PASSING OFF

ON

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OR

ILLEGAL SUBSTITUTION OF THE GOODS OF ONE TRADER FOR THE GOODS OF ANOTHER TRADER

BY

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Dear Sir

Yours Truly

PREFACE

THIS little work is a reproduction, with a few clerical alterations and a few notes, of a course of four lectures delivered by me in November, 1903, at King's College, London.

JOHN CUTLER.

LINCOLN'S INN,
January, 1904.

ABBREVIATIONS

R.P.C.—Reports of Patent Design and Trade Mark Cases.
L.R.—Law Reports.

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PASSING OFF

PART I

General Statement of Rules of Law

It is a thoroughly well-established rule of law that 'no man has a right to pass off his goods as though they were the goods of another.' Perhaps it would be more strictly accurate to use the word 'trader' instead of 'man,' and to say that 'no trader has a right to pass off his goods as though they were the goods of another trader,' for the rule is undoubtedly based on trade considerations. As will be mentioned more in detail later on, it is equally true that A has no right to pass off the goods of X as the goods of B. Another way of stating the proposition is that, in supplying a customer who orders and expects to get the goods of A, the substitution of any other goods is illegal, unless the customer understands that he is not getting what he ordered and assents thereto. The above-mentioned rule is quite in accordance with the principles of commercial

honesty; whether it is in accordance with commercial practice is another thing.* Whether in trade circles this rule of law is more honoured in the breach than the observance in the present day is a matter upon which there are many diverse opinions. But this is certain, that breaches of the rule are so common as to afford a great deal of work to both branches of the legal profession, and to occupy a great deal of the time of the Law Courts. The rule under consideration is well established, and it is easy of comprehension. The difficulties that arise are in its application to the circumstances of any particular case. When a plaintiff calls

* In the recent case of *De Kuyper and Son* v. *Baird* (20 R.P.C. 581), the Irish Master of the Rolls said: 'It is melancholy for one who has to sit in a Court of Chancery in this country to find so many traders willing to go as close as they dare in order to capture trade by false pretences. They are not confined to this particular trade, though they swarm in it. Mineral waters, ale, porter, whisky (of the different well-known brands), brandy, and gin—all afford scope for this nefarious industry. No sittings pass without my having to give injunctions with costs in cases of this sort. It is a disgraceful state of facts; though I have no intention of censuring a whole trade (in which there are hundreds of honourable men who would not stoop to anything mean or even questionable) because there are dishonest persons engaged in it. The effort of an honest man, anxious to commend his own goods on the ground of quality or cheapness, or both, ought to be to brand them with a mark as unlike as possible to other brands, which have their own value, instead of trying to go as close as he can with legal impunity in the way of imitating them.'

upon a Court to grant an injunction to restrain a defendant from passing off his goods as being the goods of the plaintiff, the question which the Court has to decide is always a question of fact: Is the defendant, in fact, doing that of which the plaintiff is entitled to complain—is the defendant, in fact, passing off, or doing that which is calculated to pass off, his goods as those of the plaintiff? The answer to the question depends upon all the circumstances of the case—the circumstances affecting the plaintiff and his trade, and the circumstances affecting the defendant and his trade. It follows from this that, although the principles on which a passing-off case is decided are a guide to the decision of a subsequent passing-off case, the facts in such prior case are not and cannot be a guide to the decision of the subsequent case. As the view taken of the facts of the case is a matter entirely personal to the judge who tries it (or to the jury, if the case is tried with a jury), in the sense that the tribunal is not fettered by (indeed, ought not to regard for this purpose) the decisions in previous cases, it is impossible to predicate beforehand with anything approaching to certainty what that view will be. Another element of uncertainty in passing-off cases is the circumstance that witnesses' statements before the trial often so materially differ in character and in extent from the statements which they make in the witness-

box. Therefore, if A consults a lawyer as to whether he would succeed in a passing-off case against B, the utmost that the lawyer can conscientiously say is either 'in my opinion you will not succeed,' or 'in my opinion you will succeed provided the evidence comes out at the trial as it now is upon paper, and provided nothing adverse to your case is sprung upon you in court.' Another element of uncertainty arises from this, that sometimes the tendency of the judges appears to be to err on the side of severity towards defendants in passing-off cases, and sometimes on the side of leniency. At present the swing of the pendulum is towards what may well be considered to be undue leniency. Competition in trade is doubtless beneficial to the purchasing community, but there is a vast difference between justifiable and unjustifiable competition, although it is not so easy as it ought to be to draw the line between them. Competition which to most minds would be unjustifiable is not always illegal. A trader brings out a new article, or a new variety of an old article, or adopts a novel method of putting an article on the market. Directly he has begun to achieve a measure of success, some of his rivals are sure to begin trying to subtract a portion of his trade. If it is done by running other goods on their merits in competition with his, this is both justifiable and legal; if it is done by imitating his goods or the get-up

of his goods, this is certainly morally unjustifiable. It may or may not be illegal, because imitation of a man's goods, or of the get-up of his goods, is not always illegal. It is only illegal if it is carried to such an extent as to lead to the imitation goods being passed off as his. If the imitation stops short of that, then it is only treated as the sincerest form of flattery, but this is a form of flattery from which the person imitated would be only too glad to be exempt.

The rule of the law that no trader will be allowed to pass off his goods as those of another trader is, as previously stated, a well-established rule. It may be an interesting matter for lawyers to inquire when it was first introduced or adopted into our legal system. But for all practical purposes it is immaterial whether it was introduced, as some say, only about a century ago, or whether it is, as others say, of much older date. It is sufficient for us that it has been in existence for many years, and is now so firmly established that nothing short of an Act of Parliament can abrogate it.

It may here be remarked, although more will be said on the subject subsequently, that in passing-off actions it is not necessary that the person charged with passing off should be proved to have *intended* to pass off his goods as those of the plaintiff. The question is, What is the commercial effect of what he is doing? If the effect would be to pass off his

goods as those of the plaintiff, then his honesty of purpose or the absence of any intention to deceive is no defence. But his intention is by no means immaterial, because whenever the Court is convinced in a passing-off case that the defendant intended to deceive—intended that his goods should be passed off as the plaintiff's—it will be very difficult, though not impossible, for him to satisfy the Court that his fraudulent conduct will not have the effect he intended it should have. In reference to this, it must be observed that an intention to imitate or copy, and an intention to pass off or deceive by that imitation or copy, are two distinct things. The former may be legal, but the latter never can.

Again, when a plaintiff seeks an injunction to restrain a defendant from passing off his goods as the plaintiff's, the plaintiff is not obliged to prove that the defendant's acts have had that effect—*i.e.*, he need not prove actual deception—he need not prove that any person has, in fact, been misled by the appearance of the defendant's goods into purchasing them in the belief that they were the plaintiff's goods, although it is far better for his success in the action if he can do so, because it is obviously an uphill game for a defendant to contend that his goods are not calculated to deceive when they, in fact, have deceived. But

one isolated instance of deception, or even two instances of deception, are not necessarily sufficient in a doubtful case, because they may have occurred to persons or under circumstances which predispose the Court not to place reliance on them. Still, evidence of actual deception of purchasers is always most valuable to a plaintiff in a passing-off action, and he should use all efforts to procure it. In short, what the plaintiff has to do is to satisfy the Court that what the defendant is doing is calculated to deceive—calculated to lead to his goods being mistaken for the plaintiff's.

Again, the plaintiff need not prove that the purchasers from defendant are likely to be deceived if he can prove that sub-purchasers—*i.e.*, purchasers from those who purchase from the defendant—are likely to be deceived. This is practically very important. In most passing-off cases the defendant is the manufacturer of the goods complained of. The purchasers from such a defendant will be wholesale houses or retail traders, who buy to resell to the public, or both. The wholesale houses will certainly not be deceived; the retail traders are very unlikely to be deceived. They probably know that the goods they are buying are the defendant's goods, and are in no way connected with the plaintiff. They have the requisite trade knowledge to protect them; but it may well be that the purchasers from the retail

traders—the public buying over the counter—may be deceived: they have not the requisite trade knowledge to protect them. Therefore a defendant may 'pass off' not only by selling to purchasers who think they are buying the plaintiff's goods, but by selling goods to persons who are not deceived (who know the goods are not the plaintiff's), but who buy to resell to persons who may be deceived. Putting it in another way, a man must not only not deceive purchasers from himself by passing off, but he must not put into the hands of purchasers from himself goods which they can pass off on purchasers from them.

Finally, it is not necessary for the plaintiff to prove that the ultimate purchasers who are deceived know him or his firm. They may or they may not. In the Yorkshire Relish case, to which frequent references will be made, it was established that numbers of the purchasers of Yorkshire Relish had never heard of the plaintiff or his firm; but that on asking for Yorkshire Relish they meant a particular sauce emanating from a particular trade source. So, too, if a lady asks for Vinolia Soap, she probably does not know who made it; what she requires is the article she has always known under that name, and nothing else. Many other instances might of course be cited, but it is unnecessary to do so.

PART II

Passing off, a Matter of Representation

A TRADER must not pass off his goods as the goods of another trader. This illegal passing off may be effected in a variety of ways; those most ordinarily occurring will be mentioned hereafter; but first it should be remarked that passing off is really a matter of representation. When B passes off his own goods as the goods of A, B represents that the goods are the goods of A, and the purchaser takes them on the faith of that representation. In fact, the general rule under consideration is sometimes laid down in this way: 'No man has the right to represent his goods as the goods of another.' This was the way in which the proposition was stated by Lord Justice Turner in *Burgess* v. *Burgess* and adopted by Lord Halsbury, in *Reddaway* v. *Banham*.* Lord Justice Vaughan Williams, too, in one of the latest reported cases of the kind, begins his enunciation of the law thus: 'There can, of course, be no doubt that nobody has any right to represent his goods as the goods of somebody else.'

To give one more, and a longer quotation, Lord Justice Cotton, in the *Singer Manufacturing Com-*

* 13 R.P.C. 218; L.R., 1896, A.C. 199.

pany v. *Loog*,* said: 'The question is this, whether the defendant has represented that the goods manufactured by him were manufactured by the plaintiffs, or whether he has done anything calculated so to represent. I quite agree that it is unnecessary that a fraudulent intention in issuing the circulars complained of should be established. If the natural consequence of those things, even in circumstances not known to him, is that they will represent the goods to be those of another person, it is wrongful, and, as this Court says, a fraud in him, to continue the user after those circumstances are brought to his knowledge. We must consider whether he has represented, or done that which is reasonably calculated to give that misrepresentation, and we must consider what is relied on.'

In that case certain circulars, price-lists, and invoices issued by the defendant were relied on by the plaintiffs as containing or involving a representation that the defendant's goods were the plaintiffs'. The Court of Appeal decided that they did not, and the House of Lords affirmed the decision of the Court of Appeal. Although in that case the circulars, etc., were held not to contain the illegal misrepresentation, yet in other cases it has been held that similar documents have contained or conveyed a representation that the defendant's goods in connection with

* L.R. 18 Ch. Div. 417.

which they were issued were the plaintiffs'.* The plaintiff, in a passing-off action, then, must satisfy the court that what the defendant has done amounts to a representation, or will be taken to be a representation, that the defendant's goods are the plaintiff's. Such a representation can be made in a variety of ways, some of the most prominent of which will be mentioned later.

Lord Chancellor Halsbury dealt with this subject in *Powell* v. *Birmingham Vinegar Brewery Company* in the House of Lords.† After referring to the rule that no man has any right to represent his goods as the goods of another, Lord Halsbury said: 'The most obvious way in which a man would infringe this rule is if he were to say in terms, "these are the goods manufactured by" a rival tradesman, and it seems to be assumed that unless he says something equivalent to that no action will lie. It appears to me that that is an entire delusion. By the course of trade, by the existence and technology of trade, and by the mode in which things are sold, a man may utter that same proposition, but in different words, and without using the name of the rival tradesman at all. A familiar example, of course, is when, without using any

* See *Jay* v. *Ladler*, 6 R.P.C. 136; *Faulder and Co.* v. *Rushton*, 20 R.P.C. 477.

† 14 R.P.C. 727.

name, by the identity of the form of the bottle, or the form of the label, or the nature of the thing sold in the package, he is making the statement, not in express words, but in one of those different forms, in which the statement can be made, by something that he knows will be so understood by the public.'

PART III

Copying or Imitating Trade Marks

Now as to some of the ways in which the representation complained of in a passing-off action can be made. First of all, it can be made by copying or colourably imitating the plaintiff's trade marks or labels. It is not intended on this occasion to deal more fully with the trade marks than is necessary for the exhaustive treatment of the subject under consideration. The use of a trade mark was one of the earliest, and is now the most general, and, in fact, the most effectual means that a trader can use to distinguish his goods in the market. It is a means which easily impresses itself on the minds of the purchasing public, and it lends itself admirably to pictorial advertising. Of course, it is open to piracy, but where the goods of A are known and distinguished only by A's trade mark, a rival who wishes to pass

off his goods as the goods of A can only do so by copying or colourably imitating A's trade mark, which is illegal. The simpler a trade mark is the better for trade purposes, because a simple mark does not lend itself so readily to colourable imitation as a trade mark composed of or containing several elements. Trade marks can, of course, be registered, and by the Statute at present in force the registration of a person as proprietor of a trade mark is *primâ facie* evidence, and, after five years, conclusive evidence of his right to the exclusive use of the trade mark. In such a case, if a rival simply copies the registered trade mark, the proprietor can restrain the use of the copy as a matter of course—*i.e.*, he need not establish that the use of the copy is calculated to represent that the goods of the infringer are his goods. When, however, the trade mark is not simply copied, but only imitated, different considerations come into play. In such a case, the owner of the trade mark, to succeed in an action for infringement, has to prove that the imitation which he complains of is calculated to deceive—calculated to lead to the goods of the infringer being taken for his goods—in fact, he has to prove, just as he would have in a passing-off action, that the infringer by using the imitation of his trade mark is representing his goods as those of the plaintiff. Is there, then, no difference between an action for infringement of a

registered trade mark by imitating it and an action for passing off? Yes, there is a most important difference. In the majority of passing-off actions the plaintiff has to allege and prove that something on which he relies denotes his goods in the market, or (changing the phrase) distinguishes them from the goods of other traders, and it is because of his goods being so denoted or distinguished that he alleges that the defendant's conduct amounts to a representation that the defendant's goods are the plaintiff's. This the plaintiff in a passing-off action often fails to prove, and if he fails to prove it his action will be dismissed with costs; whereas in an action for infringement of a registered trade mark the Court assumes—in fact, is bound to assume—that the plaintiff's trade mark performs its proper function of denoting or distinguishing his goods in the market. This difference will be more fully appreciated when it is seen how often a plaintiff, in an action for passing off founded on a copying of that which he claims as his trade name, fails to prove that it is his trade name because he fails to prove that it denotes or distinguishes his goods on the market.

It was in reality to assist trade mark owners by relieving them of the necessity of proving in actions of infringement that their trade marks denoted or distinguished their goods in the market that the system of registration of trade marks was

introduced by the Trade Marks Registration Act, 1875. That Act provided for the registration of marks which were trade marks within the definition clause of the Act. By a section engrafted on this Act of 1875 by an Act passed about a year afterwards—*i.e.*, in 1876, it was enacted that 'From and after the 1st day of July, 1877, a person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of any trade mark as defined by the principal Act until and unless such trade mark is registered in pursuance of that Act, or until and unless with respect to any device, mark, name, combination of words, or other matter or thing in use as a trade mark before the passing of the principal Act, registration thereof as a trade mark under the principal Act shall have been refused as hereinafter is mentioned.'

The last part of this provision of the Statute was intended to preserve the rights of the owners of old trade marks—that is, trade marks in use before the 13th of August, 1875—the date of the passing of the Act of 1875—by allowing them to sue for infringement, whether their marks were registered or not; but in an infringement action a plaintiff, the owner of an old trade mark, must do one of two things, either produce a certificate of registration, or produce a certificate of refusal of registration. With regard to trade marks that came into existence—*i.e.*, began to

be used after the 13th of August, 1875, if they were trade marks within the definition clause of the Act of 1875, then, according to the provision under consideration, they must be registered before they could be sued upon. But then, what would be the position of a mark which came into use after the 13th of August, 1875, which was a trade mark properly so-called because it denoted or distinguished the goods of the owner in the market, but which could not be registered because it did not fall within the definition clause of the Act of 1875? Was such a mark without protection? No. But then, what was the protection? It was this. The High Court, exercising Equity jurisdiction, held that the Trade Marks Registration Act in no way interfered with the old jurisdiction of Courts of Equity to restrain a man from doing that which was calculated to pass off his goods as the goods of a plaintiff who was involving that jurisdiction. This was the decision of the Court of Appeal in the well-known case of *Mitchell* v. *Henry*.* No more need be said about this provision of the Act of 1875, but reference must be made to the one in force now—namely, Section 77 of the Patents, Designs and Trade Marks Act, 1883. That section is in these words: 'A person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of a trade mark unless, in the case

* L.R. 15 Ch. Div. 181.

of a trade mark capable of being registered under this Act, it has been registered in pursuance of this Act, or of an enactment repealed by this Act, or, in the case of any other trade mark in use before the 13th of August, 1875, registration thereof under this part of this Act, or of an enactment repealed by this Act, has been refused. The Comptroller may, on request, and on payment of the prescribed fee, grant a certificate that such registration has been refused.'

With regard to the wording of the section, it is necessary to observe that the words 'trade mark capable of being registered under this Act' in effect now mean a trade mark which is a trade mark within the meaning of Section 64 of the Act of 1883, as it stands after the alterations effected by the amending Act of 1888. There is really no material difference between Section 77 of the Act of 1883 and the corresponding provision of the previous Act to which attention has just been drawn.

This being so, of course it has been held to have no interfering effect with the equitable jurisdiction of the High Court to restrain passing off. But the point that it has such an effect has been raised and argued, although without success. Thus, in the case of the *Great Tower Street Tea Company* v. *Langford*,* in 1887, where the plaintiffs complained of the defendants selling tea in packets which were a

* 5 R.P.C. 66.

colourable imitation of the plaintiffs' packets, it was argued for the defendants that as some of the letter-press on the plaintiffs' packets was capable of registration under Section 64 of the Act of 1883, and was not so registered, the plaintiffs were prevented by Section 77 from suing in respect thereof; but Lord Justice Stirling (then Mr. Justice Stirling) said: 'I think the decisions of the court have gone to the extent of saying that the old law still remains, and that you are not entitled to sell your goods in such a way as to lead the person buying them to believe that they are the goods of another man. That is the real question, and, as I understand it, the decisions of the Court of Appeal come to this: that the old law still remains, and it is upon that ground that the present case is put. Therefore I have to decide in this case whether the defendants are really selling their goods in such a way as to get the benefit of the reputation of the plaintiffs. I think upon the evidence that I must take it that they are.' The point arose in a few other cases subsequently, and then, in 1895, came the well-known Yorkshire Relish case, *Powell* v. *Birmingham Vinegar Brewery Company*, which went ultimately to the House of Lords. There the plaintiff had registered the words 'Yorkshire Relish' as an old trade mark. Proceedings were taken to get this mark removed from the Register of trade marks, and they were successful,

and the mark was removed from the Register on the ground that the words had never been used by themselves as a trade mark on the goods themselves, and therefore ought not to have been registered. Subsequent to this removal, the plaintiff commenced an action against the Birmingham Vinegar Brewery Company, complaining of their using the words 'Yorkshire Relish' on a sauce of theirs, and thereby passing off their sauce as his. He succeeded in the Court of First Instance, in the Court of Appeal, and in the House of Lords.* It might have been well expected that this and the other cases to which reference has been made would have set the point at rest. But no! Very recently, in the case of *Faulder* v. *Rushton*,† the point cropped up again. That was a case in which the plaintiffs in a passing-off action complained of the use by the defendants of the word 'Silverpan' in respect of jams. This word the plaintiffs had used for fourteen years for their jams, and had registered as a prominent part of a trade mark, which trade mark had, however, been expunged from the Register. The plaintiffs having obtained an injunction, the defendants brought the matter before the Court of Appeal, who dismissed their appeal, and held that the injunction was rightly granted. Lord Justice Vaughan Williams, in delivering his judgment, said: 'Having said that the question in this

* 14 R.P.C. 720. † 20 R.P.C. 477.

case is a mere question of fact, I had better, before I go any further, dispose at once of a question of law which Mr. Moulton mentioned in the earlier part of his opening, but on which very little reliance was placed, either by Mr. Moulton at the end of his address, or by Mr. Maberly at any time in his address. That is a suggestion that the effect of Section 77 of the Act of 1883 is to disable the plaintiffs from bringing this action at all. I cannot agree. I only read Section 77 as defining the conditions which are necessary if anyone claims the benefits of that Statute. You cannot claim the benefits of that Statute unless certain conditions are present, one of which is that you have placed your trade mark on the Register, and so placed it there as to be entitled to keep it there. I shall say no more upon that part of the case.'

PART IV

Protection of Trade Marks, Registered and Unregistered

THE last-quoted judgment puts the position quite clearly. If a trade-mark owner finds that his trade mark is being copied or colourably imitated, then, of course, he desires to stop that infringement of his

rights; if his trade mark is registered, then he brings an action for infringement of registered trade mark, in which case he obtains what the Lord Justice calls 'the benefits of the Statute,' which are not inconsiderable. He need not, as we have seen, prove that his trade mark denotes or distinguishes his goods, and if the defendant has, in the course of the proceedings, in any way questioned the right to the exclusive use of the trade mark, the plaintiff, if he wins the action, can get a certificate that such right came in question, with the result that in any subsequent action for infringement of the same trade mark he will get solicitor and client costs, unless the judge in such subsequent action expressly deprives him of the same. If, however, the trade mark is not registered, then the plaintiff's action will be one for passing off, and his claim will be that by using a copy or a colourable imitation of the mark which denotes or distinguishes the plaintiff's goods in the market the defendant is representing that his goods are the goods of the plaintiff. The plaintiff will then have to prove two things—first, that the mark on which he relies does in fact denote or distinguish his goods in the market; secondly, that the mark which the defendant is using is calculated to represent his goods as being the goods of the plaintiff.

PART V

Distinctive Labels

Now as to labels. A label is very frequently used as the principal or only means of denoting or distinguishing a trader's goods in the market. A label that distinguishes or is capable of distinguishing a trader's goods in the market must obviously be a distinctive label. A distinctive label is one of the things which, under the Statute, is capable of being registered as a trade mark.* But there is a disposition nowadays not to register distinctive labels as trade marks because of the requirements of the Patent Office as to disclaiming the right to the exclusive use of portions of the label when registering. It is not intended now to go into this question of disclaimer,

* It has been held that for a distinctive label to be registerable as a trade mark it must contain one of the essential particulars enumerated in the section of the Act as to registerable trade marks (see *Wright, Crossley and Co.'s Trade Mark*, 17 R.P.C. 398). But this is erroneous. A 'distinctive label' is of itself an essential particular within the section; to say that it shall not be an essential particular unless it contains within itself another essential particular is to override the language of the Act. 'Distinctive' was defined by Lord Halsbury, L.C., as 'distinguishing a particular person's goods from somebody else's goods' (*Perry Davis* v. *Harbord*, 7 R.P.C. 340). Why it should be attempted to limit this common-sense definition it is difficult to see.

important though it is. It must suffice to say that there is that disposition not to register labels as trade marks to which allusion has just been made, and that in consequence thereof there are numbers of unregistered labels in use which could be, and would be, registered if the Statute was properly construed in this respect.

An unregistered label can only be protected by means of a passing-off action. But in this way it can be protected, for of course it is no more legal for B to represent his goods to be A's goods by copying or imitating A's label than in any other way. If in a passing-off action the court is satisfied that the plaintiff's label is known in the market as denoting or distinguishing the plaintiff's goods, then it will restrain another trader from using such a label as would be calculated to deceive—*i.e.*, such a label as will amount to a representation that such trader's goods are the plaintiff's goods.

PART VI

Labels Distinctive by Reason of Device or Catchword

FOR the purpose of the following remarks labels may be divided into two classes—first, there are labels in which the most prominent or salient feature is

some device, which may or may not be a registered trade mark, or some catchword or catchwords which the owner of the label claims as his trade name; second, there are labels in which the prominent or salient feature—*i.e.*, that which catches the eye or arrests the attention of the purchaser or would-be purchaser—is the general appearance, or, as it is called, the 'get-up' of the label. With regard to the first class, the owner of the label has to establish to the satisfaction of the court that the device or catchword that he relies on is associated or identified with his goods in the market—*i.e.*, distinguishes them in the market—and then he can restrain a rival from using this device or catchword, or any imitation thereof, in such a way as to deceive—*i.e.*, in such a way as to make the actionable misrepresentation to which reference is being frequently made. In such a case it is no defence for the trader whose conduct is complained of to say 'in all other respects my label is quite different to yours,' or 'I am using my own name on my label.' A very striking illustration of this is found in the Yorkshire Relish case (*Powell* v. *Birmingham Vinegar Brewery Company*). There the plaintiff established that the words 'Yorkshire Relish' were his trade name—*i.e.*, that they distinguished his sauce from the sauces of other makers. He obtained an injunction against the defendants to restrain them from using those words, as they were using them,

notwithstanding that the general appearance of their label, on which the words appeared, was quite different to his. Their label was a white label with gilt lettering, and in the centre was St. George and the Dragon on a gilt disc. Powell's label was one on which the printing was partly in white and partly in red. There was a great deal of blue about the label, and in the centre was a willow-pattern plate in blue and white. Then, again, Powell's firm name of Goodall, Backhouse and Co. appeared conspicuously at the bottom of his label, while the 'Birmingham Vinegar Brewery Co., successors to Holbrook and Co.,' appeared prominently at the bottom of their label. In fact, for trade purposes there was no similarity between the two labels, except that they both contained prominently the words 'Yorkshire Relish.' Yet the injunction awarded prevented the defendants from continuing to use their label because of the words 'Yorkshire Relish' being on it. If they had liked to take out 'Yorkshire Relish' and substitute 'Cornish Relish,' they might have gone on using the label, but they did not, for reasons which are not difficult to conjecture.

PART VII

Labels Distinctive by Reason of 'Get-up.'

THE second class of labels are those which are distinctive of the owner's goods in the market, not by reason of any one salient or prominent feature, but because of the general appearance or 'get-up.' Here it may be remarked that it is by no means an easy matter for a trader who relies solely on the general appearance or get-up of a label to protect such a label, because it is not easy to satisfy the court that it is the general appearance of a label which attracts would-be purchasers, or which purchasers go by as denoting the goods they wish to obtain; and, in addition, there is a growing disposition on the part of judges to give the go-by to what is the real point—*i.e.*, whether the label complained of is, *as a whole*, calculated to deceive, and in lieu thereof to take this line—to dissect the two labels, the plaintiff's and defendant's, to pick out the points of resemblance and the points of difference between the two, and then to give the greatest weight to the points of difference, or, indeed, even to ignore the points of resemblance, if those points are matters common to the trade. This process utterly ignores the fact that in a case where the plaintiff relies on general get-up he is not relying on any element or elements of that

get-up, but on the combination of the whole, and upon the effect which that combination has in the ordinary course of trade. The question really is, not how many of the elements the defendant has taken, or how many he has not taken, or what additions, if any, he has made, but does his label as a whole look so like the plaintiff's as a whole that unwary customers would take his label for the plaintiff's? The case of *Lever* v. *Goodwin*,* decided in 1887, is a very good illustration of what is meant. There the plaintiffs put their soap into wrappers of imitation parchment paper (which was then not a common thing), and printed (which was unusual) some letterpress on it in spaced or broken type; *i.e.*, so that the letterpress read in two ways, either straight ahead or, as it were, in jumps—*i.e.*, reading only the lines which were printed in large capitals and omitting the intermediate parts in smaller type, and this get-up was identified with Lever's soap. The defendants put up their soap in wrappers of imitation parchment paper, and they also printed on the wrappers letterpress in spaced or broken type. Their letterpress was quite different from the plaintiffs', and the defendants' name, 'Goodwin's,' appeared in capitals four times among the letterpress. Mr. Justice Chitty, who tried the case, decided in favour of the plaintiffs. He said: 'I hold, as a matter of fact, that when these things are looked at

* 4 R.P.C. 492.

in the way in which they would be by an ordinary purchaser, not side by side, but where a man or a woman has bought the plaintiffs' and then goes to the shop and gets this other thing, the defendants', handed, the things are so alike as to be calculated to deceive. I do not think it is necessary to read through the whole of the wrappers, because I am satisfied the purchasers do not do that as a rule. There is a large class of purchasers who do not; but the thing is just in regard to form, in regard to shape, and in regard, in fact, to all that should be intended to distinguish the one from the other, in such a form as, I think, is calculated to deceive. A point, and a strong point, which was made for the defendants was that their name appeared, and so it does. I am afraid that it is that which led the defendants, when they were preparing their wrapper, to think that they could escape. "If I put my name on it, I can then always say that my name would not be mistaken for the plaintiffs'," but, unfortunately for them, and for their point of view, but fortunately, I think, in the interests of justice, that is not a sufficient answer. It is a matter to which I have, of course, given great weight, but I think it is not sufficient.'

The case went to the Court of Appeal, who upheld the decision of Mr. Justice Chitty. It was strongly contended in the Court of Appeal on behalf of the defendants that the plaintiffs had no monopoly in the

elements of their wrapper, and that the defendants ought not to be restrained from using things in which the plaintiffs had no monopoly. This Lord Justice Cotton characterized as an obvious fallacy. He said: 'There may be no monopoly at all in the individual things separated, but if the whole are so joined together as to attempt to pass off, and to have the effect of passing off, the defendants' soap as the plaintiffs', then, although the plaintiffs have no monopoly either in "Self-washing" or "Self-washer," or in the parchment paper, or in the spaced printing, yet if those things, in which they have no sole right, are so combined by the defendants as to pass off the defendants' goods as the plaintiffs', then the defendants have brought themselves within the old common law doctrine, in respect of which equity will give to the aggrieved party an injunction in order to restrain the defendant from passing off his goods as those of the plaintiff.'

PART VIII

Comparison of Labels

A RECENT important label case is that of *Payton* v. *Snelling*, which was before the House of Lords in 1900.* There the plaintiffs relied on the general get-up of their coffee tins, and the facts were substan-

* 17 R.P.C. 628.

tially these: The plaintiffs began by selling their coffee in circular tins, surrounded by paper labels. The predominant colour of the label for one quality was red, for another quality blue, and for another quality green. There were three sizes of the tins of each colour. The plaintiffs subsequeutly adopted enamelled tins in red and blue, displaying a reproduction of the labels for the two larger sizes of the two higher qualities. The smaller tins of these qualities, and all of the lowest quality, were still used with paper labels. The brand 'Royal' appeared on the back and front of all the plaintiffs' tins. The defendants sold coffee in circular red, blue, and green tins, all of which were enamelled, resembling in general appearance, but differing in details, from the plaintiffs' tins. The brand 'Flag' appeared upon the back and front of all the defendants' tins, and their trade mark a flag, in tricolour, was on the front of each tin. The names and addresses of the plaintiffs and defendants were not placed upon their respective tins. The action was tried before Mr. Justice Byrne, who held in effect that the defendants' tins were calculated to deceive, and gave judgment for the plaintiffs. The defendants then went to the Court of Appeal, who differed from Byrne J., and decided against the plaintiffs. The plaintiffs then went to the House of Lords, who affirmed the decision of the Court of Appeal. Lord

Lindley, in his judgment in the Court of Appeal,* said: 'What is it that the plaintiffs must make out in order to entitle them to succeed in this action? They must make out that the defendants' goods are calculated to be mistaken for the plaintiffs'; and where, as in this case, the goods of the plaintiff and the goods of the defendant unquestionably resemble each other, but where the features in which they resemble each other are common to the trade, what has the plaintiff to make out? He must make out, not that the defendant's are like his by reason of those features which are common to them and other people, but he must make out that the defendant's are like his by reason of something peculiar to him, and by reason of the defendant having adopted some mark, or device, or label, or something of that kind, which distinguishes the plaintiff's from other goods which have, like his, the features common to the trade. Unless the plaintiff can bring his case up to that, he fails. It appears to me that when once you get that clearly in your mind, when you eliminate those features which are common to the trade and ask yourselves, not whether the plaintiffs' and the defendants' things are alike, but whether the defendants have copied that which distinguishes the plaintiffs', the conclusion must be different from that at which the learned Judge arrived.'

* 17 R.P.C. 52.

In the House of Lords this expression of Lord Lindley's opinion was not dissented from. It was not expressly referred to, but Lord Macnaghten and Lord Davey both said that they entirely agreed with the judgments of the Court of Appeal. Therefore it appears to lay down the present rule of the court on the subject, and that rule is quite different to what it was when *Lever* v. *Goodwin* was decided. The rule now seems to be that you must eliminate everything that is common to the trade before you begin to consider whether a defendant's label so closely resembles a plaintiff's label as to be calculated to deceive. In the case of *Lever* v. *Goodwin*, if you had eliminated everything common to the trade in the plaintiff's label, you would have had only the word 'Sunlight' left, and if you had eliminated everything common to the trade from the defendant's label, you would have had only the word 'Goodwin's' left. No one could have traced any resemblance to 'Sunlight' in 'Goodwin's,' so that if the elimination process had been applied in that case the plaintiff must have failed. It cannot be that the last word has been said on this subject. The Courts in comparing labels of the kind now under consideration for the purposes of passing-off actions, may return to the old, and, as is submitted, the correct way of looking at them, and look at them as a whole—*i.e.*, look at them as they are actually used, and as they actually

strike the eye of the purchaser or intending purchaser. It is quite possible to have a label on which every single element may be common to the trade, and yet the combination of those elements may be so novel and so striking that the whole may be so distinct from any other label in use in the particular trade as to be admirably suited to distinguish the owner's goods in the market. Such a label ought to be entitled to protection, but so long as the elimination rule prevails it is not.

It may be remarked that when comparing a plaintiff's label and a defendant's label in a passing-off action, where the plaintiff relies on his label as a whole, the question which the Court has to decide is really the same whether the label is registered as a trade mark or not, the question being, of course, Is the defendant's label as a whole so like the plaintiff's label as a whole that the defendant's goods on which it is used will be taken to be the plaintiff's? Therefore the recent and very instructive case of *Hennessy* v. *Dompe** may be mentioned, where the plaintiffs sought an injunction to restrain the use by the defendants of a label on brandy bottles, which they contended was an illegal imitation of their well-known brandy label, which is registered as a trade mark. Hennessy's label was oblong—a common shape in the trade. In the centre was 'James Hennessy

* 19 R.P.C. 333.

and Co.'s Cognac'—cognac being below the firm's name. The word 'cognac' is, of course, common to the trade, and the position of the firm's name is common to the trade. All round the label were garlands of vine leaves; but garlands of vine leaves are common to the trade. At the top of the label, over the name 'Hennessy and Co.,' was a bar with curved and scrolled ends, from which rose a mailed arm holding a battle-axe. This was the only part of the label, except the firm's name, peculiar to the plaintiffs; but it was not established that the public paid attention to this device in purchasing the plaintiffs' goods, although one of the plaintiffs' witnesses said that it was well known as denoting their brandy. The plaintiffs' label in use was printed in white and gold, a method of printing common to the trade. The defendants' label, of which the plaintiffs complained, was of the same shape as the plaintiffs', and was similarly printed in white and gold. In the centre was 'Jules Chateau et Cie. Cognac' printed, with cognac placed below the firm's name. Round the label were garlands of vine leaves. On the top of the label over the firm's name was a bar with curved and scrolled ends, very closely resembling in shape and appearance the plaintiffs' bar (which, by the way, the plaintiffs did not claim to be peculiar to them), but nothing rose from the defendants' bar. In fact, the general resemblance in appearance of the

two labels was very striking. The case came before Mr. Justice Kekewich, who decided against the plaintiffs, holding that the defendants' label was not calculated to deceive. He adopted in his judgment the elimination process. He disregarded all the elements that were common to the trade, and went solely on the presence of the arm and battle-axe in the plaintiffs' and its absence in the defendants', and the substitution of Jules Chateau et Cie. for James Hennessy and Co. Of course, the plaintiffs appealed, and it would have been an excellent thing in the interests of honest trade if the Court of Appeal had had to give their views on the case, but they had not; for before the appeal was reached in the list the parties appeared before the Court of Appeal, and the defendants admitted that their label was an infringement (although, as they said, an innocent infringement) of the plaintiffs' registered label. Whereupon, by consent, the judgment of Mr. Justice Kekewich was reversed, and an injunction was granted to restrain the further use of the defendants' label.* Of course, the defendants would not have taken this course had they thought that the Court of Appeal would have supported the judgment of Mr. Justice Kekewich.

* 20 R.P.C. 175.

PART IX

Trade Names

THE next branch of the subject to be dealt with is passing off by unlawfully using the trade name which denotes or distinguishes the goods of a trader in the market. 'Trade name' may for present purposes be defined as a word or a combination of words (*i.e.*, a phrase) which is used by the trade or the public, or, as is more generally the case, by both the trade and the public, when asking for, or ordering, or otherwise in relation to the goods (or some of the goods) of a particular trader. It should be borne in mind that a trade name may be given to the goods of a trader either by the trader himself or by those who are in the habit of purchasing his goods, who may be called the purchasing public; in either case, if it be his trade name, he can protect it. A trade name may be given to goods by the purchasing public in one of two ways, of which the most common is by abbreviating the trade name given to his goods by the trader himself. Thus Bass's Ale is often abbreviated by the purchasing public into 'Bass,' so that Bass's Ale and 'Bass' are both trade names for ale brewed by Bass, Ratcliff, and Gretton, Limited. The other way in which the purchasing

public may give a trade name to a trader's goods is by applying to them a nickname, or a name derived from some trade mark or portion of a trade mark, or something in the get-up of the trader's goods. Thus in a case tried seventeen or eighteen years ago* it was proved that, although the Anglo-Swiss Milk Company called their goods 'Milkmaid' and 'Milkmaid Brand,' many people called them 'Dairymaid' and 'Dairymaid Brand,' so the words 'Dairymaid' and 'Dairymaid Brand' were treated by the Court as being trade names denoting the company's goods. In another case a manufacturer of cherry brandy used on one kind of his cherry brandy a label which represented a hunting scene, with two huntsmen in 'pink' as the prominent feature, and underneath 'Sportsman's Special Quality.' This became known as 'Sportsman Cherry Brandy,' but many people called it 'Huntsman Cherry Brandy,' and this was recognised in certain legal proceedings† as the trade name of the manufacturer's goods. In all cases of this kind the question is whether a particular word or phrase is in fact the trade name of the plaintiff's goods, not who gave those goods that particular name.

Here it may be observed that it is quite possible for a trader to have two trade names for the same

* *Anglo-Swiss Milk Co.* v. *Metcalf*, 3 R.P.C. 28.

† *Re Barker's Trade Mark*, 53 Law Times N.S. 24.

goods, and if he seeks to protect one of such names, it is no defence to say that his goods are as much known by the one as by the other.* A trader's goods may have two or more trade names in the same district, or they may have two or more trade names in different districts, and each and every one of these trade names will be alike entitled to protection.

Again, a trade name, if it fulfil the conditions of the Statute, is capable of registration as a trade mark. If it is registered as a trade mark, it is protected by an action for infringement of trade mark; if it is not registered, it can only be protected by means of a passing-off action. In the remarks on trade names, which follow, only those are dealt with which either cannot be or, in fact, are not registered as trade marks.

Trade names may obviously be of different kinds. One form of trade name is that in which the name of the owner, or of his predecessor in business, or a portion of such name, forms part of the trade name. One instance of this has already been mentioned—Bass's Ale; others are Pears' Soap and Beecham's Pills. Another kind of trade name is that into which the place of origin of the goods, in respect of which it is used, enters. Instances of trade names of this kind which have been upheld and protected are 'Glenfield Starch' and 'Stone Ale.' 'Glenfield

* See *Orr Ewing* v. *Johnston*, L.R. 13 C.D. at p. 446.

Starch' was the trade name of starch originally made at Glenfield, but subsequently at another place. 'Stone Ale' was the trade name of ale brewed by a firm who had carried on business at Stone over 100 years. 'Yorkshire Relish,' too, may be quoted as another instance. It was used as the trade name of a sauce or relish (which are convertible terms) made in Yorkshire. It is impossible in a limited space to deal exhaustively with trade names from a geographical point of view. All that can here be said is that there is no difference in principle between trade names which are geographical and other trade names; but they are difficult to maintain, because it is generally difficult to establish that they exist—*i.e.*, that they are trade names.

PART X

Fanciful and Descriptive Trade Names

THE two kinds of trade names which have been the most frequent subjects of cases in the law are fanciful trade names, and what are generally called descriptive trade names. Fanciful trade names are those which in no sense can be said to describe the goods to which they are applied: such are 'Eureka,' as applied to shirts; 'Excelsior,' as applied to soap. Descriptive trade names are those which more or

less completely describe the goods in respect of which they are used. It is with regard to this kind of trade names that the chief difficulties arise. The judges are setting their faces strongly against traders establishing trade names which are descriptive. They do not say that it is impossible, but what they say is that a man who wishes to establish as a trade name that which is in fact a description of his goods has a very difficult burden to discharge; in fact, some judges have gone so far as to say it is a burden which he ought not to be able to discharge—*i.e.*, that a trader ought not to be permitted to claim a descriptive term as his trade name. This arises from a natural reluctance to allow one man in effect to monopolize common descriptive words in the English language which would be as appropriate to describe the goods of others as to describe his goods. This may be right in theory, but, still, when a trader can establish that a descriptive term is in fact his trade name the Court ought not to shrink, and indeed will not shrink, from protecting it, although the effect may be to give him virtually a monopoly of the term. Thus in an old case the word 'Anatolia' was upheld as applied to liquorice, although Anatolia was a district whence the liquorice root largely came.* 'Yorkshire Relish' has been upheld as the trade name of a sauce or relish which was made

* *McAndrew* v. *Bassett*, 4 De Gex, Jones and Smith, 380.

in Yorkshire.* 'Camel Hair Belting' was about the same time upheld as the trade name for belting made from a substance known in the trade as camel-hair, and which in fact mainly consists of camel's hair.† More recently 'Silverpan Jams' was upheld as a trade name for jams boiled in silvered pans.‡ On the other hand, 'Flaked Oatmeal' was held not to be a trade name for the plaintiff's oats, which were partially reduced to powder and virtually in a flaky condition.§ 'Erect Form' was held not to be a trade name for ladies' corsets put upon the market by the plaintiff, which were intended to produce an erect or upright form in the wearer,‖ and in another late case, 'Naptha Soap' was held not to be a trade name for the plaintiffs' soap, in which naphtha in one of its forms was an important ingredient.¶ But why were the one lot of cases decided one way, and the other lot the other way? The reason is this—in every trade name case the plaintiff must satisfy the Court, upon the evidence adduced, that that which he claims as his trade name does in fact distinguish his goods in the market from like goods of other traders. In the first

* *Powell* v. *Birmingham Vinegar Brewery Co.* (*ubi supra*).
† *Reddaway* v. *Banham*, 13 R.P.C. 218.
‡ *Faulder* v. *Rushton*, 20 R.P.C. 477.
§ *Parsons* v. *Gillespie*, 15 R.P.C. 37.
‖ *Weingarten* v. *Bayer*, 20 R.P.C. 649.
¶ *Fels* v. *Hedley and Co.*, 20 R.P.C. 437.

lot of cases the plaintiff succeeded in establishing this; in the second lot of cases he was held to have failed to do so. It really depended upon the evidence in each particular case. This is quite right in theory, but, unfortunately, in practice it works rather hardly on the owners of trade names. A plaintiff in a trade-name case can never tell beforehand how much evidence will satisfy the particular tribunal before whom his case comes, therefore he ought to be prepared with a considerable body of witnesses to call, who can testify as to the identification of his trade name with his goods in the market; but when he comes into Court he often finds that the judge turns restive at the large number of witnesses, and after some six or eight have been called, says to the plaintiff's counsel, 'Cannot you shorten this?' If the plaintiff's counsel persists (as in reality he ought to persist) in calling the rest of his witnesses, the judge, being human, often resents his suggestion not being complied with, and it is never politic to ruffle the judicial ermine; but if the plaintiff's counsel calls only a few witnesses to prove the crucial part of his case, he runs the very great risk of being told, when he gets before the Court of Appeal, 'Oh, the plaintiff's evidence is much too weak to establish the identification of this term with his goods,' and the result is a decision against the plaintiff. Nevertheless, it is perfectly certain that

in a trade-name case the plaintiff must prove by evidence that that on which he relies as his trade name does in fact denote or distinguish his goods in the market. In the Yorkshire Relish case the Court treated it as proved that when people asked for Yorkshire Relish, they meant a particular sauce made by a particular maker (*i.e.*, the plaintiff); in a Naptha Soap case the Court of Appeal held that, upon the evidence, persons asking for Naptha Soap merely wanted a soap with naphtha in it—*i.e.*, not necessarily the plaintiff's soap.*

PART XI

Evidence to prove a Trade Name in Court

Two questions that then naturally occur are: (1) What is the nature of the evidence by which a trader can prove that that which he claims as his trade name does in fact denote or distinguish his goods in the market? and (2) what is the quantity or amount of such evidence that he must adduce to prove his proposition? The answer to the first of these questions is comparatively easy; the answer to the second is very difficult. As to the nature of the evidence, the plaintiff has to prove that a con-

* *Fels* v. *Thomas*, 21 R.P.C. 87.

siderable proportion of the trade, or a considerable proportion of the public, or better still, both—but obviously not all the trade or all the public—in asking for or ordering goods verbally, or in writing, or in both ways under his trade name, expect and intend to be supplied with his goods sold under that trade name and nothing else; or, as it is sometimes put more compendiously, that to them the trade name means the plaintiff's goods and nothing else. The evidence of this can and ought to be given by traders—wholesale or retail—generally retail, because retailers can speak, not only as to retail traders generally, but also as to the public, which wholesale traders cannot. Retail traders, speaking as to their own purchases, either from the plaintiff direct or from wholesale houses, can testify that when they order goods under the trade name they expect and intend to get the plaintiff's goods and nothing else, and that if they got anything else, they would not be getting what they wanted. They may also be able to say that as far as their experience goes this is true of the retail trade generally. They may be able to go further, and state that they use the trade name themselves in the ordinary course of their business as denoting the plaintiff's goods, and to distinguish them from other similar goods; for example, in their price-lists, if they issue any, or in show-cards, or window-tickets which they use when

displaying goods on the counter or in their windows. But they ought to go still further and say, if they can say it, that their customers, when they order goods under the name which the plaintiff claims as his trade name, expect and intend to get the plaintiff's goods and no others. What proof of this assertion can the retail traders give? Sometimes they can quote a customer's own words, but this is exceptional. What they can always say is, that when a customer asks for goods under the trade name in question they always supply the plaintiff's goods, and they have never known a customer to say, 'That is not the thing I wanted.' A retailer may, perhaps, say in the witness-box (but this for obvious reasons will be exceptional), 'Once when I had an order for goods under the plaintiff's trade name I by inadvertence supplied goods of another brand; these were immediately sent back by the customer as not being what he had ordered.'

But the kind of evidence on which apparently the greatest weight ought to be placed is the evidence of members of the purchasing public. A witness is called who says, 'I have been in the habit of purchasing and using this article for a long time. I am quite familiar with it, and I know it as so-and-so (giving the trade name), and when I order goods under this name I always expect and intend to get the same article as that which I have been so long

familiar with, and if I got another article I should not be getting what I wanted.' This is extremely strong evidence of the proposition that the trade name does denote the plaintiff's goods to the public, and it is increasingly the practice to adduce evidence of this sort in trade-name cases. Of course, to call one such witness would be insufficient, as no court would place much, if any, reliance upon the evidence of one such witness. But, then, how many such witnesses ought the plaintiff to call? It may be stated that he ought to be prepared with from twenty to thirty of such witnesses; whether he will have to put them all into the witness-box is another matter. Probably not, for it may be anticipated that generally (though not invariably) the same thing will happen that happened in a recent case,* where, after the plaintiff had called nine of such witnesses, the counsel for the defendant admitted that if the rest of the plaintiff's witnesses were called they would give substantially the same evidence that was given by those who were called, and the case was tried out on this basis—*i.e.*, on the basis that some twenty or more witnesses had given this evidence, and not simply the nine who had appeared in the witness-box. In selecting his twenty or thirty witnesses, the plaintiff must not take them all from one locality, but from different parts of the country,

* *Fels* v. *Hedley and Co.*, 20 R.P.C. 437.

and in particular he ought to have some from the locality where the defendant's trade is carried on. The reason for this will be seen from a subsequent reference to the case of *Faulder* v. *Rushton*.

PART XII

A Trade Name must be known to a Substantial Section of the Public

It is often said that a plaintiff to establish a trade name must prove that it is 'generally' known as denoting or distinguishing the plaintiff's goods from other similar goods. Sometimes it is contended that it must be universally so known. Universality of recognition, it has been contended, is necessary to the establishment of a trade name. 'Universally' is intelligible; 'generally' is an ambiguous term. If 'generally' means to a substantial section of the public purchasing the goods, then it is certain that the trade name must be 'generally' known; but if 'generally' is to be taken as synonymous with 'universally,' then it is now established that it is not necessary for a plaintiff to prove that his trade name is either generally or universally known—*i.e.*, that all purchasers, or intending purchasers, in every district in England know the trade name, and know it as denoting or distinguishing the plaintiff's goods

from other similar goods. On this subject Lord Justice Romer, in *Faulder* v. *Rushton*,* said: 'I will take the first question which had to be decided, and that may be stated as follows: At the time when the defendants first commenced to use the term "Silverpan," had that term acquired in the markets of Lancashire, and in other markets, the meaning of the plaintiffs' jams—that is to say, of jams manufactured and sold by the plaintiffs? As I have said, I think that on the evidence it had. Of course, I do not mean that in every town in which there was a market for jams you could find a majority of the inhabitants who knew about this jam; still less do I suppose that a majority of inhabitants of the districts in which this jam was chiefly sold, as a whole, knew the jam intimately, or possibly at all; but I think that in the markets I have referred to a substantial number of persons who were interested in the question, and whom, from their position, one would expect to have known about the jam, did so know the plaintiffs' jam; and I certainly think upon the evidence that all who knew the phrase at all, as applied to jam, before the acts of the defendants which are complained of, identified the term as meaning the plaintiffs' goods.'

Universality of recognition, therefore, is not required. What is required is that a substantial section

* 20 R.P.C. 477.

of the purchasing public should be proved to identify the trade name with the plaintiff's goods, and that this should be true of the district in which the defendant's trade is done. That this is so is shown by the Silverpan case.* In that case, which was before the Court of Appeal in 1903, the plaintiffs carried on business at Stockport, and the defendants' trade was in Wigan and the surrounding district. The plaintiffs' trade in Wigan was small, but they had a few customers there. The defendants also had a shop at Chorley, in which town the plaintiffs' goods were known. It was contended by the defendants that, as the plaintiffs had no real trade or reputation in Wigan, therefore they could not complain of what the defendants were doing there. The Court gave judgment in favour of the plaintiffs. The passages from the judgments of the Lords Justices bearing on the point immediately under consideration were these. Lord Justice Vaughan Williams said: 'I quite agree with Mr. Moulton that it is necessary that the plaintiffs should identify the word "Silverpan" with their firm Faulders. . . . And I agree with him further, that it is not only necessary that there should be proof of the identification of this word "Silverpan" with the plaintiffs' firm, but it is necessary to show that that identification is recognised within the district in which the defendants,

* *Faulder* v. *Rushton*, 20 R.P.C. 477.

whose use of the word is complained of, carry on business. But this does not mean that there must be proof that the word "Silverpan" is recognised by everyone in the district.' Lord Justice Romer expressed himself on this point as follows: 'It is true, as is said on behalf of the defendants, that in Wigan itself the number of customers established by evidence before the Court who have used and been acquainted with the plaintiffs' jams is not large; that the amount of the plaintiffs' trade there, as proved, is small. But looking at the circumstances of the case, and how the plaintiffs' goods have been advertised in Wigan and the neighbourhood, I cannot come to the conclusion that the customers, who know the plaintiffs' goods under the term "Silverpan," are so few that they ought to be disregarded in considering the question I am now dealing with. But I may point out that the defendants' shops are not even confined to Wigan. For example, they have a shop at Chorley, where, again, the plaintiffs have customers and where the plaintiffs' goods are known; and I need scarcely point out that there is no reason, if the defendants are not stopped, why they should not establish shops elsewhere than in Wigan or in Chorley. If they have a right to establish them in Wigan and in Chorley under existing circumstances, they may as well say they have a right to establish them in other districts. And it is

to be noticed that no one can say that the defendants only execute orders from persons dwelling in Wigan, or even from persons dwelling in Chorley. If orders came from persons not dwellers in Wigan and Chorley, would the defendants refuse to execute them? Of course they would not.'

In this case it is clear that the Court of Appeal came to the conclusion that the plaintiffs' goods were known under their trade name in the district where the defendants traded, although their sales were small. But supposing a plaintiff's goods were well known under his trade name in the district where the plaintiff traded, but were absolutely unknown in the district where the defendant's trade was done, would the plaintiff under such circumstances succeed in obtaining an injunction to restrain the defendant from using his trade name on his, the defendant's, goods? The answer must be in the negative, because the defendant by using the trade name could not possibly pass off his goods as the plaintiff's goods on customers who had never heard of the plaintiff's goods, and therefore never expected or intended to get the plaintiff's goods. But this is confined to a case in which the plaintiff's goods are absolutely unknown in the defendant's district—the word 'absolutely' being emphasized. Now, suppose another case—*i.e.*, where the plaintiff's goods under his trade name are slightly known in the district where the defendant's trade is done.

Would the plaintiff succeed in such a case? Not if 'slightly' means so slightly that it ought to be disregarded. But if 'slightly' means not to a very large extent, then if that extent is such that commercially it could not, and in fact would not, be disregarded, then the plaintiff would succeed. All such cases are matters of degree. This may be safely said: that where the plaintiff's goods have been identified by the plaintiff's trade name for a long period in the other districts, and *a fortiori* in districts adjacent to the district in which the defendant's trade is done, it will not be necessary to prove an extensive knowledge of the plaintiff's trade name in this latter district, provided some substantial recognition is established.

PART XIII

Trade Name—how Established

HERE it should be pointed out that the establishment of a trade name—*i.e.*, the getting it recognised by the trade or the public as denoting the plaintiff's goods—is a matter of time. It is obvious that if A puts goods on the market to-day under a new name, which he intends to use as his trade name, he cannot prove to-morrow that the trade or the public identify

that name with his goods. Consequently, if B to-morrow puts similar goods on the market under the same name, A cannot complain, because he cannot establish that it is his trade name. That which is true of to-morrow would certainly be true of to-morrow week, and probably of to-morrow month. But, then, how long does it take to establish a trade name on the market? There is no fixed time limit, and there can be none. It entirely depends on circumstances. If the goods in respect of which the trade name is used 'catch on'—to use a very expressive colloquial term—then the sales soon begin to be large, and the goods are soon widely known under the trade name. If the sales grow slowly, the recognition of the trade name grows with equal slowness. This much is perfectly certain, that it is far easier to establish in Court a trade name when the goods in respect of which it is used have been a long time on the market than it is when they have been a short time on the market. In the leading cases in which trade names have been held to have been established the plaintiff's goods had been on the market under the trade name for many years. In the Yorkshire Relish case the period was over twenty-five years; in the Silverpan case about fourteen years. On the other hand, in the Anatolia Liquorice case the period was only about six weeks.

Before passing away from the subject of the evidence by which a trade name can be established it should be remarked that the strongest evidence that can be adduced is that which is sometimes furnished by the defendant himself, by which is meant something that the defendant has done or said, or letters written by or to the defendant before the action was commenced. If the Court is satisfied that the defendant has, in fact, recognised the plaintiff's trade name as denoting the plaintiff's goods on the market, that will turn the scale against him when there is any doubt in the matter. This was what happened in *Reddaway* v. *Banham*, the Camel-Hair Belting case. There what turned the scale in the plaintiff's favour was a letter written to the defendant by one of his customers in which the customer desired that the belting he was ordering should bear no other stamp than 'Camel-Hair Belting,' and added if that were done he could take the order away from Reddaways. This letter the defendant apparently acted upon. This the House of Lords found was very strong evidence that he knew that 'Camel-Hair Belting' meant in the market Reddaway's goods. This is no novel doctrine. In the old case about the Anatolia liquorice a letter sent to the defendant ordering some liquorice from them to be stamped 'Anatolia,' which letter contained a sample of the plaintiff's goods stamped 'Anatolia,' was said by

the Lord Chancellor abundantly to prove that the plaintiff's goods so stamped were known and accepted in the market.*

PART XIV

Illegal Representation as to a Business

PASSING to another and still more difficult branch of this subject, if, as has been previously stated, a trader does, in fact, represent his goods as the goods of another trader—it is immaterial how he makes the representation—he will be restrained by injunction from repeating it. One way in which the representation can be made is by representing that his business is the plaintiff's business, or a branch of the plaintiff's business, or connected with the plaintiff's business. Any such representation, if made, will be restrained. A trade name may consist of a personal name *plus* the name of the goods. Such a trade name, if established—*i.e.*, if it be proved to denote and distinguish the owner's goods in the market—is a perfectly good trade name, and entitled to the same protection as any other kind of trade name. Instances are 'Bass's Ale,' 'Pears' Soap,' 'Beecham's Pills,' and 'Cash's Frillings.' It has often been contended that such trade names are on

* *McAndrew* v. *Bassett*, 4 De Gex, Jones and Smith, 380.

a different footing to others, but it is perfectly well settled now that they are not.

Supposing the plaintiff in a passing-off case is not relying on trade mark or trade name, but only on this, that his name or his firm name is very well known, and that the defendant is using the same name, or the same firm name, or a name so closely identical, that the public would not know the difference, and that by reason of the similarity of the defendant's trading style to the plaintiff's trading style the public will suppose that the defendant's business is the plaintiff's business, and will buy the defendant's goods in the belief that they are the plaintiff's—will the Court at the instance of the plaintiff stop the defendant?

Suppose a firm of Battleaxe and Co. to be a firm which for very many years have had a very large sale for boots, and they are very well known as sellers of very good boots, and there are no other sellers of boots named Battleaxe. A man opens a shop, say, in Regent Street, for the sale of boots, and trades there as F. Battleaxe. Obviously confusion and probably deception will arise. Can Battleaxe and Co. stop him? This is a somewhat intricate question, and several considerations arise. First, is the defendant's real name Battleaxe? If it is not his real name, he will be stopped from continuing to use it on the ground of fraud.* But suppose Battle-

* But see p. 58.

axe is the defendant's real name, will he be stopped from trading under his own name? If all that can be proved is that he is honestly using his own name in the course of his trade, he cannot be stopped from doing that, although it would be probable, it may be said certain, that some confusion would arise, and that some customers might go to his shop supposing it to be a shop of Battleaxe and Co. A man will not be restrained from simply using his own name in the course of his trade or on his own goods; and if he has been carrying on his trade in this way and takes a partner, his firm may use the ordinary designation of a firm. In reference to this the language of Lord Justice Stirling (then Mr. Justice Stirling) may be quoted in the case where Tussaud and Sons, Limited, the proprietors of the well-known exhibition of wax-works, sought to restrain Louis Tussaud from bringing out a company called Louis Tussaud, Limited, to run a waxwork exhibition. The learned judge, after referring to the well-known cases of *Burgess* v. *Burgess* and *Turton* v. *Turton*, said: 'It follows from the decisions in those two cases that the defendant is at perfect liberty to open on his own account and to carry on in his own name an exhibition of waxworks. Further, he might take partners into his business, and carry it on under the name of "Louis Tussaud and Co." That seems to me to have been expressly decided in *Turton* v. *Turton*.

Having commenced business on his own account, I apprehend that he might sell it, with the benefit of the goodwill, to third parties, and that the third parties might, if they thought fit, continue to carry on the business under the same name, that of the defendant—that is to say, they would be entitled to the full benefit of the goodwill which they had honestly and legitimately purchased from the defendant. Again, the third parties might transfer the business and the goodwill to a joint-stock company; and without expressing a final opinion on the point, I am not prepared at the present moment to say that that company might not be registered under the same name as had previously been used in connection with the business.'*

The learned Judge's proposition is quite right as far as it goes, but it really does not go very far, because, although a man can use his own name in the course of his own trade, yet if he uses it in such a way—*i.e.*, with such accompaniments—as to amount to a representation that his business is the plaintiff's business, or his goods are the plaintiff's goods, he will be restrained from making that representation. In all cases of this kind the question is whether he is making that representation or not—whether in carrying on trade under his own name, which he is entitled to do, he is carrying it on in such a way as

* *Tussaud* v. *Tussaud*, L.R. 44 C.D. 687.

to represent his business or goods to be the plaintiff's business or goods, which he is not entitled to do. Whenever the Court comes to the conclusion that the defendant's conduct is dishonest, that he is not simply exercising his right to trade under his own name, but he is seeking to pass off his business or his goods as the plaintiff's, the Court will always restrain him. Thus, in the Tussaud case, the Court, having come to the conclusion that the object of the defendant in promoting the proposed company was to induce the world to believe that the business intended to be carried on was the business of the plaintiff company, or a branch of it, granted an injunction against the defendant. In the old case of *Croft* v. *Day*,* relating to Day and Martin's blacking, Lord Justice Cotton said of the defendant in that case: 'He had got somebody of the name of Martin, who was no connection in business with him, to agree to come in and be his partner, so as to get the benefit of the name of Day and Martin. Getting a man who is not interested in the business to come in and join him for the purpose of saying he has the name of Day and Martin would be very strong evidence indeed to show that he was trying to represent his goods as those of the old firm.'

Whenever a defendant who is trading in his own name has imitated the 'get-up' of the plaintiff's

* 7 Beavan, 84.

goods, or has imitated his labels or show cards, or has issued circulars, or price-lists, or advertisements tending to induce intending purchasers to believe that his business and goods, or either of them, are or is the business or goods of the plaintiff, he will be restrained by injunction, because on the whole circumstances he will be held to have made the illegal misrepresentation which has been so frequently referred to.

Before quitting this subject, two cases relating to trade names, both decided by Lord Justice Romer (then Mr. Justice Romer), must be referred to, inasmuch as they go further than any other similar reported case. One is the case, in 1898, of the *Eastman Photographic Materials Company* v. *John Griffiths Cycle Corporation.** The Eastman Company had invented and applied the term 'Kodak' to certain of their cameras. These were largely advertised and largely sold, and the name 'Kodak' became identified with these cameras, and also with the Eastman Company and its goods in general. It became, as it were, the trade mark of the company. The company did not deal in bicycles, but it dealt in cameras specially adapted for cyclists, and these it called 'Cycle Kodaks' or 'Bicycle Kodaks.' The defendant company registered the word 'Kodak' for cycles without the knowledge of the Eastman

* 15 R.P.C. 105.

Company, and then proceeded to incorporate another company, called the Kodak Cycle Company, for the purpose of selling Kodak cycles. When this came to the knowledge of the Eastman Company they took proceedings to get the trade mark Kodak expunged from the register, and to obtain an injunction to stop the defendant companies from doing what they were doing in the way of trade—*i.e.*, selling cycles as Kodak cycles. The plaintiff company succeeded on both heads. They got the trade mark removed from the register, and they got an injunction, which was worded thus: 'To restrain the defendant companies, or either of them, from carrying on business under the name of "Kodak Cycle Company, Limited," or under any name comprising the word "Kodak" likely to mislead or deceive the public into the belief that the defendant company is the same company as, or is connected with, either of the plaintiff companies, or that the business of the said companies, or either of them, is the same as, or is in any way connected with, the business of the plaintiffs, the Eastman Photographic Materials Company, Limited.' An injunction was also granted to restrain the defendant companies, and each of them, from selling, or offering to sell, any of their cycles or goods as 'Kodak.'

The other of the two cases was decided about ten months later. It was the case of the *Dunlop*

Pneumatic Company v. *Dunlop Lubricant Company*.* There the plaintiffs, the Dunlop Pneumatic Company, sold tyres and other accessories for cycles, and their goods were known as 'Dunlop.' The defendant was carrying on business under the name of the Dunlop Lubricant Company, and sold oils and lubricants for cycles under the name of Dunlop. The plaintiff company did not deal in oils or lubricants. The plaintiffs obtained an injunction to restrain the defendant 'from carrying on business under the style of the Dunlop Lubricant Company, or under any other style or title comprising the word "Dunlop," so as to induce the belief that the defendant company is the same company as the plaintiff company, or is in connection with them, or that the business of the defendant company is the same or in any way connected with the business of the plaintiff company'; and, with regard to the goods the defendant was selling, the injunction went on to restrain the defendant, his servants and agents, from selling goods in any labels having the word 'Dunlop' upon them, so as to represent or induce the belief that the goods were the goods of the plaintiff company. Lord Justice Romer, in giving judgment in this case, said: 'It appears to me it would be wrong to allow him [*i.e.*, the defendant] to carry on business under that name, and to

* 16 R.P.C. 12.

describe the goods as he does as "Dunlop" goods, for that is the chief word that he uses on the covers of his goods with regard to his burning oil and his graphite, which he sells. The word "Dunlop" is put in a very prominent way, and I am satisfied that he does that with a view of inducing customers to believe that those goods, if they are not the goods of the plaintiffs, are goods used in some way with their sanction, or connected in some way with them, so as to get the benefit of the plaintiffs' name. It appears to me that the plaintiffs are entitled to say that the word "Dunlop" ought not to be allowed to be used under those circumstances, with those objects, by the defendant; that it would injure them in their business very considerably if it is not stopped. They themselves are sellers of cycle accessories, though, as a matter of fact, up to the present time they have not sold burning oil or lubricants. But they may do so, and in the meantime it appears to me that they are entitled to come into Court and say that a name substantially identical with theirs ought not to be allowed to be used by the defendant in the way in which he is using it.'

These two cases show that even when the goods which a defendant is selling are not goods in which the plaintiff deals, yet, if the defendant represents that his business is the plaintiff's business, or is

connected with the plaintiff's business, he will in that case be deemed to represent that his goods are the plaintiff's goods, although the plaintiff does not, in fact, deal in such goods. But in reference to these two cases it should be noticed that in the first case it was proved that there is an intimate connection between the camera trade and the cycle trade, and that it was a common thing for both cameras and cycles to be sold in the same shop. So that there would be nothing improbable in the notion that the Eastman Company had taken to selling cycles. In the second case the Dunlop Company sold, not only tyres, but other accessories for cycles, although they did not sell oils and lubricants, so there would be nothing improbable in the notion that they had taken up the sale of oils and lubricants for cycles. In other words, cyclists might easily suppose that the defendants' business was connected with the plaintiffs' business. Such a confusion would not be unnatural. But what of a case where the supposition could not reasonably arise—where the idea of confusion between the two businesses would be unnatural? If in the Dunlop case the goods in which the defendant dealt had been, say, cheese instead of oils and lubricants for cycles, would the decision have been the same? Would the defendant have been restrained from selling 'Dunlop cheese'? It may be presumed he would not, although the point

is believed to have never yet come up for judicial decision. The reason why it may be presumed he would not is because it is difficult to see how anyone could possibly suppose that a company whose business it was to make and sell tyres and other cycle accessories sold cheese, and if he did not suppose this, how could he suppose that the business of a man who sold cheese was in any way connected with the business of the Dunlop Company? But although it may be presumed that this point would be decided in the way just indicated, yet this is only certain in a case where the defendant was an honest man. If he was a dishonest man it would be quite a different matter. If the Court thought that the defendant had the fraudulent design of representing his business to be the plaintiff's business, or connected with that business, the Court would probably assume against him that his fraud would be attended with some measure of success, in spite of the difference in the goods, and so would decide against him.

PART XV

Name of a Patented Article

THE name which denotes the plaintiff's goods in the market and distinguishes them from similar goods

of rival traders is the plaintiff's trade name, and he has the right to object to its use by others. Is there any exception to this? It is often stated that there is. The exception is generally formulated thus: When a man has a patent, and during the existence of the patent, he makes and sells the patented article under a trade name, of course, during the life of the patent that trade name denotes in the market the article sold by him, and nothing else: but when the patent expires everyone is at liberty to make the article and to call it by the name the patentee has given to it; otherwise he would be able to prolong his monopoly beyond the legal limit—the life of the patent. Lord Herschell once said: 'When a patentee attaches a particular name to the product he patents, that name becomes common property as the name of the patented article. It possesses, indeed, no other name.' But this way of stating the proposition is, perhaps, too wide. First, it has been doubted by as eminent a lawyer as the late Lord Justice Kay whether this proposition extends to the name of the patentee or to a purely fanciful name, not descriptive*; and, secondly, it was decided by the Court of Appeal† some years ago (although this is often forgotten) that the proposition only applies when the patented article is a new article, and not merely a

* See 13 R.P.C., at p. 257.

† *Slazenger* v. *Feltham*, 6 R.P.C 531.

new variety of an old article. If this decision holds good, the language of Lord Herschell needs qualification.

PART XVI

Name of a New Article

AGAIN, it is sometimes contended that when a new article (not protected by a patent) is put on the market under a particular name, everyone is at liberty to make and sell that article, and to call it by that name, as there is nothing else to call it by. That may be, and probably is so, as long as the name does not ripen into the trade name of the original maker's goods, which it will do unless rival traders begin to make and sell the particular article and call it by the particular name soon after the original maker has introduced it. If A introduces an article into the market, no matter whether it is an old article or a new article or a new variety of an old article, under a new name, (unless he is protected by a patent) his rivals in trade can make or sell the same article under the same name, provided they begin to do so promptly. Then all the trade will have an absolute right to use the new name. But suppose the trade do not exercise that right promptly? They will allow the name to ripen into

A's trade name, and then the trade will be in one of two positions—either they cannot use it at all, or, if they use it, they must take care, when doing so, clearly to distinguish their goods from the goods of A. Which position they are in will depend upon whether in fact it is possible to 'clearly distinguish' or not, as will be seen later on. It may be contended, and probably will be contended by some, that this proposition is put too widely, but really it is not, especially in view of the Camel-Hair Belting case in the House of Lords,* to which allusion has been made, and the subsequent cases relating to the same article which have followed it.

PART XVII

Trade Name Destroyed by the Conduct of the Owner

As a trade name is really acquired through the laches of the market, so, too, a trade name may be lost through the laches of the owner. If the owner of a trade name allows his rivals to use his trade name on their goods without objection it will cease to be his trade name. It will become, in legal phraseology, *publici juris* — *i.e.*, common property.

* *Reddaway* v. *Banham*, 13 R.P.C. 218.

What is the test whereby to ascertain whether that which was originally a trade name has become *publici juris*—*i.e.*, common property? It becomes so when it ceases to be distinctive—when it ceases to denote solely the original man's goods in the market. Of course, it ceases to denote his goods solely if it is habitually used on similar goods by other traders. But this state of things—habitual use by other traders — can only arise with the acquiescence—*i.e.*, by the sanction of the original trader. If when he becomes aware that another or others are using his trade name he takes legal proceedings to stop that use, presumably he will succeed; if he does not, then he will be held to have acquiesced in what is being done, and will be precluded from interfering afterwards. If, therefore, a trader becomes aware that his rights to his trade name are being invaded, he must take steps promptly to assert and protect those rights, if he wishes to preserve them, and he must not content himself with a mere protest, or even with a threat of legal proceedings; but if the infringer sets him at defiance, he must follow up his threat with the proceedings he threatened.*

* Under exceptional circumstances, a trader, who knows that his rights to his trade name are being infringed, can lie by for a time without prejudicing those rights. See *Rowland* v. *Mitchell*, 14 R.P.C. 37, and *Reddaway* v. *Stephenson*, 20 R.P.C. 276.

There is another way in which a trader may by his own conduct destroy his own trade name. Let us suppose AB, a manufacturer, sells his pickles under the trade name of, say, 'Pickaxe,' and that 'Pickaxe' pickles means in the market pickles made by AB and no one else. CD, a retail grocer, comes to AB and says, 'I want a quantity of your "Pickaxe" pickles, but I want a label of my own on them, and I want on the label "Pickaxe pickles, made of the finest vegetables and the purest vinegar, by CD of So-and-so."' The manufacturer executes the order, and the pickles are put on the market by CD. The manufacturer will have destroyed his own trade name by himself putting forward the assertion that someone else besides himself manufactures 'Pickaxe' pickles. In short, he cannot afterwards deny 'Pickaxe' pickles means pickles manufactured by AB *or* CD, and does not mean pickles manufactured by AB solely. If the label, instead of 'made by,' ran 'sold by,' or 'selected by,' matters would be different, and the same mischief would not arise.

PART XVIII

Passing off Goods of a Third Party

THE foregoing remarks upon illegal passing off have been mainly, though not exclusively, addressed

to cases in which A passes off goods of his (A's) manufacture as the goods of B; but substantially the same principles are applicable to cases where A passes off the goods of a third party (say X) as the goods of B.* This kind of passing off may be effected in a variety of ways, of which three may be specifically mentioned. One is where a customer goes into a shop and asks for the goods of B, and is handed the goods of X. Another is where a showcard of B's is exhibited conspicuously in connection with the goods of X, in the expectation that purchasers, seeing the showcard, will think that the goods in connection with which it appears are the goods of B. A third is by exhibiting a few of the goods of X in conjunction with a quantity of the goods of B, so that when a purchaser asks for 'one of those'—meaning to get one of B's articles—he may be handed one of X's articles, and may take it without discovering his mistake.†

* See also p. 1.

† A trader is responsible for passing off by his servants, if done in the course of his business; and this though it may not only not have been suggested by him, but even unknown to him (*Tonge* v. *Ward*, 21 Law Times, New Series, 480). The Court, however, will not act upon one isolated case of passing off by a servant who has left a defendant's employment (*Leahy* v. *Glover*, 10 R.P.C. 141). It has been held in England that a trader is liable for passing off by his servants, even though they acted contrary to his orders (*Grierson* v. *Birmingham Hotel Co.*, 18 R.P.C. 158), and the Lord Ordinary in Scotland has simi-

The methods of commercial dishonesty are many and various, and if they amount to fraud they are illegal.

PART XIX

Civil Proceedings to restrain Passing off

COMING now to civil proceedings, which have for their object to restrain the defendant from passing off his goods, or those of a third party, as the goods of the plaintiff, but exclusive of proceedings based upon registered trade marks. Such proceedings are not brought in pursuance of any Act of Parliament, but are based upon the equitable jurisdiction of the Courts to restrain a man from doing that which passes off, or is calculated in the opinion of the Court to pass off, his goods, or the goods of a third party, as the goods of the plaintiff. If the Court is satisfied that the defendant is doing this, it will grant an injunction to restrain him from doing it in the future, and will order him to pay pecuniary compensation to the plaintiff for any injury he may have sustained in the past. In all actions for passing off

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larly held in the course of the case of *Montgomerie* v. *Young* (20 R.P.C. 781). His decision was reversed by the Appellate Court, but it is not clear how far the Appellate Court departed from his views on this point.

the burden of proof is, of course, on the plaintiff to establish his case—*i.e.*, to establish to the satisfaction of the Court that the defendant is, in fact, doing that which either results in passing off or is calculated to result in passing off goods which are not the plaintiff's as the plaintiff's goods. What exactly the plaintiff has to prove depends upon the nature of the case—*i.e.*, the character of the passing off of which the plaintiff complains. No general rule applicable to all cases can be laid down, but, for the purposes of the remarks which follow, a trade-name case may be taken where the plaintiff in effect says, 'I have a trade name, and the defendant is passing off by using my trade name or a colourable imitation of it.' Now, in such a case the plaintiff has to prove two things, and if he fails to prove either of them, his action will be dismissed. The first thing he has to prove is that that which he claims as his trade name is, in fact, his trade name—that it is a word or phrase which does denote his goods on the market, and distinguishes them from similar goods of other traders. So much has been previously said herein on this point that no more need be said now. The second thing he has to prove is that the defendant is using the same word or phrase or a colourable imitation, and using it in such a way as to lead, or to be calculated to lead, to his goods being mistaken for the plaintiff's. It will be observed that

this has two branches—the defendant must be using the same word or phrase or a colourable imitation thereof, and also must be using it in such a way as to lead, or be calculated to lead, to his goods being mistaken for the plaintiff's. This is important. A trader has the right to the exclusive use of his trade mark. He has, in fact, the monopoly of it. But a trader has no such monopoly in his trade name. He cannot claim the right to the exclusive use of his trade name; all he can claim is that no one else shall use that trade name in a deceptive way. If it is possible for one of his rivals to use the word or phrase in a non-deceptive way, he is entitled to do so, although in most cases it would be difficult, and in many cases it would be impossible. Therefore, what may be called the orthodox form of injunction in a trade-name case is, not an injunction to restrain the defendant from using the trade name absolutely, but an injunction to restrain him from using the trade name in connection with his goods without clearly distinguishing such goods from the plaintiff's goods. This was the form of the injunction granted in the Camel-Hair Belting case, in the Yorkshire Relish case, and in the Silverpan Jam case. Sometimes a defendant against whom such an injunction has been awarded alters his mode of trade—*i.e.*, continues to use the term, but in a different manner or with different accompaniments. He is then liable to be

attacked by a motion to commit him to prison for a breach of the injunction. If such a motion is made, the Court has to decide whether or not he has obeyed the injunction—*i.e.*, whether in continuing to use the name he has or has not clearly distinguished his goods from the plaintiff's. It is rare for a defendant to run the risk of such a motion, and still more rare for him to succeed if he does. In many cases, however, the Court has granted the injunction in the unorthodox form—*i.e.*, has granted an injunction restraining the defendant absolutely from using the trade name. In a well-known case the judge at the trial had granted an injunction restraining the defendant absolutely from selling his ale as 'Stone Ale,' which was the trade name of the plaintiff's ale. Against this the defendant appealed, and asked that the injunction should be varied so as not to restrain him from using 'Stone Ale' absolutely, but from using it 'so as to induce persons to believe that the defendant's ales are the plaintiff's.' But the Court of Appeal dismissed the appeal. The defendant then appealed to the House of Lords, but with the same result.* Several of the law lords expressed the opinion that they would have preferred the injunction in the qualified form, but they thought that under the circumstances of this particular case the injunction awarded ought not to be varied. The

* *Montgomery* v. *Thompson*. 8 R.P.C. 361.

circumstance which apparently influenced them in deciding as they did was that it had been established in the case that it was perfectly impossible for the defendant to sell his ale as Stone Ale without deceiving customers. Between the times when this case was before the Court of Appeal and when it was before the House of Lords, the case of *Slazenger* v. *Feltham** came before the Court of Appeal. In that case, in 1889, the Judge at the trial granted an injunction restraining the defendant absolutely from using a name for his goods which was a colourable imitation of the plaintiff's trade name, but the Court of Appeal thought the injunction was too wide, and varied it by adding the words 'in such a way as to represent that his goods are the goods of the plaintiff.' In that case it does not appear to have been suggested that it was absolutely impossible for the defendants to use the term without deception. Then there is the Magnolia case,† in which the plaintiffs appealed for the purpose of getting an injunction in the limited form turned into an absolute injunction. The judge at the trial held that 'Magnolia' meant a particular alloy which anyone could manufacture, 'but,' he said, 'it is quite clear that the manufacture of "Magnolia" has been to such an extent identified with the plaintiffs that nobody, in my opinion, would

* 6 R.P.C. 531.

† *Magnolia Metal Co.* v. *Atlas Metal Co.*, 14 R.P.C. 389.

be justified in using the word "Magnolia" without taking steps to distinguish his manufacture from the "Magnolia" that is, in point of fact, manufactured by the plaintiffs, and therefore, in the injunction which I propose to grant in this case, words carrying out that object must be introduced, but I do not hold that the plaintiffs are entitled to a monopoly in the word "Magnolia" *per se*.' The injunction which was awarded was to restrain the defendants from using the word 'Magnolia' 'as descriptive of, or in connection with, any anti-friction metal manufactured by them or either of them, without clearly distinguishing such anti-friction metal from the anti-friction metal of the plaintiffs.' The plaintiffs appealed to the Court of Appeal, asking that the injunction might be made an absolute one against the use of the term 'Magnolia,' but the Court of Appeal refused to do this. They went upon the finding of the Judge that 'Magnolia' only meant the metal, and did not denote that it was the goods of the plaintiffs—*i.e.*, it was not the plaintiffs' trade name.* This being so, it looks as if, not only ought not an absolute injunction to have been awarded, but no injunction ought to have been awarded at all, and one would not have been awarded but for the fact that, for reasons which can be surmised, though they are not quite clear in the report

* 14 R.P.C. 401.

of the case, counsel for the defendants acquiesced in the granting of an injunction in the limited form.

One more case should be referred to on this point —viz., the case of *J. and J. Cash, Limited*, v. *Joseph Cash*. There the plaintiffs, whose frillings were known as 'Cash's Frillings' (*i.e.*, it was their trade name), sought to restrain Joseph Cash, who was trading as Joseph Cash and Co., from trading in frillings or other goods similar to the plaintiffs' goods under that name or any other name including 'Cash.' At the trial the defendant's counsel stated that he did not claim for the defendant the right to sell frillings as 'Cash's Frillings,' but only the right to trade under his own name. The judge granted an injunction restraining the defendant absolutely from trading in frillings, etc., as Joseph Cash and Co. or under the name 'Cash' The defendant appealed, but only on the ground that the injunction restrained him absolutely from carrying on business under his own name. The Court of Appeal held* that the injunction went too far, and they varied it into an injunction restraining the defendant absolutely from selling his frillings as 'Cash's Frillings,' and also restraining him from carrying on business in frillings, etc., under the name of 'J. Cash and Co.,' while not in partnership with anyone else, and from carrying

* 19 R.P.C. 181.

on such a business under the name of 'Cash' or any style in which 'Cash' appeared, without taking reasonable precautions to clearly distinguish his business from the plaintiffs' business.

PART XX

Three General Propositions

THE following propositions may be laid down as correct:

1. A man will not be restrained from simply carrying on business in his own name, even though confusion may arise.

2. A man will be restrained from carrying on business in his own name dishonestly—*i.e.*, when he not only uses his own name, but uses it in such a way (that is, in conjunction with other circumstances) as to represent that his business or his goods are the business or goods of another trader.

3. If a trader has a trade name for his goods which denotes those goods solely in the market, and distinguishes his goods from similar goods of other traders, so that the trade and the public, when asking for goods under that name, mean and intend to get particular goods emanating from one particular trade source (although they may not know such trader's

name), then he is entitled to be protected by the Court against other traders using that name in such a way as to be calculated to pass off other goods as his.

PART XXI

Pecuniary Compensation to Successful Plaintiff

NEXT comes the question, What is the form of the pecuniary compensation (if any) awarded to a plaintiff in a 'passing-off' case? It may take one of two forms—either an account of the profits made by the defendant by the acts of which the plaintiff complains, and payment to the plaintiff of the amount of such profits, or payment to the plaintiff of a sum of money as damages for the loss or injury which the plaintiff has sustained by the acts of the defendant. It was supposed until very recently that the plaintiff in a 'passing-off' case could choose which of the forms of compensation he liked, but that is apparently not so now. In the recent case of *Weingarten* v. *Bayer*, which was a 'passing-off' action, the plaintiffs succeeded at the trial in getting an injunction, and in addition they asked for and obtained an account of profits. The defendants tried to get the Judge to alter his Order by awarding damages in lieu of profits, but the judge declined to do so. He said that according to the rules of law the plaintiffs were

entitled to elect between profits or damages, although he said that he thought the Court ought to be able to determine in such a case which the plaintiffs should have, and further, that he thought that in the present case there was a great deal to say in favour of damages being given and not profits.* The case went to the Court of Appeal, who decided in favour of the defendants on the merits of the case, and dismissed the action,† so they had not to decide as between damages and profits. But Lord Justice Cozens-Hardy said: 'In any point of view I think the relief given by the learned Judge contrary to his own opinion—namely, an account of profits—is wrong in a case like this. The plaintiffs' trade was confined to a few towns, and there were whole districts in which the plaintiffs' goods and the plaintiffs' name were alike unknown. On the other hand, the defendants' trade extends all over the kingdom, and is very large. To give the plaintiffs the profits of this large trade would, in my view, be grossly unjust. Damages alone ought to be given, and I see no ground for supposing that any substantial damages could be recovered.' Lord Justice Vaughan Williams said that he quite agreed with these observations of Lord Justice Cozens-Hardy. Lord Justice Romer, the third member of the Court, said nothing on this point in his judgment, but as he had in a case before

* 20 R.P.C. 289. † 20 R.P.C. 649.

him in 1898,* refused a successful plaintiff in a passing-off action an account of profits as most unjust in the particular case, and restricted him to damages, it may be assumed that his views were the same as those of his colleagues on the Bench. So it may now be treated as settled that in 'passing-off' cases it is in the discretion of the Court to give profits or damages, and it may be anticipated that they will generally give damages. When damages are given, the Court may settle the amount at the trial if it has the necessary materials before it; if it has not (and this is generally the case), the Court directs an inquiry to be held before one of the official referees to determine what is the amount of the damage that the plaintiff has sustained. The costs of the inquiry are generally reserved, because if the plaintiff fails to prove that he has sustained any damage he will generally fail to obtain the costs of the inquiry, even if he is not ordered to pay them himself.

Subject to this, a successful plaintiff in a passing-off action almost always gets the costs of the action. It must be said 'almost always,' because a successful plaintiff is not entitled to his costs as a matter of right, and if there is anything in his conduct or anything in the special circumstances of the case to warrant it, the Court can and will leave him to pay his own costs.

* *Hodgson and Simpson* v. *Kynoch*, 15 R.P.C. 465.

PART XXII

The Merchandise Marks Acts

THE provisions of the Merchandise Marks Acts, having for their object to prevent a trader from passing off his goods as those of another trader, should now be dealt with. The first section of the Merchandise Marks Act, 1887, makes it an offence, among other things, (1) to forge a trade mark; (2) to falsely apply to goods any trade mark or any mark so nearly resembling a trade mark as to be calculated to deceive; (3) to apply any false trade description to goods; and (4) to cause any of these things to be done. But it is not to be an offence if the person charged proves that he 'acted without intent to defraud.' Trade mark in this and the provision next referred to means a trade mark registered at the Patent Office, but it also includes certain foreign and colonial trade marks, for which the Act itself must be consulted. The other provision* requiring mention makes it an offence to sell or expose for sale, or possess for the purposes of sale or any other trade purpose, any goods or things to which a forged trade mark or a false trade description is applied, or to which any trade mark or any mark so nearly resembling a trade mark as to be calculated to deceive is falsely applied

* Section 2 (2).

But it is not to be an offence if the person charged proves—'(*a*) that, having taken all reasonable precautions against committing an offence against this Act, he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the trade mark, mark, or trade description; and (*b*) that on demand made by or on behalf of the prosecutor he gave all the information in his power with respect to the persons from whom he obtained such goods or things; *or* (*c*) that otherwise he had acted innocently.'

Forging a trade mark is defined by the Act as follows: 'A person shall be deemed to forge a trade mark who either—(*a*) without the assent of the proprietor of the trade mark makes that trade mark, or a mark so nearly resembling that trade mark as to be calculated to deceive; or (*b*) falsifies any genuine trade mark, whether by alteration, addition, effacement, or otherwise; and any trade mark or mark so made or falsified is in this Act referred to as a forged trade mark. Provided that in any prosecution for forging a trade mark the burden of proving the assent of the proprietor shall lie on the defendant.'

Applying a trade mark or mark or trade description to goods is defined by the Act: '(1) A person shall be deemed to apply a trade mark or mark or trade description to goods who—(*a*) applies it to the goods themselves; or (*b*) applies it to any cover-

ing, label, reel, or other thing in or with which the goods are sold or exposed, or had in possession for any purpose of sale, trade, or manufacture; or (*c*) places, encloses or annexes any goods which are sold or exposed, or had in possession for any purpose of sale, trade, or manufacture, in, with, or to any covering, label, reel, or other thing to which a trade mark or trade description has been applied; or (*d*) uses a trade mark or mark or trade description in any manner calculated to lead to the belief that the goods in connection with which it is used are designated or described by that trade mark or mark or trade description. (2) The expression "covering" includes any stopper, cask, bottle, vessel, box, cover, capsule, case, frame, or wrapper, and the expression "label" includes any band or ticket. A trade mark or mark or trade description shall be deemed to be applied whether it is woven, impressed, or otherwise worked into, or annexed, or affixed to the goods, or to any covering, label, reel, or other thing. (3) A person shall be deemed to falsely apply to goods a trade mark or mark who without the assent of the proprietor of a trade mark applies such trade mark, or a mark so nearly resembling it as to be calculated to deceive; but in any prosecution for falsely applying a trade mark or mark to goods, the burden of proving the assent of the proprietor shall lie on the defendant.'

A trade description is defined by Section 3 of the Act as any description, statement, or other indication direct, or indirect, as to certain things not material for the present purpose. A false trade description is defined by the same section as follows: 'The expression "false trade description" means a trade description which is false in a material respect as regards the goods to which it is applied, and includes every alteration of a trade description, whether by way of addition, effacement, or otherwise, where that alteration makes the description false in a material respect; and the fact that a trade description is a trade mark, or part of a trade mark, shall not prevent such trade description being a false trade description within the meaning of this Act. The expression "goods" means anything which is the subject of trade, manufacture, or merchandise. The expressions "person," "manufacturer, dealer, or trader," and "proprietor," include any body of persons corporate or unincorporate. The expression "name," includes any abbreviation of a name.' The description must be false 'in a material respect'—which means that it must be materially or substantially false, and not necessarily wholly false; and it may be remarked that the section does not extend to mere verbal descriptions.

Going back to the offences, the first offence described consists in doing something illegal to goods;

the second consists in dealing with goods to which something illegal has been previously done. The first is aimed mainly at manufacturers, the second at sellers, wholesale or retail, not being themselves the manufacturers of the fraudulent goods.

As to the first offence, it is not to be held to be committed when the person charged proves (the burden of proof is, of course, on him) that he 'acted without intent to defraud.' This does not mean intent to defraud any particular purchaser or other individual, but intent to defraud generally by passing off an article as different to that which it really is. It does not cover what are mere cases of inaccuracy of description.

With regard to the second offence, the exonerating provisions are more elaborate. There are, in fact, two grounds of exoneration: (1) That which arises under heads (*a*) and (*b*), and (2) that which arises under (*c*). If a man charged with an offence can bring himself within (*a*) *plus* (*b*), he need not bring himself within (*c*), and if he can bring himself within (*c*), he need not bring himself within (*a*) or (*b*). This is clear on the language of the provision now under consideration, and particularly by the use of the word 'otherwise' in (*c*). It has been held in a recent case in Ireland,* and held correctly, that 'innocently' in (*c*) does not 'necessarily mean an

* *Thwaites and Co.* v. *M'Evilly*, 20 R.P.C. 663.

absence of an intention to defraud purchasers. The goods sold may be equal, or superior, to those to which the trade mark lawfully belongs. The purchaser may even buy with knowledge that the brand was false, and with the intention of gaining thereby by disposing of the goods at a large profit. In such a case he would not be defrauded, yet the sale to him would not be innocent. To prove innocence, the vendor must show that he was not aware that he was violating Section 2 (2)* of the Merchandise Marks Act.

The preceding remarks on the Act have been of a more or less general character. Now attention should be called to the provision which is specially aimed at passing off. It is that which enacts that 'The provisions of this Act respecting the application of a false trade description to goods shall extend to the application to goods of any such figures, words, or marks, or arrangement or combination thereof, whether including a trade mark or not, as are reasonably calculated to lead persons to believe that the goods are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really are.'† Under this provision anyone who attempts to pass off his goods as the goods of another by using any figures, words, or marks, or arrangement or combination thereof,

* *Ante*, p. 83.

† Section 3 (2).

which are reasonably calculated to lead to the belief that his goods are the goods of that other, may be charged with an offence under the Act, and will be convicted unless he proves that he acted without intent to defraud. The provision is a very valuable one as a protection against passing off. It is frequently resorted to, and would be resorted to more often but for three circumstances: (1) In civil proceedings an injunction as to future acts can be obtained, and also compensation for the loss occasioned to the plaintiff by past acts, which is not the case in proceedings under this provision. (2) It is much easier in a doubtful case to get a judgment against the wrong-doer by civil proceedings than it is to get him convicted of a criminal offence. (3) The provision under consideration never ought to be resorted to unless the aggrieved party feels satisfied that the person to be charged had in fact an intention to defraud, or, putting it another way, unless he feels satisfied that the person charged will not be able to prove an absence of intent to defraud.

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