and it shall be lawful for any justice of the peace, on information on oath of such demand and refusal, to summon before him the party refusing, and on being satisfied that such demand ought to be complied with to order such information to be given within a certain time to be appointed by him; and any such party who shall refuse or neglect to comply with such order shall for every such offence forfeit and pay to Her Majesty the sum of five pounds, and such refusal or neglect shall be *primâ facie* evidence that the person so refusing or neglecting had full knowledge that the trade-mark together with which such chattel or article was sold, uttered, or exposed

Power to justices to summon parties refusing to give information.

Penalty for refusal 5*l.*

for sale or other purpose as aforesaid at the time of such selling, uttering, or exposing was a forged, counterfeited, and false trade-mark, or was the trade-mark of a person which had been used without lawful authority or excuse, as the case may be.

Marking any false indication of quantity, &c. upon an article with intent to defraud, penalty a sum equal to the value of the article and the further sum not exceeding 5*l.* and not less than 10*s.*

7. Every person who, with intent to defraud or to enable another to defraud, shall put or cause or procure to be put upon any chattel or article, or upon any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing, together with which any chattel or article shall be intended to be or shall be sold or uttered or exposed for sale, or for any purpose of trade or manufacture, or upon any case, frame, or other thing in or by means of which any chattel or article shall be intended to be or shall be exposed for sale, any false description, statement, or other indication of or respecting the number, quantity, measure, or weight of such chattel or article, or any part thereof, or of the place or country in which such chattel or article shall have been made, manufactured, or produced, or shall put or cause or procure to be put upon any such chattel or article, cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or thing as aforesaid, any word, letter, figure, signature, or mark for the purpose of falsely indicating such chattel or article, or the mode of manufacturing or producing the same, or the ornamentation, shape, or configuration thereof, to be the subject of any existing patent, privilege, or copyright, shall for every such offence forfeit and pay to Her Majesty a sum of money equal to the value of the chattel or article so sold or uttered or exposed for sale, and a further sum not exceeding five pounds and not less than ten shillings.

Selling or exposing for sale after the 31st December, 1863 articles with false statement of quantities, &c., penalty not more than 5*l.* or less than 5*s.*

8. Every person who, after the thirty-first day of December, one thousand eight hundred and sixty-three, shall sell, utter, or expose for sale or for any purpose of trade or manufacture, or shall cause or procure to be sold, uttered, or exposed for sale or other purpose as aforesaid, any chattel or article upon which shall have been, to his knowledge, put, or upon any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing, together with which such chattel or article shall be sold or uttered or exposed for sale or other purpose as aforesaid, shall have been so put, or upon any case, frame, or other thing used or employed to expose or exhibit such chattel or article for sale shall have been so put, any

false description, statement, or other indication of or respecting the number, quantity, measure, or weight of such chattel or article or any part thereof, or the place or country in which such chattel or article shall have been made, manufactured, or produced, shall for every such offence forfeit and pay to Her Majesty a sum not exceeding five pounds and not less than five shillings.

Proviso that it shall not be an offence to apply names or words known to be used for indicating particular classes of manufactures.

9. Provided always, that the provisions of this Act shall not be construed so as to make it any offence for any person to apply to any chattel or article, or to any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing with which such chattel or article shall be sold or intended to be sold, any name, word, or expression generally used for indicating such chattel or article to be of some particular class or description of manufacture only, or so as to make it any offence for any person to sell, utter, or offer or expose for sale any chattel or article to which, or to any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing sold therewith, any such generally used name, word, or expression as aforesaid shall have been applied.

Description of trade-marks and forged trade-marks in indictments, &c.

10. In every indictment, pleading, proceeding, and document whatsoever in which any trade-mark shall be intended to be mentioned it shall be sufficient to mention or state the same to be a trade-mark, without further otherwise describing such trade-mark, or setting forth any copy or fac-simile thereof; and in every indictment, pleading, proceeding, and document whatsoever in which it shall be intended to mention any forged or counterfeit trade-mark it shall be sufficient to mention or state the same to be a forged or counterfeit trade-mark, without further or otherwise describing such forged or counterfeit trade-mark, or setting forth any copy or fac-simile thereof.

Conviction not to affect any right or civil remedy.

11. The provisions in this Act contained of or concerning any act or any proceeding, judgment, or conviction for any act hereby declared to be a misdemeanor or offence, shall not nor shall any of them take away, diminish, or prejudicially affect any suit, process, proceeding, right, or remedy which any person aggrieved by such act may be entitled to at law, in equity, or otherwise, and shall not nor shall any of them exempt

or excuse any person from answering or making discovery upon examination as a witness or upon interrogatories or otherwise in any suit or other civil proceeding: Provided always, that no evidence, statement, or discovery which any person shall be compelled to give or make shall be admissible in evidence against such person in support of any indictment for a misdemeanor at common law or otherwise, or of any proceeding under the provisions of this Act.

Intent to defraud, &c. any particular person need not be alleged in an indictment, &c., or proved.

12. In every indictment, information, conviction, pleading, and proceeding against any person for any misdemeanor or other offence against the provisions of this Act in which it shall be necessary to allege or mention an intent to defraud, or to enable another to defraud, it shall be sufficient to allege or mention that the person accused of having done any act which is hereby made a misdemeanor or other offence did such act with intent to defraud, or with intent to enable some other person to defraud, without alleging or mentioning an intent to defraud any particular person; and on the trial of any such indictment or information for any such misdemeanor, and on the hearing of any information or charge of or for any such other offence as aforesaid, and on the trial of any action against any person to recover a penalty for any such other offence as aforesaid, it shall not be necessary to prove an intent to defraud any particular person, or an intent to enable any particular person to defraud any particular person, but it shall be sufficient to prove with respect to every such misdemeanor and offence that the person accused did the act charged with intent to defraud, or with intent to enable some other person to defraud, or with the intent that any other person might be enabled to defraud.

Persons who aid in the commission of a misdemeanor also guilty.

13. Every person who shall aid, abet, counsel, or procure the commission of any offence which is by this Act made a misdemeanor shall also be guilty of a misdemeanor.

[misdemeanor to be

Punishment for misdemeanor under this Act

14. Every person who shall be convicted or found guilty of any offence which is by this Act made a misdemeanor shall be liable, at the discretion of the court and as the court shall award, to suffer such punishment by imprisonment for not more than two years, with or without hard labour, or by fine, or both by imprisonment with or without hard labour and fine,

and also by imprisonment until the fine (if any) shall have been paid and satisfied.

Recovery of penalties.

15. In every case in which any person shall have committed or done any offence or act whereby he shall have forfeited or become liable to pay to Her Majesty any of the penalties or sums of money mentioned in the provisions of this Act, every such penalty or sum of money shall or may be recovered in England, Wales, or Ireland in an action of debt, which any person may as plaintiff for and on behalf of Her Majesty commence and prosecute to judgment in any court of record, and the amount of every such penalty or sum of money to be recovered in any such action shall or may be determined by the jury (if any) sworn to try any issue in such action, and if there shall be no such jury then by the court or some other jury, as the court shall think fit, or instead of any such action being commenced such penalty or sum of money shall or may in England or Wales be recovered by a summary proceeding before two justices of the peace having jurisdiction in the county or place where the party offending shall reside or have any place of business, or in the county or place in which the offence shall have been committed; and shall or may in Ireland be recovered in like manner by civil bill in the Civil Bill Court of the county or place in which the offence was committed, or in which the offender shall reside or have any place of business; and shall or may in Scotland be recovered by action before the Court of Session in ordinary form or by summary action before the sheriff of the county where the offence shall have been committed or the offender may reside or have any place of business, which sheriff, upon proof of the offence, either by the confession of the person offending or by the oath or affirmation of one or more credible witnesses, shall convict the offender, and find him liable in the penalty or penalties aforesaid as also in expenses; and it shall be lawful for the sheriff in pronouncing such judgment for the penalty or penalties and costs to insert in such judgment a warrant in the event of such penalty or penalties and costs not being paid to levy and recover the amount of the same by poinding: Provided always, that it shall be lawful to the sheriff, in the event of his dismissing the action and assoilzing the defender, to find the complainer liable in expenses, and any judgment so to be pro-

nounced by the sheriff in such summary action shall be final and conclusive, and not subject to review by advocation, suspension, reduction, or otherwise.

Summary proceedings before justices to be within 11 & 12 Vict. c. 43.

16. In every case in which any such penalty or sum of money forfeited to Her Majesty as hereinbefore mentioned shall be sought to be recovered by a summary proceeding before two justices of the peace, the offence or act by the committing or doing of which such penalty or sum of money shall have been so forfeited shall be and be deemed to be an offence and act within the meaning of a statute passed in the twelfth year of the reign of Her present Majesty, intituled "An Act to facilitate the Performance of the Duties of Justices of the Peace out of Sessions within England and Wales with respect to summary Convictions and Orders;" and the information, conviction of the offender, and other proceedings for the recovery of the penalty or sum so forfeited shall be had according to the provisions of the said Act.

In actions penalties to be accounted for in like manner as other moneys payable to the Crown, and plaintiffs to recover full costs of suit.

17. In every case in which judgment shall be obtained in any such action as aforesaid for the amount of any such penalty or sum of money forfeited to Her Majesty, the amount thereof shall be paid by the defendant to the sheriff or the officer of the court, who shall account for the same in like manner as other moneys payable to Her Majesty, and, if it be not paid, may be recovered, or the amount thereof levied, or the payment thereof enforced, by execution or other proper proceeding, as money due to Her Majesty; and the plaintiff suing on behalf of Her Majesty, upon obtaining judgment, shall be entitled to recover and have execution for all his costs of suit, which shall include a full indemnity for all costs and charges which he shall or may have expended or incurred in, about, or for the purposes of the action, unless the court, or a judge thereof, shall direct that costs of the ordinary amount only shall be allowed.

Limitations of actions, &c.

18. No person shall commence any action or proceeding for the recovery of any penalty, or procuring the conviction of any offender in manner hereinbefore provided, after the expiration of three years next after the committing of the offence or one year next after the first discovery thereof by the person proceeding.

After 31st December,

19. In every case in which at any time after the thirty-first day of December, one thousand eight hundred and sixty-three,

1863, vendor of an article with a trade-mark to be deemed to contract that the mark is genuine.

any person shall sell or contract to sell (whether by writing or not) to any other person any chattel or article with any trade-mark thereon, or upon any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing together with which such chattel or article shall be sold or contracted to be sold, the sale or contract to sell shall in every such case be deemed to have been made with a warranty or contract by the vendor to or with the vendee that every trade-mark upon such chattel or article, or upon any such cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing as aforesaid, was genuine and true, and not forged or counterfeit, and not wrongfully used, unless the contrary shall be expressed in some writing signed by or on behalf of the vendor, and delivered to and accepted by the vendee.

After 31st December, 1863 vendor of an article with description upon it of its quantity to be deemed to contract that the description was true.

20. In every case in which at any time after the thirty-first day of December, one thousand eight hundred and sixty-three, any person shall sell or contract to sell (whether by writing or not) to any other person any chattel or article upon which, or upon any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing together with which such chattel or article shall be sold or contracted to be sold, any description, statement, or other indication of or respecting the number, quantity, measure, or weight of such chattel or article, or the place or country in which such chattel or article shall have been made, manufactured, or produced, the sale or contract to sell shall in every such case be deemed to have been made with a warranty or contract by the vendor to or with the vendee that no such description, statement, or other indication was in any material respect false or untrue, unless the contrary shall be expressed in some writing signed by or on behalf of the vendor, and delivered to and accepted by the vendee.

In suits at law or in equity against persons for using forged trade-marks court may order article to be

21. In every case in any suit at law or in equity against any person for forging or counterfeiting any trade-mark, or for fraudulently applying any trade-mark to any chattel or article, or for selling, exposing for sale, or uttering any chattel or article with any trade-mark falsely or wrongfully applied thereto, or with any forged or counterfeit trade-mark applied thereto, or for preventing the repetition or continuance of any such wrongful act, or the committal of any similar act, in which

the plaintiff shall obtain a judgment or decree against the defendant, the court shall have power to direct every such chattel and article to be destroyed or otherwise disposed of; and in every such suit in a court of law the court shall or may upon giving judgment for the plaintiff award a writ of injunction or injunctions to the defendant, commanding him to forbear from committing and not by himself or otherwise to repeat or commit any offence or wrongful act of the like nature as that of which he shall or may have been convicted by such judgment, and any disobedience of any such writ of injunction or injunctions shall be punished as a contempt of court; and in every such suit at law or in equity it shall be lawful for the court or a judge thereof to make such order as such court or judge shall think fit for the inspection of every or any manufacture or process carried on by the defendant in which any such forged or counterfeit trade-mark, or any such trade-mark as aforesaid, shall be alleged to be used or applied as aforesaid, and of every or any chattel, article, and thing in the possession or power of the defendant alleged to have thereon or in any way attached thereto any forged or counterfeit trade-mark, or any trade-mark falsely or wrongfully applied, and every or any instrument in the possession or power of the defendant used or intended to be or capable of being used for producing or making any forged or counterfeit trade-mark, or trade-mark alleged to be forged or counterfeit, or for falsely or wrongfully applying any trade-mark; and any person who shall refuse or neglect to obey any such order shall be guilty of a contempt of court.

destroyed *and may* award injunction, &c.

22. In every case in which any person shall do or cause to be done any of the wrongful acts following; (that is to say), shall forge or counterfeit any trade-mark; or for the purpose of sale, or for the purpose of any manufacture or trade, shall apply any forged or counterfeit trade-mark to any chattel or article, or to any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or thing in or with which any chattel or article shall be intended to be sold or shall be sold or uttered or exposed for sale, or for any purpose of trade or manufacture; or shall inclose or place any chattel or article in, upon, under, or with any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing to which any trade-mark shall have been falsely applied, or to which any forged or

Persons aggrieved by forgeries may recover damages against the guilty parties.

counterfeit trade-mark shall have been applied; or shall apply or attach to any chattel or article any case, cover, reel, wrapper, band, ticket, label, or other thing to which any trade-mark shall have been falsely applied, or to which any forged or counterfeit trade-mark shall have been applied; or shall inclose, place, or attach any chattel or article in, upon, under, with, or to any cask, bottle, stopper, vessel, case, cover, reel, wrapper, band, ticket, label, or other thing having thereon any trade-mark of any other person; every person aggrieved by any such wrongful act shall be entitled to maintain an action or suit for damages in respect thereof against the person who shall be guilty of having done such act or causing or procuring the same to be done, and for preventing the repetition or continuance of the wrongful act, and the committal of any similar act.

Defendant obtaining a verdict to have full indemnity for costs.

23. In every action which any person shall, under the provisions of this Act, commence as plaintiff for or on behalf of Her Majesty for recovering any penalty or sum of money, if the defendant shall obtain judgment, he shall be entitled to recover his costs of suit, which shall include a full indemnity for all the costs, charges, and expenses by him expended or incurred in, about, or for the purposes of the action, unless the court or a judge thereof shall direct that costs of the ordinary amount only shall be allowed.

A plaintiff suing for a penalty may be compelled to give security for costs.

24. In any action which any person shall, under the provisions of this Act, commence as plaintiff for or on behalf of Her Majesty for recovering any penalty or sum of money, if it shall be shown to the satisfaction of the court, or a judge thereof, that the person suing as plaintiff for or on behalf of Her Majesty has no ground for alleging that he has been aggrieved by the committing of the alleged offence in respect of which the penalty or sum of money is alleged to have become payable, and also that the person so suing as plaintiff is not resident within the jurisdiction of the court or not a person of sufficient property to be able to pay any costs which the defendant may recover in the action, the court or judge shall or may order that the plaintiff shall give security by the bond or recognizance of himself and a surety, or by the deposit of a sum of money, or otherwise, as the court or judge shall think fit, for the payment to the defendant of any costs which he may be entitled to recover in the action.

25. Nothing in this Act contained shall be construed to affect the rights and privileges of the Corporation of Cutlers of the liberty of Hallamshire in the county of York, nor shall anything in this Act contained be construed in any way to repeal or make void any of the provisions contained in the fifty-ninth George Third, chapter seven, intituled "An Act to regulate the Cutlery Trade in England." Act not to affect the Corporation of Cutlers of Hallamshire, nor to repeal 59 Geo. 3, c. 7.

26. The expression "The Merchandise Marks Act, 1862," shall be a sufficient description of this Act. Short title.

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38 & 39 Vict. c. 91.

An Act to establish a Register of Trade-Marks.

[13th August, 1875.]

Be it enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords spiritual and temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

1. A register of trade-marks as defined by this Act, and of the proprietors thereof shall be established under the superintendence of the Commissioners of Patents, and from and after the first day of July one thousand eight hundred and seventy-six a person shall not be entitled to institute any proceeding to prevent the infringement of any trade-mark as defined by this Act until and unless such trade-mark is registered in pursuance of this Act. Registration of trade-marks.

2. A trade-mark must be registered as belonging to particular goods, or classes of goods; and when registered shall be assigned and transmitted only in connexion with the goodwill of the business concerned in such particular goods or classes of goods, and shall be determinable with such goodwill, but subject as aforesaid registration of a trade-mark shall be deemed to be equivalent to public use of such mark. Characteristics of registered trade-mark.

3. The registration of a person as first proprietor of a trade-mark shall be primâ facie evidence of his right to the exclusive use of such trade-mark, and shall, after the expiration of five years from the date of such registration, be conclusive evidence Title of first proprietor of a trade-mark.

of his right to the exclusive use of such trade-mark, subject to the provisions of this Act as to its connexion with the goodwill of a business.

Title of proprietor claiming by transmitted proprietorship.

4. Every proprietor registered in respect to a trade-mark subsequently to the first registered proprietor shall, as respects his title to that trade-mark, stand in the same position as if his title were a continuation of the title of the first registered proprietor.

Rectification of register.

5. If the name of any person who is not for the time being entitled to the exclusive use of a trade-mark in accordance with this Act, or otherwise in accordance with law, is entered on the register of trade-marks as a proprietor of such trade-mark, or if the registrar refuses to enter on the register as proprietor of a trade-mark the name of any person who is for the time being entitled to the exclusive use of such trade-mark in accordance with this Act, or otherwise in accordance with law, or if any mark is registered as a trade-mark which is not authorised to be so registered under this Act, any person aggrieved may apply in the prescribed manner for an order of the court that the register may be rectified; and the court may either refuse such application, or it may, if satisfied of the justice of the case, make an order for the rectification of the register, and may award damages to the party aggrieved.

Where each of several persons claims to be registered as proprietor of the same trade-mark, the registrar may refuse to comply with the claims of any of such persons until their rights have been determined by the court, and the registrar may himself submit or require the claimants to submit in the prescribed manner their rights to the court.

The court may in any proceeding under this section, decide any question as to whether a mark is or is not such a trade-mark as is authorised to be registered under this Act, also any question relating to the right of any person who is party to such proceeding to have his name entered on the register of trade-marks, or to have the name of some other person removed from such register, also any other question that it may be necessary or expedient to decide for the rectification of the register.

The court may direct an issue to be tried for the decision of any question of fact which may require to be decided for the purposes of this section. Whenever any order has been made

rectifying the register, the court shall by its order direct that due notice of such rectification be given to the registrar.

Restriction on registry of trade-marks.

6. The registrar shall not, without the special leave of the court, to be given in the prescribed manner, register in respect of the same goods or classes of goods a trade-mark identical with one which is already registered with respect to such goods or classes of goods, and the registrar shall not register with respect to the same goods or classes of goods a trade-mark so nearly resembling a trade-mark already on the register with respect to such goods or classes of goods as to be calculated to deceive.

It shall not be lawful to register as part of or in combination with a trade-mark any words the exclusive use of which would not, by reason of their being calculated to deceive or otherwise, be deemed entitled to protection in a court of equity; or any scandalous designs.

Establishment of registry and general rules.

7. Subject as aforesaid, a register office shall be established from and after such time (not being later than the first day of January one thousand eight hundred and seventy-six), in such manner and with such officers, and at such salaries, to be paid out of moneys provided by Parliament, as the Lord Chancellor may, with the consent of the Treasury, direct; and the Lord Chancellor may from time to time, with the assent of the Treasury as to fees, make, and, when made, alter, annul, or vary, such general rules as to the registry of trade-marks, and as to notices to be given by advertisement before the registration of trade-marks, and as to the classification of goods for the purposes of this Act, and as to the registration of first and subsequent proprietors of trade-marks, and as to the fees to be charged for registration, and also for the continuance of a trade-mark on the register or otherwise, and as to the removal from the register of any trade-mark, as to notices, and as to the persons entitled to inspect the register, and as to any proceedings to be taken to obtain the judgment or leave of the court in any matter in which the judgment or leave of the court is required to be obtained under this Act, and generally for the purpose of carrying into effect this Act, as he may deem expedient.

Any rules made in pursuance of this section shall be laid before both Houses of Parliament if Parliament be then sitting, or if not then sitting, then within ten days from the then next

assembling of Parliament, and shall be of the same validity as if they had been enacted by Parliament; provided that if either House of Parliament resolve, within one month after such rules have been laid before such House, that any of such rules ought not to continue in force, any rule in respect of which such resolution has been passed shall, after the date of such resolution, cease to be of any force, without prejudice, nevertheless, to the making of any other rule in its place, or to anything done in pursuance of any such rules before the date of such resolution.

Certificate of registrar to be evidence.

8. The certificate of the registrar as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be evidence of such entry having been made, and of the contents thereof, and of such matters and things having been done or left undone.

Provision as to Cutlers' Company and Sheffield corporate-marks.

9. With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called "the Cutlers' Company"), and the marks or devices (in this Act called "Sheffield corporate-marks") assigned or to be assigned by the master, wardens, searchers, and assistants of that company, be it enacted as follows:

(1.) Within the prescribed time and in the prescribed manner the Cutlers' Company shall at their own expense deliver to the registrar under this Act copies of all Sheffield corporate-marks in force at the time of such delivery:

(2.) When any person, after the passing of this Act, applies to the said master, wardens, searchers, and assistants to assign to him any mark or device, notice of such application, with a copy of such mark or device, shall, within the prescribed time and in the prescribed manner, be delivered to the registrar under this Act; and such mark or device shall not be assigned until after the expiration of the prescribed period from the giving of such notice. In like manner, when any person applies for the registration under this Act of a trade-mark as belonging to any goods or class of goods specified in section two of the Cutlers' Company's Act of 1860, notice of such application, with a copy of such trade-mark, shall, within the prescribed time and in the prescribed manner, be delivered to the Cutlers' Company; and such trade-mark shall not be registered until after

the expiration of the prescribed period from the giving of the last-mentioned notice:

(3.) Upon the assigning of any such mark or device, or the registration of any such trade-mark as aforesaid, notice of the assignment or registration shall, within th prescribed time and in the prescribed manner, be given to the registrar under this Act, or to the Cutlers' Company, as the case may be:

(4.) The registrar under this Act, without the special leave of the court, to be given only in cases where the applicant proves his right, shall not in respect of any goods or classes of goods with respect to which a Sheffield corporate-mark shall have been assigned and actually used, and of which mark a copy or description or notice of the assigning whereof shall have been delivered or given to the registrar as aforesaid, register a trade-mark identical with such Sheffield corporate-mark, or so nearly resembling the same as to be calculated to deceive:

(5.) The master, wardens, searchers, and assistants of the Cutlers' Company shall not assign to any person a mark or device identical with any trade mark registered under this Act, and notice of the registration whereof shall have been given to the Cutlers' Company as aforesaid, or so nearly resembling the same as to be calculated to deceive:

(6.) Any person to whom a Sheffield corporate-mark legally belongs shall be entitled to have the same mark registered also as a trade-mark under this Act, in respect of any particular goods or classes of goods, in the same manner and upon the same terms and conditions in and upon which he might have registered the same if it were not a Sheffield corporate-mark:

(7.) Nothing in this Act shall prejudice or affect the rights and privileges of the Cutlers' Company, nor, save as is otherwise in this Act expressly provided, shall any of the provisions of this Act apply to or in the case of any Sheffield corporate-mark.

Definitions.

10. For the purposes of this Act:

A trade-mark consists of one or more of the following essential particulars; that is to say,

A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or

A written signature or copy of a written signature of an individual or firm; or

A distinctive device, mark, heading, label, or ticket;

and there may be added to any one or more of the said particulars any letters, words, or figures, or combination of letters, words or figures; also

Any special and distinctive word or words or combination of figures or letters used as a trade-mark before the passing of this Act may be registered as such under this Act.

"Prescribed" means prescribed by general rules made in pursuance of this Act; and

"Court" means any of Her Majesty's superior courts of law or equity at Westminster, or any court to which the jurisdiction of such courts may be transferred, or any one or more of such courts which may be declared to be the court for the purposes of this Act by such general rules as aforesaid; but the provisions of this Act conferring a special jurisdiction on the court as above defined shall not, except-ing so far as such jurisdiction extends, affect the jurisdiction of any court in Scotland or Ireland in causes, actions, suits, or proceedings relating to trade-marks; and if the register requires to be rectified in consequence of any proceedings in any such court in Scotland or Ireland, due notice of such requirements shall be given to the registrar, and he shall rectify the register accordingly.

Short title of Act.

11. This Act may be cited for all purposes as the Trade Marks Registration Act, 1875.

INSTRUCTIONS TO PERSONS APPLYING FOR REGISTRATION OF A TRADE-MARK.

Forms of application will be found at page 201 of the Rules. The applicant will carefully read over the Rules relating to application for registry, and attend to the notes attached to the forms.

Applications must be addressed as follows :—

The Registrar,
Trade Marks Registry Office,
Quality Court,
47, Chancery Lane, W.C.

They may either be delivered by hand or sent prepaid by post, but an application will not be attended to unless it is accompanied by the proper fees specified in schedule two of the rules.

Fees will not be received in cash. They may be paid by a Post Office Order payable to the Registrar at the General Post Office, London; or, if they exceed five pounds, may be paid by a cheque drawn to the "Registrar of Trade Marks or Bearer," and crossed "Bank of England."

Each application for the registry of a trade-mark or marks must be accompanied by a statement, on foolscap paper, of the following particulars :—

1. Name and address of applicant.

(Example.) *John Jones,*
Moon Street,
Birmingham,
Pharmaceutical Chemist.

2. Account of fees for trade-mark or marks required.

(Examples.)		£	s.	d.
One trade-mark in class 4	..	1	0	0
or				
Two trade-marks in class 20	..	1	10	0
or				
One trade-mark in four classes	..	1	6	0

The Post Office Orders or crossed cheques enclosed for payment of fees should be fastened to the form of account of fees.

Notice.

Copies of the Instructions and Rules may be obtained, on payment of a shilling for each copy, of the following publishers: Harrison and Sons, 59, Pall Mall; Stanford, Charing Cross; Knight and Co., 90, Fleet Street; Ford and Tilt, 52, Long Acre; Stevens and Sons, 119, Chancery Lane; Shaw and Sons, Fetter Lane and Crane Court, E.C.; Waterlow and Sons, 24 and 25, Birchin Lane, E.C., and 49, Parliament Street, S.W.; A. and C. Black, Edinburgh; Alex. Thom, Abbey Street, Dublin. Copies will also be sent on a prepaid application, containing the name and address of the sender, and accompanied with a Post Office Order for the amount due in respect of the copies required, and addressed to any of the above publishers.

TRADE-MARKS.

RULES.

WHEREAS by the Trade Marks Registration Act, 1875, the Lord Chancellor is authorised from time to time, with the assent of the Treasury as to fees, to make general rules as to the registry of trade-marks, and other matters connected therewith, as is in the said Act mentioned:

Now, therefore, I, the Right Honourable Hugh MacCalmont Baron Cairns, of Garmoyle in the county of Antrim, Lord High Chancellor of Great Britain, in pursuance of the said Act, and of all other powers enabling me in this behalf, do hereby make the following rules:—

Preliminary.

Classification of goods in schedule.

1. For the purposes of these rules goods are classified in the manner appearing in the first schedule hereto.

Fees.

2. The fees to be charged in pursuance of these rules are the fees specified in the second schedule hereto.

Determination of doubt as to classes.

3. If any doubt arises as to what class any particular description of goods belongs to, the doubt shall be determined by the registrar.

Registration of different trade-marks, or trade-marks in different classes.

4. A trade-mark or trade-marks may be registered in pursuance of the same application by the same person in respect of all or any goods, subject to the payment of the additional fees specified in the second schedule in respect of the registration of different trade-marks or the extension of the same trade-marks to goods in different classes.

Application for Registry.

Proceedings on application.

5. A person, whether a British subject or an alien, desiring to registrar a trade-mark shall apply to the registrar by sending

to him a statement accompanied by such declaration as is hereinafter mentioned and the prescribed fee.

Contents of statement on application.

6. The statement shall contain the following particulars:—

A. The name and address and calling of the applicant: and

B. The description or reference to a description of the trade-mark to be registered: and

C. The class or classes of goods (being some one or more of the classes mentioned in the first schedule), and the particular description or descriptions of goods in such class or classes, with respect to which he desires the trade-mark to be registered: and

D. In the case of a trade-mark used before the passing of this Act, a description of the goods in respect of which it has been used and the length of time during which it has been so used.

Requisites of statement.

7. The above statement must bear a date and be signed by the applicant. Subject to any other directions that may be given by the registrar, the statement sent to the registrar shall be upon foolscap paper of a size of thirteen inches by eight inches, and shall have on the left-hand part thereof a margin of not less than one inch and a half.

Nature and size of representation of trade-mark.

8. Subject to any other directions that may be given by the registrar, a description of a trade-mark shall be given in writing, and shall be accompanied, when practicable, by a drawing or other representation in duplicate not less than three inches square, on foolscap paper of the size aforesaid, or by pasting or otherwise fastening on such paper a specimen of the trade-mark.

Where a drawing or other representation or specimen cannot be given in manner aforesaid, a specimen or copy of the trade-mark may be sent either of full size or on a reduced scale, and in such form as may be thought most convenient.

The registrar may, if dissatisfied with the representation of a trade-mark, require a fresh representation either before he proceeds with the application or before he registers the trade-mark.

The registrar may also, in exceptional cases, deposit in the Patent Museum a specimen or copy of a trade-mark which cannot conveniently be placed on his register, and may refer thereto in his register in such manner as he thinks advisable.

9. The declaration must be on foolscap paper of the above-mentioned size, and must verify the statement, and declare that, to the best of the applicant's knowledge and belief, he is lawfully entitled to use the trade-mark, and must be made and subscribed as herein-after mentioned. Declaration to accompany application.

10. Where an application for the registry of a trade-mark is made by or on behalf of a corporate or quasi corporate body of persons, the statement and declaration shall be made by the secretary or other principal officer of the body of persons; and the registrar may require such proof as he thinks fit that the application made is duly authorised by such body of persons. Application by company.

11. On receipt of the application the registrar shall send to the applicant an acknowledgment thereof. Acknowledgment of application by registrar.

Advertisement of Application and Notice of Opposition.

12. As soon as may be after the receipt of an application made as provided by these rules, the registrar shall require the applicant to insert an advertisement of the application in the official paper, during such time, and in such form, and generally in such manner as the registrar may think desirable, and distinguishing whether the mark has or has not been used before the thirteenth day of August one thousand eight hundred and seventy-five. Advertisement of application.

13. The official paper for the purposes of these rules shall be some paper published under the direction of the Commissioners of Patents, or such other paper as such Commissioners, or any one of them may from time to time direct. Definition of official paper.

14. For the purposes of such advertisement the applicant may be required to furnish the printer of the official paper with a woodblock or electrotype of the trade-mark, of such dimensions as may from time to time be directed by the registrar, or with such other information or means of advertising the trade-mark as may be allowed by the registrar. Means of advertising trade-mark to be supplied to official paper.

15. A notice of opposition may be given by sending to the registrar, together with the prescribed fee, a written notice in duplicate, on foolscap paper of such size as aforesaid, stating the grounds of the opposition. The registrar shall send one copy of such notice to the applicant. Notice and proceedings for opposition.

Within three weeks after the receipt of such notice, or such further time as the registrar may allow, the applicant may send to the registrar, on foolscap paper of such size as aforesaid, a counter-statement of the grounds on which he relies for his application, and if he does not do so shall be deemed to have withdrawn his application.

If the applicant sends such counter-statement the registrar shall require the person who gave notice of opposition to give security, in such manner and to such amount as the registrar may require, for such costs as may be awarded in respect of such opposition; and if such security is not given within fourteen days after such requirement was made, or such further time as the registrar may allow, the opposition shall be deemed to be withdrawn.

Registration of Trade-Marks.

Time of registration of trade-mark.

16. On the expiration of three months from the date of the first appearance of the advertisement in the official paper, the registrar may, if he is satisfied that the applicant is entitled to registration, register the trade-mark in respect of the description of goods for which he may be entitled to be registered, and the applicant as the proprietor thereof, on payment of the prescribed fee.

Duty of registrar in case of disputed claim.

17. Where each of several persons claims to be registered as proprietor of the same or a nearly identical trade-mark, in respect of the same goods or goods belonging to the same class, the registrar shall use his discretion as to registering all or any of such trade-marks, either unconditionally or on the condition of the introduction of such variations (if any) or otherwise as he thinks fit, or the registrar may, if in any case he thinks it expedient, submit or require the claimants to submit their rights to the court.

Prohibition of registration of identical trade-marks.

18. Where a trade-mark has been already registered in respect of any goods or description of goods belonging to one particular class, a trade-mark identical with such trade-mark, or so nearly resembling the same as to be calculated to deceive, shall not, without leave of the court, be registered in the name of another person as proprietor thereof with respect to any goods in that class.

Similar trade-mark

19. Where goods may be considered as belonging to two or

more classes, and the trade-mark has been already registered in respect of such goods as belonging to one particular class, a trade-mark identical with such trade-mark, or so nearly resembling the same as to be calculated to deceive, shall not, without leave of the court, be registered in the name of another person as proprietor thereof with respect to the same or similar goods as belonging to another class. for similar goods not to be registered in two classes.

20. Upon registering any trade-mark the registrar shall enter in the register the date on which the statement relating to the application for registry was received by the registrar (which day shall be deemed to be the date of the registry) and such other particulars as he may think necessary, including the name and address of the proprietor. Entries to be made in register.

21. The registrar shall send notice to the applicant of the registration of his trade-mark. Notice of registration.

22. There shall not be entered in the register, or be receivable by the registrar, any notice of any trust, expressed, implied, or constructive. Trust not to be entered in register.

Registration of subsequent Proprietors.

23. The person to whom any registered trade-mark has been assigned or transmitted may apply to be registered as proprietor thereof. Registration of assignee or transmittee.

24. Where the trade-mark has been assigned, the person claiming as assignee to be registered shall send to the registrar, with his application, an assignment by deed executed both by the assignor and assignee, and a declaration verifying such assignment. Production of assignment, &c. by assignee.

25. Where a trade-mark has been transmitted by the death of the registered proprietor, the legal personal representative of such proprietor shall be recognised as having the title to the mark. Right of transmittee or his assignee.

Where the trade-mark has been transmitted by marriage, bankruptcy, or otherwise by operation of law, the person applying as the transmittee to be registered shall send to the registrar, together with his application, a statement of the manner in which such trade-mark has been transmitted, and a declaration verifying such statement.

Any transmittee may assign his interest in the mark, not-

withstanding that he has not been registered as proprietor thereof.

Evidence to be produced on transmission.

26. Where the person applying to be registered claims as the transmittee of any registered proprietor, or as the assignee of a transmittee, there shall be produced to the registrar the following evidence:—

(1.) If the business concerned in the goods with respect to which the trade-mark is registered is carried on in England or Ireland, then

A. If such transmission has taken place by the death of any person, there shall be produced the probate of the will of such deceased person, or the letters of administration to his estate, or an official extract therefrom; and

B. If such transmission has taken place by the marriage of the female proprietor, there shall be produced a certified copy of the register of such marriage, or other legal evidence of the celebration thereof, and a declaration of the identity of such female proprietor; and

C. If such transmission has taken place by the bankruptcy of the registered proprietor, or otherwise by operation of law, there shall be produced to the registrar such evidence as may, for the time being, be receivable as proof of the title of the applicant; and

(2.) Where the said business is not carried on in England or Ireland,—

There shall be produced similar evidence to that hereinbefore prescribed, or such evidence as would be received as sufficient evidence in the courts of justice of the country or place at which the proprietor carries on business.

Declaration by assignee and transmittee.

27. Every declaration made by an assignee or transmittee shall state his name and address, and that he is entitled to the goodwill of the business concerned in the goods with respect to which the trade-mark is registered, or to some part of such goodwill.

Assignee, &c., of joint owners.

28. Where two or more persons are registered as joint proprietors of the same registered trade-mark, those proprietors,

or the survivors or survivor of them, or their or his assignee or transmittee, shall alone be recognised by the registrar as having any title to the mark.

Registration of joint owners as separate owners of separate trade-marks.

29. Where divers persons claim to be severally entitled to the goodwill of a business concerned in the goods with respect to which a trade-mark has been registered, such persons, or any of them, may, if they all consent thereto, and on the production of the proper evidence, and on payment of the prescribed fee, be registered separately as separate proprietors of such trade-mark.

If all of such persons so entitled do not so consent, the registrar shall not, without leave of the court, register any of them as separate proprietors of such trade-mark.

Continuance of a Trade-Mark on the Register.

Removal of trade-mark after fourteen years unless fee paid.

30. At a time not being less than two months nor more than three months before the expiration of fourteen years from the date of the registration of a trade-mark, the registrar shall send a notice to the registered proprietor that the trade-mark will be removed from the register unless the proprietor pays to the registrar, before the expiration of such fourteen years (naming the date at which the same will expire), the prescribed fee, and if such fee be not previously paid, he shall at the expiration of one month from the date of the giving of the first notice send a second notice to the same effect, and if such fee be not paid before the expiration of such fourteen years the registrar may, after the end of three months from the expiration of such fourteen years, remove the mark from the register, and so from time to time at the expiration of every period of fourteen years.

Payment of additional *fee after* expiration of fourteen years.

31. If before the expiration of the said three months the registered proprietor pays the said fee, together with the additional prescribed fee, the registrar may, without removing such trade-mark from the register, accept the said fee as if it had been paid before the expiration of the said fourteen years.

Power of Commissioners to restore trade-mark.

32. Where after the said three months a trade-mark has been removed from the register for non-payment of the prescribed fee, the Commissioners of Patents, or one of them, may, if they are satisfied that it is just so to do, restore such trade-mark to the register on payment of the prescribed additional fee and compliance with such conditions as they may think just.

Trade-mark like one removed not to be registered for five years.

33. Where a trade-mark has been removed from the register for non-payment of the fee or otherwise, such trade-mark shall nevertheless for five years after the date of such removal be deemed for the purpose of section six of the Act, and not for any other purpose, to be a trade-mark which is already registered.

Removal of trade-mark where no business in goods.

34. The court may, on the application of any person aggrieved, remove any trade-mark from the register on the ground, after the expiration of five years from the date of the registry thereof, that the registered proprietor is not engaged in any business concerned in the goods with respect to which a trade-mark is registered.

Alteration and Rectification of Register.

Alteration of non-essential parts of trade-mark

35. The registered proprietor of any registered trade-mark may, by leave of the court, alter such trade-mark, so that he do not alter any one or more of the particulars in such mark which are declared by section ten of the Act to be the essential particulars of a trade-mark, and the registrar shall, on payment of the prescribed fee and compliance with the requisitions of the registrar as to the deposit of representations of the trade-mark as altered, alter the register accordingly.

Entry of rectification in register.

36. Where due notice of an order of any court rectifying the register has been given to the registrar, the registrar shall forthwith, upon a copy of so much of the order as relates to such rectification being left with the registrar, and payment of the prescribed fee, rectify the register in accordance with the order.

Publication of rectification or alteration of register.

37. Whenever the register is rectified or altered in any particular in respect to any trade-mark, the registrar shall, if he thinks that such rectification or alteration should be made public, at the expense of any person interested, publish, by advertisement or otherwise, and in such manner as he thinks just, the circumstances attending the rectification or alteration of the register.

Notice to registrar of opposition in any matter.

38. Any person may send, with the prescribed fee, notice to the registrar of his desire to oppose the registration of any assignee or transmittee, or any alteration of the register. The registrar shall give to the applicant for such registration or

alteration the like notice, and may require security for costs in like manner as in the case of a notice of opposition to the original registration of a trade-mark.

The registrar in such case may, if he think fit, require the parties interested to submit their claims to the court.

39. If the registered proprietor of a trade-mark send to the registrar, together with the prescribed fee, notice of an alteration in his address, the registrar shall alter the register accordingly. Alteration of address, &c., in register.

Inspection of Register.

40. On such days and during such hours as the registrar may from time to time determine, not being less than three hours on three separate days in a week, any person may, on paying the prescribed fee, inspect the register of trade-marks; and any person may, on paying the prescribed fee, obtain an office copy of any entry in the register. Inspection and copies of register.

41. The registrar when required for the purpose of any legal proceeding or other special purpose to give a certificate as to any entry, matter, or thing which he is authorised by this Act, or any of these rules to make or do, may on payment of the prescribed fee, give such certificate, and shall specify on the face of it the legal proceeding or other purpose for which such certificate is granted. Certificate by registrar.

Application to the Court.

42. The court for the purposes of this Act is hereby declared to be the Chancery Division of Her Majesty's High Court of Justice. Definition of court.

43. An application to the court under the Act and these rules may, subject to rules of court under the Supreme Court of Judicature Act, 1875, be made by motion or by application in chambers, or in such other manner as the court may direct. Application to court.

44. Where the registrar refuses to comply with the claims of any persons until their rights have been determined by the court, the manner in which the rights of such claimants may be submitted by the registrar, or, if the registrar so require, by the claimants, to the court shall, unless the court otherwise order, be by a special case; and such special case shall be filed and proceeded with in like manner as any other special case Submission to court of conflicting claims.

submitted to the court, or in such other manner as the court may direct.

Settlement of special case.

45. The special case may be agreed to by the parties, or if they differ may be settled by the registrar.

Cutlers' Company.

Time for delivery of old Sheffield marks.

46. The time within which the Cutlers' Company are in pursuance of the Act to deliver to the registrar copies of all Sheffield corporate-marks in force at the time of such delivery shall be the first day of March one thousand eight hundred and seventy-six, or such later day as the Lord Chancellor may fix.

Manner of delivery of new Sheffield marks.

47. Subject to any other directions that may be given by the registrar the manner in which such copies are to be delivered shall be the sending to the registrar of copies as herein-after defined of such marks, accompanied by a statement of the names, addresses, and callings of the persons to whom such trade-marks have been assigned.

Time for delivery of new Sheffield marks.

48. The time within which the Cutlers' Company are to deliver to the registrar notice of an application to them for assigning any mark or device, with a copy of such mark or device, shall be as soon as practicable after the date at which such Company have determined on the mark or device to be assigned.

Manner of delivery of new Sheffield marks.

49. The manner in which such notice and copy shall be delivered to the registrar shall be the sending to the registrar a notice of the application, accompanied by a statement comprising the like particulars as a statement required to be made by an applicant for the registration of a trade-mark by the registrar under the Act, so far as such particulars are known to the Cutlers' Company.

Period between notice to registrar and assignment of new Sheffield marks.

50. The period before the expiration of which such mark or device shall not be assigned by the Cutlers' Company, shall be six weeks from the date of sending the said notice to the registrar.

Time for notice of application to register new trade-

51. The time within which notice of an application for the registration under the Act of a trade-mark as belonging to any particular goods or class of goods specified in section two of the Cutlers' Company's Act, 1860, together with a copy of the trade-mark, is to be delivered to the Cutlers' Company, shall be

as soon as practicable after the receipt of the application by the registrar. marks to Cutlers' Company.

52. The manner in which such notice is to be given shall be the sending to the Cutlers' Company a copy of the official journal containing the mark of which notice is required to be given, with a note distinguishing such mark. Manner of giving notice to Cutlers' Company of application.

53. The period from the giving of such notice, before the expiration of which the trade-mark is not to be registered, shall be six weeks from the date of sending such notice to the Cutlers' Company. Time between notice to Cutlers' Company and registration of trade-mark.

54. The time within which notice of the assignment of any trade-mark or device, or the registration of any trade-mark, is to be given to the registrar or to the Cutlers' Company (as the case may be) shall be fourteen days after such assignment or registration. Time for notice of assignment of mark or registration of mark.

55. The manner in which such notice shall be given shall be the sending a notice of such assignment or registration, with sufficient particulars to identify the mark, or device, or trade-mark, to the registrar or Cutlers' Company, as the case may be. Manner of giving notice of assignment or registration of mark.

56. A copy of a trade-mark for the purpose of these Rules when sent by the Cutlers' Company shall be a drawing or representation of the trade-mark, and, subject to any other directions that may be given by the registrar, shall be of a size of not less than three inches square, and shall be upon foolscap paper of such size as aforesaid. Description of copies for purpose of Cutlers' Company.

Declaration and Evidence.

57. In any case in which any person is required under this Act to make a declaration on behalf of himself, or of any body corporate, or any evidence is required to be produced to the registrar, the registrar, if satisfied that from any reasonable cause such person is unable to make the declaration, or that such evidence may be dispensed with, may, upon the production of such other declaration or evidence, and subject to such terms as he may think fit, dispense with any such declaration or evidence. Dispensing with declaration, evidence, &c.

58. The declarations required by these rules shall be made and subscribed in the United Kingdom under the authority of the Act of the fifth and sixth years of the reign of King William the Fourth, chapter sixty-two, "to repeal an Act of the present session of Parliament, intituled 'An Act for the more effectual Manner in which and persons before whom declaration is to be taken.

abolition of oaths and affirmations taken and made in various departments of the State, and to substitute declarations in lieu thereof, and for the more entire suppression of voluntary and extra-judicial oaths and affidavits,' and to make other provisions for the abolition of unnecessary oaths," and may be made and subscribed before any justice of the peace, or any commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding.

The declaration, when taken out of the United Kingdom, shall

(*a.*) If made in any part of Her Majesty's dominions be made and subscribed before some court, justice, or officer authorised by law in such part of Her Majesty's dominions to administer an oath for the purpose of a legal proceeding; and,

(*b.*) If made out of Her Majesty's dominions, be made and subscribed before a British consul, vice-consul, or other consular officer.

Notice of seal of officer taking declaration to prove itself.

59. Any document purporting to have affixed, impressed, or subscribed thereto or thereon the seal or signature of any person hereby authorised to take such declaration in testimony of such declaration having been made and subscribed before him, may be admitted by the registrar without proof of the genuineness of any such seal or signature, or of the official character of such person or his authority to take such declaration.

Declaration by infant, lunatic, &c.

60. If any person is, by reason of infancy, lunacy, or other inability, incapable of making any declaration or doing anything required or permitted by the Act or these rules to be made or done by such incapable person, then the guardian or committee, if any, of such incapable person, or if there be none, any person appointed by any court or judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purpose of the Act and these rules be as effectual as if done by the person for whom he is substituted.

Commissioners of Patents.

Registrar subject to Commissioners of Patents.

61. The registrar, in the exercise of his powers, duties, and discretion under the Act and these rules, shall be subject to the superintendence of the Commissioners of Patents, and shall conform in every case to any instructions, directions, orders, or rules (general or special) that may be issued, given, or made by such Commissioners, or any one of them; and he shall in all cases of doubt be entitled to refer to the said Commissioners, or any of them, for instructions.

Notices.

Notices to be in writing and served by post.

62. Applications, statements, notices, and documents required by the Act or by these Rules to be served or sent, shall be in writing or print, or partly in writing and partly in print, and may be delivered personally, or served and sent by post, and if sent by post shall be deemed to have been served and received respectively at the time when the letter containing the same would be delivered in the ordinary course of post; and in proving such service or sending it shall be sufficient to prove that the letter containing the notice was prepaid and put into the post properly addressed.

Mode of addressing notices.

63. Any application, statement, notice, and document to be served or sent on or to the registrar shall be deemed to be properly addressed if addressed to the registrar of trade-marks at his office; and if required to be served on or sent to the proprietor of any trade-mark shall be deemed to be properly addressed if addressed to the registered proprietor at his registered address.

Construction of rules.

64. These rules shall be construed as if they were part of the Trade Marks Registration Act, 1875, which Act is in these Rules referred to as "the Act."

Forms.

65. The forms in the third schedule to these rules or such other forms as the registrar may direct may be used in all cases to which they are applicable.

CAIRNS, C.

We the Commissioners of Her Majesty's Treasury do hereby assent to the above Rules so far as they relate to fees.

MAHON.
R. WINN.

SCHEDULES.

FIRST SCHEDULE.

Classification of Goods.

	Illustrations.
	Note.—Goods are mentioned in this column by way of illustration, and not as an exhaustive list of the contents of a class.
Class 1. Chemical substances used in manufactures, photography, or philosophical research.	Such as— Acids, including vegetable acids. Alkalies. Artists' colours. Pigments. Mineral dyes.
Class 2. Chemical substances used for agricultural and horticultural purposes.	Such as— Artificial manure. Sheep washes.
Class 3. Chemical substances used in medicine and pharmacy.	Such as— Tinctures. Extracts. Barks. Patent medicines. Cod-liver oil.
Class 4. Raw vegetable and animal substances used in manufactures.	Such as— Resins. Oils. Dyes.

Class 4—*cont.*

Tanning substances.
Fibrous substances (*e.g.* cotton, hemp, flax, jute).
Wool.
Silk.
Cork.
Seeds.
Glue.
Bone.
Sponge.

Class 5.

Unwrought and partly wrought metals used in manufacture.

Such as—
Iron and steel, pig or cast.
" rough.
" bar and rail, including rails for railways.
" bolt and rod.
" sheets, and boiler and armour plates.
" hoops.
" wire.
Lead, pig.
" rolled.
" sheet.
Copper.
Zinc.

Class 6.

Machinery of all kinds, and parts of machinery, except agricultural machines and implements included in Class 7.

Such as—
Steam engines.
Boilers.
Pneumatic machines.
Hydraulic machines.
Locomotives.
Sewing machines.
Weighing machines.
Machine tools.
Mining machinery.
Fire engines.

Class 7.

Agricultural and horticultural implements and machines.

Such as—
Ploughs.
Drilling machines.
Reaping machines.

Class 7—cont.	Thrashing machines. Drainage implements. Dairy implements. Garden implements. Cyder presses. Beehives.
Class 8.	
Philosophical instruments, instruments and apparatus for useful purposes, or for teaching.	
Class 9.	
Musical instruments.	
Class 10.	
Horological instruments.	
Class 11.	
Surgical instruments and apparatus.	
Class 12.	
Cutlery and edge tools.	Such as— Knives. Forks. Scissors. Shears. Files. Saws. Corkscrews. Tweezers. Button-hooks.
Class 13.	
Metal goods not included in other classes.	
Class 14.	
Goods of precious metals (including aluminium, nickel, &c.), and jewellery, and imitations of such goods and jewellery.	Such as— Plate. Clock cases. Pencil cases. Sheffield and other plated goods. Gilt and ormolu work.

	Class 15.	
Glass.		Such as— Window and plate glass. Painted glass. Glass mosaic. Glass for optical purposes.
	Class 16.	
Porcelain and earthenware.		Such as— China. Stoneware. Terra-cotta. Statuary porcelain. Tiles. Bricks.
	Class 17.	
Manufactures from mineral and other substances for building or decoration.		Such as— Cement. Plaster. Imitation marble.
	Class 18.	
Engineering, architectural, and building contrivances.		Such as— Diving apparatus. Warming apparatus. Ventilating apparatus. Filtering apparatus. Lighting contrivances. Drainage contrivances. Electric bells.
	Class 19.	
Arms and military stores, not included in Class 20.		Such as— Cannon. Small-arms. Fowling-pieces. Swords. Shot and other projectiles. Camp equipage. Military equipments. Military accoutrements.
	Class 20.	
Explosive substances.		Such as— Gunpowder.

Class 20—*cont.*

Gun cotton.
Dynamite.
Fog-signals.
Percussion caps.
Fireworks.
Cartridges.

Class 21.

Naval architectural contrivances and naval equipments.

Such as—
Boats.
Anchors.
Chain cables.
Windlasses.
Rigging.
Logs.

Class 22.

Carriages.

Such as—
Railway carriages.
Waggons.
Railway trucks.
Velocipedes.

Class 23.

Cotton yarn and thread.

Class 24.

Cotton piece goods of all kinds.

Class 25.

Cotton goods not included in Classes 23, 24, or 38.

Class 26.

Linen and hemp yarn and thread.

Class 27.

Linen and hemp piece goods.

Class 28.

Linen and hemp goods not included in Classes 26 and 27.

Class 29.

Jute yarns and tissues, and other articles made of jute.	

Class 30.

Silk, spun, thrown, or sewing.	

Class 31.

Silk piece goods.	

Class 32.

Other silk goods not included in Classes 30 and 31.	

Class 33.

Woollen and worsted yarns.	

Class 34.

Woollen cloths and worsted stuffs.	

Class 35.

Woollen and worsted goods not included in Classes 33 and 34.	

Class 36.

Carpets, floor-cloth, and oil-cloth.	Such as— Drugget. Mats and matting. Rugs.

Class 37.

Leather, and skins unwrought and wrought, and hair and feathers.	Such as— Saddlery. Harness. Portmanteaus. Furs. Bristles. Haircloth. Wigs. Hair mattresses.

Class 38.	
Articles of clothing.	Such as— Hats of all kinds. Caps and bonnets. Hosiery. Gloves. Boots and shoes. Other ready-made clothing.
Class 39.	
Paper (except paper hangings), stationery, printing, and book-binding.	Such as— Envelopes. Sealing wax. Pens (including steel pens). Ink. Playing cards. Blotting cases.
Class 40.	
Goods manufactured from india-rubber and gutta-percha not included in other classes.	
Class 41.	
Furniture and upholstery.	Such as— Paper hangings. Papier-mâché. Mirrors. Japan goods.
Class 42.	
Substances used as food.	Such as— Cereals. Pulses. Oils. Hops. Malt. Dried fruits. Tea. Spices. Sago. Salt. Starch. Sugar.

Class 42—*cont.*

Preserved meats.
Honey.
Confectionery.
Biscuits.
Oil cakes, &c.
Pickles.
Vinegar.

Class 43.

Fermented liquors and spirits.

Such as—
Beer.
Cyder.
Wine.
Whisky.
Liqueurs.

Class 44.

Mineral and aërated waters, natural and artificial.

Class 45.

Tobacco, whether manufactured or unmanufactured.

Class 46.

Seeds for agricultural and horticultural purposes.

Class 47.

Candles, illuminating oils, matches, and common soap.

Class 48.

Perfumery (including perfumed soap).

Class 49.

Toys.
Games of all kinds.
Archery.
Fishing-tackle.

Class 50.

Miscellaneous, including—
(1.) Goods manufactured from ivory, bone, wood,

Class 50—*cont.*

not included in other classes.

(2.) Goods manufactured from straw or grass, not included in other classes.

(3.) Goods manufactured from animal and vegetable substances, not included in other classes.

(4.) Tobacco pipes.

(5.) Umbrellas.

(6.) All goods not included in the foregoing classes.

GENERAL NOTE.

Any wares made of mixed materials (for example, of both cotton and silk) shall be included in such one of the classes appropriated to those materials as the registrar may decide.

SECOND SCHEDULE.

FEES.

The following fees shall be payable to the registrar on or for the following occasions or purposes :—

	£	s.	d.
1. On application to register one trade-mark for one or more articles included in one class .	1	0	0
2. On application to register more than one trade-mark for one or more articles included in one class, for each additional trade-mark after the first	0	10	0
3. On application to register a trade-mark in respect of goods in different classes, for every class after the first to which such trade-mark is extended, an additional fee of . .	0	2	0
4. For registration of one trade-mark . .	1	0	0
5. Where the same person is registered at the same time for more than one trade-mark, for registration of each additional mark after the first	0	10	0

	£	s.	d.
6. Where the same person is registered at the same time for the same trade-mark in respect of goods in different classes, for the registration of one mark in each class after the first an additional fee of	0	2	0
7. For entering notice of opposition . . .	2	0	0
8. For registering subsequent proprietor . .	1	0	0
9. For altering address on the register . .	0	5	0
10. For every entry in the register of a rectification thereof or an alteration therein, not otherwise charged	0	10	0
11. For continuance of mark at expiration of fourteen years	2	0	0
12. Additional fee where fee is paid within three months after expiration of fourteen years .	1	0	0
13. Additional fee for restoration of trade-mark when removed for non-payment of fee. .	2	0	0
14. For certificate	1	0	0
15. For inspecting register, for every quarter of an hour	0	1	0
16. For office copy of documents, 2*d.* per folio, but never less than	0	1	0
17. Settling a special case by registrar . .	2	0	0

Note.

If a copy of a trade-mark is required for any purpose, such copy shall be supplied by or at the expense of the applicant.

THIRD SCHEDULE.

Form A.

Form of Statement on Application for Registration of one Trade-Mark.

I,* [*John Jones, of Moon Street, in the City of Birmingham, pharmaceutical chymist,*] apply to be registered as proprietor of a trade mark† [*being a goat's head and neck with a gold collar attached thereto*], and which is represented in the paper annexed hereto.

I desire that the said trade-mark may be registered in respect of the description of goods following, contained in [*Class I.,*

* *Here insert name, address, and calling of the applicant.*

† *Here insert in writing description of trade-mark.*

‡ *Here insert description of the goods, and the class or classes under which the applicant desires to have them registered.*

that is to say, ‡ *acids, including vegetable acids, alkalies, artists' colours, pigments, mineral dyes*].

I have used the said trade-mark in respect of the said goods for [*ten*] years before the date of this statement.§

‖ The day of 187 .

(Signed) *John Jones.*¶

§ *This paragraph may be omitted if the trade-mark was not used before the* 13*th of August,* 1875.

‖ *Here insert date.*

¶ *Here insert signature.*

Form B.

Form of Statement on Application for Registration of more than one Trade-Mark.

I,* [*John Jones, of Moon Street, in the City of Birmingham, pharmaceutical chymist,*] apply to be registered as proprietor of the following trade-marks, numbered from "1" to .

The trade-marks are described as follows; that is to say,

No. 1 is†

and is represented on paper 1 annexed hereto.

No. 2 is†

and is represented on paper 2 annexed hereto [*and so forth*].

I desire that the said trade-marks may be registered in respect of the descriptions of goods following; that is to say,

As to No. 1, in respect of the following goods contained in class ‡

As to No. 2, in respect of the following goods contained in class ‡ [*and so forth*].

§ I have used the trade-marks numbered [*respectively*] and in respect of the goods for which I desire them to be registered for years before the date of this statement.

‖ The day of 187 .

(Signed) *John Jones.*¶

* *Here insert name, address, and calling of the applicant.*

† *Here insert in writing description of trade mark.*

‡ *Here insert description of the goods and the class or classes under which the applicant desires to have them registered.*

§ *This paragraph may be omitted if the trade-marks were not used, before the* 13*th of August,* 1875.

‖ *Here insert date.*

¶ *Here insert signature.*

Form C.

Form of Declaration to accompany Statement on Application for Registration of one Trade-Mark.

I *A.B.* of

do hereby solemnly and sincerely declare, to the best of my knowledge and belief, as follows:—

(1.) The statement signed by me, and dated the day of , and marked with the letter "A," and

shown to me at the time of making this declaration is true:

(2.) The description of the trade-mark in such statement is a true description of the trade-mark for the registration of which I apply:

(3.) I am lawfully entitled to the use of the trade-mark of which the said description is a true description.

Signed *A.B.*
Declared before me

NOTE.—*The above Form will require to be altered so as to suit an application for the registration of more than one trade-mark.*

FORM D.

FORM OF ASSIGNMENT OF TRADE MARK.

Trade mark, class *
Name
Place of business

I † *A.B.* of in the county of being registered proprietor of the trade-mark above particularly described, in consideration of pounds paid to me by *E.F.*, carrying on business at in the county of under the firm of *F. & Co.*, hereby assign the said trade-mark to the said *E.F.*, together with the goodwill of the business concerned in the goods with respect to which the trade-mark is registered

In witness whereof I have hereunto subscribed my name and affixed my seal, this day of 18 .

(Signed)
Executed by the above-named *A.B.*,
in the presence of

[*insert description and place of residence.*]

Executed by the above-named *E.F.*,
in the presence of

* *Hereafter number or other means of identifying trade-mark in register.*

† *Alter as necessary if there be more than one proprietor.*

Form E.

Declaration by Transmittee applying to be registered as Proprietor.

* *Hereenter number or other means of identifying trade mark in register.*

Trade mark, class , No. *.
Name of owner
Firm
Place of business

† *After accordingly, if more than one person makes the declaration.*

‡ *After according to circumstances.*

(1.) I, † the undersigned *A.B.* of in the county of , ‡ carrying on business at , in the county of , declare as follows:

I declare that *A.B.*, the registered proprietor of the trade-mark above described ‡ [died at in the county of , having first made his will, dated the day of , whereby he appointed me executor and I proved [*or* confirmed] his said will on the day of in the Court of], or [died at in the county of on the day of , intestate, and letters of administration of his estate and effects were [confirmation as executor of the said was] on the day of duly granted to me by the Court of]:

Or,

§ *After according to circumstances.*

I declare, that [the estate of *C.D.*, the registered proprietor of the trade-mark above described, was, on the day of duly § [adjudged a bankrupt] [sequestrated], and that I was on the day of appointed trustee of the [sequestrated] estate of the said *C.D.*, and I am by law entitled to be registered as proprietor of the said trade-mark in place of the said *C.D.*:

Or,

‖ *After according to circumstances.*

I declare that on the day of intermarried with and am now the husband of *C.D.*, the registered proprietor of the trade-mark above described; and ‖ I declare that on such marriage the interest of the said *C.D.* in the said trade-mark and in the goodwill of the business concerned in the goods with respect to which the trade-mark is registered became by law vested in me, and that I am entitled to be registered as owner of the said trade-mark in place of the said *C.D.*, and I declare that *C.D.* is the person referred to in the annexed certificate.

(2) I am lawfully entitled to the goodwill * of the business concerned in the goods with respect to which the trade-mark so transmitted to me is registered.

* *If the declarant is entitled only to some share in the goodwill, the share must be specified.*

And I make this solemn declaration believing the same to be true.

(Signed)

Dated at the
day of 18 .

Made and subscribed by the above-named *A.B.* in the presence of me,

(Signed)

Name of registrar [*or* justice of the peace acting in and for *or*, &c.]

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