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The Law of

TRADE-MARKS, TRADE-NAME, AND MERCHANDISE MARKS,

WITH CHAPTERS ON

TRADE SECRET AND TRADE LIBEL,

AND A

FULL COLLECTION OF STATUTES, RULES, FORMS AND PRECEDENTS.

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OF THE INNER TEMPLE, BARRISTER-AT-LAW.

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PREFACE

TO THE SECOND EDITION.

During the seven years which have elapsed since the publication of the first edition of this book, a very considerable number of decisions, modifying or illustrating the law of trade-marks, trade-name and merchandise-marks, have been reported. In the present edition these have been embodied in the text and notes, and it has been found necessary to re-write some parts of the book, and, in particular, part of the section of Chapter VIII. dealing with word-marks, and the whole of the section of Chapter XVI. dealing with the supposed right of any trader to the honest use of his own name. In the result a substantial increase in the size of the volume was inevitable, notwithstanding that the pages have been enlarged.

All the recent authorities have been carefully considered and, it is hoped, have been sufficiently stated. The Appendix has also been extended by the addition of a number of forms and official notices, including the Consolidated General Orders of the Custom House under the Merchandise Marks Acts.

For many of the official forms and notices the Editors are indebted to the courtesy of the learned Registrar of Trade-marks (Mr. R. Griffin), to the Solicitor to the Custom House, and to the India Office.

A summary of Foreign and Colonial Laws of Trade and Merchandise Marks has been added, and it is hoped that it will be found useful. It has, for the most part, been abstracted or condensed from the official publications referred to in the notes.

The cases have been brought down to the Whitsun Vacation, 1901.

Of the recent decisions referred to above, the judgment of the House of Lords in the *Solio Case* has, perhaps, attracted most attention. It completely altered the construction put upon sect. 64 (1) (d) and (e) of the principal Act, and threw open the Register to all words which are substantially non-descriptive of the goods for which they are used, notwithstanding that forensic or official ingenuity might be able to find in them some indirect allusion to the nature or use of the goods. This result was unquestionably in accordance with the intention of Parliament when the Act of 1888 was passed, and it gave great satisfaction to the trading community.

The feature of the litigation of the past seven years has, however, been the growing prominence of cases turning upon unregistered trade-marks. The *Camel Hair Belting* and the *Yorkshire Relish Cases* made it plain that it is possible for words which are of the most obviously descriptive character in themselves to

be practically monopolised in a particular trade by a single trader. More recently the *Cellular Clothing Case* has indicated some of the limits within which this can be done. The general tendency of the modern decisions is to sweep away all the subordinate rules as to what can and what cannot be acquired as a Common Law trade-mark, and to return in every instance to the simple inquiry whether what the defendant is doing is calculated to pass off his goods as those of the plaintiff. However attractive this apparent simplicity may appear at first sight, it is doubtful whether it will be satisfactory in the long run. As things stand, the task of advising at what point the wide advertisement and extensive use of a descriptive word by a trader on a large scale enables him to debar his smaller rivals from making use of it has become one of extreme difficulty.

A striking illustration of a difficulty analogous to that just referred to, and of the tendency to abandon rules which were formerly assumed as settled principle, is furnished by the *Valentine* litigation and the recent case before Mr. Justice Kekewich of *Cash* v. *Cash*. In each instance a defendant was restrained from using his own name, and that not upon any ground of fraud. It is to be hoped that the question how far the rule that a man may under all circumstances honestly use his own name, for which *Burgess* v. *Burgess* has been cited during more than forty years, is now to be relied on will before long be considered by the highest tribunal.

A Bill to consolidate and amend the law of trade-

marks has been from time to time before the House of Commons for some years past. There appears to be no likelihood of its passing at present or in its existing shape. It can be purchased of Messrs. Eyre & Spottiswoode, East Harding Street, E.C. (Bill No. 79 of 1901, price 3*d.*). The Bill proposes a number of minor amendments and three changes of substantial importance. It is proposed to admit for registration any non-dictionary word, and also any mark or word to the exclusive use of which the applicant is entitled and which is capable of distinguishing his goods. It is further proposed that a *disclaimer* made for the purposes of registration shall not affect any Common Law rights of the applicant in the matter described. Both of these alterations will call for, and will no doubt receive, very careful consideration before they become the law. The Bill further provides that the costs of the Comptroller upon an appeal from his decision shall not be payable by the applicant unless for good cause shown. This would remedy an obvious injustice.

If the Bill is ever seriously considered by Parliament, its drafting, which as it stands is somewhat loose and popular in expression, will no doubt be revised. And inasmuch as the law of registered trade-marks now forms by itself but a very small part of the whole subject, it is eminently desirable that, when the occasion arises, the amendment, if not the codification, of the whole of the law of trade-marks, trade-names and passing-off should be considered.

A minor but useful amendment of the existing

practice might be made without the assistance of Parliament. The classification of goods under the Trade-Mark Rules has never been revised, and it is now seriously defective and out of date. For instance, no proper place is provided for either pneumatic tyres or photographic films.

The writer has been greatly assisted in the preparation of the present edition by Mr. F. G. UNDERHAY, who has undertaken not only the most laborious part of the work, but the whole of the revision of the earlier chapters.

The Editors are also much indebted to the gentlemen already referred to above, and also to Mr. JOHN CUTLER, K.C., Mr. A. WOOD-RENTON, of Gray's Inn, Mr. CRAIES, of the Inner Temple, and Mr. HAROLD WADE, of the firm of Boult, Wade & Kilburn, Patent Agents, for criticism and suggestions. Several of the gentlemen referred to have been kind enough to read parts of the proof.

D. M. KERLY.

TEMPLE,
June, 1901.

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44.—*After* "*Vaseline*," *add* "(an appeal is, however, pending)."

70, note (*v*).—*Add*, "It had, however, been expressly disclaimed."

90, note (*n*).—*For* "9 R. P. C. 215," *read* "9 R. P. C. 213."

170.—*For* "Emolliorum," *read* "Emolliolorum."

180, note (*t*).—At commencement *insert*, "An appeal is, however, pending."

222, note (*e*).—*For* "in use in England," *read* "use in England."

249, note (*u*).—*For* "9 R. P. C. 370," *read* "8 R. P. C. 370."

251.—*Add* to contrasted devices, "J. B. D. in an oval ring an infringement of G. B. D. in an oval ring, *Maréchal and Ruchon* v. *McColgan*, Chatterton, V.-C. (Ireland), 18 R. P. C. 262."

271, note (*k*).—*For* "45 Ch. D. 35," *read* "41 Ch. D. 35."

290, note (*i*).—*For* "(1892) 3 Ch. 301," *read* "(1892) 3 Ch. 201."

298, note (*d*).—*For* "(1892) 2 Ch. 402," *read* "(1891) 2 Ch. 402."

337, note (*g*).—*After* "(1900) 1 Q. B. 310," *add* "affirmed by House of Lords, *Times*, May 5th, 1901."

369, note (*r*).—*Add*, "*John Jameson & Son, Ld.* v. *R. S. Johnston & Co., Ld.*, Porter, M.R. (Ireland), 18 R. P. C. 259."

407, note (*k*).—*For* "17 R. P. C. 817," *read* "17 R. P. C. 517."

416, note (*g*).—*After* "deception," *add* "a perpetual injunction was granted at the trial (about to be reported in 18 R. P. C.)."

421, note (*h*).—*Add*, "In *Maréchal and Ruchon* v. *McColgan*, Chatterton, V.-C. (Ireland), 18 R. P. C. 262, the stamp was ordered to be delivered up by the defendant."

429, note (*i*).—*Add*, "And as to whether a plaintiff can get the costs of a motion so far as they exceed those of an order in chambers, see *Gandy Belt Manufacturing Co.* v. *Fleming, Birkby & Goodall, Ld.* (about to be reported in 18 R. P. C.)."

430, note (*m*).—*Add*, "See also *Clarke* v. *Hudson* (about to be reported in 18 R. P. C.)."

470.—*Add* to list of cases in which injunctions have been refused, "*Daimler Motor Co., Ld.* v. *British Motor Traction Co.*" (about to be reported in 18 R. P. C.) in which the plaintiffs sought to restrain registration of a company under the name "*Daimler Wagon Co., Ld.*"

470.—*For* "*Bamstead*," *read* "*Bumsted*."

493, note (*z*).—*Add* to cases quoted, *Colman* v. *Farrow*, 15 R. P. C. 198.

522, note (*o*).—*For* "37 & 38 Vict. c. 51, s. 4," *read* "62 & 63 Vict. c. 23, s. 2."

562, note (*e*).—*For* "25 & 26 Vict. c. 88, s. 2," *read* "25 & 26 Vict. c. 88, s. 1."

817.—*Add after* "Merchandise Marks (Prosecution) Act, 1894," "57 & 58 Vict. c. 19."

817.—*For* "54 & 55 Vict. c. 28," *read* "54 & 55 Vict. c. 15; 50 & 51 Vict. c. 28."

Book I.

THE LAW OF TRADE-MARKS.

CHAPTER I.

INTRODUCTION.

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1. Trade-Marks before the Registration Acts.

The foundation upon which the law relating to trade-marks and trade-names rests is that the deception of the public by the offer for sale of goods as possessing some connection with a particular trader, which they do not in fact possess, is a wrong in respect of which the trader has a cause of action against any person who is the author of, or is responsible for, the deception.

The leading principle as stated by James, L. J.

"No man," said James, L. J. (*a*), "is entitled to represent his goods as being the goods of another man; and no man is permitted to use any mark, sign or symbol, device or means, whereby, without making a direct false representation himself to a purchaser who purchases from him, he enables such purchaser to tell a lie or to make a false representation to somebody else who is the ultimate customer. That being, as

(*a*) *Singer Manufacturing Co.* v. *Loog*, 18 C. D. p. 412; 52 L. J. Ch. 481 (1880).

it appears to me, a comprehensive statement of what the law is upon the question of trade-mark or trade-designation, I am of opinion that there is no such thing as a monopoly or a property in the nature of a copyright, or in the nature of a patent, in the use of any name. Whatever name is used to designate goods, anybody may use that name to designate goods; always subject to this, that he must not, as I said, make, directly or through the medium of another person, a false representation that his goods are the goods of another person."

Early trade-mark cases at law and in equity.

The law on this subject cannot be traced back further than the present century. It is, indeed, sometimes alleged, upon the authority of *Southern* v. *How* (*b*), that an action lay for the infringement of a trade-mark as early as the reign of James I. In that case the defendant, a clothier, had applied the mark of another clothier to his own inferior cloth, and it was held that for this an action for deceit could be brought. According to one report (*c*), the action was brought by the owner of the mark, and if this is correct the case does undoubtedly establish the proposition suggested. According to another report (*d*), however, the plaintiff was the defrauded purchaser, and the action, therefore, an ordinary action of deceit. In the case of *Blanchard* v. *Hill* (*e*), Lord Hardwicke refused to grant an injunction to restrain a trader from imitating the mark of another; but the language of his judgment suggests that if the defendant had used the mark with a fraudulent design to pass off inferior goods by that means, or to draw away customers from the owner of the mark, he might have granted the injunction.

Lord Eldon, who so greatly extended the jurisdiction of the Court of Chancery in regard to injunctions (*f*), in several instances granted injunctions to restrain a defendant from pretending that his goods were those of, or were

(*b*) Popham, 144; Cro. Jac. 471; 2 Rolle, 28. See *Magnolia Metal Co.* v. *Tandem Smelting Syndicate, Ld.*, 17 R. P. C. 477, at p. 464, (1900) H. L.

(*c*) Popham, p. 144.

(*d*) Cro. Jac. 471.

(*e*) 2 Atk. 484 (1742), Great Mogul Stamp on playing cards.

(*f*) See 2 Law Review, p. 282; Kerly's History of Equity, p. 258.

connected with the plaintiff (*g*); and in *Cruttwell* v. *Lye* (*g*) he stated the principle on which he acted in similar language to that of James, L. J., cited above. "There can be no doubt," he said, "that this Court would interpose against that sort of fraud which has been attempted by setting up the same trade in the same place, under the same sign or name, the party giving himself out as the same person." The earliest reported case in which the infringement of a trade-mark, in the particular case a label placed upon blacking, was restrained is *Day* v. *Day* (*h*), in 1816.

Early cases at common law.

Sykes v. *Sykes*.

The interference of the common law courts for the protection of trade-marks seems to have been a little later in date. The first reported case is *Sykes* v. *Sykes* (*i*), in 1824. The declaration in that case alleged that the plaintiff carried on the business of a shot-belt and powder-flask manufacturer; that he was accustomed to mark his goods with the words *Sykes' Patent*, to distinguish them from articles of the same description made by other persons; that they enjoyed a great reputation; that the defendants fraudulently marked their own inferior goods with the same mark in imitation of the plaintiff's, and sold them "as and for" goods of the manufacture of the plaintiff, and that the plaintiff thereby had suffered damage in loss of custom and loss of reputation. Bayley, J., who tried the case, asked the jury "whether the defendants adopted the mark in question for the purpose of inducing the public to suppose that the articles were not manufactured by them, but by the plaintiff," and the jury found a verdict for the plaintiff. A new trial was moved for on the ground that the evidence did not support the declaration, since the purchasers from the defendants knew whose manufacture the goods were. No authorities were cited, so far as can be judged from the report, but Abbott, C. J., who delivered the judgment of the Court, treated the law as fully settled. "I think," he said, "that the substance of the declaration was proved. It was established most clearly

(*g*) *Hogg* v. *Kirby*, 8 Ves. 215 (1803); *Longman* v. *Winchester*, 16 Ves. 269 (1809); *Cruttwell* v. *Lye*, 17 Ves. 335 (1810).

(*h*) Eden on Injunctions, ed. 1821, p. 314; Sob. Dig. p. 10.

(*i*) 3 B. & C. 541; 3 L. J. K. B. o.s. 46.

that the defendants marked the goods manufactured by them with the words *Sykes' Patent* in order to denote that they were the genuine manufacture of the plaintiff; and although they did not themselves sell them as goods of the plaintiff's manufacture, yet they sold them to retail dealers for the express purpose of being resold as goods of the plaintiff's manufacture. I think that is substantially the same thing, and that we ought not to disturb the verdict." This judgment has frequently been cited in subsequent cases as fully establishing, so far as it went, not only the jurisdiction of the Courts, but also the principle upon which they proceed in trade-mark cases (*k*).

Inferiority of the infringer's goods.

In 1833, in *Blofeld* v. *Payne* (*l*), the Court of King's Bench decided that it was not necessary for the plaintiff, in an action for damages at common law, to prove that the goods sold by the infringer were inferior to those to which the mark in question might rightly be applied, or to prove that he had suffered special damage by the defendant's acts; and in 1863, in *Edelsten* v. *Edelsten* (*m*), the same rule was referred to as being settled beyond question in suits in equity (*n*).

Proof of fraud unnecessary in equity. *Millington* v. *Fox*.

Property in a trade-mark.

An important step was taken in 1838, by the decision of Lord Cottenham in *Millington* v. *Fox* (*o*), that an injunction could be obtained to restrain infringement of a trade-mark, even though the infringement was due to ignorance, and was without fraudulent intent. This decision led, by an obvious deduction, to the establishment of a right of property in trade-marks; and, although the nature of this right gave rise to much discussion, and was defined in different terms by Chancery judges in subsequent cases, it soon became firmly established, and the protection of trade-marks in equity was expressly based upon it (*p*). No similar step was taken by

(*k*) *Ford* v. *Foster*, L. R. 7 Ch. p. 630 (1872); *Singer Manufacturing Co.* v. *Loog*, 18 C. D. p. 403; 52 L. J. Ch. 481 (1880), both C. A.

(*l*) 4 B. & Ad. 410; 2 L. J. K. B. N.S. 68.

(*m*) 1 De G. J. & S. 185.

(*n*) See per Lord Blackburn in *Singer Manufacturing Co.* v. *Loog*, 8 App. Ca. p. 30; 52 L. J. Ch. 481, at p. 489 (1880).

(*o*) 3 My. & Cr. 338.

(*p*) *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185; *Hall* v. *Barrows*, 4 De G. & S. 150; 32 L. J. Ch. 548; 33 L. J. Ch. 204; *Leather Cloth Co.* v. *American Leather Cloth Co.*, 1 H. & M. 271; 4 De G. J. & S. 137; 11 H. L. C. 523; 32 L. J. Ch. 721; 33 L. J. Ch. 199; 35 L. J. Ch. 53 (all

the common law courts, and in them fraud remained an essential ingredient of a cause of action for the infringement of a trade-mark down to the date of the amalgamation effected by the Judicature Acts.

2. Registration of Trade-Marks.

Development of the specialized action of infringement.

The principle stated at the beginning of this chapter, and the dicta there cited, have, obviously, a wider application than merely to the case of trade-marks proper. Conduct of every kind, which is calculated to pass off the goods of the defendant as those of the plaintiff, falls within them, whether it consist of the imitation of the symbol expressly adopted by the plaintiff to distinguish his goods and to identify them with him, that is, his trade-mark; or of the imitation of any other symbols which have become associated with his goods, so as, in fact, to distinguish and identify them; or of the imitation of the general appearance, the "get up," of his goods as they appear in the market; or of the imitation of the name under which he trades. The trade-mark cases, however, were so much the more numerous and important, that, as already stated, a definite property-right in the use of a trade-mark was set up, and the action for infringement became a specialized and distinct form of the more general action to restrain, or to obtain damages for "passing off."

Difficulty and cost of the old trade-mark suits.

The litigation of trade-mark cases was, however, found to be extremely costly, and otherwise unsatisfactory. The essence of a trade-mark right being the reputed association in the market of the symbol in question with the goods of the plaintiff, it was often necessary to call a large number of witnesses to give evidence of the reputation, especially if the defendant alleged that the pretended trade-mark was either mere descriptive matter, or was, on any other grounds, a mark common to the trade; and, as infringers were usually persons of no substance, it was often impossible to recover the costs after the plaintiff had conducted his action to a

in 1863) and decisions of Lord Westbury, L. C. And see *Day* v. *Riley and Whittaker*, 17 R. P. C. 517, at p. 520, (1900) *obiter* by Buckley, J. Also the judgments of Lord Herschell in *Reddaway* v. *Banham*, (1896) A. C, p. 209; 13 R. P. C. p. 228; and of Kekewich, J., in *Saxlehner* v. *Apollinaris Co.*, (1897) 1 Ch. p. 903; 14 R. P. C. p. 656, as to whether there can be "property" in any common law trade-mark.

successful issue. Moreover, success against one infringer did not relieve the owner of a trade-mark from the necessity of proving his title afresh if, in any action against another infringer, the defendant chose to dispute it. Thus, the case of *Rodgers* v. *Nowill* (*q*) lasted five years and cost the plaintiff 2,211*l.*, without in the end giving him any security that he might not have to incur equal delay and expense in proceeding against any subsequent infringer of his mark who should venture to run the risk of disputing his title to the exclusive use of it. And these dilatory and expensive proceedings were, practically, the only means available of preventing the infringement of a trade-mark; for such infringement, except in cases where the spuriously-marked goods were sold to persons who were cheated by the seller into buying them under the belief that they were goods upon which the imitated trade-mark might properly be put, was not within the reach of the criminal law (*r*).

The Committee of 1862.

These evils, and the unsatisfactory state of the law in regard to the false marking of goods in general, led to an urgent demand from the traders of the country for more efficient protection, and in 1862 a Select Committee of the House of Commons were appointed to consider several trade-marks and Merchandise Marks Bills then before Parliament. The Committee were strongly urged to report in favour of the establishment of a Register of trade-marks and the creation of trade-mark rights by registration, in the manner already adopted by several foreign States, and long familiar, as regards cutlers' marks, in and within six miles of the lordship of Hallamshire, in England (*s*). And Mr. Leonard Edmunds, then Clerk of the Patents, explained to the Committee a scheme which he had drawn up for registering and indexing trade-marks in the manner at that time adopted for patents, many of the features of which were embodied in the Registration Acts subsequently passed. The proposals were, how-

(*q*) Evidence of G. J. Rodgers before the Committee of 1862. M. M. A. Report, 1862, Q. 458. The case is reported in its various stages, 6 Hare, 325; 5 C. B. 109; 17 L. J. C. P. 52; 3 De G. M. & G. 614; 22 L. J. Ch. 404 (1846).

(*r*) See below, p. 17, and per Mellish, L. J., in *Fisher* v. *Apollinaris Co.*, L. R. 10 Ch. p. 303; 44 L. J. Ch. p. 502 (1875).

(*s*) See "Sheffield Marks," below, p. 101.

ever, strenuously opposed by Mr. Hindmarch, Q.C., the leading patent and trade-mark lawyer of the day, and by the Attorney-General, and they were not indorsed by the Committee. Registration of trade-marks was, in consequence, postponed for some years; but the Bill upon which the Merchandise Marks Act of 1862 (*t*) was founded was amended and favourably reported upon by the Committee, and was forthwith passed into law.

The Merchandise Marks Act of 1862.

The Act just mentioned dealt principally with the criminal law, but it contained some provisions affecting the civil law of trade-marks. It provided that there should be implied, on the sale of any article with a trade-mark attached to it, a warranty that the trade-mark was genuine (*u*). It gave a statutory right of action for damages, and for an injunction to any person aggrieved, against anyone who should apply a forged or counterfeited trade-mark to any article, or to the covering of any article, for the purpose of sale, manufacture, or trade (*x*), and empowered the Court to order the destruction of goods marked with spurious trade-marks (*y*). It also authorized Courts of Law to grant injunctions in trade-mark cases (*y*). These provisions are, however, believed to have been of as little practical service as were the amendments of the criminal law effected by the Act, which are referred to in a later section of this chapter.

The Registration Act of 1875.

Thirteen years later the Trade-Marks Registration Act, 1875 (*z*), which came into operation on the 13th of August, 1875, established the present Register of Trade-marks. The object of this Act was twofold: it was directed, on the one hand, to diminish the difficulty and cost of, or to altogether remove the necessity for the proof of title by use and reputation, which had cast so great a burden upon the owners of trade-marks in proceedings to restrain infringement; and, on the other, to secure the publication of marks which had been appropriated as trade-marks, and to define the rights of their proprietors, for the information of traders, and, further, to

(*t*) 25 & 26 Vict. c. 38.

(*u*) Sect. 19, see now M. M. A. 1887, s. 17; Chap. XVII., p. 520.

(*x*) Sect. 22.

(*y*) Sect. 21.

(*z*) 38 & 39 Vict. c. 91. See the chapter on "The Register," below, p. 56.

limit the classes of marks which should be capable of being so appropriated (*a*). The Act, accordingly, provided that registration should be *primâ facie* evidence of the right of the registered proprietor to the exclusive use of the trade-mark (*b*) in connection with goods of the class for which it was registered and used (*c*), and should, after the expiration of five years, be conclusive evidence of such right, so long as the trade-mark remained upon the Register (*d*); provided that the proprietor of the mark remained the owner of the goodwill of the business in which it was used. And, with a view to compelling registration, the Act provided that from and after the 1st of July, 1876 (a date which was extended by the amending Acts (*e*)), a person should not be entitled to institute any proceeding to prevent the infringement of any trade-mark as defined by the Act until and unless such trade-mark was registered in pursuance of the Act, or, according to a subsequent modification, in the case of any mark in use as a trade-mark before the passing of the Act of 1875, until and unless registration of the mark as a trade-mark should have been refused (*f*).

What might be registered as trade-marks under the Act of 1875.

The marks admitted to registration as trade-marks under the first Registration Act were required (*g*) to consist of one or more of the following essential particulars: a name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or a written signature or copy of a written signature of an individual or firm; or a distinctive device, mark, heading, label, or ticket; and to these essential particulars there might be added any letters, words, or figures, or combination of letters, words, or figures; and it was further provided that any special and distinctive word or words, or combination of figures or letters, used as a trade-

(*a*) Per Fry, L. J., in the *Apollinaris Co.'s Tm.*, (1891) 2 Ch. p. 235; 8 R. P. C. 137; and Cotton, L. J., in *Van Duzer's Tm.*, 34 C. D. p. 634; 4 R. P. C. 31 (1887).

(*b*) Sect. 3.

(*c*) *Edwards* v. *Dennis*, 30 C. D. 454 (1885), C. A.; below, p. 307.

(*d*) *Palmer's Tm.*, 21 C. D. 47; 24 C. D. 504 (1882), C. A.; below, p. 309.

(*e*) 39 & 40 Vict. c. 33, and 40 & 41 Vict. c. 37.

(*f*) 39 & 40 Vict. c. 33, s. 1. See now sect. 77 of the Act of 1883, below, p. 312.

(*g*) Sect. 10.

mark before the passing of the Act might be registered as such under the Act.

The Act attained a considerable measure of success, and 27,844 trade-marks were registered under it, but its provisions did not allow words to be registered as trade-marks (*h*) unless they were old marks, or were registered in combination with one or more of the enumerated essential particulars; and as word-marks are exceedingly popular in this country, and were admitted and protected as trade-marks abroad, an alteration of the definition clause was determined upon (*i*). This was effected by the Patents, Designs, and Trade-Marks Act, 1883 (*j*), which came into operation on the 1st of January, 1884. The new Act repealed the Act of 1875, with its amending Acts of 1876 and 1877, but re-enacted, in substance, their principal provisions. It directed that the Register of trade-marks, of which the old Register is to be deemed to be a part (*k*), should be kept at the Patent Office established by the Act (*l*), and should be under the control of the Comptroller-General of Patents, Designs, and Trade-marks, who acts under the superintendence and direction of the Board of Trade (*m*). It also introduced a number of new rules and provisions to regulate applications for, oppositions to, and rectifications of registration, and effected important changes with regard to the Sheffield cutlery marks (*n*), which the older Act had, substantially, left untouched.

The Registration Act of 1883.

The most material alteration introduced by the Act of 1883 was the power it conferred to register a mark of which the essential particular should be a "fancy word or fancy words not in common use." What was intended by "a fancy word not in common use" the Act did not define, and the omission was the cause of a great deal of litigation; but a fairly definite meaning was at length put upon the phrase by the Court of Appeal, in the *Melrose* hair restorer, and the *Electric* velveteen cases (*o*). To fall within the meaning, a word

"Fancy words" allowed to be registered.

(*h*) *Exp. Stephens*, 3 C. D. 659 (1876), Jessel, M. R. (*Acilyton*).

(*i*) See the Comptroller's second report for 1884.

(*j*) 46 & 47 Viet. c. 57.

(*k*) Sect. 114 (2).

(*l*) Sect. 78.

(*m*) Sect. 82.

(*n*) Sect. 81, see below, p. 101.

(*o*) *Van Duzer's and Leaf's Tms.*, 34

must, the Lords Justices held, be "obviously not intended to be descriptive," and must "speak for itself and be a fancy word of its own inherent strength," and be "so obviously and notoriously inappropriate as neither to be deceptive or descriptive, nor calculated to suggest deception or description."

Lord Herschell's Committee, 1887.

Soon after the decisions just referred to, a very distinguished Committee, presided over by Lord Herschell, were appointed by the Board of Trade to inquire into the duties, organization, and arrangements of the Patent Office under the Act of 1883, as far as related to trade-marks and designs, and the Committee presented in August, 1887, an interim, and in March, 1888, a final report, dealing not only with the matters specified, but with the general question of the registration of trade-marks. These important reports are frequently referred to in subsequent pages of this book (*oo*), and it will be sufficient here to refer to a few only of the suggestions made by the Committee. They recommended that a new definition clause should be enacted, stating what symbols might be registered, and substituting for the fancy-word phrase in the Act of 1883 the phrases "An invented word or invented words; or a word or words having no reference to the character or quality of the goods, and not being a geographical name" (*p*), and that additions to registered trade-marks (that is, matter other than their essential particulars registered with them) should be expressly disclaimed by the applicants for registration (*p*). The alterations and some minor changes were passed into law by the amending Act of 1888 (*q*), which came into operation on the 1st of January, 1889.

Invented word or words.

Doubtful marks to be rejected.

The Committee further reported, as principles which ought to govern the Comptroller in the acceptance for registration or the rejection of marks: that "inasmuch as the object of registration is to secure a distinctive mark, and the registration

C. D. 623; 4 R. P. C. 31 (1887). See, however, *Re Borril Tm.*, (1896) 2 Ch. 600; 13 R. P. C. 382; and below, p. 159.

(*oo*) The reports may be referred to on the construction of the Act of 1888, to show the mischief which it was directed to remedy. *Eastman Photographic Materials Co.'s Application*, (1898) A. C. 571; 15 R. P. C. 476.

(*p*) Act of 1888, s. 10.

(*q*) 51 & 52 Vict. c. 50.

of a mark which may conflict with a mark already registered would not only be to the detriment of the owner of such prior mark, but of the applicant himself, we think that in cases where it is doubtful whether the mark ought to be accepted or not, the safer and more beneficial course would be to reject it" (*r*); and that, in their opinion, in comparing a new mark tendered for registration with a prior mark which it was alleged to resemble too closely, the question should be determined by considering what is the leading characteristic, or, as it is otherwise expressed, what is the idea, of each mark. The Acts, it has been held, vest in the Comptroller a discretion, to be exercised, of course, judicially and subject to appeal, whether to register or reject any mark first used since the 13th of August, 1875 (*s*); and this discretion, exercised in the light of the recommendations of the Committee, has made the choice of a new trade-mark, or the registration of an existing one, often a matter of considerable uncertainty and trouble.

For some time after the Act of 1888 was passed a construction was put upon the new clauses allowing the registration of "invented words" and "words having no reference to the character or quality of the goods" for which the mark was to be used, which made the amendment of the law almost wholly inoperative. It was held that no word was qualified to be the "essential particular" of a registered trade-mark unless it satisfied both clauses simultaneously, and that even a remote suggestion of some real or assumed characteristic of the goods would make it objectionable. Thus the word *Somatose* was refused registration as a trade-mark for a medical food (*t*). In the year 1898, however, in the *Solio* case (*u*), this decision was overruled by the House of Lords, and it was decided that the clauses referred to are alternative and independent, so that any really new-coined word, whether it has some reference to, or contains some suggestion of, the character or quality of the goods or not, as well as any existing word which has no such reference, may be registered as a

(*r*) Interim Report, par. (2).
(*s*) *Eno* v. *Dunn*, 15 App. Ca. 253; 7 R. P. C. 311 (*Fruit-Salt Baking Powder*) (1890).
(*t*) See Chap. VIII., pp. 172, 179.
(*u*) See Chap. VIII., p. 171.

trade-mark, or may be the essential particular of a trade-mark, unless it is objectionable on other grounds. This decision has greatly increased the usefulness of the Register, by enlarging the area from which new marks may be chosen as well as by admitting to registration large numbers of word-marks already in use.

Unregistered trade-marks are still numerous.

Down to the end of the year 1899, 93,362 trade-marks had been registered under the Acts, and some eight or nine thousand applications are annually made for registration (*x*); but a very large number of trade-marks in actual use in the country still remain unregistered, either because they are not capable of registration for the reason that they do not fall within the definition clause of the Act (*y*), or because their proprietors do not think it worth while to seek to register them. These unregistered trade-marks, notwithstanding the prohibitory sections of the Acts (*z*) already mentioned, which make registration, in general, a condition precedent to litigation to restrain or to obtain damages for infringement, are in many cases to a great extent protected by the Courts in the "passing-off" actions, next to be referred to. For it is now well settled that if the use by the defendant upon his goods of an unregistered trade-mark belonging to the plaintiff is calculated to pass off or cause to be passed off the defendant's goods as the goods of the plaintiff, an injunction may be granted to restrain such use (*a*), and this whether the use be deliberately fraudulent and intended by the defendant to be deceptive, or not (*b*).

3. Passing-off and Trade-name Actions.

By the judgments in *Millington* v. *Fox* (*c*) and later cases in equity (*d*), and by the Acts referred to above and the

(*x*) Comptroller's Report for 1899; 3,777 marks were registered in 1899.

(*y*) Act of 1888, s. 10.

(*z*) Act of 1875, s. 1; Act of 1883, s. 77.

(*a*) *Montgomery* v. *Thompson*, 41 C. D. 35; (1891) A. C. 217; 8 R. P. C. 361 (*Stone Ales*), where the plaintiff's mark was removed from the Register, but he succeeded in the action.

(*b*) *Reddaway & Co.* v. *Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639; 9 R. P. C. 503; C. A., see below, pp. 450 and 451.

(*c*) 3 My. & Cr. 338 (1838), Cottenham, L. C.

(*d*) See the next chapter,

decisions upon them, the conditions under which a right of property in a trade-mark may be acquired, and the manner and degree in which it would be protected, have been fully established; but the symbol which a trader adopts as his trade-mark is only one of the badges or *indicia* by which his trade and the goods he deals in are identified with him, and distinguished from the trade of his rivals in business and similar goods which are not his but theirs. These badges are generally numerous, and they comprise in particular the name under which he trades, that is, his trade-name; the names or titles by which his goods are referred to, that is, the trade-name of his goods; and the fashion or "get-up" in which the goods appear in the market, so far as these are distinctive of his trade and goods. The principles of the decisions cited above, from which the law of trade-marks was specialized, apply also to these cases—of "trade-name" and "passing-off" as they are comprehensively termed. The first reported judgment in which the two classes of cases were formally contrasted is that of Jessel, M. R., in *The Singer Manufacturing Co.* v. *Wilson* (*e*). "The cases which have come before the Court," the late Master of the Rolls said, "may, I think, be conveniently divided into two classes; the first class, which is the more numerous one, consists of cases where the goods manufactured are distinguished by some description or device in some way or other affixed to the article sold. It may be, as I said before, description, that is, it may consist of a name or names, or a lengthy description consisting of names with superadded words, and that description may be either affixed to, or impressed upon, the goods themselves by means of a stamp or an adhesive label, or it may be made to accompany the goods by being impressed or made to adhere to an envelope or case containing the goods. Now, as to this class, it is quite immaterial that the maker of the goods to which—what I will call for the sake of shortness—the trade-mark is affixed did not know that it was a trade-mark, and had not the slightest intention of defrauding anybody.

Trade names and "get-up."

Actions for infringement of trade-marks and passing-off actions contrasted.

(*e*) 2 C. D. 434; 45 L. J. Ch. 490 (1874).

"The second class (*f*) of cases are of a totally different character: they are always cases of fraud. They are cases where the defendant, without putting any trade-mark at all on his goods, or putting a trade-mark which is admittedly different in substance from the trade-mark, if any, of the plaintiff on the goods, has represented the goods as being goods manufactured by the plaintiff. . . . What the defendant has said or done must amount to a representation that the goods to be sold are the goods of the plaintiff, or that they are manufactured by the plaintiff. What amount of representation will be sufficient for that purpose must again depend, of course, on the facts of each particular case."

It will be seen that Sir George Jessel here limited the right to redress in the second class of cases to cases where the defendant had acted with fraudulent intention, and for the purpose of deceiving the customers, or intending customers, of the plaintiff, and in this his judgment was endorsed and approved by the Court of Appeal (*g*). In the House of Lords, however, this distinction between the two classes of cases was not accepted. Lord Cairns said there was no such difference in point of principle (*h*), and that since the decision in *Millington* v. *Fox* (*i*) it was necessary neither to aver nor to prove fraud. "In the present case," he added, "the question must, as it seems to me, be: Are the advertisements of the defendant, having regard to the evidence in the case, calculated to mislead an unwary purchaser of the machines?" The question came up again in *Singer Manufacturing Company* v. *Loog* (*k*), and although the case was decided on the ground that the evidence showed that the conduct of the defendant in question was not in fact calculated to deceive, several of the judgments delivered contain passages which are in accordance with Lord Cairns' opinion. James, L. J., summed up the law in the words quoted at the beginning of this chapter; and Lord Selborne used language to the same

Proof of fraud unnecessary, if the defendant's conduct is calculated to deceive.

(*f*) 2 C. D. p. 443.

(*g*) There are statements to the same effect in the judgments in *Chevrin* v. *Walker*, 5 C. D. 850 (1876), decided before the *Singer Case* reached the House of Lords.

(*h*) 3 App. Ca. p. 389; 47 L. J. Ch. p. 487 (1877).

(*i*) Above, p. 4.

(*k*) 18 C. D. 395 (1879); 8 App. Ca. 15 (1882): 52 L. J. Ch. 481.

effect. "It was contended" (*l*), he said, "that the acts of the defendant enabled his wholesale customers to show these documents to their own retail customers for the purpose of passing off the goods bought from the defendant as the plaintiffs' manufacture. The answer is, that, unless the documents were fabricated with a view to such a fraudulent use of them, or *unless they were in themselves of such a nature as to suggest, or readily and easily lend themselves to, such a fraud*, . . . the supposed consequence is too remote, speculative, and improbable to be imputed to the defendant, or to be a ground for the interference of a court of justice with the course of the defendant's business."

And it may now be taken as settled that (*m*), even where there is no question of a registered trade-mark, or of any mark at all attached to the goods, a trader will not be allowed to act in a manner which leads, or is calculated to lead, to deception, although the deception is entirely unintended by him, unless he has some special justification for his conduct, as, for instance, an independent right to use a name similar to the plaintiff's name (*n*). He does, in fact, commit a fraud when he continues his conduct after discovering its dangerous character (*o*).

"No man," said Cotton, L. J., in the case of *Turton* v. *Turton* (*n*), "must pass off his goods as the goods of another. Of course, that may be done unintentionally; but where there is a manifest and natural meaning in the words used that the goods are the goods of somebody else, and the man who uses those terms uses not his name only, but somebody else's, he would be stopped from doing so as soon as he is aware of the facts which make the *primâ facie* intention and result of what he is doing, passing off his goods as the goods of somebody else. It was formerly said that no action could be maintained unless a man had done so fraudulently and intentionally; but when he finds out that the natural construction of what he is doing, when the facts are known, is to represent his goods to be somebody else's,

(*l*) 8 App. Ca. p. 21; 52 L. J. Ch. p. 484.

(*m*) See Chap. XII., p. 317, and Chap. XVI., p. 451.

(*n*) See below, pp. 500 *et seq.*

(*o*) See below, p. 376.

then he should be stopped, even though he had originally done that unintentionally and innocently." And in their final report, Lord Herschell's Committee said: "There can be no doubt that if a manufacturer or vendor has obtained for his goods a reputation amongst the public, he could, by process of law, quite apart from the Trade-Marks Acts, prevent goods that were not his from being offered to the public on the representation that they were so (*p*)."

Trade-names. The protection of the trade-names of individuals, firms, and companies from deceptive imitations is an important application of the principles just stated (*q*); and in connection with them, the chief practical exception to the rule, that the defendant will not be allowed to continue conduct which is calculated to lead to his goods or trade being taken to be the goods or trade of the plaintiff, is found in the rule that a man may honestly trade under his own name, and describe his goods by it, whatever the consequences may be (*r*). But even this exception, according to the most recent authorities, must give way in extreme cases, where the use of the defendant's own name by itself and without qualification, is calculated to pass off his goods as those of the plaintiff. *Bass' Ale* and *Pears' Soap* have frequently been cited (*rr*) as instances of names which could not be used without qualification and precautions against mistake by a Bass or a Pears entering into the trade in question and competing with the well-known firm of the same name.

Right to trade under one's own name.

4. The Criminal Law of False Marking.

At the common law, as already stated, it was an offence to cheat by fraudulently selling the goods of A. under the pretence that they were the goods of B., or to sell goods under any material false pretence that they were different goods from what in fact they were, and such false pretences

(*p*) Report of 1888, p. xii.

(*q*) See below, Chap. XVI., p. 462.

(*r*) See *Burgess* v. *Burgess*, 3 De G. M. & G. 896; 22 L. J. Ch. 675 (1853), L. JJ.; *Turton* v. *Turton*, 42 C. D. 128; 58 L. J. Ch. 677 (1889), C. A.; *Saunders* v. *Sun Life Assurance Co.*, (1894) 1 Ch. 537; 63 L. J. Ch. 247; *Jamieson* v. *Dublin Distillers Co.*, (1900) 1 Ir. R. 43. See below, pp. 500 *et seq.*

(*rr*) See *Cash* v. *Cash*, cited below, p. 508, and the judgment of Vaughan Williams, L. J., in *Jamieson* v. *Jamieson*, 15 R. P. C. p. 192.

might have been effected by using spurious trade-marks or other deceptive marks of origin or description upon the goods sold; but the mere imitation of a trade-mark, unless it happened to be a Sheffield cutler's mark (*s*), or the mere impression or use of a false mark, was not criminally punishable (*t*). The Committee of 1862, whose report has been already referred to (*u*), were assured by the witnesses called before them that false marking had become extremely prevalent, to the serious detriment of honest trading. Not only were the trade-marks of well-known English manufacturers frequently infringed at home and flagrantly copied abroad, so that the manufacturers both lost the custom of the buyers of the spuriously marked goods and suffered in reputation through the inferiority of the goods sold as theirs, but false marks of description, of length, quantity, material, make, and the like—what are now known as trade descriptions (*x*)—were applied to goods by unscrupulous traders with impunity. And the witnesses complained, with good reason, that the existing law was wholly inadequate to cope with these evils. Unfortunately, however, the Committee declined several drastic proposals for amendment, which were afterwards adopted with conspicuous success in the Merchandise Marks Act of 1887, as they refused to recommend the establishment of a register of trade-marks, and the Merchandise Marks Act of 1862, which was passed upon their report, was, it is believed, a dead letter from its first enactment. At any rate, when another Committee on merchandise marks were appointed, in 1887, complaints precisely similar to those made to the former Committee were urgently repeated to them.

The Merchandise Marks Act of 1862.

As the Act of 1862 was repealed by that of 1887, it is unnecessary here to summarize its clauses. In substance the offences created by it were very nearly the same as those existing under the later statute; but it was vitiated by defects which have now been removed, for, while it enacted that the forgery of a trade-mark with intent to defraud (*y*), or the false application of a trade-mark to goods (*y*), or to the

(*s*) See below, p. 643.
(*t*) See Book II., p. 563.
(*u*) Above, p. 6.
(*x*) Merchandise Marks Act, 1887, s. 3.
(*y*) Sect. 2.

envelope of goods (*z*), with the like intent, should be misdemeanours, it left the onus of proving the intent to defraud of the person charged upon the prosecutor, and it made no provision for the summary prosecution of these offences. The Act was also deficient in omitting to provide for the seizure of falsely marked goods upon importation from abroad (*a*), and it was, moreover, a monument of complicated and redundant drafting.

The International Convention.

In 1884 Great Britain acceded to the International Convention For The Protection Of Industrial Property, to which all important civilized States, except Germany, Austria and Russia, now belong (*b*), and thereby formally engaged to cooperate in the execution of the stipulations contained in the convention and protocol (*c*) agreed upon between the original parties thereto, at Paris, in the previous year. And by Article IX. of the convention it is provided that all goods illegally bearing a trade-mark or trade-name may be seized on importation into those States of the Union where the mark or name has a right to legal protection, and that the seizure shall be effected at the request of either the proper public department or of the interested party, pursuant to the internal legislation of each country. It became necessary, accordingly, to amend the law, and out of several Bills introduced into Parliament for this purpose, the Committee of the House of Commons selected and amended the Merchandise Marks Law Consolidation and Amendment Bill, which subsequently became the Merchandise Marks Act of 1887.

The Merchandise Marks Act of 1887.

The last-mentioned Act (*d*) provides that any person shall be guilty of an offence, punishable on indictment or on summary conviction by fine or imprisonment, who either (1) forges a trade-mark by making or imitating it without the consent of the proprietor, or by falsifying any genuine mark; or (2) falsely applies any trade-mark to goods, by applying it,

(*z*) Sect. 5.

(*a*) The Customs Act of 1876, s. 42, forbade the importation of articles of foreign manufacture bearing the names, marks, or brands of manufacturers resident in the United Kingdom, &c.

(*b*) See list, Appendix, p. 762.

(*c*) See Appendix, p. 764.

(*d*) See Book II., Chap. I., p. 554.

or an imitation of it, without the consent of the proprietor; or (3) applies to goods any false trade description, that is, a description or indication as to the number, quantity, measure, &c., or the place or country of origin of the goods, or the mode of manufacturing them, or their material, or as to their being the subject of an existing patent, privilege, or copyright, which is false in a material respect; or (4) sells or exposes, or has in his possession for sale, or any purpose of sale or manufacture, any goods to which a forged trade-mark or false trade description is applied, or to which any trade-mark, or imitation of a trade-mark, is falsely applied (*e*). A criminal intention on the part of the person charged is a necessary element of each of the above-mentioned offences (*f*); but the burden of proving that he has acted with the consent of the proprietor of the trade-mark, or without intent to defraud, or otherwise innocently, as also the burden of establishing any of the special excuses allowed by the Act, is cast upon the person charged as soon as it is established that he has done any of the acts which, coupled with such criminal intention and in the absence of these excuses, bring his case within the definition of an offence under the statute. The Act, moreover, forbids (*g*) the importation of goods by means of or in relation to which an offence against it has been committed, and also of all goods of foreign manufacture bearing any name or trade-mark being or purporting to be that of a manufacturer or trader within the country, unless it be accompanied by a definite indication of the country where the goods were made or produced. It contains also some special provisions with regard to the marking of watch cases.

The Act is directed only against false marking.

It will be seen, therefore, that the Act is directed against false marking only. Deceptive marks or deceptive trade descriptions are forbidden by it to be placed upon goods, but it does not operate to make marking of any kind com-

(*e*) Subsidiary offences, such as making dies for forging trade-marks, are here passed over.

(*f*) *Gridley* v. *Swinborne*, 52 J. P. 739, 791; 5 T. L. R. 71 (1888), Coleridge, L. C. J., and Grantham, J.; and see below, p. 603.

(*g*) Sect. 16, below, p. 624.

pulsory, and it does not extend to cases of verbal false descriptions (*h*).

The Merchandise Marks Act Committee of 1890.

The Act appears to have attained a considerable success, but it did not fully satisfy the trading community, and three years after its passing another Committee of the House of Commons were appointed to consider its working. And by their report (*i*) the Committee stated that, while there was a consensus of opinion that the Act of 1887 had generally been most beneficial to the manufacturing interests of the country, and that the importation of fraudulently marked goods, or of goods bearing a false indication of origin, had materially diminished since the Act came into operation, yet complaint had been made that its operation in regard to goods in transit to foreign States had occasioned serious inconvenience and loss to the shipping industries. This complaint, however, the Committee believed to be ill-founded, and they refused to recommend the exemption from the Act of the goods referred to.

The Custom House authorities have recently, however, by the Consolidated Instructions of 1900, given directions under which goods in transit, in the absence of information calling for their examination, will generally be allowed to pass without scrutiny (*k*).

The Committee also refused to accept either a proposal to increase the stringency of the Act by providing that all foreign goods should be marked with an indication of origin, or a proposal to relax it by allowing the general mark "made abroad" where the Act now requires the particular country of origin to be signified (*l*). On the other hand, with a view to stopping the importation of adulterated articles, which, if they bore no trade description at all, did not come under the Act, they recommended that the "Customs Entry" (*m*), in which both the description of goods imported and the port from which they come must be stated, should be made a "trade description" within the Act, and that, in cases affecting the general interest of the country, or of a section of the com-

The Merchandise Marks Act, 1891.

(*h*) Below, p. 571.
(*i*) M. M. A. Report, 1890.
(*k*) Para. 36, printed *post*, p. 825.
(*l*) See below, p. 631.
(*m*) See below, pp. 571, 583.

munity, or of a trade, prosecutions under the Act should be undertaken by the State. The Merchandise Marks Act of 1891 was passed to carry these proposals into effect. By an Act of 1894 the Board of Agriculture has been authorized to undertake prosecutions (*n*).

5. International and Colonial Arrangements.

A foreigner who is the owner of a trade-mark, acquired as such in England by use and consequent reputed connection with its owner, has always had the same right to protection in our Courts as a subject of the United Kingdom (*o*) (unless he happened to be an alien enemy), and neither the Registration Act of 1875 nor the Merchandise Marks Acts of 1862 or 1887 conferred any special privilege or right of protection for their trade-marks or trade-names upon subjects of this, as contrasted with subjects of other, States. Many treaties existed, moreover, by which this country agreed to give to the subjects of other countries the same right of protection in respect of their trade-marks as were enjoyed by its own subjects (*p*). On the other hand, when registration of the trade-mark concerned became, under the Acts of 1875 and 1883, in general, a condition precedent to the bringing of an action of infringement, as such (*q*), it was required in the case of foreign as well as of other plaintiffs, and the acquisition of a trade-mark abroad gave no title or right to priority of registration of a trade-mark in the English Register.

When the Act of 1883 was passed the International Convention (*r*), already referred to, had just been drawn up, and in contemplation of the accession of this country thereto, which took place in the following year (*s*), sect. 103 (*t*) was inserted, with the view, apparently, of fulfilling the obligations entered into by the United Kingdom with the other contracting States. The section, however, meets those obli-

(*n*) *Post*, p. 613.

(*o*) *The Collins Co.* v. *Reeves*, 28 L. J. Ch. 56 (1858), Stuart, V.-C.

(*p*) See a paper presented to Parliament, 1872. C. 633.

(*q*) Act of 1883, s. 77, Chap. XII., p. 312.

(*r*) See Appendix, p. 764.

(*s*) 17 March, 1884.

(*t*) See Chap. XX., p. 545.

gations but very imperfectly (*u*) and the bulk of its provisions are inapplicable to trade-marks. Its only substantial operation in regard to them, indeed, is to confer upon an applicant for the protection of a trade-mark, in one of the other contracting States, a priority over other applicants for registration here during the space of four months, without conferring any title to registration based upon the success of the application in the foreign State, or any exemption from the conditions and formalities to be fulfilled and complied with by ordinary applicants for registration here (*v*).

Her Majesty was empowered by sect. 104 of the Act of 1883, by Order in Council (*x*), to apply the provisions of the above-mentioned section, with such variations or additions as might seem fit, to any British possession (*y*).

The protection of the Merchandise Marks Act, 1887, referred to in the preceding section of this chapter, extends to any trade-mark which, either with or without registration, is protected by law in any British possession (*z*) or foreign State to which the provisions of the above-mentioned section (sect. 103) are, under Order in Council, for the time being applicable (*a*).

(*u*) See per Stirling, J., in *The Californian Fig Syrup Tm.*, 40 C. D. 620; 6 R. P. C. 126 (1888).

(*v*) See last case, and *Carter Medicine Co.'s Tm.*, (1892) 3 Ch. 472; 9 R. P. C. 401, North, J.

(*x*) See the list, Appendix, p. 762.

(*y*) See the definition in sect. 117.

(*z*) Below, p. 762.

(*a*) M. M. A. 1887, s. 3 (1), Book II., Chap. I., p. 560, "trade-mark."

CHAPTER II.

THE DEFINITION OF A TRADE-MARK.

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Definition.

A TRADE-MARK is a symbol (*a*) which is applied or attached to goods (*b*) offered for sale in the market (*c*), so as to distinguish them from similar goods, and to identify them with a particular trader (*d*) or with his successors as the owners of a particular business (*e*), as being made, worked upon, imported, selected, certified or sold (*f*) by him or them, or which has been properly registered under the Acts as the trade-mark of a particular trader (*g*).

It would, perhaps, have been clearer to have stated the definition in the following form: "A trade-mark is a symbol which is publicly used as the trade-mark of a particular trader, or is properly registered as such under the Acts," so as to lay stress upon the element of public user which creates the trade-mark, and to which registration is by statute to be deemed equivalent (*h*), and to have added a definition of public user to the effect suggested in the definition selected. It appears to be preferable, however, to cast the whole definition into one in order to avoid the inconvenience of importing into it a reference to the term defined.

The Registration Acts contain no definition;

The Registration Acts contain no definition of what is a trade-mark, though they do contain enumerations of the classes of symbols which are capable of registration under them as trade-marks (*i*). But trade-marks can still be

(*a*) Below, p. 28.
(*b*) Page 28.
(*c*) Page 32.
(*d*) Page 34.
(*e*) See Chap. XIII., Assignment and Devolution of Trade-Marks, p. 324: and *Pinto* v. *Badman*, 8 R. P. C. 181 (1891), per Fry, L. J.
(*f*) Page 52.
(*g*) Page 54; and see Chap. XII., Effect of Registration, p. 302. As to Cutlers' corporate marks, see Chap. VI., p. 101.

(*h*) Act of 1883, s. 75; Act of 1888, s. 17. See below, p. 54; and Chap. XII., Effect of Registration, p. 302.

(*i*) See Chap. VIII., "What marks may be registered," p. 115.

acquired by user independently of registration (*k*), so as not only to secure a certain measure of protection by the Courts in "passing-off" actions, but often to confer a preferential claim to registration, or to constitute an objection to the registration of newer marks for the same goods which bear too close a resemblance to them (*l*). Moreover, among the symbols admitted to registration under the Acts are "any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures, used as a trade-mark before the 13th day of August, 1875" (*m*), and questions still frequently arise as to whether old marks registered, or tendered for registration, under this provision, or the provisions to the like effect in the earlier Acts, were used as trade-marks or not. It is therefore necessary to consider what constituted a symbol to be a trade-mark apart from the Acts, and this is the more important because in making registration, or, more precisely, the application for registration, equivalent to public user of the trade-mark, the Acts have imported and adopted the old law determining what the public user of trade-marks is, and what are its effects.

but they import the old law.

The definitions of "mark" and "trade-mark," for the purposes of the Merchandise Marks Act, 1862 (*n*), embodied in that Act are in the following terms: "The word 'mark' shall include any name, signature, word, letter, device, emblem, figure, sign, seal, stamp, diagram, label, ticket or other mark of any other description; and the expression 'trade-mark' shall include any and every such name, signature, word, letter, device, emblem, figure, sign, seal, stamp, diagram, label, ticket or other mark as aforesaid, lawfully used by any person to denote any chattel, or (in Scotland) any article of trade, manufacture or merchandise, to be an article or thing of the manufacture, workmanship, production

Definitions in the Merchandise Marks Act of 1862.

(*k*) See below, pp. 316, 317.

(*l*) A trade-mark so acquired may, under some circumstances, be properly described as such without necessarily implying that it is registered. *Sen-Sen Co.* v. *Britten*, (1899) 1 Ch. 692; 16 R. P. C. 137,

Stirling, J.

(*m*) Act of 1888, s. 10, replacing sect. 64 of the Act of 1883, and corresponding to sect. 10 of the Act of 1875.

(*n*) 25 & 26 Vict. c. 88, s. 1.

or merchandise of such person, or to be an article or thing of any peculiar or particular description made or sold by such person, and shall also include any name, signature, word, letter, number, figure, mark or sign which, in pursuance of any statute or statutes for the time being in force relating to registered designs, is to be put or placed upon or attached to any chattel or article during the existence or continuance of any copyright or other sole right acquired under the provisions of such statutes or any of them."

The Merchandise Marks Act, 1887.

The Act of 1862 was repealed by the Merchandise Marks Act of 1887, which, without further defining "trade-mark," enacted that, for the purposes of the Act, the expression "trade-mark" should mean a trade-mark registered in the Register of trade-marks kept under the Patents, Designs, and Trade-Marks Act, 1883, and should include any trade-mark which, either with or without registration, is protected by law in any British possession or foreign State to which the provisions of the 103rd section of the Patents, &c. Act are, under Order in Council, for the time being applicable (*o*).

Judicial definitions.

Although the principles upon which the law of trade-marks rests have been often dwelt upon and explained in the judgments in the leading cases on the subject, many of which have been referred to in the previous chapter, yet judges have but seldom attempted to state precisely what a trade-mark is, and no formal definition is to be found in any reported judgment.

Lord Westbury.

In *The Leather Cloth Co.* v. *The American Leather Cloth Co.* (*p*), Lord Westbury said "the word 'trade-mark' is the designation of these marks or symbols, as and when applied to a vendible commodity, and the exclusive right to make such user or application is rightly called property."

Bacon, V.-C.

And in *Ford* v. *Foster* (*q*), Bacon, V.-C., described a trade-mark in the following terms: "The meaning and use of a trade-mark is that the same person dealing in goods, no matter of what kind, whether of his own manufacture or not, having a certain defined shape, if he stamps upon them some indication that that particular article is his and his only,

(*o*) Sect. 3 (1), below, p. 560.
(*p*) 4 De G. J. & S. p. 142; 33 L. J. Ch. 199 (1863).
(*q*) L. R. 7 Ch. p. 616 (1872).

may thereby acquire so far an exclusive right to it that no man may imitate his mark, and the legal right goes no further than that."

"User as a trade-mark," Kay, J., said, in *Richards* v. *Butcher* (*r*), "means, not what the person who uses has in his own mind about it, not what he has registered in a foreign country, but what the public would understand when the trade-mark, or so-called trade-mark, is impressed upon the goods, or upon some wrapper or case containing the goods, to be the trade-mark. That is the trade-mark proper; and user as a trade-mark means, and must necessarily mean, the impressing of those words either upon the goods, or upon some wrapper or case containing the goods, in such a way that the public would necessarily understand those words to be, and alone to be, the trade-mark of the person who uses them." And in the same case, on appeal, Lord Esher said: "You use the thing as a trade-mark if you use it in business, or, as is often said, in the market, as a mark to denote your goods, and to distinguish them from the goods of anyone else" (*s*). Kay, J., and Esher, M. R.

In *The Magnolia Metal Company's Trade-Marks* (*t*), Rigby, L. J., dealing with the case of a name, said: "In order that the name of an article may in any case be the trade-mark of the manufacturer, it is essential that the name should indicate, not the article only, but also that the article is manufactured by the person claiming it as a trade-mark, as distinguished from other persons also manufacturing or entitled to manufacture it." Rigby, L. J.

Object of trade-marks to protect trade.

The protection afforded to trade-marks has for its object the protection of trade only. In *Batt & Co.* v. *Dunnett*, Lord Halsbury, in the course of the argument, observed: "The Trade-Mark Acts are not for copyright in marks; they are to protect trade-marks. If you have no goods you are claiming copyright only, you are not claiming for the purpose of protecting your trade" (*u*).

(*r*) (1891) 2 Ch. p. 532; 8 R. P. C. 249 (*Monopole*).

(*s*) (1891) 2 Ch. p. 543.

(*t*) (1897) 2 Ch. p. 390; 14 R. P. C. p. 626.

(*u*) 16 R. P. C. p. 413 (1899).

A Symbol.

What symbols may be trade-marks.

Before the Trade-Marks Registration Act, 1875 (*x*), no restriction was placed upon the kind or class of symbols which, if adopted and used as a trade-mark, would be protected against infringement or piracy, except that the Courts refused to interfere where the symbols contained misrepresentation (*y*), or were, or were so used as to be, calculated to deceive, and they would, no doubt, if any case had occurred, have refused to interfere also where the symbols themselves were scandalous or indecent. The only general limit, therefore, put upon the choice of a trade-mark was that it should be capable of distinctive user in accordance with the terms of the definition (*z*).

Applied or attached to Goods (*a*).

It is immaterial whether the mark is attached to the goods or to the covering in which they are sold (*b*). It may be impressed, stamped, cut, drawn, painted or stained on the goods themselves, as the words *Sykes' Patent* were in *Sykes* v. *Sykes* (*c*), or on their envelope, as are labels on bottles and brands on corks, or in any other way attached to the goods—for instance, by being marked upon tallies (*d*) tied on to them, or upon reels upon which the goods are wound, or on

The mark must go to market with the goods;

a card to which the goods are fastened (*e*). All that is necessary is that there shall be some physical connection between the goods and the mark, so that the mark shall go with the goods into market (*f*). A device is not a trade-

(*x*) Sect. 10, replaced by sect. 64 of the Act of 1883, and now by sect. 10 of the Act of 1888.

(*y*) See below, pp. 397 *et seq.*

(*z*) See below, p. 34.

(*a*) See the *dicta* quoted above, pp. 26 and 27, and below, p. 189.

(*b*) *Singer Manufacturing Co.* v. *Wilson*, 2 C. D. p. 441, Jessel, M. R., and pp. 451, 455, James and Mellish, L. JJ.; 45 L. J. Ch. pp. 491, 496, 497 (1876).

(*c*) 3 B. & C. 541; 3 L. J. K. B. o. s. 46 (1824).

(*d*) *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185 (1863), Westbury, L. C.

(*e*) Cf. *Chameleon Patents Manufacturing Co.* v. *Marshalls, Ld.*, 17 R. P. C. 527 (1900), Kekewich, J., a passing-off case, where it was held that by such means a defendant might represent his goods to be those of the plaintiff.

(*f*) See *Powell's Tm.*, (1893) 2 Ch.

mark unless it is so applied or attached, although it may be used by a trader in his advertisements, price lists, or trade circulars, so as to become commonly associated with him and his goods, as, for instance, lithographs of Millais' picture "Bubbles" are associated with Pears' Soap.

Thus, in *Thompson* v. *Montgomery* (*g*), the ale of the plaintiffs had been known for many years as *Stone Ale*, and there was evidence that that name had been used in ordering goods from them, and in selling goods to their customers, as a description of the ale, or of a particular class of ale made by them. Beyond this there was no evidence of the use of the name as a trade-mark, and the Court of Appeal accordingly held that the words had been wrongly claimed as a trade-mark in use before 1875, and ordered them to be removed from the register. So in *Powell's Case* (*h*) it was decided that the use of the words *Yorkshire Relish* upon the rough packing cases in which the bottles of sauce were placed for safe carriage was not, under the circumstances of the case, use of the words as a trade-mark. "The function of a trade-mark," Bowen, L. J., said (*i*), "is to give an indication to the purchaser or possible purchaser as to the manufacture or quality of the goods—to give an indication to his eye of the trade source from which the goods come, or the trade hands through which they pass on their way to the market. Accordingly, it may either be marked on the goods themselves, or, if that is not possible or convenient, it may be marked on the vehicle of the goods, and may be, and sometimes, I dare say, is, marked upon a covering or exterior, such as a packing case. But when you are considering a mark upon the vehicle as distinct from a mark upon the goods, you must ask yourself carefully, Is this mark used as

388, (1894) A. C. 8; 10 R. P. C. 63, 195; 11 R. P. C. 4. (*Yorkshire Relish.*)

(*g*) 41 C. D. 45; 6 R. P. C. 404 (1889). There was no appeal upon this point to the House of Lords. An injunction was granted notwithstanding the removal of the mark.

(*h*) Note (*f*); cf. *Richards* v. *Butcher*, (1891) 2 Ch. 522; 8 R. P. C. 249, Kay, J., and C. A., *Monopole* used on packing cases and wine corks, and *Day* v. *Riley and Whittaker*, 17 R. P. C. 517, Buckley, J., *Day & Sons' Black Drink* stencilled on packing cases.

(*i*) (1893) 2 Ch. p. 404.

and must sell the goods.

a trade-mark?" And the test to be applied was otherwise stated in the same case to be the question, Does the alleged trade-mark sell the goods?

Use on corks.

The question whether stamping a mark on the corks of wine bottles at the sides or ends where it cannot be seen is user of it as a trade-mark has been discussed (*k*) but not decided. It is submitted that it may be if, in fact, the known presence of the mark, or the expectation of finding it, induces the customer to buy the wine as that of the proprietor of the mark.

Trade-mark rights are restricted to the class of goods for which the mark is used.

The exclusive rights existing in respect of a trade-mark are restricted to the class of goods to which it has been attached or applied (*l*). It is, therefore, no infringement to apply the same or a similar mark to other goods. This rule was clearly stated in a dictum of Lord Westbury, in the *Leather Cloth Case*, which has often been cited. "Property in a trade-mark," he said, "is . . . . the right to the exclusive use of some mark, name, or symbol in connection with a particular manufacture or vendible commodity; consequently, the use of the same mark in connection with a different article is not an infringement of such right of property" (*m*). Thus, a trade-mark used for carriages might be adopted as a new trade-mark for woollen goods (*n*).

So no one can acquire an exclusive right to affix the trade-mark to goods which do not fall within the class indicated by the mark, or, in other words, to goods which do not possess the attribute the mark is understood and intended to connote. Thus, in *Cotton* v. *Gillard* (*o*), the defendant had invented a

(*k*) *Kinahan & Co.'s Application*, 10 R. P. C. 393 (1893), Chitty, J.; *Richards* v. *Butcher*, (1891) 2 Ch. 522; 8 R. P. C. 249, Kay, J., and C. A. Marks so used were protected in *Moet* v. *Clyboue*, Seb. Dig. p. 316 (1877), Jessel, M. R.; and *Moet* v. *Pickering*, 8 C. D. 372; 47 L. J. Ch. 527 (1878), C. A.

(*l*) *Somerville* v. *Schembri*, 12 App. Ca. 453; 4 R. P. C. 179 (1887), on appeal from Malta; and see *Coleman* v. *Brown*, 16 R. P. C. 619 (1899). As to registered trade-marks, see below, pp. 307, 366.

(*m*) 4 De G. J. & S. 137; 33 L. J. Ch. p. 201 (1863).

(*n*) Per Jessel, M. R., in *Singer Manufacturing Co.* v. *Wilson*, 2 C. D. p. 443; 45 L. J. Ch. 494 (1876). And see Chap. XV., on Infringement, below, p. 366. Cf. *The Australian Wire Importers' Tm.*, 41 C. D. 278; 6 R. P. C. 311, cited p. 217.

(*o*) 44 L. J. Ch. 90 (1874). So a trade-mark cannot be separated

sauce which was prepared from a secret recipe not known to the plaintiff, and was called the *Licensed Victuallers' Relish*. The plaintiff had purchased from the assignee in bankruptcy of the defendant's son all his interest in the sauce, and this, he contended, included the right to the trade-mark used with the business. Jessel, M. R., however, held that this right could not exist or be transferred without the goods with which the mark was connected, and that the plaintiff could have no assistance from the Court to enable him to pass off under the mark, as the original sauce, an imitation of his own (*p*).

The use of trade-mark on other goods not protected.

Of course, the extent of the class of goods to which a trade-mark is properly applicable will vary very much in different cases. If the mark means that the goods are made by its owner, then it will not rightly be applicable to goods which he has bought to resell, and on the principle of the case just cited it would seem that if, in such a case, the owner were to give up manufacturing he would lose his trade-mark, although he commenced to deal as a merchant in the same goods (*q*). If, again, the mark means that the goods are selected, shipped, or sold by the owner, then, probably, it may be rightly applicable to many different kinds of goods, and to kinds which may vary, and perhaps very widely, from time to time (*r*).

It is clear, however, that the rights arising out of the possession of a trade-mark, registered or unregistered, are not limited to the exact kinds of goods for which the mark has been used; actions for infringement of a registered trade-mark are by virtue of sect. 77 limited to the goods for which the mark is registered, but, subject to that limitation, the extent of the goods to which the rights are limited is a question of fact in each case, depending to a great extent on the commercial connection between the kinds of goods in question, as, for instance, whether they are usually sold by the same class of persons (*s*).

from the goodwill of the business to which it has been attached; see below, pp. 324 and 343.

(*p*) Cf. *Birmingham Vinegar Brewery Co., Ld.* v. *Powell*, (1897) A. C. 710; 14 R. P. C. 720.

(*q*) See below, p. 52.

(*r*) Below, p. 52; and see Chap. XII., p. 302, Effect of Registration.

(*s*) *Australian Wine Importers' Tm.*,

Anyone may apply the mark to the right goods.

As the mark must not be applied to the wrong goods, so, on the other hand, it may be applied by anyone to the right goods. Thus, in *Farina* v. *Silverlock* (*ss*), Lord Cranworth refused an injunction to restrain the defendant, a printer, from printing labels in imitation of the labels on the plaintiff's Eau de Cologne, on the ground that the labels might be intended to be placed upon scent which had actually come from the plaintiff (*t*). And the test of infringement laid down in all the cases is that the defendant's acts shall be calculated to pass off goods as the plaintiff's which are not his (*u*); and that is all that an ordinary form of the injunction granted in trade-mark cases restrains (*x*).

Offered for Sale in the Market.

The mark must be applied to goo is offered for sale.

An allegation that the plaintiff's goods were sold with the trade-mark attached, and that they enjoyed a great reputation, was regularly inserted in the declaration in the old common law action for infringement (*y*). And in *Lawson* v. *The Bank of London* (*z*), an action to restrain the defendants from usurping the name of the plaintiff's bank, a demurrer was allowed because the declaration did not allege that the plaintiff had carried on business as a banker, but only that he had expended money in advertisements. "No action could, I apprehend," said Willes, J., in that case, "be maintained for the sale of goods branded or stamped with another manufacturer's mark, which mark had never been put forward to the world by the party complaining of the misuser of it."

41 Ch. D. 278; 6 R. P. C. 311 (1889), C. A.; and *Eastman Photographic Materials Co., Ld.* v. *John Griffiths Cycle Corporation, Ld.*, 15 R. P. C. 105 (1898), Romer, J.; and see below, Chap. X., p. 237.

(*ss*) 1 K. & J. 509; 6 De G. M. & G. 214; 24 L. J. Ch. 632; 26 L. J. Ch. 11 (1855).

(*t*) The plaintiff was given liberty to try this question at law, and the bill was retained for a year. He succeeded in his action at law, and was subsequently granted an injunction in equity, 4 K. & J. 650, Wood, V.-C.; 30 L. T. 242; 31 L. T. 99.

(*u*) See below, p. 373.

(*x*) See per Cotton, L. J., in *Thompson* v. *Montgomery*, 41 C. D. p. 48, 6 R. P. C. 213 (1889); and see the judgment of Lord Halsbury, L. C., in *Reddaway* v. *Banham*, (1896) A. C. p. 207; 13 R. P. C. p. 225.

(*y*) See *Sykes* v. *Sykes*, 3 B. & C. 541; 3 L. J. K. B. o. s. 46 (1824); above, p. 3.

(*z*) 18 C. B. 84; 25 L. J. C. P. 188 (1856).

This dictum was cited with approval by Lord Cairns, in *Maxwell* v. *Hogg* (*a*). In that case the defendant registered at Stationers' Hall the word *Belgravia* as the name of an intended new magazine, in the year 1863. In 1866 the plaintiff began to advertise a different intended new magazine under the same name. The defendant thereupon hurriedly brought out a number of his magazine in September, 1866, and the plaintiff followed in October, and cross suits were then brought by each to restrain the other from using the name. Both suits failed. The plaintiff's was dismissed because his advertisements and expenditure gave him no title to the name before the defendant's first number appeared, and the defendant's because of his uncandid conduct in rushing forward his magazine, knowing of the plaintiff's undertaking, without giving him warning. That the trader's goods should have acquired any reputation for special excellence or quality in order that his mark should be protected, was, however, Lord Cairns declared, unnecessary; but, he said (*b*), all the definitions of trade-mark rights given in Equity, "seem to me to be opposed to the idea that protection can be given where there has been no sale or offering for sale of the articles to which the name is to be attached." According to the decisions, he added, no property in a name (or mark) could be acquired except through the process of sale or offering for sale in the market.

And the second of the "essential qualities for constituting property in a trade-mark" enumerated by Lord Westbury in *McAndrew* v. *Bassett* (*c*), was that the article marked with the mark in question was actually a vendible article in the market (*d*).

Long user of mark or proof of actual reputation unnecessary.

It is not, however, necessary that the goods should be in the market with the mark affixed for any definite or any considerable time. Thus it was no objection to the defen-

(*a*) L. R. 2 Ch. 307; 36 L. J. Ch. 433 (1867).

(*b*) L. R. 2 Ch. p. 314; 36 L. J. Ch. p. 436.

(*c*) 4 De G. J. & S. 380; 33 L. J. Ch. 561 (1864), (*Anatolia liquorice*).

(*d*) See also *Powell's Tm.*, (1893) 2 Ch. 388; 10 R. P. C. 63, 195, cited above, p. 29; and the observations of Halsbury, L. C., in *Batt & Co.* v. *Dunnett* (1899), 16 R. P. C. p. 413, cited *supra*, p. 27.

dant's counterclaim in *Maxwell* v. *Hogg* (*e*), that he had brought out but one number of his magazine, and that only a few days before the plaintiff's issue appeared; and in the same case, as already stated, Lord Cairns decided that reputation for quality was immaterial for the acquisition of the legal right (*f*).

Nor is it essential that the significance of the mark should be proved to have become known to any ascertained person or persons. It is sufficient, subject now to the provisions of the Acts in regard to registration, to entitle a trader to protection for his mark that he has offered goods for sale with the mark so attached that it will, when known, indicate his connection with the goods. It would be an insoluble inquiry, as Lord Romilly declared in *Hall* v. *Barrows* (*g*), to seek to discover when first a mark acquired a distinctive character in the market as denoting the goods of the trader who first used it.

So as to distinguish the Goods from similar Goods, and to identify them with a particular Trader.

Mark must be distinctive.

That it is of the essence of a trade-mark that it should have this distinguishing character, is fully established by the statements of the principles upon which the law of trade-marks rests, stated in the last chapter, and the *dicta* quoted at the beginning of this chapter. The rule is further illustrated by the question, which has always been regarded as the test of infringement: Will the use of the trade-mark by the defendant lead purchasers to mistake his goods for those of the plaintiff? (*h*).

(*e*) L. R. 2 Ch. 307 (1867); 36 L. J. Ch. 433.

(*f*) So it is unnecessary for the plaintiff in an infringement action to allege that the defendant is selling inferior goods under his mark: *Blofield* v. *Payne*, 4 B. & Ad. 410; 2 L. J. K. B. 68 (1833); *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185 (1863), Lord Westbury, L. C.

(*g*) 32 L. J. Ch. p. 551 (1863); and see per Wood, V.-C., in *McAndrew* v. *Bassett*, 33 L. J. Ch. 561 (1864).

(*h*) See per Ld. Westbury in *Hall* v. *Barrows*, 4 De G. J. & S. 150; 33 L. J. Ch. p. 208 (1863); and in *Leather Cloth Co.* v. *American Leather Cloth Co.*, 4 De G. J. & S. 137; 33 L. J. Ch. 199 (1863), and per Ld. Blackburn in *Orr-Ewing* v. *The Registrar of Trade Marks*, 4 App. Ca. p. 494, 48 L. J. Ch. 715 (1879).

"The right which a manufacturer has in his trade-mark," Lord Cranworth said, in the *Leather Cloth Case* (*i*), "is the exclusive right to use it for the purpose of indicating where, or by whom, or at what manufactory the article to which it is affixed was manufactured." And the same judge, in *Farina* v. *Silverlock* (*k*), after distinguishing copyright from the right to a trade-mark, added, "anyone who has acquired a particular mode of designating his particular manufacture, has a right to say, not that other persons shall not sell exactly the same article, better or worse, or an article looking exactly like it, but that they may not so sell it as to steal the plaintiff's trade-mark, and make purchasers believe it is the manufacture of somebody else." And in *Massam* v. *Thorley's Cattle Food Co.* (*l*), James, L. J., said, "That in truth is the meaning and object and result of a trade-mark. It indicates this, that you may take this as a warranty that it has come from the particular manufacturer of the goods with which you have been hitherto pleased" (*m*).

Not necessary that public should know the name of the owner of the mark.

But it is not necessary that the public should know the name of the trader who uses the trade-mark. In *Powell* v. *The Birmingham Vinegar Brewery Co., Ld.*, there was evidence that many purchasers of "Yorkshire Relish" knew nothing of the plaintiffs, but in reference to this Lord Herschell said, "in the present case, it seems to me that 'Yorkshire Relish' means the manufacture of a particular person. I do not mean that in the minds of the public the name of the manufacturer was identified, but that it meant a particular manufacture, and that when a person sold 'Yorkshire Relish' as the appellants did, by selling it as 'Yorkshire Relish' and calling it 'Yorkshire Relish,' they represented to the public that it was that manufacture which was known as and by the name of 'Yorkshire Relish'" (*n*).

A provision in the Registration Acts allows any "special

(*i*) 11 H. L. C. 523; 35 L. J. Ch. p. 57 (1865).

(*k*) 6 De G. M. & G. 214; 26 L. J. Ch. p. 12 (1855).

(*l*) 14 Ch. D. 748; 42 L. T. N. S. 851.

(*m*) See also the passage from the judgment of Rigby, L. J., in *Magnolia Metal Co.'s Tms.*, (1897) 2 Ch. p. 390; 14 R. P. C. p. 626, cited *supra*, p. 27.

(*n*) (1897) A. C. p. 715: 14 R. P. C. p. 730.

and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures, used as a trade-mark before the commencement of the Act of 1875," to be registered as a trade-mark (*o*); and it has been held that the qualification "special and distinctive" does no more than embody the requirements of the existing law in regard to what were or might be trade-marks (*p*).

A name or device, therefore, which is merely descriptive of the goods themselves or of some quality or attribute which they possess, or are supposed to possess, or which is common to the trade (*q*), cannot be a trade-mark. And it follows that marks which were once distinctive may have fallen into one of these groups, and so ceased to be available as trade-marks.

What are distinctive marks.

The element of distinctiveness is essential in any mark which is to be registered as a trade-mark under the Acts, and its characteristics as established and illustrated by judicial decisions will be considered in a later chapter (*r*); but it will be convenient here to state in outline the leading cases in which this branch of trade-mark law has been discussed, apart from the operation of the Acts, since these cases are still frequently referred to, and turn upon principles of general application.

Descriptive marks, and marks apparently descriptive, but having a secondary distinctive meaning.

The question whether a mark is merely descriptive can hardly arise except with regard to word-marks (*s*). It may be stated in either of the following forms: Do the words which are claimed as a trade-mark (or trade-name, for the same principles apply to both) merely denote the goods, or have they a secondary meaning connoting a connection with the persons who claim them as a trade-mark? or, Are the words the known description of all goods of the class by whomsoever they are made or sold, or only of the species within it which are made or sold by those particular manufacturers or traders?

The question arose as early as the case of *Millington* v.

(*o*) As to what marks come within the proviso, see Chap. VIII., p. 184, below.

(*p*) *Hopkinson's Tm.*, (1892) 2 Ch. 116; 9 R. P. C. 102, Kekewich, J.

(*q*) As to marks common to the trade, see below, pp. 135 and 204.

(*r*) Chap. VIII., p. 132.

(*s*) As to pictures of the goods, see *James' Tm.*, 33 C. D. 392; 3 R. P. C. 340 (1886), C. A. (*Dome Black Lead*), and below, p. 145.

Fox (*t*). There the plaintiffs sued the defendants for infringing their trade-marks consisting of the words *Crowley Millington*, or one of them, and certain marks which they and their predecessors had used as brands on steel since the seventeenth century; the defendants alleged that both *Crowley* and *Millington* were technical terms understood in the market to mean steel shaped in a particular way, and this would have been a good defence had the evidence been sufficient to support it.

The name of a new pattern. *Ford* v. *Foster*.

In *Ford* v. *Foster* (*u*) the plaintiff sought to restrain the defendants from placing the word *Eureka* upon shirts of the defendants' manufacture. The plaintiff had introduced into the market shirts of a certain shape, which he sold as *Ford's Eureka Shirts*, and the defendants alleged that the word in question was the known description of shirts of that particular shape. They were at liberty to make and sell the shirts, and consequently, they urged, to use the name also. Bacon, V.-C., was in favour of the defendants upon the evidence as to this, but he decided the case on the ground that the word *Eureka* was only part of the plaintiff's trade-mark, and that he had no right to its exclusive use. The plaintiff appealed, and the decision was reversed, the Lords Justices finding that retail buyers would be led to believe by the use of the word that the goods were goods made by the plaintiff. The test whether a name has become *publici juris*, said (*x*) Mellish, L. J., must be "whether the use of it by other persons may still have the effect of inducing the public to buy goods not made by the original owner of the trade-mark as if they were his goods." If not, he added, "however hard, to some extent, it may appear on the trader, yet practically, as the right to a trade-mark is simply a right to prevent the trader from being cheated by other persons' goods being sold as his goods through the fraudulent use of the trade-mark, the right to the trade-mark must be gone." An injunction was accordingly granted to restrain the defendants from applying

Test whether a trade-mark has become *publici juris*.

(*t*) 3 My. & Cr. 338 (1838), Cottenham, L. C.

(*u*) L. R. 7 Ch. 611 (1872); 41 L. J. Ch. 682.

(*x*) At page 628. See also *Whitstable Oyster Fishery Co.* v. *Hayling Fisheries, Ld.*, 17 R. P. C. 161 (1900), Buckley, J.

the mark *Eureka* to any shirts not manufactured by the plaintiff (*y*); but the defendants were left at liberty to advertise the name between themselves and the trade, as the Court thought that in the trade the name had the meaning contended for by them, and that the use of it in the manner stated could not lead to deception.

The *Singer* cases.

Singer v. *Wilson.*

The most important of the earlier cases on the subject are two cases in which the Singer Manufacturing Co. sought to maintain a monopoly in the use of the name *Singer* for sewing machines manufactured by them. The cases were, in fact, trade-name not trade-mark cases, but the principles upon which they proceeded, and the judgments delivered in them, are equally applicable to both marks and names. The plaintiffs were an American company carrying on a business, originally founded by one J. M. Singer, in sewing machines which they and their predecessors had extensively advertised under the name in question, and they alleged that their machines were not of any particular type which was known as the *Singer Machine*, but were of many varieties, some of which had specific names appropriated to them. They were accustomed to place a distinctive trade-mark, comprising their name and a particular device, upon each of their machines, but it was not alleged in either case that the defendant had infringed this trade-mark. The defendant in the first case (*z*) had issued advertisements and price lists in which he professed to sell *Singer* and *New Singer* machines, but in which he described them as manufactured by himself. He had not infringed the plaintiff's distinctive trade-mark. For the defence it was alleged that the name *Singer* meant one of two particular types of machine, that it had come to be like *Hansom* and *Brougham*, the "name of the article, and not a mark or sign indicating the manufacturer" (*a*). The case took a somewhat unusual course. It was dismissed by Jessel, M. R., without the defendant having been called upon, and this decision was

(*y*) For form of injunction, see L. R. 7 Ch. p. 634; Appendix, p. 750.

(*z*) *Singer Manufacturing Co.* v. *Wilson*, 2 C. D. 434; 45 L. J. Ch. 490 (1875); 3 App. Ca. 376; 47 L. J. Ch. 481 (1877). See also the Scotch case of *Singer Manufacturing Co.* v. *Kimball*, 11 Court of Sess. Cas. 3rd series, 267, where an injunction was granted. See below, p. 40, note (*h*).

(*a*) Per Lord Cairns, 3 App. Ca. p. 385; 47 L. J. Ch. p. 485.

upheld by the Court of Appeal, but reversed by the House of Lords, the House deciding that, upon the evidence of the plaintiffs, an answer was called for, and that, therefore, the defendant ought to be required to prove the allegation on which he relied (*b*).

In non-suiting the plaintiffs, Jessel, M. R., proceeded on the ground that as the word *Singer* was not attached to the goods it was not a trade-mark, and that the plaintiffs could, therefore, only succeed by making out a case of fraudulent representation (*c*). The representations made in the defendant's price lists and advertisements were, he held, incapable of misleading anyone as to the origin of the machines. The Court of Appeal took the same view of the representations, and relied chiefly on that in upholding the decision. In the House of Lords, Lord Cairns said the question must be, "Are the advertisements of the defendant, having regard to the evidence in the case, calculated to mislead an unwary purchaser of the machines?" And this question might still be answered affirmatively, he thought, although when the advertisements came to be spelt out with care, there was no actual representation on them that the goods they referred to were made by the plaintiffs. And he rejected the distinction suggested by Jessel, M. R., between cases where a trade-mark used on the goods was infringed, and cases where the name by which the goods were advertised and known was pirated. Fraud, or intent to deceive, need not, he said, be alleged or proved in either case (*d*). The other law lords agreed that the plaintiffs had made out a case to show that the defendant's advertisements might lead to his goods being bought as and for theirs, and that, therefore, the defendant ought to have been called upon to displace this case, or to establish by evidence his own contention as to the meaning of *Singer*. The case was sent down for a new trial, but there is no further report of it.

Singer v. *Loog*.

Many of the same questions were discussed again in the case of the *Singer Manufacturing Co.* v. *Loog* (*e*). There the

(*b*) The case does not appear to have been carried any further.

(*c*) See above, p. 13, where the judgment is quoted at length.

(*d*) 3 App. Ca. p. 391; 47 L. J. Ch. p. 488; and see above, p. 14.

(*e*) 18 C. D. 395 (1879); 8 App. Ca. 15; 52 L. J. Ch. 431 (1882).

defendant had placed upon the machines which he sold a plate marked *Singer machine*, but bearing also words referring to the foreign makers of the goods. This plate he offered to abandon, but he claimed the right to use the word *Singer* to describe his machines. He did not, in fact, call his machines *Singers*, but advertised them as *our Singer machines*, and as machines made on the *Singer system*. Both the Court of Appeal and the House of Lords, reversing the judgment of Bacon, V.-C., decided that the documents issued by the defendant were not calculated to deceive, and the action consequently failed. The question as to the secondary meaning of the word *Singer* did not, therefore, call for decision (*f*); but it was agreed by all the judges, and was admitted by the plaintiffs themselves, that they could claim no exclusive use of the word if the defendant could show that the article in question was a specific article known by a specific name, and that, as in the case of the Wellington boots and Hansom cabs, he was unable to designate the article in any other way than by its known name (*g*). Lord Selborne, however, found as a fact that the term *Singer* did signify a system of construction for sewing machines known to the trade (*h*).

No monopoly can be maintained in the reputation of goods which anyone may make and sell.

The obvious intention of the plaintiffs in both these cases was to monopolise, if possible, the reputation gained by the machines which they had been the first to introduce into the market by preventing other traders from using the name by which the machines were known, and this they were not allowed to do. "The reputation acquired by machines of a particular form or construction," said Lord Selborne (*i*), "is one thing; the reputation of the plaintiffs is another. If the defendant has no right under colour of the former to invade the latter, neither have the plaintiffs any right under colour of the latter to claim (in effect) a monopoly of the

(*f*) 18 C. D. p. 419.

(*g*) 18 C. D. p. 398.

(*h*) The question of fact is now settled by *The Singer Manufacturing Co.* v. *Spence & Co.*, 10 R. P. C. 297 (1893), where it was admitted that to an inner ring of the trade *Singer* means a system of manufacture; but Romer, J., found it means the plaintiffs' manufacture, to a large part of the public.

(*i*) 8 App. Ca. p. 27; 52 L. J. Ch. p. 487; see also *Leonard and Ellis' Tm.*, 26 C. D. p. 297; 53 L. J. Ch. 603 (1884), C. A.

former. If the defendant has (and it is not denied that he has) a right to make and sell, in competition with the plaintiffs, articles similar in form and construction to those made and sold by the plaintiffs, he must also have a right to say that he does so, and to employ for that purpose the terminology common to the trade, provided always that he does this in a fair, distinct, and unequivocal way."

The Liebig's Extract Case (*k*) affords a good example of a name which was held to be merely the name of the goods, common to all the world, and subject to no monopoly rights. There Baron Liebig, the inventor of the process by which the extract was prepared, had purported to confer upon the plaintiffs an exclusive right to use his name in connection with the goods, and they sought to restrain the defendant from using the words *Liebig's Extract*. The process of manufacture had, however, been long published and largely employed, and the goods were commonly known by the name in question. The injunction was accordingly refused (*l*).

Secondary meaning of words originally common.

On the other hand, a striking example of words, which in their primary meaning were purely descriptive, acquiring a secondary meaning—namely, that the goods described by them were the manufacture of a particular company—is afforded by the case of *Reddaway* v. *Banham* (*m*). The plaintiffs in that case had for many years made belting, consisting mainly of camel-hair, for machinery, and sold it under the name *Camel-hair Belting*. The defendants, who had sold similar belting under other names, commenced to sell it under the name *Camel-hair Belting*, and in most cases put that name only on the belting. The plaintiffs commenced an action for an injunction to restrain the defendants from using the word *camel* in such a manner as to pass off their goods as and for the plaintiffs' goods. The jury found (1) that *Camel-hair Belting* meant belting made

(*k*) *Liebig's Extract of Meat Co.* v. *Hanbury*, 17 L. T. N. S. 298 (1867), Wood, V.-C.; *Id.* v. *Anderson*, 55 L. T. 206 (1884), Chitty, J.

(*l*) In *Liebig's Extract of Meat Co., Ld.* v. *Chemists' Co-operative Society, Ld.* (1896), 13 R. P. C. 635, 736, it was held, by Kekewich, J., to be proved that the plaintiffs' goods were known as "Liebig Company's Extract of Meat" or "The Company's Extract of Meat."

(*m*) (1896) A. C. 199; 13 R. P. C. 218.

by the plaintiffs as distinct from belting made by other manufacturers, and that it did not mean belting of a particular kind without reference to any particular manufacturer; they also found that the description was likely to mislead purchasers, and that the defendants had endeavoured to pass off their goods as the plaintiffs' goods. In spite of these findings, it was held by the Court of Appeal that *Camel-hair Belting* was a true description of the defendants' goods, and that they could not be restrained from using it, and the Court dissolved the injunction granted by Collins, J.; the House of Lords, however, reversed the judgment of the Court of Appeal. In Lord Herschell's judgment the following passages occur: "The name of a person, or words forming part of the common stock of language, may become so far associated with the goods of a particular maker that it is capable of proof that the use of them by themselves, without explanation or qualification, by another manufacturer, would deceive a purchaser into the belief that he was getting the goods of A. when he was really getting the goods of B" (*mm*). And, replying to the argument that the defendants had only used a true description of their goods, he said, "I think the fallacy lies in overlooking the fact that a word may acquire in a trade a secondary signification differing from its primary one, and that if it is used, to persons in the trade who will understand it, and be known and intended to understand it, in its secondary sense, it will none the less be a falsehood because in its primary sense it may be true" (*n*).

In *The Cellular Clothing Company* v. *Maxton & Murray* (*o*), it was, however, pointed out that such a case as the *Camel-hair Belting Case* was difficult to establish, and the House of Lords held that the plaintiffs in the *Cellular Case* had failed to prove that the word *Cellular* had the secondary meaning of identifying goods so described with the plaintiffs (*p*).

(*mm*) (1896) A. C. p. 210; 13 R. P. C. 228.

(*n*) (1896) A. C. p. 212; 13 R. P. C. p. 229.

(*o*) (1899) A. C. 326; 16 R. P. C. 397. See also *Parsons* v. *Gillespie*, (1898) A. C. 239; 15 R. P. C. 67.

(*p*) And see the judgment of Cozens-Hardy, J., in *Wolff* v. *Nopitsch*, 17 R. P. C. at p. 330; and the Scotch case, *John Dewar & Sons* v. *J. H.*

Name of goods made under an expired patent.

Where an article has been introduced as new and has been first manufactured under a patent, the name by which it is known becomes common property so soon as the expiration of the patent right puts an end to the monopoly in the manufacture and sale of the article; and, although the name may have, down to that time, identified the goods with the maker of them, it is no longer available for him as a trade-mark or trade-name.

On this subject, Lord Herschell's Committee said in their report (*q*): "It has been suggested that there is a necessity for some statutory definition of the trade-mark rights which are acquired in connection with words used as the names of patented articles. Where a patent has been obtained for some article of commerce, and the patentee gives it a name which he registers as his trade-mark, has he a right, at the end of the term of his patent, to prevent other people from selling it under that name? It is clear that he obtains the patent upon the condition that, at the expiration of the term of his monopoly, the public shall have the right to manufacture and use it; and if the only name by which it is known is that which the proprietor has registered as a trade-mark, it would certainly seem inconsistent with the right thus intended to be conferred on the public, if everyone, except the original patentee, were prevented from calling it or selling it by that name which alone it bears. The authorities appear, however, to show that such a claim could not be maintained."

The cases of *The Wheeler and Wilson Manufacturing Co.* v. *Shakespear* (*r*) and *The Linoleum Manufacturing Co.* v. *Nairn* (*s*) are the leading authorities on this head. In the former case, the plaintiffs were manufacturers of sewing machines made according to an expired patent, and in the manufacture, therefore, they had no monopoly. The defendant advertised himself as the "agent for the sale of the

Dewar, 17 R. P. C. 341, at p. 353, Inner House, First Division; and as to names obtaining a secondary meaning, see Chap. XVI., pp. 500 *et seq.*

(*q*) Report of 1883, p. xiv.

(*r*) 39 L. J. Ch. 36 (1870), James, V.-C.

(*s*) 7 C. D. 834; 47 L. J. Ch. 430 (1878), Fry, J.

Wheeler-Wilson machine" in Birmingham, although he was not the plaintiffs' agent, and was not selling machines made by them. He alleged that his advertisement meant only that he sold the machines. The Court, while restraining him from advertising himself as agent, refused to restrain him from describing the machines he sold as *Wheeler and Wilson's*. It was not, said James, V.-C., the name of the makers but of the thing itself, and the monopoly under the expired patent could not be prolonged by granting a monopoly in the name.

The name given to a new article cannot be monopolized. *The Linoleum Case.*

In *The Linoleum Case* (*ss*), the plaintiffs used a trade-mark containing the word *Linoleum* for a floor-cloth which had been first manufactured and sold by them under a patent, and they unsuccessfully endeavoured to restrain the defendants from selling similar cloth as *Linoleum Floor Cloth* after the patent had expired. Fry, J., found as a fact that the word *Linoleum*, which was taken by the defendants, was not an essential part of the plaintiffs' trade-mark, but was descriptive only. It was, he said, the name of the thing, and the defendants were not bound to invent a new name for it if they made it. The name, he added (*t*), "only secondarily means the manufacture of the plaintiffs, and has that meaning only so long as the plaintiffs are the sole manufacturers. In my opinion, it would be extremely difficult for a person who has been, by right of some monopoly, the sole manufacturer of a new article, and has given a new name to the new article, meaning that new article and nothing more, to claim that the name is to be attributed to his manufacture alone after his competitors are at liberty to make the same article. It is admitted that no such case has occurred, and I believe it could not occur" (*u*).

The principle thus laid down has been approved and adopted in more recent cases. Thus, Lord Herschell, in *Reddaway* v. *Banham* (*x*), says: "Where a patentee attaches

(*ss*) *The Linoleum Co.* v. *Nairn*, 7 C. D. 834; 47 L. J. Ch. 430 (1878); followed in *Formalin Hygienic Co. Ld.'s Application*, 17 R. P. C. 486 (1900), Farwell, J.; and *Cheseborough Co.'s Tm.*, 18 R. P. C. 191 (1901), Buckley, J. (*Vaseline*); cf. *Young* v. *Macrae*, 9 Jur. N.S. 332 (1862), Wood, V.-C., *paraffin* not a trade-mark.

(*t*) 7 C. D. p. 837; 47 L. J. Ch. p. 432.

(*u*) See below, p. 243.

(*x*) (1896) A. C. p. 214; and 13 R. P. C. p. 230.

a particular name to the production he patents, that name becomes common property as the name of the patented article. It possesses, indeed, no other name. That name would necessarily be applied to it by all persons desiring to purchase the article. It is not descriptive of the name of a particular manufacturer, but of the article itself, by whomsoever it is patented."

In *The Magnolia Metal Co.'s Trade Marks* (*y*), Rigby, L. J., delivering the judgment of the Court of Appeal, said: "When the article is made under a secret process, or its manufacture is protected by a patent, no person who has not acquired the secret, or obtained a licence from the patentee, can manufacture it. Accordingly, it is established as a general rule, that when an article is made under a secret process, or where the manufacturer of it is protected by a patent, the manufacturer or patentee cannot by any means entitle himself to a monopoly in the use, after the secret process has been discovered or the term of the patent has expired, of the name by which the manufactured article is exclusively known whilst the secret is undiscovered or the term of the patent is unexpired. What exceptions this general rule may be subject to it is not necessary for the purposes of this case to inquire into." In the case last quoted from, the manufacture of the metal had been carried on in America under a secret process; but subsequently patents were taken out in America and the United Kingdom, and these patents were unexpired at the date of the application, which was for the removal, from the Register, of marks, one of which consisted of, and another of which included, the word *Magnolia*. One ground of the application was that magnolia metal was the name of a particular alloy; as to two of the marks in question the application succeeded on this ground, it being held that, before the date of the patent or the registration of the marks, the name *Magnolia* had been treated as the name of the article manufactured by the secret process, and therefore, independently of the question arising on the patents, the registration of these marks was bad.

The fact that the patent for the goods is bad is im-

(*y*) (1897) 2 Ch. 371; and 14 R. P. C. 621.

material, for a practical monopoly may be obtained by a bad patent (*z*); nor can a person who has given a name to an article which he has wrongly put forward as made under a patent be in a better position than if his statement were true (*a*). During the maintenance of the monopoly, either by the continuance of the patent or the non-discovery of the secret process, no one, of course, can use the name of the article for a different article so as to pass it off as that of the person having the monopoly (*b*). On the other hand, although the patent is unexpired, if it be for a process, and a method of making the article without infringing the patent be discovered, a name which indicates the article may be used notwithstanding the existence of the patent (*c*).

Whether it is open to a patentee to show that, after the expiration of the patent, the word which was the name of the article when the patent expired has subsequently come to denote his manufacture only, is a question which has not arisen for decision. But, although it would no doubt be difficult to establish such a case, it would seem to be possible.

Article formerly made under secret process.

It may, perhaps, be doubted whether the rule in the case of an article manufactured under a secret process is as absolute as in the case of a patented article (*d*), and whether it is not open to the manufacturer of an article made by him under a process formerly secret but since discovered to show that the mere use of the name by another person would

(*z*) *Formalin Hygienic Co. Ld.'s Application*, 17 R. P. C. 486 (1900), Farwell, J.; see also *Magnolia Metal Co.'s Tms.*, *supra*, and *Winser* v. *Armstrong*, below, note (*f*). The *Magnolia* patent was subsequently revoked: *Miller's Patent*, 15 R. P. C. 205.

(*a*) *Meaby & Co., Ld.* v. *Triticine, Ld.*, 15 R. P. C. 1 (1898), North, J.; and see below, p. 401, as to misrepresentation respecting patents.

(*b*) *Birmingham Vinegar Co., Ld.* v. *Powell*, (1897) A. C. 710; 14 R. P. C. 720; the question of the rights of the parties if the defendants had been selling the same article as that known as "Yorkshire Relish" did not arise on the facts, as found.

(*c*) *Young* v. *Macrae*, 9 Jur. N.S. 322. With respect to this case, the subsequent comments of Wood, V.-C., on his decision contained in *Braham* v. *Bustard*, 1 H. & M. 447 (1863), should be borne in mind: see Lord Macnaghten's judgment in *Reddaway* v. *Banham*, (1896) A. C. at p. 220; 13 R. P. C. 234.

(*d*) The means by which the monopoly is obtained is different, and in the case of a secret process the rule cannot be based upon an implied condition in the grant by the Crown.

deceive purchasers into the belief that the goods were those of the original manufacturer, or, in other words, to show that the name indicates not merely the article but the article manufactured by him (*e*).

Under registered design.

If a man registers a new design, and gives the article made in accordance with that design a name, that name describes the article, and it may, after the expiration of the protection, be used for that purpose by other persons (*f*).

Original.

The first introducer of goods which have come to be known by the name which he applied to them, so that that name has been lost to him as a distinctive mark, has in some cases been allowed to distinguish his goods by the name with the prefix *original*. Thus, in the *Reading Sauce Case* (*g*), Romilly, M. R., said: "Where there are a great number of persons who produce the same article, *original* means that the article so called is that made by the first inventor. That is the meaning of *original* which the Court of Chancery has always recognized."

Name of the place of origin.

The name of the place of origin of the goods would, on the same principles, in general, be bad as a trade-mark, for any importer from the same place would be at liberty to use it; but where the name has acquired a secondary meaning, identifying the goods upon which it appears with a particular trader, the trader has frequently been protected against fraudulent imitators. Even in cases where this secondary meaning has been acquired, however, according to the rule adopted in the analogous case of a trader using his own name (*h*), the Courts would not interfere to altogether restrain

(*e*) The question was left open in the House of Lords in the *Yorkshire Relish Case;* but the proposition as laid down by Lindley, L. J., in the Court of Appeal, (1896) 2 Ch. at p. 72; 13 R. P. C. at p. 252; and approved by Lord Davey, (1897) A. C. at p. 717; 14 R. P. C. at p. 732, is not so absolute as in the case of a patented article. See also the judgment of Rigby, L. J., in the *Magnolia Case*, quoted *supra*, p. 45, and Chap. XIX., p. 538.

(*f*) *Winser & Co.* v. *Armstrong & Co.*, 16 R. P. C. 167 (1899), Byrne, J. (*Winser interceptors*).

(*g*) *Cocks* v. *Chandlers*, L. R. 11 Eq. p. 447; 40 L. J. Ch. p. 575 (1871); see also *Browne* v. *Freeman* (1), 12 W. R. 305 (1864), Wood, V.-C.; S. C. (2), W. N. (1873), 178 (*Chlorodyne*), L. JJ.; *Lazenby* v. *White*, 41 L. J. Ch. 354, n. (1870) (*Harvey's Sauce*).

(*h*) See *Turton* v. *Turton*, and *Valentine Meat Juice Co.* v. *Valentine Extract Co., Ld.*, below, pp. 505, 508.

the use of the name in question by a second trader who is honestly using the name in question merely for the purpose of indicating the place of origin of his goods, although they might require him to use it in such a way as that his goods are clearly distinguished from those of the other trader (*i*).

Anatolia liquorice.

In *McAndrew* v. *Bassett* (*j*) the word *Anatolia* stamped upon liquorice was held to be a good trade-mark. The plaintiff made his goods of a mixture of juices obtained partly from Spain and partly from the district of Andoli; and he chose *Anatolia*, which was one form of the latter name, as his mark. The defendant, having seen the plaintiff's mark in the market, caused it to be applied to goods of his own made solely from Spanish juice. If the name had had a known meaning indicating the origin of the goods, it is clear that the plaintiff could not have monopolized it; but as it had, when he assumed it, and at the time of the infringement, no such meaning, the Court decided that it was a good trade-mark. "It is not," said Wood, V.-C., "like the case . . . of there being some district from which a well-known wine, such as Burgundy, is imported, and the first importer calls it *Burgundy*; although he may have stamped *Burgundy* on his corks for twenty years, he could not prevent anybody else from calling a wine produced in Burgundy by the name of the place from which it was imported."

Seixo v. *Provezende.*

In *Seixo* v. *Provezende* (*k*), part of the plaintiff's trade-marks consisted of the word *Seixo*, which was his own name and was also the name of the estate from which the wine, in connection with which the mark was used, came. The defendants adopted the same word in their trade-mark, and

(*i*) There are *dicta* in the *Stone Ales Case*, in the House of Lords, which suggest that a practical monopoly might be acquired of the use of the name of a place where goods are manufactured: *Thompson* v. *Montgomery*, (1891) A. C. 217; 8 R. P. C. 365; above, p. 29. The case was one of deliberate fraud; but, in view of the *Valentine Case*, it may be doubted whether the same result could not have been reached without proof of fraud. The recent case of *Cash* v. *Cash*, cited p. 508, is the only case of a person being absolutely restrained from using his name in a certain trade.

(*j*) 4 De G. J. & S. 380; 33 L. J. Ch. 561 (1864), Wood, V.-C., and Westbury, L. C.

(*k*) L. R. 1 Ch. 192; 14 L. T. N. S. 314 (1865).

they alleged that their wine came from an estate adjoining the plaintiff's and also known as *Seixo*. It appeared that the produce of the defendant's estate was far less in quantity than that of the plaintiff, that the plaintiff's wine was well known by his trade-mark, and that the district in which both estates were situate was known as "Sitio do Seixo," meaning "the stony country." Wood, V.-C., granted an injunction to restrain the defendants from using the word in question without clearly distinguishing the wines they sold under it from the wines of the plaintiff (*l*), and, on appeal, Cranworth, L. C., upheld this decision. "Assuming the truth of what is contended for by the defendants," the Lord Chancellor said (*m*), "that is, that parts of their vineyards are known by the name *Seixo*, that does not justify them in adopting a device or brand the probable effect of which is to lead the public when purchasing their wine to suppose that they are purchasing wine produced from the vineyards, not of the defendants, but of the plaintiffs."

Glenfield starch.

In the *Glenfield Starch Case* (*n*), the defendant was restrained from using the word *Glenfield* on the labels attached to starch made by him, and from calling such starch *Glenfield Starch*, although his starch was actually made, and that of the plaintiffs was not made, at the place of that name. The plaintiffs had formerly manufactured their goods at Glenfield, and had adopted the name *Glenfield Starch*, and a label comprising the words to describe them; and the defendant, as the House of Lords found, set up a factory at Glenfield—an open place with a few cottages—for the express purpose of securing the name, and of profiting by the plaintiff's reputation. He called his starch *Royal Palace Starch*, but placed the name *Glenfield* in large letters on his labels, and his agents sold his goods as *Glenfield Starch*.

"I take it to be clear from the evidence," Lord Westbury said (*o*), "that, long antecedently to the operations of the

(*l*) See form of injunction which was approved by the H. L. in *Montgomery* v. *Thompson* (note (*p*)), L. R. 1 Ch. p. 194; Appendix, p. 749.

(*m*) L. R. 1 Ch. p. 198; 14 L. T. N. S. p. 316.

(*n*) *Wotherspoon* v. *Currie*, L. R. 5 H. L. 508; 42 L. J. Ch. 130 (1872).

(*o*) L. R. 6 H. L. p. 521.

respondent, the word *Glenfield* had acquired a secondary signification or meaning in connection with a particular manufacture—in short, it had become the trade denomination of the starch made by the appellants. It was wholly taken out of its ordinary meaning, and in connection with starch had acquired that peculiar secondary signification to which I have referred. The word *Glenfield*, therefore, as a denomination of starch, had become the property of the appellants."

This decision was followed and approved by the House of Lords in the *Stone Ales Case* (*p*) in the year 1891, which was a very similar case (*q*).

But a name which originally begins in its use as a geographical term, and long continues to be used as such, cannot readily cease to be a geographical term and acquire the secondary meaning above referred to (*r*).

Geographical names are expressly excepted from the list of essential particulars for registered trade-marks contained in the present Act (*s*).

Advertisement of the goods not a trade-mark.

So a mere advertisement or description of the goods concerned, or of some quality which they possess, is not a trade-mark. And on this ground Lord Westbury based his judgment in the House of Lords in the *Leather Cloth Case* (*t*).

Leather Cloth Case.

The trade-mark of the plaintiffs in that case consisted of a circle formed by the words *Crocketts' International Leather Cloth Company, Newark, N. Y., U. S. A., West Ham, England,* inside of which in the upper half was an eagle, with the word *Excelsior* over it, and the words *Crocketts & Co., tanned leather*

(*p*) *Montgomery* v. *Thompson*, (1891) A. C. p. 217; 8 R. P. C. 361; above, p. 29; cf. also *Huntley and Palmer* v. *The Reading Biscuit Co.*, 10 R. P. C. 277 (1893), Chitty, J. (*Reading biscuits*).

(*q*) See also *Barlay & Co., Ld.* v. *Hughes*, 15 R. P. C. 290 (1898), where North, J., on an interlocutory motion, restrained the use by the defendant of *Dindigul* in connection with cigars, without clearly distinguishing such cigars from the plaintiffs' cigars; but the injunction was not to prevent the defendant from describing any cigars sold by him, in fact made of *Dindigul* tobacco, as being so made.

(*r*) Per Cozens-Hardy, J., in *Wolff* v. *Nopitsch*, 17 R. P. C. 321, at p. 330 (1900).

(*s*) Act of 1888, s. 10 (1) (e), below, p. 178; see also p. 166.

(*t*) *The Leather Cloth Co.* v. *The American Leather Cloth Co.*, 11 H. L. C. 523; 35 L. J. Ch. 53 (1865).

cloth below it, and in the lower half the words *Patented, January* 24, 56, *I. R. and C. P. Crockett, Manufacturers,* 12 *yards.* The defendants had a trade-mark containing features similar to some of these. Wood, V.-C., granted an injunction (*u*), but on appeal (*x*) this was rescinded by Lord Westbury on the ground that the plaintiffs' trade-mark contained material misrepresentations which disentitled them to relief. When the case came before him again, in the House of Lords, however, Lord Westbury said (*y*): "I am satisfied that I ought to have regarded this affix to the plaintiff's goods, which is here denominated a trade-mark, as something which, according to the anterior usage and application of the words trade mark, by no means resembles or comes within the description of anything that has hitherto been properly designated by that name." It was, he added, "in reality, an advertisement of the character and quality of their goods."

So the words *Nourishing Stout* were refused protection (*z*), by Malins, V.-C., who distinguished the case before him from two earlier cases, in one of which (*a*) words meaning *exactly* 12 *yards*, printed in three foreign languages, and placed upon long cloth, and in the other (*b*) the words *Excelsior White Soap*, had been accepted as trade-marks.

Chearin v. *Walker.*

And in *Chearin* v. *Walker* (*c*), a tablet bearing the words *G. Chearin's Improved Patent Gold Medal Self-Cleaning Rapid Water Filter, Boston, England,* with the Royal Arms and the words *By Her Majesty's Royal Letters Patent,* was held by Jessel, M. R., in the Court of Appeal, not to be a trade-mark. "What (the plaintiff) uses," he said (*d*), "is an inscription which he chooses to place or bake on his filters,

(*u*) 1 H. & M. 271; 32 L. J. Ch. 721.

(*x*) 4 De G. J. & S. 137; 33 L. J. Ch. 199.

(*y*) 35 L. J. Ch. p. 66.

(*z*) *Raggett* v. *Findlater*, L. R. 17 Eq. p. 29; 34 L. J. Ch. 64 (1873). This case and the others here cited must be taken subject to the law established by *Reddaway* v. *Banham* (*supra*, p. 41), that words *primâ facie* of a descriptive meaning may acquire a secondary meaning if they lose their ordinary meaning and come to indicate the goods of a particular manufacturer.

(*a*) *Broadhurst* v. *Barlow* (1872), unreported: see L. R. 17 Eq. p. 38.

(*b*) *Braham* v. *Bustard*, 1 H. & M. 447; 9 L. T. N.S. 199 (1863), Wood, V.-C.

(*c*) 5 C. D. 850; 46 L. J. Ch. 686 (1876), C. A.

(*d*) 5 C. D. p. 862.

and which tells its own story. The inscription is not in distinctive characters, but in ordinary type. There is nothing in it to show that it was made by any particular manufacturer. It is not possible to say that such an inscription is a trade-mark." The action failed also on the ground that the tablet falsely represented that the goods were made under an existing patent, whereas, in fact, the patent had expired.

The essential quality of distinctiveness as a necessary element in a trade-mark has been carefully preserved by the Acts, and by the decisions upon them. These are dealt with in a subsequent chapter (*e*).

Made, worked upon, imported, selected, certified, or sold.

Connection of the owner of the trade-mark with the goods.

The office of the trade-mark is to indicate some connection between the goods to which it is applied and a particular trader (*f*); but it is not necessary that the buyers should know the name of the trader, it is sufficient that the mark identifies a particular manufacture (*g*). What this connection is, is immaterial; but it should be a constant one. If a maker chooses to sell under a trade-mark which is identified with goods of his manufacture, goods made by others, his conduct will tend to destroy the original significance of the mark, and eventually to confer upon it a new meaning; but, until the alteration is known, buyers may justly complain of deception (*h*).

The connection most commonly intended by a trade-mark is that of origin or manufacture; but, as already said, many others may be connoted. This is succinctly expressed in the statement of Bowen, L. J., in a recent case (*i*), that the

(*e*) See 38 & 39 Vict. c. 91, s. 10; 46 & 47 Vict. c. 57, s. 64; 52 & 53 Vict. c. 50, s. 10; and below, Chap. VIII., What may be Registered, p. 115.

(*f*) See the *dicta* cited above, p. 26.

(*g*) See *Birmingham Vinegar Brewery Co.* v. *Powell*, (1897) A. C. 710; and 14 R. P. C. 720; and *supra*, p. 35.

(*h*) The deception may constitute the offence of applying a false trade description. See *Stacey* v. *Chilworth Gunpowder Co.*, 24 Q. B. D. 90; 59 L. J. M. C. 13 (1890), Lord Coleridge, L. C. J., and Mathew, J. See also *Johnson* v. *Raylton*, 7 Q. B. D. 438 (1881), a case of implied contract; and the Merchandise Marks Act, 1887, Book II., Chap. I., pp. 569 *et seq.*

(*i*) *Powell's Tm.*, (1893) 2 Ch. p. 404; 10 R. P. C. 195.

function of a trade-mark is to give an indication of "the trade source from which the goods come, or the trade-hands through which they pass on their way to the market." And in the Merchandise Marks Act of 1862 (*k*), the words used were "manufacture, workmanship, production, or merchandise."

Trade-mark of selector of goods.

In some cases it is difficult to decide what the precise meaning of a trade-mark is; for instance, where A. has selected and imported goods made by B. for many years, and has sold them under a particular trade-mark. If A. has been the sole importer, does the reputation of the mark refer to his selection and importation, or to B.'s manufacture? Such a question arose in *Hirsch* v. *Jonas* (*l*). There the plaintiff bought cigars of a foreign maker, who, at his request, placed a label bearing the words *Gloria de Ingluterra Havannah*, which had been designed and registered as his copyright by the plaintiff, upon the boxes. Subsequently, the maker began to supply to the defendants for sale in the market similar cigars, not purchased by the plaintiff, but bearing the same label, and this the plaintiff unsuccessfully sought to restrain. The name of the plaintiff did not appear on the boxes, but that of the maker did. "The trade-mark of manufactured goods," said Jessel, M. R. (*m*), "means, I suppose, that the goods are manufactured by the person whose trade-mark it purports to be. I can understand a man saying, 'I am not the actual manufacturer of goods, but the selector of goods, and my reputation for cleverness and selection is so great, that goods marked with a mark to show that they have been selected and approved of by me will fetch a higher price in the market.' If Hirsch had put on the box '*Gloria de Inglaterra Havannah* Cigars selected by *Hirsch*,' he might have had a case to prevent other people imitating that. It would show that the cigars selected were approved of by him. If he got a great reputation in that way, I can understand he would have a right of protection for that which indicates to the public that the cigars were selected and approved of by him.

Hirsch v. *Jonas.*

(*k*) Sect. 1, quoted above, p. 25.

(*l*) 3 C. D. 584; 45 L. J. Ch. 364 (1876).

(*m*) 3 C. D. p. 586; 45 L. J. Ch. p. 365.

That is not his case. There is nothing on the boxes to show anything about Hirsch at all. All he says is that the trade knows this mark as denoting cigars sold by him, which I dare say it does" (*n*).

In *Robinson* v. *Finlay* (*o*) the marks in question were held to indicate a connection with three different persons—the manufacturer, the exporter, and the consignee, since they had always and only been used upon goods which had passed through the hands of all of these in their several capacities. The Court of Appeal, accordingly, decided that neither of the parties alone was entitled to the marks.

Designer for another person.

A servant who designs a mark which his employer adopts and uses has no claim in regard to it, and is not entitled after leaving his employment to use the mark on his own goods (*p*).

Registered under the Acts as a Trade-Mark.

Before the Registration Acts were passed, the only general way in which a trade-mark could have been acquired was by public user, in the manner described in the earlier part of the definition given above (*q*), or in the case of a Cutlers' Corporate Mark, for use by a cutler resident in or within six miles of Hallamshire, by assignment from the Cutlers' Company (*r*). But registration, or, rather, the application for registration, is now to be deemed equivalent to the public use of the registered trade-mark (*s*), and the registration of a person as proprietor of a trade-mark is to be *primâ facie* evidence of his right to the exclusive use of the trade-mark, and after the expiration

(*n*) Cf. *Knott* v. *Marshall*, W. N. (1894) 214, where a person who bought from the manufacturer in bulk, and put the goods up in distinctive packets, was held by Chitty, J., to be entitled to restrain another purchaser from the manufacturer from imitating this get-up.

(*o*) 9 C. D. 487; 39 L. T. N.S. 398 (1877), Bacon, V.-C., and C. A.; *Jones' Tm.*, 53 L. T. N.S. 1 (1885), C. A.

(*p*) *Roger's Tm.*, 12 R. P. C. at p. 156 (1895), North, J.

(*q*) *Hudson's Tm.*, 32 C. D. 311; 3 R. P. C. 155 (1886), C. A.

(*r*) See Chap. VI., Sheffield Marks, below, p. 101.

(*s*) Act of 1883, s. 17, replacing sect. 75 of the Act of 1883, and sect. 2 of the Act of 1875; below, p. 304.

of five years from the date of registration, to be conclusive evidence of his right to such exclusive use, subject to the provisions of the Act (*t*).

These sections, it has been decided, create a new method in which trade-mark rights can be acquired (*u*). Their construction and effect are discussed in a later chapter (*x*).

(*t*) Act of 1883, s. 76, replacing sect. 3 of the Act of 1875.

(*u*) *Hudson's Tm.*, 32 C. D. 311; 3 R. P. C. 155 (1886), C. A.; below, p. 304.

(*x*) Chap. VIII., What may be Registered, p. 115. Chap. XII., Effect of Registration, p. 302.

CHAPTER III.

THE REGISTER OF TRADE-MARKS, AND THE TRADE-MARKS BRANCH OF THE PATENT OFFICE.

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The Register. THE Register of trade-marks was established by the Act of 1875 (*a*), and it is now continued under sect. 78 of the Act of 1883, which provides that there shall be kept at the Patent Office (*b*) a book called the Register of Trade-Marks, wherein shall be entered the names and addresses of proprietors of registered trade-marks, notifications of assignments and of transmissions of trade-marks, and such other matters as may be from time to time prescribed. And the books of the original Register are treated as part of the present Register (*c*).

The Manchester office and the Sheffield Register. There are also Registers at Manchester and Sheffield. The former, a copy of the Register at the Patent Office, so far as

(*a*) Sects. 1 and 7.
(*b*) 25, Southampton Buildings, Chancery Lane, London, E.C.
(*c*) Act of 1883, s. 114.

it relates to goods in Classes 23, 24, and 25 (*d*) (*i.e.*, cotton goods), and the latter, a branch Register for trade-marks for metal goods registered by residents in Hallamshire, or within six miles of it (*e*).

By sect. 101 of the Act of 1883, the Board of Trade may from time to time make general rules, subject to the provisions of the Act, for regulating the practice of registration, for classifying goods and for certain other purposes, and may alter or amend the forms in the First Schedule to the Act. The trade-mark rules and forms at present in force under this section are those of 1890, as amended by those of 1897 and 1898 (*f*).

The Comptroller.

The Register was formerly under the control of the Registrar appointed in pursuance of the Act of 1875, but it is now, as well as the whole of the Patent Office, of the business of which it forms part, under the immediate control of the Comptroller-General of Patents, Designs, and Trade-Marks, who is appointed by, and acts under the superintendence and direction of, the Board of Trade (*g*), and who may in any case of doubt or difficulty arising in the administration of any of the provisions of the Act, apply to either of the law officers for directions in the matter (*h*). The Comptroller's address is, The Comptroller, Patent Office, Trade-Marks Branch, 25, Southampton Buildings, London.

Any act or thing directed by the Acts to be done by or to the Comptroller may, in his absence, be done by or to any officer for the time being in that behalf authorized by the Board of Trade (*i*). The business in relation to trade-marks is, in practice, undertaken by the Registrar of Trade-Marks on behalf of the Comptroller.

(*d*) Below, p. 718.

(*e*) As to the Manchester office, see below, p. 113, and as to the Sheffield registry, p. 106.

(*f*) See App., p. 691.

(*g*) Sect. 82 (3). Lord Herschell's committee recommended that the practice which had grown up of consulting the Board of Trade in particular instances, in regard to applications for registration, should cease, except so far as it might be necessary to bring such instances before them by way of illustration for the purpose of obtaining a direction on some point of general principle or practice. Report of 1888, p. vii.

(*h*) Sect. 95. See below, p. 74.

(*i*) Sect. 82 (4).

Entries on the Register.

In addition to the matters directed by sect. 78, quoted above, to be entered upon the Register, there are entered also the name, address, and description of the proprietor of each mark (*k*), the date of the application for registration (*l*), a statement of the class or classes of goods for which the mark is registered (*m*), disclaimers under sect. 74 of the Act (*n*), a note of the orders of the Court made under sects. 62, 69, 72, 90, or 92, and affecting the mark (*o*), and such other particulars as the Comptroller thinks necessary (*p*). And these last particulars include notes entered on the Register in pursuance of undertakings by the proprietor to confine the use of his mark to goods forming part only of a class, or to restrict the manner of use of his mark (*q*), and in regard to other restrictions on the full rights ordinarily conferred by a simple registration. It has been decided that notes expressing a condition of registration that the mark should only be used, or should not be used, within a certain geographical area ought not to be entered on the Register (*r*).

No trusts to be entered.

No notice of any trust may be entered upon the Register or be receivable by the Comptroller, whether the trust be express, implied, or constructive (*s*), so that the entry of a reference to an agreement limiting the rights of the proprietor of the mark and not stating its terms, is irregular (*t*).

Title conferred by registration.

There is no patent or other document issued by the Comptroller in respect of the title to a trade-mark, but the application, followed by the registration of the trade-mark, is equivalent to the public user (*u*), by which, and by which

(*k*) Rule 33.

(*l*) Rule 34.

(*m*) Sect. 65. See form of application, Form F., Appendix, p. 706.

(*n*) Act of 1888, s. 16.

(*o*) Rule 46.

(*p*) Rule 34.

(*q*) See below, pp. 219 and 282; and *Re Ratcne & Co.*, Seb. Dig. p. 395 (1879), Jessel, M. R.; *De Otaduy's Tm.* (1885), W. N. p. 177, Pearson, J.; *Mitchell & Co.'s Tm.* (2), 28 C. D. 666 (1885), Chitty, J.; *Keep's Tm.*, 26 C. D. 187 (1884), Pearson, J. But as to entering notes of undertakings to confine the use of a mark to a certain district, see now *Dewhurst's Tm.*, note (*r*), and below, p. 219.

(*r*) *Dewhurst's Tm.*, (1896) 2 Ch. 137; 13 R. P. C. 288, C. A.; and see below, p. 219.

(*s*) Sect. 85. Rule of 1876 (22), of. Companies Act, 1862, s. 30.

(*t*) *De Otaduy's Tm.* and *Mitchell & Co.'s Tm.*, above, note (*q*).

(*u*) Act of 1888, s. 17.

alone, title to a trade-mark was acquired before the Acts (*x*). Registration confers a right to the exclusive use of the mark (*y*), and, in the case of any trade-mark which is capable of registration, except an old mark of which registration has been refused, it is a condition precedent to any proceedings for the infringement of the trade-mark (*z*). The person registered as proprietor has power to assign the trade-mark (*a*).

Alterations of the Register.

Provision is made for the rectification of the Register, and also for its alteration in any non-essential particular, by order of the Court (*b*), and for the correction of clerical errors (*c*), and the entry of changes of address (*d*), by the Comptroller.

Falsification of the Register.

The falsification of entries in, or of writings purporting to be copies of entries in, the Register, and the tendering or production of any such entry or writing, knowing it to be false, is a misdemeanour (*e*).

Devolution of title.

Devolutions of title to a trade-mark by assignment, transmission, or other operation of law, are directed to be entered on the Register by the Comptroller at the request of the person becoming entitled, and upon proof to the satisfaction of the Comptroller of the title of the applicant (*f*).

Removal of entries.

A trade-mark may, probably, be removed from the Register because the business, to the goodwill of which the rights conferred by the registration are attached (*g*), has come to an end, and it may also be removed on the ground that at the time of registration the applicant had no *bonâ fide* intention

(*x*) See the last Chapter.

(*y*) Sect. 76. See Chap. XII.; below, p. 302, Effect of Registration.

(*z*) Sect. 77. See Chap. XII.; below, p. 312.

(*a*) Sect. 87. See Chap. XIII., p. 324.

(*b*) Sects. 90 and 92. Rules 46 to 50. See Chap. XI.; below, p. 262, Rectification of the Register.

(*c*) Sect. 91.

(*d*) Rule 48.

(*e*) Sect. 93; below, p. 640.

(*f*) Sect. 87. Rules 36 to 40. See Chap. XIII.; below, p. 324, Assignment and Devolution of Trade-Marks.

(*g*) Sect. 70. *Ralph's Tm.*, 25 C. D. 194; 53 L. J. Ch. 188 (1883), Pearson, J.; and *Batt's Tm.*, *infra*, note (*h*). There is no rule in the present code corresponding to r. 34 of the Rules of 1876, which was as follows:—"The Court may, on the application of any person aggrieved, remove any trade-mark from the Register on the ground, after the expiration of five years from the date of the registry thereof, that the registered proprietor is not engaged in any business concerned in the goods with respect to which a trade-mark is registered." See Chap. XIV.; below, p. 338.

of using it (*h*), or after fourteen years, for non-payment of fees, under sect. 79 (*i*), or whenever the mark is on the Register without sufficient cause (*k*). In the case of non-payment of fees a record of the removal and of the cause thereof is entered on the Register (*l*).

Inspection of the Register.

The Register is open to the inspection of the public on payment of the prescribed fee (which is at present one shilling for every quarter of an hour spent in inspecting) on every week day between the hours of ten and four, except on the usual holidays (*m*) and days of which due notice is given at the Patent Office, and times when the Register is required for any purpose of official use (*n*).

Searches.

It is generally advisable before offering a trade-mark for registration to cause a search to be made through the Register, to discover whether any of its essential features have been anticipated in such manner as to be a bar to the application (*o*), and it is often necessary for other purposes. The Comptroller does not undertake to make searches except in connection with formal applications for registration (*o*), but the searches are greatly facilitated by the indexes with which the Register is provided. There are three of these, and they include both actually registered and advertised trade-marks. They are :—

Indexes.

I. An index of devices arranged in each class in the order of advertisement;

II. An index of devices arranged in each class under the following heads:

(1.) Animals, including insects and reptiles.
(2.) Birds.
(3.) Buildings and landscapes.

(*h*) *Batt's Tm.*, (1898) 2 Ch. 432; 15 R. P. C. 262, 534, Romer, J., and C. A.; and in House of Lords, sub nom. *Batt* v. *Dunnett*, (1899) A. C. 428; 16 R. P. C. 411.

(*i*) Page 349.

(*k*) See the judgment of C. A. in *Batt's Tm.*, *supra*; and below, Chap. XI., Rectification of the Register, p. 277.

(*l*) Rule 47.

(*m*) When the last day for doing any act, under the Statute or the Rules, falls on a public holiday, Sunday or Saturday, such day is not counted. Sect. 98.

(*n*) Sect. 88. Rule 52.

(*o*) Instructions (7). See sects. 72 and 73, and Chap. X.; below, p. 211.

II. Index of devices—*continued*.
(4.) Crests, including crowns, coats of arms, and heraldic symbols.
(5.) Fish.
(6.) Geometrical forms, including suns, moons, stars, &c.
(7.) Human figures.
(8.) Miscellaneous.
(9.) Monograms.
(10.) Shipping, including anchors and flags.
(11.) Trees, flowers, fruit, &c.
(and warning is given that, in using this index, it is often necessary to look under several heads in order to insure a complete search);

III. An index of words forming the essential or material features of marks.

It is to be regretted that the recommendation of Lord Herschell's committee (*p*), that a catalogue of words rejected should be kept, has not been followed.

Certified copies of the Register, sealed with the seal of the Patent Office, of any entry in the Register, are directed to be given to any person requiring the same on payment of the prescribed fee (*q*). And printed or written copies of or extracts from the Register, purporting to be certified by the Comptroller and sealed with the Patent Office seal, are receivable in evidence without proof or production of the originals (*r*). And a certificate, purporting to be under the hand of the Comptroller, of any entry, matter, or thing, which he is authorized by the Act or Rules to make or do, is *primâ facie* evidence of the entry and of its contents, and of the matter or thing having been done or left undone (*s*).

Certified copies of the Register to be evidence.

Comptroller's certificate to be evidence.

Rule 60 requires that every certificate of registration shall have specified on the face of it a statement whether it is intended to be used in legal proceedings, or for the purpose of obtaining registration in a foreign country, or for other

(*p*) Report of 1888, p. ix.
(*q*) Sect. 88. For fees, see Appendix, p. 703.
(*r*) Sect. 89.
(*s*) Sect. 96.

purposes; and the fees payable for the certificates vary according to the uses which they are to serve (*t*).

Patent Office seal.

The seal of the Patent Office and impressions thereof, are to be judicially noticed and admitted in evidence (*u*).

Notices and documents may be sent by post.

Any application, notice, or other document, authorized or required to be left, made, or given at the Patent Office or to the Comptroller, or to any person under the Act, may be sent by a prepaid letter through the post; and if so sent, is to be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post; and it is sufficient, in proving such service or sending, to prove that the letter was properly addressed and put into the post (*x*).

(*t*) For fees, see Appendix, p. 703; and for form of request for certificates, Forms L., R., S., T.1, and form of certificate U.; below, pp. 709 *et seq.*

(*u*) Sect. 84.

(*x*) Sect. 97.

CHAPTER IV.

REGISTRATION OF TRADE-MARKS.

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THE registration of trade-marks is governed by sects. 62 to 69, and 71 to 74 of the Act of 1883, as amended by the Act

of 1888; and subject to the provisions of the Acts, the practice of registration is regulated by the Trade-Marks Rules, 1890, as amended by those of 1897 and 1898. Of the sections mentioned, sect. 64 (1) and (3) (ii), declaring what may be registered (*a*); sects. 71, 72, and 73, imposing certain restrictions on registration (*b*), and sects. 74 and 64 (2) and (3) (i) providing for additions and disclaimers (*c*), are dealt with in other chapters of this book. The present chapter deals with the application for registration and the procedure consequent upon it.

By **sect. 62**—

Sect. 62. Application for registration.

"(1.) The Comptroller may, on application by or on behalf of any person claiming to be the proprietor of a trade-mark, register the trade-mark.

"(2.) The application must be made in the form set forth in the First Schedule to this Act, or in such other form as may be from time to time prescribed, and must be left at, or sent by post to, *the Patent Office in the prescribed manner* [such place and in such manner as may be prescribed] (*d*).

"(3.) The application must be accompanied by the prescribed number of representations of the trade-mark, and must state the particular goods or classes of goods (*e*) in connection with which the applicant desires the trade-mark to be registered.

"(4.) The Comptroller may, if he thinks fit, refuse to register a trade-mark, but any such refusal shall be subject to appeal (*f*) to the Board of Trade, who shall, if required, hear the applicant and the Comptroller, and may make an order determining whether, and subject to what conditions (*g*), if any, registration is to be permitted.

"(5.) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court (*h*); and in that

(*a*) Chap. VIII., p. 115.
(*b*) Chap. X., p. 212.
(*c*) Chap. IX., p. 197.
(*d*) Act of 1888, s. 8. The words in italics were repealed by the Act of 1888.
(*e*) Chap. V., p. 96.
(*f*) Page 86.
(*g*) See below, p. 92.
(*h*) Page 88.

event the Court shall have jurisdiction to hear and determine the appeal and may make such order as aforesaid.

"[(6.) Where an applicant for the registration of a trade-mark otherwise than under an international convention (*i*) is out of the United Kingdom at the time of making the application, he shall give the Comptroller an address for service in the United Kingdom, and if he fails to do so the application shall not be proceeded with until the address has been given"] (*k*).

1. Who may apply to Register a Trade-Mark.

The section says "any person claiming to be the proprietor," but if it is shown that the claim is a wrongful or an erroneous one the mark should be refused registration, and, if registered, it can be removed under sect. 90 (*l*). If, however, a mark has been registered by a trader who honestly believes he has invented and is entitled to it, although in fact it belonged at the time to another trader, and if it has been largely used by the registered proprietor, the Court may refuse to remove it (*m*).

Person includes firm or partnership (*n*), also a body corporate (*o*).

The proprietor.

Proprietor means the person who is entitled to a mark in which trade-mark rights have been acquired by user under the law apart from the Acts, either by himself or by his predecessor in business, the trade-mark having been assigned to, or having devolved upon, him with the goodwill of the business in connection with which it is used (*p*), or else the person who has invented (*q*) or selected, or caused to be invented or

(*i*) Chap. XX., p. 545.

(*k*) Act of 1888, s. 8.

(*l*) *Apollinaris Co.'s Tm.*, (1891) 2 Ch. 186; 8 R. P. C. 137, Kekewich, J., and C. A.; and *Batt* v. *Dunnett*, (1899) A. C. 428; 16 R. P. C. 411. See Chap. XI., p. 262.

(*m*) *Mouson* v. *Boehm*, 26 C. D. 398; 53 L. J. Ch. 932 (1884), Chitty, J.; *Paine & Co.* v. *Daniell & Son's Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 219, C. A.

(*n*) Rule 7.

(*o*) Sect. 117. Rule 41.

(*p*) See Chap. II., p. 24.

(*q*) *Hudson's Tm.*, 32 C. D. 311; 3 R. P. C. 155 (1886), C. A.; cf. *Munch's Application*, 50 L. T. 12 (1884), Chitty, J.

selected (*r*), a mark which is new in respect of the class of goods for which registration is sought.

An importer.

An importer of goods produced abroad, whether by manufacture, or—as, for instance, mineral waters—by a process of nature, is not the proprietor of the trade-mark of the producer, even though he has an exclusive contract for importation of the goods into, or for dealing with them in, this country, and notwithstanding that the producer consents to his application to register (*s*). "The registration by the importer was wrong," said Fry, L. J., who delivered the judgment of the Court of Appeal in the case in which this was decided. He added: "If the mark registered had been one which indicated the importer it might have been maintained (*t*); but an importer has no right to appropriate to himself a mark which, as in this case, both by user and express statement on its face, asserts itself to be a mark of the producer or of the owner of the place of origin, because at the time of the registration the mark was an old one, and of course could not be registered as a new one; it was an old one of Kreuzberg's (the producer), and therefore could not be registered as an old one of the Apollinaris Company" (the importers).

It was argued on behalf of the company, in the case just referred to, that, being entitled by the terms of a contract with the producer to the whole produce of the spring from which the producer obtained the goods to which the mark was attached, the company were entitled to register the mark as their own; but the Court refused to determine this question, since the contract relied on was, in fact, subsequent in date to the registration of the mark by the company.

Where the mark belongs to the importer.

In cases where a mark is used by a sole importer there may be a question whether it is his mark, signifying that the goods which bear it have been selected or imported by him, or the mark of the producer, signifying, as in the common

(*r*) *I.c.*, for himself. See *Roger's Co.'s Tm.*, 13 R. P. C. 600; 75 L. T. *Tm.*, 12 R. P. C., at p. 156 (1895), North, J.

(*s*) *Apollinaris Co.'s Tm.*, (1891) 2 Ch. pp. 226—230; 8 R. P. C. 137, C. A.; and *European Blair Camera* n.s. 63 (1896).

(*t*) Cf. the judgment of Jessel, M. R., in *Hirsch* v. *Jonas*, 3 C. D. 584; 45 L. J. Ch. 364 (1876), cited, p. 53.

course, that the goods are his manufacture, and this question must be decided according to the manner in which the mark and goods are put before the public (*u*).

But where a manufacturer abroad sold and sent goods bearing the words *Bull's-eye*, his trade-mark, to a person in England, the importation of such goods into this country, coupled with the circulation of certain pamphlets containing the words, was held to be such a use here of those words by the manufacturer as to prevent the importer setting up a claim to the exclusive use of them, although the words were only known to the public in connection with goods sold by the importer. And the registration of the words by the importer was ordered to be expunged (*x*).

Registration by licensee under patent.

Where a person has sold goods under a licence from the owner of a patent giving to them a certain name, a question may arise whether the name is the name of the article or indicates the goods of the person dealing in them. Thus, in *Freeman* v. *Sharpe* (*y*), the patented article had been sold by the licensees under the name *Capstan*, and they had registered that word as a trade-mark by arrangement with the plaintiffs. On the termination of the licence the licensees made and sold a somewhat different article under the name *Capstan No.* 2, and the plaintiffs, the owners of the patent, which was still unexpired, sought to restrain such use of the word *Capstan*, and to expunge the mark from the Register, on the ground that the word was the name of the article, and that the goodwill

(*u*) See *Hirsch* v. *Jonas*, note (*t*), and the *European Blair Camera Co.'s Tm.*, 13 R. P. C. 600 (1896); and Chap. II., p. 53. *Goodfellow* v. *Prince*, 35 C. D. 9; 56 L. J. Ch. 545 (1887), C. A.; *Robinson* v. *Finlay*, 9 C. D. 487; 39 L. T. N.S. 393 (1877), C. A.; and *Jones' Tm.*, 53 L. T. 1 (1885), C. A., were cases of joint ownership of trade-marks. In *Saxlehner* v. *Apollinaris Co.*, (1897) 1 Ch. 893; 14 R. P. C. 645, Kekewich, J. (a passing-off case), the defendants had had by contract for many years the exclusive sale in the United Kingdom of *Hunyadi Janos* water, and on the determination of the contract they were restrained from using the word *Hunyadi* on other water without clearly distinguishing the same from *Hunyadi Janos* water, but it was held that a red mark which they had used on *Hunyadi*, and also on other waters, was their own trade-mark.

(*x*) *European Blair Camera Co.'s Tm.*, 13 R. P. C. 600 (1896), Stirling, J.

(*y*) 16 R. P. C. 205 (1899), North, J. (*Capstan Closets*).

of the defendants in the article had determined. Both the action and the motion to rectify failed, however, the Court finding that the name indicated goods manufactured and sold by the defendants in the action.

Application through agent.

The application for registration, and all other communications between the applicant and the Comptroller, may be made by or through an agent duly authorized to the satisfaction of the Comptroller (*z*), and the proprietor may appoint an agent to act on his behalf for all purposes connected with the registration (*a*); but the Comptroller is not bound to recognize as such agent any person whose name has for certain reasons been erased from the Register of Patent Agents, and not restored (*z*). If the proprietor appoints an agent, he will be bound by his acts, so that where, under the Act of 1883, by the default of the agent, the registration was not completed within twelve months, it was deemed to have been abandoned (*a*). Under the Act of 1888, in any such case notice of the non-completion is sent from the Patent Office to the principal, and he is allowed fourteen days, or such further time as the Comptroller may direct, to complete the registration (*b*).

Registration in the agent's name.

If the mark is, as sometimes happens, by the agent's mistake or fraud, registered in the name of the agent instead of that of his principal, it may be removed and a new application made (*c*). In some cases, where there has been no wrongful intention on the part of the agent, an assignment to the principal (*d*), or to his successor in business (*e*), has been permitted, or a rectification of the Register effected (*f*); but the authorities are conflicting upon the question whether

(*z*) Rule 9, as amended by T. M. R. 1898. Sect. 63. See also Instructions, 12, Appendix, p. 726. Official notices as to the authorization of agents have from time to time been given and published in the "Trade-Marks Journal"; for these, see below, Appendix, pp. 731, 732.

(*a*) *Jackson & Co.* v. *Napper*, 35 C. D. 162; 4 R. P. C. 45 (1887), Stirling, J.; *Loftus' Tm.*, (1894) 1 Ch. 193; 11 R. P. C. 29, North, J.

(*b*) Act of 1888, s. 9, amending sect. 63 of the Act of 1883.

(*c*) *Marler's Tm.*, 44 L. T. 98 n. (1878), Jessel, M. R.

(*d*) *Farina's Tm.*, 44 L. T. 99 n. (1881), Jessel, M. R.

(*e*) *Welcome's Tm.*, 32 C. D. 213; 3 R. P. C. 76 (1886), Chitty, J.; *Re Australian Wine Co.*, 61 L. T. 427 n. (1885), Chitty, J.; *Greenlees' Tm.*, 9 R. P. C. 93 (1892), Stirling, J.

(*f*) *Rust's Tm.*, 44 L. T. 98 n. (1880), Jessel, M. R.

either of these courses ought to be allowed (*g*). Where an agent acting for two separate principals has, by mistake, registered the trade-mark of one in the name of the other, removal and a fresh application are necessary (*h*).

2. The Comptroller's Discretion.

The Comptroller has a discretion under the Act to register or to refuse any trade-mark which falls within the class of things which may be registered under sect. 64, and which is not debarred from registration by some other section of the Act. The following table shows the reasons for refusals which arise under the Acts and Rules themselves:—

Reasons for refusal of the application.

(1.) The application is not made by or on behalf of any person (properly) claiming to be the proprietor of the mark (*i*).

(2.) It is not made in proper form (*k*).

(3.) It is deemed to be abandoned (*l*).

(4.) The mark tendered does not consist of or contain any of the essential particulars of a registerable trade-mark (*m*).

(5.) The application is successfully opposed (*n*). Besides any other ground for refusal, an opponent may show that the registration of the proposed mark would be unjust to him, *e.g.*, by giving to the applicant the exclusive right to use a mark which he is already lawfully using, though not as a trade-mark (*o*), or he may show that it is a common mark (*p*).

(6.) Where there are conflicting claims to registration, the Comptroller may refuse to register upon any of them until the decision of the Court has been obtained (*q*).

(*g*) See *Rivière's Tm.*, 55 L. J. Ch. 545 (1886), C. A., and note (*h*); and cf. *Grocott's Design*, 17 R. P. C. 139 (1900). See also Chap. XI., p. 283, below.

(*h*) *Kingsford & Son's Application*, 6 R. P. C. 413; 41 L. T. 426 (1889), Kay, J.

(*i*) Sect. 62 (1); above, p. 64.

(*k*) Sects. 62 (2), 64 (2), 74 (2), Rules 7—16, Instructions 8—14, Appendix, pp. 692 to 695, and 725, 726. See also *Wright, Crossley & Co.'s Application*, (1900) 2 Ch. 218; 17 R. P. C. 386.

(*l*) Sect. 63, p. 76.

(*m*) Sect. 64 (1), Chap. VIII., p. 117.

(*n*) Sect. 69, pp. 79 *et seq.*

(*o*) See per Cotton, L. J., in *Hudson's Tm.*, 32 C. D. p. 320; 3 R. P. C. 155 (1886); *Roger's Tm.*, 12 R. P. C. 149 (1895), North, J. And see Chap. X., p. 211.

(*p*) Chap. VIII., p. 135. Of course a common mark is not distinctive, and therefore falls under the fourth objection.

(*q*) Sect. 71. Rules 43—45.

(7.) The mark tendered is identical with, or has a resemblance which is calculated to deceive to, another mark already on the Register for the same goods or description of goods (*r*).

(8.) It comprises words the use of which, by reason of their being calculated to deceive or otherwise, would be deemed disentitled to protection in a Court of Justice (*s*).

(9.) It comprises a scandalous design (*s*).

(10.) Its use would, in the Comptroller's opinion, be contrary to law or morality (*t*).

(11.) It contains one or more of the things which, according to the rules, cannot be registered as marks or parts of new marks (*u*), *e.g.*, the royal arms (*v*).

The Comptroller's discretion to refuse to register.

The discretion to refuse to register which is vested in the Comptroller is a judicial discretion, and is subject to the appeal referred to below. It is submitted that, in the exercise of it, regard ought not to be had to considerations other than those just enumerated above, or such further objections, if there are any, as would have been bars to the acquisition of trade-mark rights at common law, or as are sanctioned by the terms of the Act (*x*). In some of the cases cited in the next paragraphs, however, the Comptroller's discretion has been referred to in very general terms; but these references ought, probably, to be understood as directed to cases of suggested deceptive marks, such as those in which the several *dicta* were spoken (*y*).

(*r*) Sect. 72, pp. 212, 220.

(*s*) Sect. 73, p. 253.

(*t*) Sect. 86.

(*u*) Instructions 28—30; p. 728, below. See also the Official Notices, Appendix, p. 731. The Court will be slow to depart from a practice of the Office founded upon the Instructions. See *König and Ebhardt's Tm.*, (1896) 2 Ch. 236; 13 R. P. C. 449, Stirling, J.

(*v*) See *Habbuck* v. *Brown*, 17 R. P. C. 148 (1900), where Kekewich, J., whose decision was subsequently affirmed by the Court of Appeal (17 R. P. C. 638), said that the exclusive right to the royal arms could not be claimed by the plaintiffs.

(*x*) In *Players' Application*, (1901) 1 Ch. 382; 18 R. P. C. 65, Cozens-Hardy, J., upheld the Comptroller's objection that the mark applied for was substantially the same as a previously registered mark of the applicants', the application for which had stated that they would in use vary the words *Navy Cut* (the exclusive use of which was disclaimed). The mark applied for contained the words *Navy Mixture*, the exclusive use of them being disclaimed.

(*y*) And for instance, *Deschurst's Application*, (1896) 2 Ch. 137; 13 R. P. C. 288, C. A.

"The Comptroller," Kay, J., said, in *The Emollio Case* (*z*), "when he is asked to register a trade-mark, is bound to consider whether, looking to all the circumstances of the case, he can exercise his discretion by permitting the trade-mark to be registered." And in *The Australian Wine Importer's Case* (*a*), the same learned judge said: "Does it follow because (the opponent) could not get an injunction, that (the applicant) is entitled to put the trade-mark on the register? In my opinion, it does not follow at all, and I have said so many times. In my opinion the Comptroller ought to exercise his discretion in a wise (*b*) and comprehensive way."

Eno v. *Dunn.*

The existence of a discretion to refuse registration was asserted in the most decisive manner by the majority of the Law Lords in the House of Lords in *The Fruit Salt Case* (*c*). There, Lord Herschell said: "The case was argued on behalf of the respondent as if he had an absolute right to have any trade-mark registered which was not proved to fall within the terms of either the 72nd or 73rd section of the Act. Those sections prohibit the registration of a trade-mark in certain specified cases, but there is no duty cast upon the Comptroller of registering every other trade-mark that may be applied for. On the contrary, whilst he is in certain cases prohibited from registering, a discretion whether to register or not appears to me to be in all other cases plainly conferred. Of course, this discretion must be reasonably and not capriciously exercised; but it is, in my opinion, a reasonable exercise of it to refuse registration when it is not clear that deception might not result from it." And Lord Watson said that in cases where it is doubtful whether a trade-mark tendered for registration is calculated to deceive or not, the application ought to be disallowed. Lord Halsbury, who dissented from the conclusion arrived at in the case, treated the Comptroller's

(*z*) *Grossmith's Tm.*, 6 R. P. C. 180; 60 L. T. 612 (1889).

(*a*) 41 C. D. 278; 6 R. P. C. 311 (1889). See also *Turney & Sons' Tm.*, 11 R. P. C. at p. 44, (1894) North, J.

(*b*) *Quære* wide.

(*c*) *Eno* v. *Dunn*, 15 App. Ca. 252; 7 R. P. C. 311 (1890) Lords Watson, Herschell, and Macnaghten. Lords Halsbury and Morris dissented from the decision arrived at, which was that the mark in question was calculated to deceive.

discretion as more closely limited. "While I agree," he said, "that no absolute right to the registration of a trade-mark is given to an applicant for registration, the meaning and intent of the statute itself is that, unless for some of the reasons contemplated by the statute there is an objection to the registration, the trade-mark ought to be registered. Unless we are of opinion that there is something in the proposed trade-mark which the statute renders an objection to its registration, we ought to grant the application" (to register). And this opinion accords with that expressed by Lord Blackburn in *The Orr-Ewing Case*, soon after the passing of the Act of 1875 (*d*). "I cannot construe this section" (*e*), his Lordship said, "as meaning anything else than that, when the Court of Chancery is satisfied that the applicant is a person who is, for the time being, entitled to the exclusive use of a trade-mark in accordance with law, and that the trade-mark is one within (the definition section of the Act); the Court is, *ex debito justitiæ*, to rectify the register (*f*), just as it would, before the Act of 1875, have been bound *ex debito justitiæ* on similar proof, to prevent anyone infringing the trade-mark shown to be his property. The burden of proof lies upon the person making the application to amend the register; but if he does produce such proof as would, in the opinion of the Court, entitle him to an injunction, I do not think the words 'if satisfied of the justice of the case' can, or ought to be, construed as meaning to give the Court a discretion to consider whether the nature of the trade-mark is such as to make it inconvenient that he should exercise the right of property which it is proved he actually has."

The Orr-Ewing Case.

The opinion last cited was delivered in a case where the marks concerned were old marks, and the apparent conflict between it and the opinions of the majority of the Law

(*d*) *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Ca. 479; 48 L. J. Ch. p. 717 (1879). Lord Cairns held the same opinion, for he speaks of the appellant's right to be registered. Lord Gordon, the remaining judge, concurred in Lord Blackburn's judgment.

(*e*) Sect. 5 of the Act of 1875, corresponding to sect. 90 of the present Act.

(*f*) Upon the refusal of the Registrar to register a mark under the old Act, the procedure by way of appeal was to move to rectify.

Lords in *The Fruit Salt Case* may probably be reconciled by treating the doctrine of a right *ex debito justitiæ* to register as applicable only to marks used as trade-marks before the 13th of August, 1875. Sect. 77 expressly excepts from the prohibition of actions for the infringement of unregistered trade-marks the cases of such old marks as have been refused registration, and the corresponding section previously in force contained a similar exception (*g*). This last-mentioned exception was, however, cited by Lord Blackburn in his opinion. He stated that it did not affect the conclusion he had arrived at.

In his dissenting judgment in *The Somatose Case* (*h*), Lindley, L. J., said: "The sections (*i.e.*, sects. 70, 72 and 73) and the discretion given by sect. 62 (4) of the Act of 1883 .... would clearly justify the rejection of any trade-mark, even if it contains one of the statutory requisites, if such mark be of an indecent or libellous character, or if it infringes the rights of some other person, or if it is identical with, or so similar to one already registered as to be calculated to deceive. But I can find no other restriction, and if a person seeks to register a mark which is open to none of these objections, and which does contain one of the essentials mentioned in sect. 10 of the Act of 1888, I am aware of no legal principle which would justify the Court in refusing to direct its registration."

In *The Solio Case*, Kekewich, J. (*i*), in upholding the refusal by the Comptroller to register the word *Solio*, gave considerable weight to the consideration that he would be overruling the discretion of the Comptroller, and reversing a practice of the office not to register in connection with photographic materials words indicating a connection with the sun; but in the Court of Appeal (*k*), and also in the House of Lords (*l*), where the registration was allowed, the question was treated

(*g*) Act of 1876, s. 1.

(*h*) *Farbenfabriken Formals Fried. Bayer & Co.'s Tm.*, 11 R. P. C. p. 88; (1894) 1 Ch. 645. Kay and Smith, L. JJ., did not discuss this point.

(*i*) *Eastman Photographic Materials Co.'s Application*, 13 R. P. C. at p. 709; 76 L. T. N.S. at p. 731 (1897).

(*k*) 14 R. P. C. 487; 76 L. T. N.S. 732.

(*l*) (1898) A. C. 571; 15 R. P. C. 476.

as being purely whether the word fell within one of the essential particulars defined in the Act (*m*).

Where the Comptroller takes objection to a mark on the ground of its resemblance to a registered mark, the matter is not concluded by the consent of the owner of the latter mark to the registration. Such consent may be evidence as to the probability of deception. It does not bind the Comptroller (*n*).

Comptroller to hear applicant before refusing the application.

The Comptroller is directed, before exercising his discretion adversely to an applicant for registration, if so required within one month from the date of his objection, to give the applicant an opportunity of being heard personally or by his agent, by sending the applicant ten days' notice of a time when he may be so heard, and the applicant is directed, within five days from the date when such notice would be delivered in the ordinary course of the post, to notify to the Comptroller whether he intends to be so heard or not (*o*).

The decision of the Comptroller against an applicant (*p*) for or against an opponent (*q*) of, the registration of a mark is subject to appeal to the Board of Trade, who may refer the question to the Court (*r*).

The Comptroller may consult the law officers, and he acts under the Board of Trade.

The Comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of the Act, apply to either of the law officers for directions in the matter (*s*). It has been decided by the Court of Appeal in a patent case (*t*) that in any such case the Comptroller may so apply, notwithstanding that the matter involves a question of construction of the Act, and the Court will not in its discretion grant a mandamus against the Comptroller where he has properly taken the direction of the law officer under the section (*u*).

(*m*) And see *Linotype Co.'s Application*, 14 R. P. C. 900, (1897) Kekewich, J.

(*n*) *Deuhurst's Application*, (1896) 2 Ch. 137; 13 R. P. C. 288, C. A.

(*o*) Sect. 94. Rules 17 and 18.

(*p*) Sect. 62 (4), (5): *Re Australian Wine Importers, Limited*, 41 C. D. p. 285; 6 R. P. C. p. 314.

(*q*) Sect. 69 (3), (4).

(*r*) Page 86, below.

(*s*) Sect. 95. *Re Tm. Normal*, 35 C. D. p. 245; 4 R. P. C. 123, per Lindley, L. J.

(*t*) *R. v. The Comptroller-General of Patents, Ex parte Tomlinson*, (1899) 1 Q. B. 909; 16 R. P. C. 233, Grantham and Kennedy, JJ., and C. A.

(*u*) See also the judgment of Lindley, L. J., in *Re Tm. Normal*, 35 C. D. p. 245; 4 R. P. C. p. 128 (1887), C. A.

But, of course, the direction of the law officer would not interfere with any right of appeal expressly conferred by the Act.

It is also provided by sect. 82 (3), that the Comptroller shall act under the superintendence and direction of the Board of Trade. It was formerly the practice for him to consult the Board in regard to his decisions in individual cases, but Lord Herschell's Committee recommended that this practice should be abandoned: they said, "we think it was only intended that the Board of Trade should give general directions or settle questions of general practice; not that they should interfere with the personal responsibility of the Comptroller in individual cases, except when the matter comes before them in due course of appeal" (*x*).

3. Procedure on application to Register.

The procedure by which an application to register is to be made is described in the paragraphs 8 to 27 of the instructions printed in the Appendix (*y*), and by Rules 7 to 16 (*z*). A printed form of application corresponding with the form F. (*a*) attached to the rules, which is the form at present in use, may be obtained, and it must be filled up, and the necessary representations of the mark must be attached to and sent with it, in accordance with the rules, and the directions given in the notes to the form.

Form of application.

When a trade-mark contains a word or words in other than Roman characters, a sufficient transliteration and translation to the satisfaction of the Comptroller of each of such words must be given; and where a trade-mark contains a word or words in a language other than English, the Comptroller may ask for an exact translation thereof (*b*).

The applicant for registration must state in his application the essential particulars of the trade-mark, and must disclaim any right to the exclusive use of the additional matter, if

Essential particulars and disclaimers.

(*x*) Report of 1888, p. vii.

(*y*) Page 725.

(*z*) By the Trade-Mark Rules of 1897 and 1898, new rules have been substituted for Rules 9, 13, 14, and 15 of 1890.

(*a*) Page 706. Sect. 62 (2).

(*b*) See the present Rule 15, Trade-Mark Rules 1897, below, p. 694.

there is any in the mark, and a copy of the statement and disclaimer are to be entered upon the Register (*e*).

What may be essential particulars of registered trade-marks is considered in Chapter VIII. (*d*), and additions and disclaimers are dealt with in Chapter IX. (*e*).

The address of the applicant must in every case be stated in full in the form, and it is provided by the Act of 1888 (*f*) that, "where an applicant for the registration of a trade-mark, otherwise than under an international convention (*g*), is out of the United Kingdom at the time of making the application, he shall give the Comptroller an address for service in the United Kingdom, and if he fails to do so the application shall not be proceeded with until the address has been given."

Abandonment of the application.

It is provided by **sect. 63** that—

"Where registration of a trade-mark has not been or shall not be completed within twelve months from the date of the application, by reason of default on the part of the applicant, *the application shall be deemed to be abandoned* [the Comptroller shall give notice of the non-completion to the agent employed on behalf of the applicant, and if at the expiration of fourteen days from that notice the registration is not completed, shall give the like notice to the applicant, and if at the expiration of the latter fourteen days, or such further time as the Comptroller may in special cases permit, the registration is not completed, the application shall be deemed to be abandoned]."

The amendment was made by sect. 9 of the Act of 1888 in accordance with a recommendation of Lord Herschell's Committee, in order to avoid such accidents as had happened in *Jackson* v. *Napper* (*h*), where the proprietors imagined that their trade-mark had been registered.

(*c*) This is an addition to sect. 64 (2) made by sects. 10 and 16 of the Act of 1888. It applies to all old marks which are not within sect. 63 (3) (ii). See *Wright, Crossley & Co.'s Application*, (1900) 2 Ch. 218; 17 R. P. C. 386.

(*d*) Page 115.

(*e*) Page 197.

(*f*) Sect. 8. Sect. 62 (6) of Act of 1883.

(*g*) Sect. 103. Chap. XX., p. 546.

(*h*) 35 C. D. 162; 4 R. P. C. 46 (1886), Stirling, J.; and see *Loftus' Tm.*, (1894) 1 Ch. 193; 11 R. P. C. 29, North, J.

Sect. 63 was held to be retrospective (*i*), but not to operate so as to prevent a fresh application being made in a case where the merits of the abandoned application had never been gone into or considered (*j*). By sect. 27 of the Act of 1888 the Act of 1883 is, as from the commencement of the Act of 1888, to take effect subject to the additions, omissions, and substitutions required by the latter, but nothing in the Act of 1888 is to affect the validity of any act done, right acquired, or liability incurred before its commencement (*k*).

The Comptroller may either accept the mark tendered or refuse it. Unless he refuses to entertain the application (*l*), he is directed to cause it to be advertised (*m*) in the official paper during such times and in such manner as he thinks fit (*n*). The advertisement comprises either a representation of the mark or a reference to the place where a specimen or representation is deposited for exhibition (*n*). It is then open for any one who objects to the registration, within one month, or such further time, not exceeding three months, as the Comptroller may allow, after the advertisement, to send in notice of opposition (*o*). **Advertisement.**

If there is no opposition, or if the opposition is disallowed, and the Comptroller is satisfied that the applicant is entitled to registration, the registration proceeds. This is provided by Rule 32, which is as follows:—

The registration.

"As soon as may be after the expiration of one month from the date of the advertisement of the application the Comptroller shall, subject to opposition to the application and the determination thereof, if he is satisfied that the applicant is entitled to registration, and on payment of

(*i*) *Haycard's Tm.*, 54 L. J. Ch. 1003; 53 L. T. N.S. 487 (1885), Kay, J.; and *Jackson* v. *Napper*, *supra*.

(*j*) See note (*h*), *ante*, p. 76.

(*k*) As to this proviso, see *Loftus' Tm.*, *supra*; *Burgoyne's Tm.*, 6 R. P. C. p. 231 (1889), Chitty, J.; *Apollinaris Co.'s Tms.*, (1891) 2 Ch. at p. 201; 8 R. P. C. at p. 148, Stirling, J.; *Talbot's Tm.*, 11 R. P. C. 77; 63 L. J. Ch. 264 (1894), Stirling, J.

(*l*) Act of 1888, s. 12.

(*m*) Act of 1883, s. 68. Before the Act of 1888, the mark had to be advertised in every case.

(*n*) Rules 27—30. Since the beginning of the year 1892, the advertisements have included all statements and disclaimers made in pursuance of sects. 64 and 74. See Official Notice, printed in the Appendix, p. 732.

(*o*) Sect. 69, as amended by sect. 13 of the Act of 1888. See p. 79, below.

the prescribed fee (*p*), enter the name, address, and description of the applicant in the Register of trade-marks, as the registered proprietor of the trade-mark in respect of the particular goods or classes of goods described in his application" (*q*).

Death of the applicant before registration.

If the applicant have died before the registration, the Comptroller may register the name of the person owning the goodwill of his business, after the death and ownership have been proved to the satisfaction of the Comptroller (*r*).

Refusal to register.

If the Comptroller refuses the application, he gives notice of his objection to the applicant so that he may, if he thinks it advisable, require the Comptroller to hear him upon the application personally, or by his agent (*s*).

Certificate of refusal to register an old mark.

Where the Comptroller refuses an old mark, that is, a mark used as a trade-mark before 13th August, 1875, he may, on request, and on payment of the prescribed fee (*t*), grant a certificate that registration has been refused (*u*).

Amendments.

Amendment of application.

The Comptroller may, on request in writing accompanied by the prescribed fee (*x*), correct any clerical error in, or in connection with, an application for registration of a trade-mark (*y*), and may permit an applicant for registration of a trade-mark to amend his application by omitting any particular goods or classes of goods in connection with which he has desired the trade-mark to be registered (*z*). And a more general power of amendment is provided by Rule 54, by which, "any document or drawing or other representation of a trade-mark for the amending of which no special provision is made by the said Acts may be amended, and any irregularity in procedure, which in the opinion of the Comptroller may be obviated without detriment to the interests of

(*p*) See Table of Fees, p. 703.

(*q*) See Chap. III., p. 56, on the Register, and Rule 34.

(*r*) Rule 33.

(*s*) Sect. 94. Rules 17—19.

(*t*) £1, see Table of Fees, p. 703.

(*u*) Sect. 77. Rule 60. Instructions 35.

(*x*) 5*s*.

(*y*) Sect. 91 (a).

(*z*) Act of 1888, s. 24, Act of 1883, as amended, and sect. 91 (d).

any person may be corrected, if the Comptroller think fit, and on such terms as he may direct" (*a*).

Enlargement of the prescribed times.

It is further provided that the time prescribed by the Rules for doing any act or taking any proceeding thereunder, may be enlarged by the Comptroller, if he shall think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms as he may direct (*b*).

4. Opposition to Registration.

When the mark has been accepted and advertised, any person—not merely any person who would be aggrieved by the registration (*c*)—may oppose the registration by showing that the mark is, or would, if registered, be, an infringement of his rights, or that on any other ground it ought not to be registered (*d*).

Opposition to registration.

The procedure by which an opposition is to be conducted is regulated by sect. 69 of the Act of 1883, as amended by sect. 13 of the Act of 1888, and by Rule 31 (*e*), which provide as follows:—

Sect. 69. "(1.) Any person may within *two months* [one month or such further time, not exceeding three months, as the comptroller may allow] of the *first* advertisement of the application, give notice in duplicate at the Patent Office of opposition to registration of the trade-mark, and the Comptroller shall send one copy of such notice to the applicant.

"(2.) Within *two months* [one month] after receipt of such notice or such further time as the Comptroller may allow, the applicant may send to the Comptroller a counter-statement in duplicate of the grounds on which he relies for his application, and if he does not do so, shall be deemed to have abandoned his application (*f*).

"[(3.) If the applicant sends such counter-statement

(*a*) For the decisions under this with regard to notices of opposition, see p. 84, below.

(*b*) Rule 55.

(*c*) Cf. sect. 90. But see *R.* v. *The Comptroller-General of Patents*, *Ex parte Tomlinson*, (1899) 1 Q. B. 909; 16 R. P. C. 233, C. A.

(*d*) Below, p. 85.

(*e*) These are summarised in par. 32 of the Instructions, Appendix, p. 728.

(*f*) Cf. sect. 63, above, p. 76.

the Comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall, after hearing the applicant and the opponent, if so required, decide whether the trade-mark is to be registered, but his decision shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the opponent and the Comptroller, and may make an order determining whether, and subject to what conditions (if any), registration is to be permitted.]

"[(4.) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court, and in that event the Court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid.]

"[(5.) If the applicant abandons his application after notice of opposition in pursuance of this section he shall be liable to pay to the opponent such costs in respect of the opposition as the Comptroller may determine to be reasonable.]

Notice of opposition.

"[(6.) Where the opponent is out of the United Kingdom (*g*) he shall give the Comptroller an address for service in the United Kingdom.]"

RULE 31. "(1.) A notice of opposition to the registration of a trade-mark shall state the ground or grounds on which the opponent intends to oppose the registration, and be signed by him or by his solicitor, and shall also contain an address for service in the United Kingdom, and shall be in the Form J. (*h*) in the second schedule to these Rules, with such variations as circumstances may require.

Opposition on the ground of trade-mark already on the Register.

"(2.) Where the grounds, or one of the grounds, of opposition is that the applicant is applying for the registration of a trade-mark identical with one already on the Register with respect to the same goods or description of goods, or having such resemblance to a trade-mark already on the Register with respect to such goods or description of goods as to be calculated to deceive, the

(*g*) Cf. sect. 62 (6), above, p. 65.

(*h*) Appendix, p. 708.

notice shall state the date of registration, and the number on the Register of such trade-mark already on the Register (*i*).

Opponent's evidence.

"(3.) Within two months after the expiration of one month, or such further time not exceeding three months as the Comptroller may allow from the date of the advertisement of the application, the opponent shall leave at the Patent Office, Trade-Marks Branch, such evidence by way of statutory declaration (*k*) as he may desire to adduce in support of his opposition, and deliver to the applicant copies thereof.

Applicant's evidence.

"(4.) Within one month from the delivery of the opponent's copies of his statutory declarations (*l*) the applicant shall leave at the Patent Office, Trade-Marks Branch, his evidence (*m*) by way of statutory declaration in answer, and deliver to the opponent copies thereof, and within seven days from such delivery the opponent shall leave at the Patent Office, Trade-Marks Branch, his evidence by way of statutory declaration in reply, and deliver to the applicant copies thereof. Such last-mentioned evidence shall be confined to matters strictly in reply.

Evidence in reply.

Closing of evidence.

"(5.) No further evidence shall be left on either side except by leave of the Comptroller upon the written consent of the parties duly notified to him, or by special leave of the Comptroller given on an application made to him.

Applications for leave to adduce further evidence.

"(6.) Either party making such application shall give notice thereof to the opposite party, who shall be entitled to oppose the application.

Appointment of time for hearing.

"(7.) On the completion of the evidence, the Comptroller shall, upon application by either party, upon Form E. (*n*) in the Second Schedule to these Rules, and

(*i*) Sect. 72, Chap. X., p. 212. The date and number can be ascertained by inspecting the Register.

(*k*) See Rule 61, p. 702.

(*l*) *Ibid.*

(*m*) The applicant's *counter-statement* must be sent to the Comptroller within one month after the receipt of notice of opposition, or such further time as the Comptroller may allow, sect. 69 (2).

(*n*) Appendix, p. 705.

upon payment of the prescribed fee (*o*), appoint a time for the hearing of the case, and shall give the parties at least seven days' notice of such appointment.

Disallowance of opposition in certain cases.

"(8.) On the hearing of the case no opposition shall be allowed in respect of any ground not stated in the notice of opposition, and where the ground or one of the grounds of opposition is that registration is being applied for in respect of a trade-mark identical with one already on the Register, with respect to the same goods or description of goods, or having such resemblance to a trade-mark already on the Register with respect to such goods or description of goods as to be calculated to deceive, the opposition shall not be allowed upon such ground, unless the date of registration and the number on the Register of the trade-mark already on the Register have been duly specified in the notice of opposition (*p*).

"(9.) The decision of the Comptroller in the case shall be notified to the parties."

Summary of procedure on an opposed application.

The order of procedure upon an opposed application for registration is summarised in the following table:—

(1) Application (*q*).

[(2) Notice of objection of Comptroller to entertain the application (*r*).

(3) Notification by applicant to the Comptroller that he wishes to be heard, within one month of (2) (*s*).

(4) Ten days' notice of appointment for hearing from Comptroller to applicant, and counter-notice by applicant within five days (*ss*).

(5) Notice of appeal to Board of Trade, one month from decision of Comptroller, with grounds of appeal and case in support (*t*).]

(6) Advertisement of application (*u*).

(7) Notice of opposition, one month from advertisement. Notice to be in duplicate, with grounds of opposition,

(*o*) £1, see p. 703, below.

(*p*) Cf. Rule 31 (2), *supra*.

(*q*) Page 74. Form F., p. 706.

(*r*) Rule 17.

(*s*) Page 74. Form E., p. 705. No fee appears to be payable except in cases of opposition.

(*ss*) Rule 18.

(*t*) Rules 20—26, below, p. 695.

(*u*) Page 77.

and address in United Kingdom, and to be signed by opponent or his solicitor (*v*).

(8) Counter-statement (in support of the application), one month from receipt of (7) from Comptroller. To be in duplicate with grounds of application (*x*).

(9) Opponent's evidence, three months from advertisement (6). To be by statutory declaration delivered at the Patent Office. Copies of the declarations to applicant.

(10) Applicant's evidence in answer, one month from receipt of (9). To be by statutory declarations and copies as (9).

(11) Opponent's evidence in reply, seven days from receipt of (10). Statutory declarations and copies as (9).

(12) Notice of appeal to Board of Trade, one month from decision of Comptroller, with grounds of appeal and case in support (*y*).

Forms of the several notices and other documents referred to in the above table are set out in the Appendix, pp. 735 to 741.

The last four sub-sections of sect. 69 were introduced by the Act of 1888, and they have the effect of assimilating the procedure upon an opposition to that upon the application before the advertisement (sect. 62). Under the Act of 1883, as it originally stood (*z*), the opponent was required to give security for costs, or was deemed to have withdrawn his opposition. If he duly gave security the case was not, as it now is, determined by the Comptroller in the first instance, subject to appeal to the Board of Trade and reference to the Court, but was referred to the Court at once (*a*). The alteration was made, and the power of the Comptroller to give the opponent the costs of an abandoned application was conferred upon the recommendation of Lord Herschell's Committee. It is somewhat curious that no provision has

(*v*) Form J., Appendix, pp. 708, 735.

(*x*) See form in Appendix, p. 736.

(*y*) Appendix, pp. 707, 737.

(*z*) Sect. 69 (3) and (4).

(*a*) As to the old practice, see *Re Simpson, Davies & Sons' Tm.*, 15 C. D. 525; 42 L. T. 675 (1880), Jessel, M.R.; *Anderson's Tm.*, 26 C. D. 409; 53 L. J. Ch. 664 (1884), Chitty, J.: Sebastian, 3rd ed., p. 434.

been made to give the applicant costs of an unsuccessful opposition before the Comptroller (*b*).

Objections not contained in the notice of opposition.

It will be seen that the Comptroller in determining the case is, under Rule 31 (8), restricted to the objections raised by the opponent's notice. It has been said, however, that the Court must, upon an appeal to it, consider all objections to the registration of the mark (*c*). And it does not follow that the Comptroller will necessarily register a mark, even where he is obliged to disallow the opposition to it, if, as it is submitted is the case, his discretion (*d*) to refuse to register remains exercisable, until the registration has been actually effected.

Amendments and enlargement of times by the Comptroller.

The Comptroller's powers under sect. 91 and Rules 54 and 55 to amend clerical errors in connection with any application for registration, and to allow the amendment of any document, drawing, or representation of a trade-mark, for the amendment of which no special provision is made by the Acts, and to enlarge the times prescribed by the rules for doing any act or taking any proceeding thereunder, have already been stated (*e*).

Under Rule 54, it seems that a notice of opposition may be amended, even though the amendment raises an entirely new case of fraud against the applicant. So, in *Moët's Trade-Mark* (*f*), where the Comptroller's deputy had refused to amend an opposition on the ground that he had no power, and notwithstanding that he had also expressed an opinion that, as it was directed to charge fraud against the applicant, it could not be made "without detriment to his interests," and that on the merits it ought not to be allowed, the Divisional Court directed a mandamus to the Comptroller to hear and determine the application to allow the amendment, and Mathew, J., said he thought it ought to be made.

The Registrar (sitting for the Comptroller) has held that he has no jurisdiction to allow an amendment of a notice of opposition after the expiration of the three months mentioned

(*b*) See p. 95, below.

(*c*) See p. 92, below.

(*d*) Under sect. 62, see p. 69, above.

(*e*) Page 78, above; cf. also Rule 53 (power to dispense with evidence), Appendix, p. 701.

(*f*) 7 R. P. C. 226 (1890), Mathew and Grantham, JJ.

in sect. 69, or after the case has been heard and disposed of before the Comptroller. In the case in question (*g*), the opponent in the course of an appeal to the Courts asked for leave to amend his notice, but this, Stirling, J., held, he had no jurisdiction to grant, and the opponent then made a similar application to the Registrar, with the result already stated. Where an appeal is contemplated, it is essential, therefore, that any amendment of the application or notice of opposition which is considered material should be made before the case is determined by the Comptroller.

Grounds of Opposition.

The reasons for refusing to register a mark which is propounded for registration are dealt with in detail elsewhere (*h*). Those which are most commonly relied on by an opponent are the following:

(i.) That the mark propounded has such resemblance to a trade-mark already on the Register with respect to the goods or the description of goods for which the mark propounded is sought to be registered as to be calculated to deceive (*i*). In this case the register number of the mark already on the Register, and the date of its registration, must be stated in the notice of opposition (*k*).

(ii.) That the registration or use of the mark would interfere with the use by the opponent of some mark in which he has rights, or which he is actually lawfully using, whether as an unregistered trade-mark (*l*), or as an advertisement (*m*), or as a mark common in the trade (*n*), and that, consequently, the applicant's mark is not distinctive.

(iii.) That the mark propounded is his mark, and not that

(*g*) *Robertson, Sanderson & Co.'s Tm.*, (1892) 2 Ch. 245; 9 R. P. C. 264.

(*h*) See above, p. 69, and the Chapter on Rectification of the Register, p. 262; Forms, Appendix, pp. 735 *et seq.*

(*i*) Sect. 72 (2), p. 220.

(*k*) Rule 31 (2) and (8), above, p. 80.

(*l*) Page 138.

(*m*) Page 139.

(*n*) Page 135.

of the applicant (*o*), or that it has been acquired by the applicant in fraud of his rights (*p*).

5. Appeal from the Comptroller.

By sect. 62 (4) and (5), and sect. 69 (3) and (4) (*q*), which are in similar terms, an appeal to the Board of Trade from the decision of the Comptroller refusing to register the trade-mark, is given whether there has or has not been any opposition. In the latter case it would still be open to the Comptroller, after a successful appeal from his refusal to accept a mark, on notice of opposition from an opponent under sect. 69, to refuse registration (*r*). An appeal is also given by sect. 69 to an opponent who has unsuccessfully resisted the registration of a mark. These appeals were introduced by the Act of 1883.

Appeal to the Board of Trade.

The practice on appeal to the Board of Trade is governed by Rules 20 to 26 inclusive, which are as follows:—

Notice of appeal.

"20. When any person intends to appeal to the Board of Trade from a decision of the Comptroller in any case in which an appeal is given by the said Acts, he shall, within one month from the date of the decision appealed against, leave at the Patent Office, Trade-Marks Branch, a notice of such his intention.

Grounds of appeal to be stated.

"21. Such notice shall be accompanied by a statement in writing of the grounds of appeal, and of the appellant's case in support thereof.

Transmission of notice.

"22. A copy of the notice of intention to appeal, accompanied by a statement of the case, shall also be forthwith sent to the Secretary of the Board of Trade, No. 7, Whitehall Gardens, London; and, where there has been an opposition before the Comptroller, to the opponent or applicant as the case may be.

Directions by Board.

"23. The Board of Trade may thereupon give such directions (if any) as they may think fit with respect to

(*o*) Sects. 71 and 72 (1), p. 212, and see "proprietor," p. 65. The mark may be copyright. As to a copy of a foreign picture, see *Schauer* v. *Field*, (1893) 1 Ch. 35; 62 L. J. Ch. 72, C. A.

(*p*) *Heaton's Tm.*, 27 C. D. 570 (1884), Kay, J. (*Hoop L. Iron*); *Moët's Tm.*, 7 R. P. C. 226 (1890), Mathew and Grantham, JJ.

(*q*) Above, pp. 64 and 79.

(*r*) See the judgments in *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Ca. 479; 48 L. J. Ch. 707 (1879).

evidence, or otherwise, for the purpose of the hearing of the appeal by the Board of Trade, or for the purpose of their referring the appeal to the Court to hear and determine the same (*s*).

Hearing of appeal.

"24. Where the Board of Trade intend to hear the appeal, seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for the hearing, shall be given to the Comptroller and to the appellant; and, where there has been an opposition before the Comptroller, to the opponent or applicant as the case may be.

No appeal unless notice duly given.

"25. No appeal shall be entertained of which notice has not been given within one month from the date of the decision appealed against, or such further time as the Comptroller may allow, except by special leave of the Board of Trade.

Evidence on appeal.

"26. Subject to the directions and leave of the Board of Trade, the evidence to be used on an appeal to the Board of Trade in the matter of an opposition shall be the same as that used at the hearing before the Comptroller."

Notice of and case on appeal.

The fee payable on appeal is at present 1*l.*, and the notice of appeal in use is Form H., which must be filled up in accordance with the marginal notes (*t*). The case on appeal is a summary statement, generally drafted in a somewhat argumentative form, of the questions raised and the facts upon which the appellant relies, and it may include the statement of the grounds of appeal, which must be sent with the notice. Forms of notice and case on appeal are given in the Appendix (*t*).

The case frequently concludes with a request that the appeal may be referred to the Court, and the Board of Trade, in that case, usually so refer it at once without hearing the parties themselves, in accordance with the recommendation

(*s*) The directions may include a direction to the applicant to serve a person materially interested, and also directions allowing fresh evidence to be adduced before the Court, if the latter think fit: *Application of Extract of Meat (Baron Liebig) Photograph Brand, Ld.*, 17 R. P. C. 161 (1900), Cozens-Hardy, J., where, and also in the Appendix, at p. 740, the general form of the directions will be found set out.

(*t*) Pages 707, 737.

of Lord Herschell's Committee (*u*). It is presumed that where any real question was raised either of law or fact the Board would, if requested, refer the matter to the Court (*x*).

No appeal to the Court direct.

There is no appeal other than that given by this section, open to an unsuccessful applicant, for he cannot apply to the Court under sect. 90 as a person aggrieved by the omission of his name from the Register (*y*); but the authority referred to (*y*) does not directly apply to the case of an unsuccessful opponent, although much of the reasoning of it does. It would, however, be anomalous that any other person aggrieved should be able to apply to remove a mark from the Register, but that one who had opposed the registration before the Comptroller should be barred (*z*). No doubt, if the opposition had come before the Court the matter would be *res judicata* between the registered owner and the opponent (*a*).

The Court.

The Court is the High Court of Justice (*b*) in England (*c*), but in practice all the appeals are heard in the Chancery Division.

Reference of rival claims to the same mark to the Court direct.

The Comptroller may, however, under sect. 71, submit, or require the claimants to submit, their rights to the Court direct in any case where each of several persons claims to be registered as proprietor of the same trade-mark. The sub-

(*u*) Report of 1888, p. vii.

(*x*) See the *Normal Co.'s Tm.*, 35 C. D. 231; 3 R. P. C. 269; 4 R. P. C. 123 (1886). The present practice of the Board is to refer the appeal when the mark has been refused under sect. 72, but (as a rule) to hear it when the mark has been refused under sect. 64.

(*y*) *Normal Co.'s Tm.*, and cf. *Woolley* v. *Broad*, (1892) 1 Q. B. 806; 9 R. P. C. 208, Lawrance and Wright, JJ.

(*z*) See, however, *Moët's Tm.*, 7 R. P. C. 226 (1890), Mathew and Grantham, JJ.

(*a*) In *Re Arbenz's Application*, 35 C. D. p. 257; 4 R. P. C. 143 (1887), the Court of Appeal required the opponent, who was appealing, as a condition for leave to appeal out of time, to undertake not to move to rectify the Register.

(*b*) Sect. 117 (1). So that an order of the House of Lords allowing an appeal from the Comptroller should be remitted to the High Court for execution: *Re Orr-Ewing & Co.*, 28 W. R. 412 (1880), Hall, V.-C. The order is made an order of the High Court on motion of course, which may be *ex parte*: Seton, 5th ed., 746, and *Badische Anilin und Soda Fabrik* v. *Levinstein*, 4 R. P. C. at p. 470 (1887), Chitty, J.

(*c*) Sect. 117 (1). The provisions for Scotland, Ireland, and the Isle of Man do not seem to authorise a reference to any other Court.

mission is, unless the Court otherwise directs, by a special case, which may be settled by the Comptroller in case of difference (*d*).

Appeal by summons or notice of motion.

The appeal may be brought before the Court on summons or by motion (*e*), asking that the appeal may be heard and decided, and that the Comptroller be directed to proceed, or not to proceed, as the case may be, with the registration of the mark in question. Procedure by motion is now the more usual course (*f*); and, as a summons is always adjourned into Court, no expense is saved by proceeding by summons. Some of the judges (*g*) object to determining what are really trials of causes, often involving property rights of considerable value, in the hurry of motion-day; and if the question of registration depends on an issue of fact as to which cross-examination is necessary, the motion or summons is ordered to be set down in the witness list.

Notice of the motion or summons should be given to the Comptroller, so that he may appear if he thinks fit, and the opponent, or the applicant, as the case may be, should be made a respondent. And if there has been no opposition, but the Comptroller has refused to register because of the presence of marks similar to the mark in question on the Register, the Court generally requires notice of the appeal to be sent to the owners of such marks (*h*); and the directions given, on a reference by the Board of Trade to the Court, generally direct service on or notice to such owners (*i*), and

(*d*) Rules 44, 45, p. 699.

(*e*) Daniell's Chancery Practice, p. 1489, Chanc. Forms, p. 671, and see *Simpson, Davies and Sons' Tm.*, 15 C. D. 525 (1880).

(*f*) Procedure by summons was adopted in the *Apollinaris Cases*, (1891) 2 Ch. 186; 8 R. P. C. 137; in *Eno* v. *Dunn*, 15 App. Cas. 252; 7 R. P. C. 311 (1889); and in *Wright, Crossley & Co.'s Application*, 17 R. P. C. 386 (1900). *Eastman Photographic Materials Co., Ld.'s Application*, 13 R. P. C. 707; 76 L. T. 730 (1896); *Extract of Meat (Baron Liebig) Photograph Brand, Ld.'s Application*, 17 R. P. C. 161 (1900); and *Linotype Co.'s Application*, 14 R. P. C. 900 (1897); *Kynoch & Co.'s Tm.*, 14 R. P. C. 905 (1897); *Linotype Co.'s Application* (No. 2), 17 R. P. C. 380 (1900), are recent instances of motions.

(*g*) Kekewich, J., for instance.

(*h*) See *Kenrick and Jefferson's Tm.*, 7 R. P. C. 321 (1890), Chitty, J.

(*i*) See *Dewhurst's Application*, (1896) 2 Ch. 137; 13 R. P. C. 288; and *König and Ebhardt's Tm.*, (1896) 2 Ch. 236; 13 R. P. C. 449; *Pomril, Ld.'s Application*, 18 R. P. C. 181.

even though the Comptroller's refusal is not based on similarity to another registered mark, the Board of Trade may direct service on a person materially interested in the matter (*k*). If the appeal is allowed, or an opposition is disallowed, the successful party must forthwith leave an office copy of the order at the Trade-Marks Branch of the Patent Office, and the Register is thereupon to be rectified or altered, or the purport of the order to be otherwise duly entered in the Register, as the case may be (*l*).

Address for service where the applicant or opponent is abroad.

Where the applicant or opponent is out of the United Kingdom, he is required to give an address for service (*m*); but this does not provide for the case of a Scotch or Irish applicant or opponent. Where, therefore, a person who would otherwise be named as a respondent to the appeal is in Scotland or Ireland, and so cannot be served with the notice of motion or summons, the practice of sending him notice in writing of the day fixed for the hearing, and of omitting his name as respondent, has been introduced (*n*), for this is all that "natural justice" requires (*o*). And if the person to whom such notice has been sent does not choose to appear at the hearing, he is bound by the decision of the Court (*o*).

Scotch or Irish applicant or opponent.

Evidence upon the appeal.

The evidence before the Comptroller, in the case of an opposition, is given by statutory declarations (*p*), or, in special cases, in such other way as the Comptroller directs (*q*). The declarations are not, however, evidence upon an appeal to the Court, and the proper course is for the deponents to verify their declarations by affidavit (*r*). The Board of Trade, in referring an appeal to the Court, generally give the appellant liberty to adduce such further evidence as the

(*k*) *Application of Extract of Meat (Baron Liebig) Photograph Brand, Ld.*, 17 R. P. C. 161 (1900), Cozens-Hardy, J.

(*l*) Rule 46, p. 700.

(*m*) Sects. 62 (6) and 69 (6).

(*n*) *Bancroft & Co.'s Tm.*, 5 R. P. C. 209 (1887); *Stringer's Application*, 8 R. P. C. 445 (1891); *Robertson, Sanderson & Co.'s Tm.*, (1892) 2 Ch. 245; 9 R. P. C. 215; all Stirling, J.

(*o*) *King & Co.'s Tm.*, (1892) 2 Ch. 462; 9 R. P. C. 350, Kekewich, J., and C. A.

(*p*) Rules 31 and 61, pp. 697, 702.

(*q*) Rule 53, p. 701.

(*r*) *Farrow's Tm.*, 7 R. P. C. 260; 63 L. T. 233 (1890), Stirling, J.; and *Kingsford's Application*, 15 R. P. C. 197 (1898), where North, J., held that each declaration must be verified by the declarant himself.

Court may see fit to direct or permit (*s*); and such evidence is usually given on affidavit also (*t*). Where the application to the Court is by summons, the evidence should be completed before the summons is adjourned to the judge (*u*).

Modification of the application on the appeal.

As already stated, the Court has no jurisdiction to amend the application (*v*) or notice of opposition on appeal (*x*). And it will not generally be influenced by an offer made in Court by the appellant to modify his application (*y*); but in a case where, after the Comptroller's decision, the applicant offered to allow a disclaimer sufficient for the protection of the opponent to be entered with his mark on the Register, the Court allowed the appeal without costs (*z*); and where, on an application to register a mark which included a crown, one of the grounds on which the Comptroller refused registration was the presence on the Register of certain marks, all of which included crowns, and on appeal to the Court the applicants offered to disclaim the exclusive use of the crown and certain words, the application was ordered to be proceeded with on the terms of the applicants making such disclaimer (*a*); and in the same case the applicants were allowed on the appeal to modify their application by limiting it to some only of the goods in respect of which registration was originally asked. And where the Comptroller refused to register on the ground that two other marks already on the Register contained the prominent word of the mark in question; and, the owners of these marks having been served with notice of the appeal, one of them did not appear, and the other was satisfied by the consent of the appellant to restrict the rights conferred by

(*s*) *Kingsford's Application*, *supra*, and *Application of Extract of Meat (Baron Liebig) Photograph Brand, Ld.*, 17 R. P. C. 161 (1900), Cozens-Hardy, J.

(*t*) In accordance with Order XXXVIII. r. 1 of the Supreme Court Rules. For an order made by the judge as to evidence, see *Roger's Tm.*, 12 R. P. C. at p. 153 (1895), North, J.

(*u*) *Jackson* v. *Napper*, 35 C. D. 166; 4 R. P. C. 45 (1886), Stirling, J.

(*v*) *Players' Application*, (1901) 1 Ch. 382; 18 R. P. C. 65, Cozens-Hardy, J., and the cases as to disclaimers, below, p. 202.

(*x*) *Robertson, Sanderson & Co.'s Tm.*, (1892) 2 Ch. 245; 9 R. P. C. 264, Stirling, J.

(*y*) It is therefore too late to offer to disclaim on the appeal, see below, p. 92, 202.

(*z*) *Swift Specific Co.'s Tm.*, 6 R. P. C. 352 (1889), Stirling, J.

(*a*) *König and Ebhardt's Application*, (1896) 2 Ch. 236; 13 R. P. C. 449, Stirling, J.

the registration to particular goods, the appeal was allowed on payment of costs (*b*).

The provisions contained in sect. 64 (2) as to the statement in the application of essential particulars, and disclaimer of the exclusive use of added matter, cannot be waived by the Court on an appeal from the Comptroller (*c*).

Registration subject to conditions.

By the express terms of sect. 62 (4) and (5), and sect. 69 (3) and (4), the Board of Trade and the Court on appeal may respectively make orders for registration, subject to any conditions they may think proper to impose. Conditions have been imposed in particular cases requiring the alteration of the mark, *e.g.*, by adding the applicant's name to it, the registration of a disclaimer, or the restriction of the use of the mark to a limited portion of the goods within the class in respect of which it is registered (*d*). A condition that the mark shall only be used within a limited geographical area will not be put on the Register (*e*). The Court cannot, of course, impose conditions except at the applicant's request, or with his consent; and it rarely does so in any case unless the parties have come to terms (*f*).

The Court must consider all objections.

On the appeal the Court has jurisdiction to enter into and determine all questions arising on the objections, including, of course, in a case where the Comptroller has already registered the mark, the question whether the mark has been rightly admitted to the Register. So, where the appeal against the refusal of the Comptroller to register the word *Gem* had been allowed by Kay, J., and the registration had been made accordingly, and it was contended in the Court of Appeal that the only questions which could be considered by

Appeal after actual registration.

(*b*) *Kenrick and Jefferson's Tm.*, 7 R. P. C. 321 (1890), Chitty, J.; but as to the weight to be given to consents by owners of other marks, see *Dewhurst's Application*, (1896) 2 Ch. 137; 13 R. P. C. 288, C. A.

(*c*) *Goodall's Tm.*, 42 C. D. 566; 38 W. R. 189 (1889), North, J.; *Meeus' Application*, (1891) 1 Ch. 41; 8 R. P. C. 25, Chitty, J.; *Wright, Crossley & Co.'s Application*, (1900) 2 Ch. 218; 17 R. P. C. 386, Byrne, J.; *Players' Application*, above, note (*v*).

(*d*) Cf. Rectification, under sect. 90, Chap. XI., pp. 281 *et seq.*

(*e*) *Dewhurst's Application*, (1896) 2 Ch. 137; 13 R. P. C. 288, C. A.

(*f*) In *Eno* v. *Dunn*, 7 R. P. C. p. 314 (1890), in reply to a suggestion that the respondents were willing to distinguish their mark, Halsbury, L. C., said: "We have nothing to do with offers here."

the Court were those affecting the respective rights of the applicant and the opponent, treating the registration, subject to those rights, as properly made, and it was alleged that the user by the opponent on which he relied had been a fraud on the applicant, the Court of Appeal rejected the contention. "The Court is bound," Cotton, L. J., said, "to enter into all the considerations which must be determined in order to see whether the particular mark or word is rightfully on the Register," and, *inter alia*, the question whether the word was, and it was held that it was, a descriptive word (*g*). And in the *Sanitas Case*, where the Comptroller had refused registration on the ground of the precedent registration of other marks, and he desired on the appeal to argue also (1) that the word in question was not a fancy word, and (2) that it was part of the appellant's name, Kay, J., said, in answer to an objection to this, "I shall have to consider every possible objection" (*h*).

The Court has no power to direct the Comptroller to register part of the mark shown in the application (*i*).

If an unsuccessful opponent appeals, and then, after the appeal is referred to the Court, is willing to withdraw his opposition, an order should be obtained dismissing the appeal and directing the Comptroller to proceed with the registration (*j*).

6. Costs.

Costs of the appeal.

The Court has no jurisdiction to make the Comptroller pay costs (*k*), and the ordinary rule is that even a successful appellant pays the costs of the Comptroller as well as his own.

(*g*) In *Re Arbenz' Application*, 35 C. D. 248; 4 R. P. C. 143 (1886), Kay, J., and C. A.; and cf. *Paine* v. *Daniell & Sons' Breweries, Ld.*, (1893) 2 Ch. 567; 10 R. P. C. 217, C. A.; and *Talbot's Tm.* (1894), 11 R. P. C. 77, Stirling, J., rectification cases.

(*h*) *Sanitas Co.'s Tm.*, 4 R. P. C. 533; 58 L. T. 166 (1887).

(*i*) *Meeus' Application*, (1891) 1 Ch. 41; 8 R. P. C. 25, Chitty, J. (*Key Brand, Geneva*).

(*j*) *Crosfield & Son's Application*, 15 R. P. C. 754 (1898), North, J., required a consent brief to the dismissal to be produced.

(*k*) *Rotherham's Tm.*, 14 C. D. 585; 49 L. J. Ch. 511 (1880), C. A., unsuccessful appeal by Registrar; *Leaf's Tm.*, 33 C. D. 477; 3 R. P. C. 289 (1886), and *Van Duzer's Tm.*, 3 R. P. C. 243, both Bacon, V.-C.; *Colman's Tm.*, (1894) 2 Ch. 115; 11 R. P. C. 129, Stirling, J., all successful ap-

In the *Alpine Case* (*l*) Mr. Justice Chitty said that the Comptroller's costs were deemed to be costs incidental to registration. "In fact," he added, "the only method by which the successful appellant might escape paying the costs would be by showing that the refusal to register emanated from personal impropriety on the part of the officers refusing." This statement seems to be somewhat too strongly put, for in several cases a successful appellant has not been ordered to pay costs (*k*), although no suggestion of improper conduct or motive on the part of the Comptroller was made.

If the opponent appeals, or appears as a respondent to the applicant's appeal, the costs of the application to the Court generally follow the event; but the Court has jurisdiction, which it frequently exercises, to refuse to make any order for costs where it is dissatisfied with the conduct of the successful party. Thus, where the applicants based their case in part on an alleged exclusive right to the use of certain words in their label and they had no such right (*m*); and where the judge thought that both appellant and respondent had behaved improperly, no costs were given (*n*). And where opponents appealed from the decision of the Comptroller allowing registration, and succeeded on one ground of objection but failed on other grounds which involved issues of fact, the appellants were ordered to pay the costs so far as they had been increased by these issues, the respondents paying the other costs, with the usual set-off (*o*).

Test case.

So, too, where the case was argued as a test case, no costs were given, although the application failed (*p*), and in another

New objection at the hearing.

peals by applicant from Comptroller; and *Eastman, &c. Co.'s Application*, (1898) A. C. p. 585; 15 R. P. C. p. 487, applicant successful in House of Lords. See below, "test case."

(*k*) See note (*k*), *ante*, p. 93.

(*l*) 54 L. J. Ch. p. 730 (1885). The "Law Reports" do not contain this part of the judgment; see also *Farbenfabriken & Co.'s Tm.*, 11 R. P. C. p. 93; (1894) 1 Ch. 645, C. A.; cf. Chap. XI., p. 301.

(*m*) *Hudson's Tm.*, 32 C. D. 311; 3 R. P. C. 155 (1886), (*Carbolic Acid Soap Powder*), C. A.

(*n*) *Fuente's Tm.*, (1891) 2 Ch. 166; 8 R. P. C. 214, Romer, J.

(*o*) *Wright, Crossley & Co.'s Application*, (1900) 2 Ch. 218; 17 R. P. C. 386, Byrne, J.

(*p*) *Van Duzer's Tm.*, 34 C. D. 623; 4 R. P. C. 31 (1887), C. A.; *Farbenfabriken Formals Fried. Bayer & Co.'s Tm.*, 11 R. P. C. p. 93; (1894) 1 Ch. 645, C. A. (*Somatose*).

case where the Comptroller took a new point in Court, after the objection upon which he had refused registration had been removed, and succeeded upon it, he did not press for costs (*q*).

In a case in which an applicant appealed from the Comptroller's refusal to register, and succeeded only in the House of Lords, the House made no order as to the costs of the appeal to them, but expressed an opinion that the costs in the Court of Appeal, which the appellants had been ordered to pay to the Comptroller, should be repaid to the applicants, but not the costs of the hearing before Kekewich, J. (*r*).

Costs before the Comptroller.

No costs of the proceedings before the Comptroller, except so far as these are allowed by the taxing master as costs of or occasioned by the proceedings in Court, can be given (*s*); and the same rule applied under the old Act (*t*). But the Comptroller has power, where an applicant abandons his application after notice of opposition has been given, in accordance with sect. 69, to direct the applicant to pay to the opponent such costs in respect of the opposition as the Comptroller may determine to be reasonable (*u*). This power was conferred upon the recommendation of Lord Herschell's Committee (*x*), in order to spare owners of existing marks from the expense of contesting unwarrantable applications to register marks which would prejudice their rights. But if the applicant puts in a counter statement it would seem that he has not abandoned his application within the meaning of the sub-section, although he does not appear at the hearing (*y*), and this is the view acted on by the Comptroller.

(*q*) *Thompson's Tm.*, 6 R. P. C. 213 (1888); but cf. the *Sanitas Co.'s Tm.*, 4 R. P. C. 533; 58 L. T. 166 (1887), Kay, J.

(*r*) *Eastman, &c. Co.'s Application*, (1898) A. C. at p. 585; 15 R. P. C. p. 488.

(*s*) *Australian Wine Importers' Tm.*, 41 C. D. 278; 6 R. P. C. 311 (1889), C. A.

(*t*) *Brandreth's Tm.*, 9 C. D. 618; 47 L. J. Ch. 816 (1878), Jessel, M. R.

(*u*) Sect. 69 (5); p. 80, above.

(*x*) Report of 1888, p. vii.

(*y*) See sub-sects. (2) and (3).

CHAPTER V.

CLASSIFICATION OF GOODS.

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It has already been shown that the use of the mark in connection with goods of the particular kind identified with it is of the essence of trade-mark rights (*a*), and this essential feature is retained by the Registration Acts. It is provided that—

> "A trade-mark must be registered for particular goods or classes of goods" (*b*).

And that—

> "A trade-mark, when registered, shall be assigned and transmitted only in connection with the goodwill of the business concerned in the particular goods or classes of goods for which it has been registered, and shall be determinable with that goodwill" (*c*).

And the express restrictions on the registration of identical marks and marks having such resemblance to registered trade-marks as to be calculated to deceive, which are contained in sect. 72, apply only where the marks already registered are on the Register with respect to the same goods or description of goods as those for which the marks put forward for registration are sought to be registered.

Classes.

Accordingly, goods have been divided by the draughtsman of the Trade-Mark Rules into forty-nine classes, and a mis-

(*a*) *Ante*, p. 28; and see *Somerville v. Schembri*, 12 App. Cas. 453; 4 R. P. C. 179 (1887).

(*b*) Act of 1883, s. 65, following Act of 1875, s. 2.

(*c*) Act of 1883, s. 70, following Act of 1875, s. 2. As to Assignments, see Chap. XIII., p. 324.

cellaneous and residuum class (*d*), and the Rules provide that if any doubt arises as to what class any particular description of goods belongs to, the doubt shall be determined by the Comptroller, and that any wares made of mixed materials (for example, of both cotton and silk) shall be included in such one of the classes appropriated to those materials as the Comptroller may desire (*e*). For the convenience of applicants for registration an alphabetical guide to the classification of goods has also been drawn up and published (*f*), and in case of uncertainty, upon application by letter to the Comptroller, giving a full description of the goods and the purposes for which they are used, the Comptroller will inform any intending applicant what class he should name in his application.

Many of the classes comprise a number of very different kinds of goods, for example, class 6: "Machinery of all kinds, and parts of machinery, except agricultural and horticultural machines included in class 7," comprises both engine-boilers and sewing machines. Registration in a class does not, however, confer on the registered proprietor any right to sue for infringement of the mark in regard to goods of kinds other than those for which he uses his mark. Thus, where the owner of a mark comprising the word *Neptune*, who had used it only for iron sheets, although class 5, for which it was registered, includes also wire, brought an action against a person who had registered and used a mark comprising the same word for wire, the Court of Appeal refused to grant an injunction, and they ordered the Register to be rectified by restricting the registration of the plaintiff's mark to iron sheets only (*g*). In this case (*Edwards* v. *Dennis* (*g*)) the plaintiff claimed the mark as assignee of the goodwill of a business which dealt only in the iron sheets, and it was held that, as assignee, his trade-mark rights under the Acts must, in any event, be restricted to the goods with

Registration and protection for part of a class.

(*d*) An Official Notice calls attention to the advisability of carefully specifying the goods for which a mark is intended, and no others, on an application to register in class 50. See Appendix, p. 732. See the remarks upon the classification in the Preface.

(*e*) Rule 6. Sch. 3. Appendix, p. 715.

(*f*) It can be procured at the Sales Department of the Patent Office.

(*g*) *Edwards* v. *Dennis*, 30 C. D. 454; 55 L. J. Ch. 125, C. A. (1885).

which the business assigned to him was concerned (*h*); but Cotton, L. J., stated that, in his opinion, it was not the intention of the Act (of 1875) that a man registering a trade-mark for an entire class, and using it only for one article in that class, should be able to claim for himself the exclusive right to use the mark for every article in the class, and with this opinion the other Lords Justices agreed. This opinion was endorsed and followed by Chitty, J., when the question arose in an action brought by the original proprietors of a trade-mark (*i*), who endeavoured, but unsuccessfully, to secure exclusive rights for cigars in a trade-mark which they had registered in the tobacco class, but which, as it comprised the word "mixture," was appropriate, and had at first been used, only for cut tobacco (*j*).

Trade-mark should not be registered for goods in which there is no intention to deal.

A broader question is whether registration can be properly made in respect of goods in which the applicant does not deal or intend to deal. This has recently been decided in *Batt & Co.'s Trade-Marks* (*k*). In that case the respondent, who was a general exporter and dealer, had registered two trade-marks in 1882 and 1889 respectively for all the goods comprised in class 42, and in 1897 an application was made to remove the marks from the Register on the ground that the respondent had never used them in connection with any goods in class 42, and had never had any *bonâ fide* intention of so using them. Romer, J., found these facts against the respondent and ordered the removal of the marks so far as regards class 42, and his decision was upheld in the Court of Appeal and the House of Lords. Lindley, M. R., delivering the judgment of the Court of Appeal, which was approved and affirmed in the House of Lords, held that the decision in *Edwards* v. *Dennis* (*l*) fairly governed the case in principle and stated the question of law as follows:—

"Can a man properly register a trade-mark for goods in which he does not deal, or intend to deal—meaning by intend-

(*h*) Act of 1875, s. 2. Act of 1883, s. 70.

(*i*) *Hargreaves* v. *Freeman*, (1891) 3 Ch. 39; 8 R. P. C. 237.

(*j*) Cf. Instructions, 31, *post*, p. 728.

(*k*) (1898) 2 Ch. 432; 15 R. P. C. 262 and 534, Romer, J., and C. A.; (1899) A. C. 428; 16 R. P. C. 411 (*sub nom. Batt* v. *Dunnett*).

(*l*) See note (*g*), above, p. 97.

ing to deal, having at the time of registration some definite and present intention to deal—in certain goods or descriptions of goods, and not a mere general intention of extending his business at some future time to anything which he may think desirable? This question we answer in the negative" (*m*).

A trade-mark may be originally registered for certain only of the goods comprised in a class, and it will then, of course, be protected as to those goods only (*n*). And if it be registered for the whole class, but the proprietor of it be entitled to protection for part of the class only, the Court may rectify the Register by restricting the entry, as it did in *Edwards* v. *Dennis* (*o*) and in *Harrison* v. *Woodroffe* (*p*). In the latter case Kekewich, J., said: "It was never intended that a man, having a trade-mark for one class of machinery, should register it for all." In practice, leave to register a mark is frequently given, and oppositions to registration are frequently withdrawn, or overruled, on the terms that the registration be restricted in this way to part of a register class (*q*). The restriction is effected by the entry of a note of the agreement upon the Register, and in a case where, without any formal opposition, it had been agreed between the applicant and an objector, that the registration should be restricted to certain goods in the class for which it was effected, Pearson, J., on an *ex parte* application, directed the Comptroller to enter a note of the restriction on the Register (*r*).

(*m*) Cf. also *Hedley's Tms.*, 17 R. P. C. 719 (1900), where a mark, on which an applicant for rectification based his application, had been registered but not used, and any intention to use it had been given up, Cozens-Hardy, J., said it could probably be removed from the Register.

(*n*) *Jay* v. *Sadler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.; *Hart* v. *Colley*, 44 C. D. 193; 7 R. P. C. 93 (1890), North, J.

(*o*) 30 C. D. 454, C. A. (1885).

(*p*) 42 C. D. 691; 7 R. P. C. 25 (1889); and see *Batt & Co.'s Tms.*, *supra*.

(*q*) See, for instance, *Jelley's Application*, 51 L. J. Ch. 639 n. (1878), Jessel, M. R.; *Braby & Co.'s Applications*, 21 C. D. 222; 51 L. J. Ch. 637 (1882), North, J.; and *Kenrick and Jefferson's Tm.*, 7 R. P. C. 321 (1890), Chitty, J.

(*r*) *Keep's Tm.*, 26 C. D. 187; 54 L. J. Ch. 637 (1884); but, as to the particular restriction in this case, see *Deuchurst's Application*, (1896) 2 Ch. p. 143; 13 R. P. C. p. 97, C. A., where the Court distinguished between a condition of registration and

Series of Marks.

By **sect. 66** it is provided that—

"When a person claiming to be proprietor of several trade-marks which, while resembling each other in the material particulars thereof, yet differ in respect of (a) the statement of the goods for which they are respectively used or proposed to be used, or (b) statements of numbers, or (c) statements of price, or (d) statements of quality, or (e) statements of names of places, seeks to register such trade-marks, they may be registered as a series in one registration. A series of trade-marks shall be assignable and transmissible only as a whole, but for all other purposes each of the trade-marks composing a series shall be deemed and treated as registered separately."

Registration of a series of marks.

The section was probably introduced to clear up the difficulties which arose under the earlier Act upon the question how such series were to be registered (*s*).

When an application is made for such a series, a representation of each of the marks included in the series must be affixed to the form of application, and to each of the accompanying forms (*t*).

a note of an agreement; see also Chap. XI., p. 282; and Chap. X., p. 219.

(*s*) See *Barrow's Tms.*, 5 C. D. 353 (1877); 46 L. J. Ch. 450, C. A.

(*t*) Chap. IV., p. 75; Rule 14 as now in force, see T. M. R. 1897, and Instructions, 17; App. pp. 694 and 726. Separate electrotypes must be sent also, Rule 30, p. 696.

CHAPTER VI.

SHEFFIELD MARKS.

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Sheffield Marks and the Cutlers' Company.

THE care of the Register, and the registration of marks to be used on metal goods registered under the present Act by a person carrying on business in Hallamshire, or within six miles thereof, is committed, by sect. 81 (*a*) of the Act, to the Cutlers' Company.

The Cutlers' Company.

This company was incorporated by the Act 21 James I., c. 31, and its members and proceedings are regulated by several Cutlers' Company Acts, referred to below. But long before the seventeenth century Hallamshire had been noted for its cutlery manufactures, and from time to time a jury of cutlers was empannelled with the other juries of the local Court Leet, to assign marks to the different manufacturers, wherewith to distinguish their respective wares; and in the Court Rolls of the Manor of Sheffield of the 7th of Elizabeth, and, again, in the Rolls of 1590, presentments of the regulations governing persons engaged in the knife-making and certain other cutlery trades are recorded (*b*). The seventh of these regulations provided that no person should strike any mark upon his wares but that which was assigned him in the

(*a*) See below, p. 106.
(*b*) Hunter's History of Sheffield; London, 1819, p. 118.

Lord's Court under a penalty of ten shillings. The cutlers had also a charter granted by the lords of the manor (*c*).

The incorporating Act, the Cutlers' Company Act, 1623 (*d*), laid down certain regulations for the control of persons engaged in the businesses of manufacturing knives, shears, scissors, or other cutlery wares, within the specified district, and incorporated the persons then so engaged, and it fixed the limits of the district concerned, as they have ever since remained, to be those of the lordship of Hallamshire and within six miles compass from it. The Act, in particular, provided that persons engaged in the businesses mentioned, in the said district, should strike such marks, and such marks only, as should be assigned to them by the company. These regulations were repealed by the Cutlers' Company Act of 1791 (*e*), and fresh regulations, chiefly relating to the admission of new freemen and to the taking of apprentices, were enacted. By sect. 17 of the Act last mentioned, members of the company, who alone were then permitted to manufacture the goods referred to (*f*), were forbidden, under a penalty, to strike, engrave, or use any mark like, or counterfeiting a mark assigned to any other person. The Cutlers' Company Act of 1801 (*g*) empowered any freeman of the company to bequeath his mark, as his other personalty, by his will, his widow not to be thereby prevented from carrying on the trade, or selling the right to the mark, for her lifetime, to any other person entitled to carry on the trade. The Cutlers' Company Act of 1814 (*h*) threw open the specified trades to all persons, and removed the existing restrictions as to taking apprentices. It provided, further (sect. 3), that all manufacturers, whether freemen or not, on application, should have marks assigned to them by the company, the marks not to be marks previously assigned, and at the time continuing to be the property of any persons other than the applicants, and not to consist of surnames; (sect. 4) that marks in

(*c*) M. M. A. Report, 1862. Evidence of Mr. Jackson, Q. 104.

(*d*) 21 James 1, c. 31, local.

(*e*) 31 Geo. 3, c. 58, local.

(*f*) Knives, sickles, shears, scissors, razors, files, and forks, or any of them, sect. 3.

(*g*) 41 Geo. 3, c. 97, local.

(*h*) 54 Geo. 3, c. 119, local.

common use should not be assigned; and (sect. 6) that an assigned mark might be bequeathed by will, and if it were not bequeathed, it should go to the widow and family of the proprietor on his death, but not so as to give power to more than one person in the family to use it at the same time. The last Cutlers' Company Act, that of 1860 (*i*), extended the provisions of the Acts to all persons within the district using or exercising the trades of manufacturers of steel, makers of saws and edged tools, and other articles of steel, or steel and iron combined, having a cutting edge, and it enabled persons carrying on any of the trades within the Acts, and not being freemen of the company, to become freemen on payment of the proper fees, and to have marks assigned to them.

Corporate marks were assignable in gross.

It will be seen that, under these Acts, the old corporate marks were assignable personal property of the grantee; this was, at all events, the case where the marks were owned by non-freemen, and where they did not comprise any personal elements calculated to make their use by others than the original grantees misleading (*k*). In this respect they differed from ordinary trade-marks, which are, and always have been, assignable or capable of transmission only in connection with the business in which they are used

Grant of a corporate mark.

The right to the mark originated in the grant by the company, and lasted for the lives of the grantee and his widow. The grant was made upon the application of the grantee after a search, carried out by the searchers of the company, to ascertain whether the mark applied for was the subject of a then existing grant. Marks, as they lapsed, were re-granted over and over again (*l*).

Recent legislation and the Cutlers' Company.

The rights and privileges of the Cutlers' Company were expressly saved by sect. 25 of the Merchandise Marks Act, 1862. There is no similar provision in the Merchandise Marks Act of 1887, but, except in so far as that Act restricts the use of particular marks as being forged trade-marks, or

(*i*) 23 Vict. c. xliii.

(*k*) *Bury* v. *Bedford*, 32 L. J. Ch. 741; 33 L. J. Ch. 465; 4 De G. J. & S. 352 (1863), M. R. and L. JJ.

(*l*) See the evidence of Mr. Jackson, Qq. 113, 117, 142, and Mr. Hunter, Q. 1899; M. M. A. 1862.

false trade descriptions, it does not in any way affect the rights or privileges of the company. The Act of 1875 (*m*) empowered the owner of a Sheffield corporate mark to have it registered under that Act in the same manner and on the same terms as if it were not a Sheffield corporate mark.

Closing of the Register.

Under the Act of 1883 the old Register of corporate marks was closed on the 31st of December, 1888 (*n*).

The Act of 1875.

The Act of 1875 left the register of the Cutlers' Company, and the power of the Company to assign marks, untouched, except that it restricted the latter power in regard to marks identical with, or so nearly resembling as to be calculated to deceive, marks registered under the Act in the manner mentioned below (*o*). And it provided generally that:—

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

The Act provided (*p*) further, (1) for copies of all the Sheffield corporate marks in force being delivered to the Registrar; (2) for notices of new applications to the company for the assignment of corporate marks, and copies of the marks applied for being delivered to the Registrar, and for notices of applications to the Registrar for registration under the Act of marks belonging to any goods or class of goods within the Cutlers' Company Acts (*q*), and copies of the marks referred to, being delivered to the company (*r*); and (3) for notices of assignment and registration.

Sub-sections (4), (5), and (6) of section 9 of the Act of 1875 were in the terms following:—

Mark resembling a corporate mark not to be registered.

"(4.) *The Registrar, under this Act without the special leave of the Court, to be given only in cases where the applicant proves his right, shall not in respect of any goods or classes of goods with respect to which a Sheffield corporate*

(*m*) Sect. 9 (6), set out below.
(*n*) Sect. 81 (9).
(*o*) Sect. 9 (5).
(*p*) Sect. 9. Appendix, p. 686.
(*q*) See list below; p. 106.

(*r*) The company sometimes opposed the registration of marks which they deemed to resemble too closely corporate marks in use. See *Re Rosing*, 54 L. J. Ch. 975, n. (1878).

mark shall have been assigned and actually used, and of which mark a copy, or description, or notice of the assigning thereof shall have been delivered or given to the Registrar as aforesaid, register a trade-mark identical with such Sheffield corporate mark, or so nearly resembling the same as to be calculated to deceive (s).

Corporate mark resembling registered mark not to be assigned.

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

Corporate mark might be registered.

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

The Act of 1883.

The Act of 1883, on the other hand, provided for the closing, within five years from the commencement of the Act (*t*), of the Register of corporate marks, and for the commencement of a new Register of trade-marks to be kept at Sheffield by the Cutlers' Company, to which the corporate marks might be transferred; and it directed that all corporate marks entered on the Register of corporate marks and not entered on the new Register before the closing of the former, should be deemed to have been abandoned (*u*).

The Act of 1888.

Sect. 81, which is the part of the Act relating to the Sheffield marks, and containing the provisions just referred to, has been amended by sect. 20 of the Act of 1888, the principal alteration being occasioned by the substitution of, and the extension thereby of the section to, "metal goods," meaning "all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal," in place of "cutlery, edge tools, raw steel, goods made of steel, or of steel and iron combined, whether with

(s) Cf. s. 6 of the Act of 1875 and sect. 72 of the Act of 1883,

(t) 1st January, 1884, sect. 3.

(u) Sect. 81 (9),

or without a cutting edge." The last-mentioned class of goods had been inserted in the original section in the place of the list taken by the Act of 1875 from the Cutlers' Company Act of 1860, namely, knives, sickles, shears, scissors, razors, files, forks, saws, edge tools, or other articles of steel, or of steel and iron combined, having a cutting edge.

The effect of sect. 81.

The section is set out below, the words printed in italics being repealed, and those in brackets introduced by the amending Act (*x*). The general effect of the section is to make the Sheffield Register a branch of the principal Register for trade-marks used on metal goods and registered by persons carrying on business in Hallamshire or within six miles thereof, and to place the local Register under the charge of the Cutlers' Company. The duties of the company are, however, ministerial only as regards the registration of old corporate marks (*y*); as regards the registration of other marks, the Company are substituted for the Comptroller, subject to his veto upon any particular registration (*z*), unless such veto is overruled on appeal by the Court, and subject, in cases where the Comptroller's veto is not exercised, to appeal from the Company to him (*a*). The rules relating to Sheffield marks are Rules 56 to 59 inclusive (*b*).

Duties of the Cutlers' Company with regard to registrations.

Section 81 is as follows:—

Sheffield Marks.

Registration by Cutlers' Company of Sheffield marks.

"**81.** With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called the Cutlers' Company) and the marks or devices (in this Act called Sheffield marks) assigned or registered (*c*) by the master, wardens, searchers, and assistants of that company, the following provisions shall have effect:

Cutlers' Company to open a new register;

(1.) The Cutlers' Company shall establish and keep

(*x*) Act of 1888, s. 20.

(*y*) *Lambert's Tm.*, 5 R. P. C. 542; 6 R. P. C. 344 (1889), C. A.

(*z*) Sub-sect. (5).

(*a*) Sub-sect. (12).

(*b*) See below, p. 701.

(*c*) *I.e.*, registered under the Act of 1875.

at Sheffield a new Register of trade-marks (in this Act called the Sheffield Register):

(2.) *The Cutlers' Company shall enter in the Sheffield Register, in respect of cutlery, edge tools, or raw steel and the goods mentioned in the next sub-section, all the trade-marks entered before the commencement of this Act* (*d*) *in respect of cutlery, edge tools, or raw steel and such goods in the Register established under the Trade-Marks Registration Act*, 1875, *belonging to persons carrying on business in Hallamshire, or within six miles thereof, and shall also enter in such Register, in respect of the same goods, all the trade-marks which shall have been assigned by the Cutlers' Company and actually used before the commencement of this Act, but which have not been entered in the Register established under the Trade-Marks Registration Act*, 1875.

[(2.) The Cutlers' Company shall enter in the Sheffield Register, in respect of metal goods (*e*) as defined in this section, all the trade-marks entered before the 1st day of January, 1889 (*f*), in respect of metal goods either in the Register established under the Trade-Marks Registration Act, 1875, or in the Register of trade-marks under this Act, belonging to persons carrying on business in Hallamshire, or within six miles thereof. The Cutlers' Company shall also, on request made in the prescribed manner (*g*), enter in the Sheffield Register, in respect of metal goods (*h*), all the trade-marks which shall have been assigned by the Cutlers' Company and actually used before the 1st day of January, 1884 (*i*), but which have

to enter in it the Sheffield marks on the old Registers for metal goods, and old corporate marks.

(*d*) 1st January, 1884.

(*e*) Metal goods are defined by sub-sect. (14), below.

(*f*) Commencement of the Act of 1888. As regards the registration of old corporate marks, the duties of the company are ministerial only: *Lambert's Tm.*, p. 106, *supra*.

(*g*) *I.e.*, made according to the last Form in the Rules, Appendix, p. 715. The application must be in duplicate, Rule 56. The procedure is generally the same as on an application to the Comptroller: Chap. IV., p. 63.

(*h*) Metal goods are defined by sub-sect. (14), below.

(*i*) Commencement of the Act of 1883.

not been entered in either of the said Registers] (*k*).

Application for Sheffield mark.

(3.) An application for registration of a trade-mark used *on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge* [on metal goods] (*l*), shall, if made after the commencement of this Act by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company (*m*) :

Notice to Comptroller.

(4.) Every application so made to the Cutlers' Company shall be notified to the Comptroller in the prescribed manner (*n*), and unless the Comptroller within the prescribed time (*o*) gives notice to the Cutlers' Company that he objects to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner (*p*).

Veto by Comptroller.

(5.) If the Comptroller gives notice of objection as aforesaid, the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may appeal to the Court (*q*) :

Entry on Register also.

(6.) Upon the registration of a trade-mark in the Sheffield Register the Cutlers' Company shall give notice thereof to the Comptroller, who shall thereupon enter the mark in the Register of trade-marks; and such registration shall bear date as

(*k*) Act of 1888, s. 20 (1).

(*l*) Act of 1888, s. 20 (2).

(*m*) The effect of this sub-section and sub-sect. (7) is to constitute the Sheffield Register a branch register for metal goods. The application must be on Form F., Appendix, p. 706; see Instructions (33), p. 729.

(*n*) A copy of the application is to be sent within seven days, with two representations of the mark for each class: Rule 57.

(*o*) The time is one month from receipt of notice: Rule 58 (1).

(*p*) *I.e.*, as an ordinary application is proceeded with by the Comptroller, sub-sect. (7), Rule 59. If no such objection is made by the Comptroller, the Cutlers' Company shall require the applicant to send the Comptroller a wood block or electrotype, as the Comptroller may direct, and the Comptroller shall, if satisfied with such wood block or electrotype, advertise the application in the same manner as an application made to him at the Patent Office: Rule 58 (2).

(*q*) The Court is defined by sects. 117 and 111. Cf. sect. 81, subsect. (12), which gives an appeal from the Company to the Comptroller.

of the day of application to the Cutlers' Company, and have the same effect as if the application had been made to the Comptroller on that day:

(7.) *The provisions of this Act, and of any general rules made under this Act, with respect to application for registration in the Register of trade-marks, the effect of such registration, and the assignment and transmission of rights in a registered trade-mark shall apply in the case of applications and registration in the Sheffield Register; and notice of every entry made in the Sheffield Register must be given to the Comptroller by the Cutlers' Company, save and except that the provisions of this sub-section shall not prejudice or affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield Register:*

[(7.) The provisions of this Act and of any general rules made under this Act with respect to the registration of trade-marks, and all matters relating thereto, shall, subject to the provisions of this section, apply to the registration of trade-marks on metal goods by the Cutlers' Company and to all matters relating thereto; and this Act and any such general rules shall, so far as applicable, be construed accordingly with the substitution of the Cutlers' Company, the office of the Cutlers' Company, and the Sheffield Register, for the Comptroller, the Patent Office, and the Register of Trade-Marks respectively; and notice of every entry, cancellation, or correction made in the Sheffield Register shall be given to the Comptroller by the Cutlers' Company: provided that this section shall not affect any life estate and interest of a widow (*r*) of the holder

Procedure and rules.

Widow's corporate mark.

(*r*) The corporate marks were assigned for the life of the assignee and his widow: see *ante*, p. 103, and the Cutlers' Company Act, 1814, *ante*, p. 102.

of any Shoffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield Register] (*s*).

Application for Sheffield mark to Comptroller.

(8.) Where the Comptroller receives from any person not carrying on business in Hallamshire, or within six miles thereof, an application for registration of a trade-mark used *on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge* [on metal goods] (*t*), he shall in the prescribed manner (*u*) notify the application and proceedings thereon to the Cutlers' Company:

Closing of Cutlers' Register.

(9.) At the expiration of five years from the commencement of this Act (*x*) the Cutlers' Company shall close the Cutlers' Register of corporate trade-marks, and thereupon all marks entered therein shall, unless entered in the Sheffield Register, be deemed to have been abandoned (*y*):

Registration for two Sheffield marks.

(10.) A person may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield Register as proprietor of two or more trade-marks:

Firm or company.

(11.) A body of persons, corporate or not corporate, may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield Register as proprietor of a trade-mark or trade-marks (*z*):

Appeal to the Comptroller.

(12.) Any person aggrieved (*a*) by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner (*b*), appeal to the Comptroller, who shall have power to confirm, reverse, or modify the

(*s*) Act of 1888, s. 20 (3).

(*t*) Act of 1888, s. 20 (2).

(*u*) *I.e.*, by sending a copy of the official paper, the Trade-Marks Journal, containing the application: Rule 58 (3).

(*x*) 1st of January, 1884.

(*y*) See Chap. XIV., p. 338.

(*z*) Person in the Act includes a body corporate: sect. 117; and in sect. 62 (application for registration), it includes a firm: Rule 7.

(*a*) See sect. 90, p. 264.

(*b*) Form W., Appendix, p. 713. No time for appeal has been fixed.

decision, but the decision of the Comptroller shall be subject to a further appeal to the Court (*c*):

Counterfeiting Sheffield marks.

(13.) So much of the Cutlers' Company's Acts as applies to the summary punishment of persons counterfeiting Sheffield corporate marks, that is to say, the fifth section of the Cutlers' Company's Act of 1814, and the provisions in relation to the recovery and application of the penalty imposed by such last-mentioned section contained in the Cutlers' Company's Act of 1791 (*d*), shall apply to any mark entered in the Sheffield Register (*e*):

Metal goods.

[(14.) For the purposes of this section the expression 'metal goods' means all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal] (*f*):

Certificate of master of the company.

[(15.) For the purpose of legal proceedings in relation to trade-marks entered in the Sheffield Register a certificate, under the hand of the master of the Cutlers' Company, shall have the same effect as the certificate of the Comptroller]" (*g*).

A complete collection of representations of pending applications in classes 5, 6, 7, 11, 12, 13, 14 and 22 is now kept for public inspection at the Cutlers' Hall, Sheffield. On an application in any of those classes being made at the Patent Office, one representation of the mark is forwarded by the Comptroller to the Cutlers' Company: see Official Notices printed in the Appendix (pp. 733, 734).

(*c*) Cf. sub-sect. (*b*), above.

(*d*) For the sections referred to, see p. 643, below.

(*e*) The effect of this is to extend the last-mentioned sections to all the locally registered metal goods marks.

(*f*) For the list of goods to which the Cutlers' Company's Acts and the Act of 1875 applied, see pp. 103, 106; and for the list to which the unamended Act of 1883 applied, see the repealed sub-sect. (2).

(*g*) The certificate is evidence: sect. 96; Rule 60, above, p. 61.

CHAPTER VII.

COTTON MARKS AND THE MANCHESTER OFFICE.

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The repealed Cotton Marks Rules.

By the Rules issued under the Act of 1875 (*a*), marks for cotton goods in Classes 23, 24, and 25 (*b*) were specially treated. An office was set up at Manchester for the exhibition of all devices, marks, &c., used in the cotton trade, and in the Rules called *cotton marks*, and every person using any cotton mark was required to send to the office three representations of it. A committee of persons versed in the usages of the cotton trade was appointed to consider the cotton marks, of which representations were sent in to the Manchester office, and to divide them into two classes: (a) those which were, in the opinion of the committee, trade-marks within the meaning of the Act; and (b) those which were not; and power was given to the Commissioners of Patents to add any cotton marks to either class (*c*). It was provided that any proprietor of a cotton mark not specified in class (b) might apply to be registered as proprietor of the mark in the manner and subject to the conditions in and under which he might have applied to be registered in respect of any other trade-mark, but that it should not be lawful to register any

(*a*) Now repealed: see Chitty's Statutes. Rules 57—63a.

(*b*) Class (23), cotton yarn and thread (under the present Rules this is replaced by (a) cotton yarn, and sewing cotton not on spools or reels, (b) sewing cotton on spools or reels); (24) cotton piece goods of all kinds; (25) cotton goods not included in Classes 23, 24, or 38. Class 39, articles of clothing.

(*c*) Rule 58 (a) of March, 1883.

person as proprietor of any cotton mark in class (b) except in pursuance of an order of the Court.

The Cotton Marks Committee.

The committee so appointed was held not to be a judicial tribunal, but merely a body appointed to consider and give an opinion on technical matters peculiarly within the knowledge of its members, and it was decided that its decisions could be reconsidered or disregarded by the Court, or by the Registrar by direction of the Court, notwithstanding that it had acted fairly and properly, and had not proceeded on any wrong principle in arriving at them (*d*). And in a number of cases applications to the Court in respect of marks placed by the committee in class (b) were successful, and the marks were registered as trade-marks (*e*).

The Manchester Branch Office.

The special rules have now been repealed (*f*) and the committee of experts dissolved (*g*); but the Manchester Office is maintained, and has been constituted a branch office of the Registry, and applications for the registration of marks in Classes 23, 24, and 25 must be addressed and sent to it (*h*). Searches also in respect of marks in classes of textiles from Classes 23, 24, and 25 may be made in the Manchester office (*i*).

The Palatine Court of Chancery.

A co-ordinate jurisdiction with that of the High Court of Justice is vested in the Court of Chancery of the County

(*d*) *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Ca. 479; 48 L. J. Ch. 707 (1879); H. L. reversing the judgment of the C. A., 8 C. D. 794; 47 L. J. Ch. 807 (1877).

(*e*) *Exp. Ede & Co.*, 28 W. R. 436 (1878), Jessel, M. R.; *Re Dugdale*, 49 L. J. Ch. 303; 28 W. R. 436 (1880), Hall, V.-C.; *Re Ward, Sturt and Sharp*, 50 L. J. Ch. 347; 44 L. T. n.s. 97 (1881), Hall, V.-C.; *Re Sykes*, 43 L. T. 626; 29 W. R. 235 (1880), Hall, V.-C.; and see Sebastian, 4th ed. p. 519, where the cases are collected.

(*f*) By the existing r. 13, four representations of marks must accompany an application to register in the cotton classes in addition to that affixed to the application: see Appendix, p. 693.

(*g*) Lord Herschell's Committee refused to adopt a recommendation that honorary trade assessors be appointed to pass or reject cotton trade-marks, on the grounds that their appointment would diminish the sense of responsibility of the office, and that it did not feel sure that the creation of such a tribunal, reserving power to override its decisions, would give general satisfaction. Report of 1888, p. x.

(*h*) Rule 8. The address is: The Comptroller, Manchester Trade-Marks Branch, 48, Royal Exchange, Manchester.

(*i*) Instructions (7) and (34).

Palatine of Lancashire in respect of any action or other proceeding in relation to trade-marks, the registration whereof is applied for in the Manchester office, subject to the ordinary right of appeal from decisions of that Court (*k*).

The registration of oriental words as part of a mark, a matter which greatly concerns the cotton trade, will be found dealt with later (*l*).

(*k*) Act of 1888, s. 26. This provision was inserted in compliance with a recommendation of Lord Herschell's Committee (Report, p. x.). The other paragraphs of the reports of the committee in regard to the Manchester office may be of interest. The committee said, in an interim report of the previous year:—"A very large proportion of the marks registered in the cotton classes, probably not less than 90 per cent., are the result of applications made by Manchester houses, or by houses having a representative in Manchester. We think it would add much to the smooth working of the Act if applications in these classes were, as far as possible, dealt with by the head of the Manchester branch of the Trade-Marks Office. It is, we think, essential that the registration should take place in London, and that the final decision should rest with the Comptroller as head of the office; but we recommend that in the case of each application, the head of the Manchester office should report his opinion as to whether the mark ought to be accepted or refused, and that his opinion should be acted upon, unless the Comptroller sees clear reason to come to a contrary conclusion. We think that this duty of revision should in all cases be discharged by the Comptroller personally." And these recommendations are endorsed in the final Report of 1888 (19).

(*l*) The present Rule 15, which was substituted by the Trade-Mark Rules, 1897, deals with marks containing words in characters other than Roman, or in a language other than English: see also Instructions (14), p. 726. The Office formerly refused to register words in oriental character, except "Chop" and "Hong" marks, *i.e.*, firm names in Chinese: see *Dewhurst's Application*, (1896) 2 Ch. p. 141; 13 R. P. C. p. 202.

CHAPTER VIII.

WHAT MARKS MAY BE REGISTERED AS TRADE-MARKS.

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THE marks which may be registered as trade-marks were determined, from the commencement of the Register until the end of 1883, by sect 10 of the Act of 1875; from the last-

mentioned date until the end of 1888, by sect. 64 of the Act of 1883, and they are at present, and from the beginning of 1889 they have been, determined by the revised and amended sect. 64, enacted by sect. 10 of the Act of 1888. Sect. 64 is printed below; the ordinary type showing the terms as revised and at present in force, the words in brackets being added by the Act of 1888, and the italic type showing the parts of the Act of 1883 which have been repealed.

Sect. 64. "**64.** (1.) For the purposes of this Act, a trade-mark must consist of or contain at least one of the following essential particulars:

(a) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner (*a*); or

(b) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade-mark (*b*); or

(c) A distinctive device, mark, brand, heading, label, ticket, *or fancy word or words not in common use* (*c*); [or

(d) An invented word or invented words (*d*); or]

[(e) A word or words having no reference to the character or quality of the goods (*e*), and not being a geographical name (*f*).]

Additions and disclaimers. (2.) (*g*) There may be added to any one or more of *these* [the essential] particulars [mentioned in this section] any letters, words, or figures, or combination of letters, words, or figures, or of any of them [but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade-mark (*h*), and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the Register] (*g*).

[(3.) Provided as follows:]

[(i.) A person need not under this section disclaim

(*a*) Page 124.
(*b*) Page 129.
(*c*) For references, see p. 115.
(*d*) Page 171.
(*e*) Page 178.
(*f*) Page 182.
(*g*) See Chap. IX., p. 197.
(*h*) See Chap. IV., p. 75.

his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof.]

(ii.) *Provided that* any special and distinctive word or words, letter, figure, or combination of letters or figures or of letters and figures used as a trade-mark before the 13th day of August, 1875, may be registered as a trade-mark under this part of this Act" (*i*).

Sect. 10 of Act of 1875.

Sect. 10 of the Act of 1875 (now repealed) was as follows:—

"*For the purposes of this Act*:

A trade-mark consists of one or more of the following essentials; that is to say,

A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner (*k*); *or*

A written signature or copy of a written signature of an individual or firm (*l*); *or*

A distinctive device, mark, heading, label, or ticket (*m*).

And there may be added to any one or more of the said particulars any letters, words, or figures, or combination of letters, words, or figures; also

Any special and distinctive word or words or combination of figures or letters used as a trade-mark before the passing of this Act (*n*) *may be registered as such under this Act*" (*o*).

Now marks may be registered.

Before the Registration Acts it was necessary for the plaintiff in a trade-mark action to plead that the mark in question had acquired a reputation and become known as his by user in connection with his goods; but the Court did not require him to prove that the user had extended over any

(*i*) Page 184.

(*k*) The same as (a) in sect. 64.

(*l*) (b) adds "applying for registration thereof as a trade-mark."

(*m*) (c) adds "brand," and (d) and (e) admit the word-marks.

(*n*) 13th of August, 1875.

(*o*) 64 (3) (ii) adds "letter, figure," and combination of "letters and figures."

long or defined period, and it was therefore practically open to a trader to obtain protection against infringers of a newly devised mark which had hardly been used at all (*p*). The Acts have provided an additional mode of acquiring trade-mark rights, for it is held that marks which have never been used may be registered as trade-marks, and a right of property thereby acquired in them (*q*). "In my opinion," Cotton, L. J., said, in *Hudson's Case*, "the language (of the Act of 1875 (*r*)), though not appropriate, means this, that a man who designs one of those special things pointed out in sect. 10, is, as designer, to be considered as the proprietor of it, and if there is no one else who has used it, or who can be interfered with by the registration and subsequent assertion of title to the mark, then he is to be considered as entitled within the meaning of the Act to the exclusive use of that which in fact he has never in any way used, but which has only been designed by him, and which he can be treated as the person entitled to register, if no one else had so used it as that his user would be interfered with by the registration."

Applicant must intend to use the mark.

But the applicant for the registration of a new and unused mark must intend to use it, as a trade-mark, forthwith, for it is not permitted to place marks on the Register merely to prevent other traders using and appropriating them (*s*). It will usually be presumed that the applicant does intend so to use the mark, but in a case where it was shown that the registered proprietor of a mark was an importer of foreign goods, and had caused the mark to be registered only for the purpose of excluding from the English market goods similar

(*p*) See above, Chap. II., p. 33.

(*q*) *Hudson's Tm.*, 32 C. D. 311; 3 R. P. C. 155 (1886), C. A.; *Great Tower Street Tea Co.* v. *Smith*, 6 R. P. C. 165; 5 T. L. R. 232 (1889), North, J.

(*r*) The Court held that it made no difference to this matter whether the case were treated under the Act of 1875 or under the Act of 1883. They, in fact, dealt with the case under the former Act.

(*s*) *Apollinaris Co.'s Tm.*, (1891) 2 Ch. 186, see at p. 234; 8 R. P. C. 137, C. A.; and *Batt & Co.'s Tm.*, (1898) 2 Ch. 432; 18 R. P. C. 262 and 534, Romer, J., and C. A.; and (1899) A. C. 428; 16 R. P. C. 411; *sub nom. Batt* v. *Dunnett*. See also as to infringement of an unused mark, per Cotton, L. J., in *Hudson's Tm.*, 32 C. D. p. 319; 3 R. P. C. 155; and *Edwards* v. *Dennis*, 30 C. D. 454; 55 L. J. Ch. 125 (1885), C. A.; and Chap. XV., below, p. 307.

to those in respect of which the registration was effected, and which had the mark affixed to them by the foreign producer to whom it belonged, the goods being intended by the producer for foreign markets only, the registration was held to be irregular, and was expunged (*u*). And where marks had been registered for seventeen years and there was no proof of user in a particular class, and it was found as a fact that there was never any *bonâ fide* intention to use the marks for goods in that class, they were removed from the Register (*x*). "A question of law then arises," said Lindley, L. J., in delivering the judgment of the Court of Appeal in *Batt's Case*, "which may be stated shortly as follows:—Can a man properly register a trade-mark for goods in which he does not deal, or intend to deal—meaning by intending to deal, having at the time of registration some definite and present intention to deal in certain goods or descriptions of goods, and not a mere general intention of extending his business at some future time to anything which he may think desirable? This question we answer in the negative. To answer it otherwise would be unduly to strain the language of the Acts relating to trade-marks, and to render those Acts extremely mischievous, instead of beneficial to trade and commerce" (*y*). The judgment of the Court of Appeal was affirmed by the House of Lords (*z*).

Section 10 of the Act of 1888. (Sect. 64.)

This section governs all applications for registration, and all registrations made or taken to be made since the commencement of the Act, the 1st of January, 1889; but, as the question whether a mark on the Register was properly qualified for registration or ought to be expunged under sect. 90, must be considered with reference to the law in force at the date when the registration complained of was

(*u*) *Apollinaris Co.'s Tm.*, (1891) 2 Ch. 186, see at p. 234; 8 R. P. C. 137, C. A.

(*x*) *Batt & Co.'s Tm.*, *supra*, note (*s*). See also *Ashton's Tm.*, 48 W. R. 389 (1900).

(*y*) (1898) 2 Ch. at p. 430; 15 R. P. C. at p. 538.

(*z*) *Ubi supra*, note (*x*).

made, or is taken to have been made (*a*), it is necessary to consider the terms of the corresponding sections in the earlier Acts and to compare them with those of this section.

What Act applied to pending registrations.

Both the Act of 1883 (*b*) and the Act of 1888 contain saving clauses (*c*), and where an application was made two days before the Act of 1883 came into operation, and the registration was opposed, and the matter came before the Court for decision, the Court of Appeal thought it "undoubtedly the better course" to treat the question as governed by the old Act of 1875. In the particular case, however, it made no difference (*d*). So, in *Burgoyne's Case* (*e*), where the application was made in December, 1887, but did not come before the Court until February, 1889, Chitty, J., held that it must be treated as made under the Act of 1883, and that the applicant, therefore, could claim registration of his mark as a "fancy word."

In the *Apollinaris Case* (*f*), Kekewich, J., put a still more favourable construction upon sect. 27 of the Act of 1888, for he held that, under circumstances similar to those of the last cited case, the applicants were entitled to registration if they could bring their mark within the terms of either the Act of 1883 or that of 1888.

Sect. 10 is purely restrictive.

Section 10 is purely restrictive, as were also the corresponding sections of the earlier Acts, which it has replaced. It is intended to limit and curtail the numerous forms of words and other things which, before the Acts, were appropriated as trade-marks (*g*).

(*a*) See the section, and *Ward, Sturt and Sharp's Tms.*, 50 L. J. Ch. 347; 44 L. T. 97 (1881), Hall, V.-C.; and *Re Borril Tm.*, 13 R. P. C. 388 (1896); 2 Ch. 604, per Lindley, L. J.; and cf. Chap. XI., below, p. 277.

(*b*) Sect. 113: "this repeal of enactments shall not affect the past operation of any of those enactments, or any . . . right to use a trade-mark granted or acquired, or application pending, . . . or right . . . acquired, . . . or anything duly done . . . under . . . any of those enactments before or at the commencement of this Act."

(*c*) Sect. 27: "nothing in this Act shall affect the validity of any act done, right acquired, or liability incurred before the commencement of this Act."

(*d*) *Hudson's Tm.*, 32 C. D. p. 317, Cotton, L. J.; 3 R. P. C. 115 (1886).

(*e*) 6 R. P. C. 227; 61 L. T. 39 (1889).

(*f*) (1891) 2 Ch. p. 201; 8 R. P. C. 137.

(*g*) Per Cotton, L. J., in *Van Duzer's Tm.*, 34 C. D. p. 634; 4 R. P. C. 31 (1887).

No mark can be put upon the Register unless it complies with the terms of this section, but the presence in it of one or more of the specified particulars does not make the mark a good trade-mark, or, of necessity, entitle it to registration. Some restrictions on registration are imposed by the Act itself (*h*), and the Comptroller has, as is shown elsewhere (*i*), discretion to allow or refuse registration where all the conditions of the Acts are complied with (*i*).

Essential Particulars.

A registered trade-mark must contain one or more of the essential particulars, or be an old mark.

No trade-mark can be properly registered unless it contains one or more of the essential particulars enumerated in the Act under which the registration is made (*k*), or unless it is within the proviso relating to old marks. This is clear enough from the Acts, but it is also supported by judicial authority. Thus, in *The Orr-Ewing Case*, Lord Cairns said (*l*): "I cannot think that the Vice-Chancellor Hall sufficiently appreciated the object and provisions of the Act of Parliament when he said that he considered that, in each case, a device or label, registration of which is applied for, must be looked at as a whole, and that if it appears to be such as in the ordinary course of business would be distinguished from other devices or labels it should be registered. To some extent, no doubt, this is true; but I apprehend the first duty cast upon the Court is to ascertain whether some one, or more than one, of the essential particulars of a trade-mark, as defined by the Act, is found to exist, so that the mark may be described with the one, or more than one, essential particular or particulars which distinguish it." And in a later case, Chitty, J., said (*m*): "The argument is that, though neither of the particulars is within the 64th section, the mark

(*h*) Sects. 72, 73 and 86. See Chap. X., below, p. 211.

(*i*) Chap. IV., p. 69; *Ehe* v. *Dunn*, 15 App. Ca. 252; 7 R. P. C. 311 (1890); and see per Lindley, L. J., above, p. 73.

(*k*) Above, p. 121.

(*l*) *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Ca. p. 484; 48 L. J. Ch. 710 (1879).

(*m*) *Bradley's Tm.*, 9 R. P. C. p. 207 (1892). The mark in question consisted of the words *Worth's Corsets* printed in ordinary type, between two co-axial ovals.

must be looked at as a whole; and being looked at as a whole, it is brought within the sub-section (c) (as a device or label) because as a whole it is distinctive. This point was raised before Mr. Justice Pearson, in *Price's Patent Candle Co.'s Case* (*n*), and without success. It is quite true that the mark must be looked at as a whole, but we must find in the whole, one at least of the essential particulars; and not one of the essential particulars, in my opinion, can be found in this mark." So, in *The Birmingham Vinegar Brewery Co.'s Application* (*o*), Kekewich, J., in considering a label, set aside the argument that, although there were none of the essential particulars in detail, yet the combination of many particulars which were not essential, might make the whole label into an essential particular. In *Wright, Crossley & Co.'s Application* (*p*), in which the applicants sought to register a label alleged to be distinctive, Byrne, J., after referring to the cases already quoted, and holding that the mark did contain an essential particular or particulars, inasmuch as it contained certain devices, said: "These devices, as and when used as part of the trade-mark, with the rest of the label appear to me to make the whole label distinctive" (*q*).

The sub-sections are alternative.

The five divisions into which essential particulars are by sect. 10 of the Act of 1883 divided, are separate and distinct (*r*). In the case of (d) and (e) a different conclusion was arrived at by the Court of Appeal in the *Somatose Case* (*rr*), where it was held that a word could not be registered as an "invented word" unless it also was a word "having no reference to the character or quality of the goods," but this

(*n*) 27 C. D. 681; 54 L. J. Ch. 210 (1884). A conventional label with the words *National Sperm* printed on it. As to labels, see further, pp. 150 to 156.

(*o*) 11 R. P. C. 195; 70 L. T. 646 (1894).

(*p*) (1900) 2 Ch. 218; 17 R. P. C. 386.

(*q*) But, although in *Clement & Cie.'s Tm.*, (1900) 1 Ch. 114; 16 R. P. C. 611, the Court of Appeal were considering a different question, namely, whether a word was part of a mark or an addition to it, they appear to have assumed that the label must be considered as a whole. See also *The Smokeless Powder Co.'s Tm.*, (1892) 1 Ch. 590; 9 R. P. C. 109. See also below, "Label."

(*r*) See Lord Herschell's judgment in *Eastman & Co., Ld.'s Application*, note (*s*), p. 124.

(*rr*) *Farbenfabriken Formals F. Bayer & Co.'s Tm.*, (1894) 1 Ch. 645; 11 R. P. C. 84.

construction of the Act was disapproved of by the House of Lords in *The Eastman Photographic Materials Co. Ld.'s Application* (*s*), and the decision of the Court of Appeal was reversed. Therefore, although in construing one division the scope of another division may be material (*t*), the fact that a thing is not an essential particular under one heading will not prevent its being a proper essential particular under another heading. It follows, too, from this construction that qualification under more than one heading is possible—for instance, a word might be an invented word within (d), and also be a word having no reference to the character or quality of the goods within (e).

Additions. To one or more of the essential particulars there may be added any of the other matters enumerated in sect 64 (2), but the applicant for registration of any such additional matter must now, under that sub-section as amended by the Act of 1888 (*u*), state in his application the essential particulars of the trade-mark, and must also disclaim (*v*), in his application also, any right to the exclusive use of the added matter, and under sect. 74, as amended by sect. 16 of the Act of 1888, a like disclaimer must be made as to any addition within sect. 74; and a copy of the statement and disclaimer is to be entered on the Register.

The power conferred by sect. 92 of the Act to alter registered marks does not extend to the alteration of their essential particulars (*x*).

Name-marks. (a.) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner.

Names are highly valued as trade-marks, or as essential particulars of trade-marks, and they were often adopted and protected as such before the Acts (*y*). Clause (a) is taken from sect. 10 of the original Act.

(*s*) (1898) A. C. 571; 16 R. P. C. 476.

(*t*) See, for instance, *Holt's Tm.*, (1896) 1 Ch. 711, 717; 13 R. P. C. 16 and 118 (1896), North, J., and C. A.; and *Pirie* v. *Goodall*, (1892) 1 Ch. 35; 9 R. P. C. 17, Vaughan Williams, J.

(*u*) Sect. 10; *Bryant and May's Tm.*, 8 R. P. C. 69; 59 L. J. Ch. 763 (1890), North, J.

(*v*) See Chap. IX., p. 199.

(*x*) See Chap. XI., p. 297.

(*y*) "The name of a firm is a very distinctive word indeed": per

Comparison of clause (a) with the following clause shows that the name need not be that of the individual or firm applying for registration, as the signature referred to in the last-mentioned clause must. But the name must be that of a real individual or firm as opposed to an imaginary individual or firm. Thus, it was held in *Holt & Co.'s Trade-Mark* (z), by Lindley and Smith, L. JJ. (Kay, L. J. dissenting), that *Trilby*, being the name of an imaginary person taken from a novel, was not within clause (a); and Lindley, L. J., said: "Clause (a) does not say that the name to be registered need be the name of a living person, nor the name of the applicant for registration. In this respect clause (a) differs from clause (b). The reference to a firm, however, points rather to real persons than to imaginary persons. In metaphorical language, an imaginary person may perhaps be called an individual, but such a use of the word is unusual, and to my mind rather fanciful. It is hardly to be supposed that the Legislature meant 'individual' to be taken in a fanciful or metaphorical sense, or meant it to denote an imaginary person who has not and never had any real existence." The question whether clause (a) is satisfied if it can be shown that the name has at some time been the name of a real person or firm did not arise; but there is nothing in the judgments of Lindley and Smith, L. JJ., to indicate that they considered that such a name would not fall within clause (a) (zz).

Name of imaginary person.

The practice of adopting trade-names which are different from those of the traders or of the partners in the firm using them is very common—for instance, in the Scotch whiskey trade, in which it is a common practice to use a Scotch name.

Jessel, M. R., in *Exp. Stephens*, 3 C. D. p. 660; 46 L. J. Ch. p. 47 (1876).

(z) 13 R. P. C. 16 and 118, C. A., (1896) 1 Ch. 711, reversing North, J. It was argued that if the word fell under clause (a)—with the condition of which it did not comply, as it was not printed in any distinctive manner—it could not be registered under clause (e). The majority of the C. A. approved the argument, but held that the word did not fall under clause (a).

(zz) In *Banks & James' Tm.*, 12 R. P. C. 333 (1895), Chitty, J., held that *Shakspere* was not a "fancy word, one of his reasons being that there were many living persons of the name.

The practice is of itself perfectly lawful, and such a name so adopted, and although so adopted for one branch only of a business, would no doubt be within the clause; and as this practice is allowed, there seems to be no reason why a trader should not adopt as his trade-mark the name of a real (*a*) or imaginary individual, for the office of the mark is not necessarily to connect the goods which bear it with him, but to connect them with the business which he conducts in them (*b*).

But the effect of the decision in *Holt's Trade-Mark* (*z*) is that if the name adopted be that of a real person or firm, it comes under clause (a), and must be printed, impressed or woven in some particular and distinctive manner; whilst if it be that of an imaginary person, it can be registered under clause (e) in ordinary lettering, provided that it has no reference to the character or quality of the goods (*c*). It was pointed out by Stirling, J., in *Colman's Application* (*d*), that in clause (a) the word "person," which would have included a body corporate (*c*), is not used, and that a question may arise whether the name of such a body comes within clause (a); there is at present no decision on the point. Names falling within clause (a) are not within clause (e) (*f*).

The question whether the signature of the applicant's predecessor in business can be registered under this sub-section is considered under clause (b) (*g*).

It does not follow that every name of an individual or firm, printed &c. as required by the sub-section, which an applicant may select is entitled to registration, for, apart from the general restrictions expressly specified by the Act (*h*), the Comptroller, in the exercise of his discretion (*i*), would, no doubt, reject any name which, contrary to the fact, tended

(*a*) Cf. *A. W. Gamage, Ld.* v. *H. E. Randall, Ld.*, 16 R. P. C. 185 (1899) (a passing-off case in which the plaintiffs failed. *Shorland* for cycling shoes).

(*b*) See *supra*, p. 35; and Chap. XVI., p. 463.

(*z*) See note (*z*), p. 125.

(*c*) See *infra*, p. 180. Cf. an official notice of Nov. 6th, 1889, Appendix, p. 731.

(*d*) (1894) 2 Ch. 127; 11 R. P. C. at p. 134.

(*e*) Sect. 117 (1).

(*f*) *Holt's Case*, *supra*.

(*g*) Below, p. 129.

(*h*) Sects. 72, 73 and 86; Chap. X., p. 211.

(*i*) See p. 69.

to suggest that the goods on which it was used were the manufacture or merchandise of, or had some connection with, a particular person or firm, or were goods of a particular kind, especially if the name were not the proper name of the applicant or of his predecessors in trade (*j*). And if the name indicated a particular living person, who did not assent to the use of his name, the Comptroller might in his discretion reject it, even although no connection of the person with the particular goods would be suggested (*k*).

Name must be mere name in nominative case.

The name must be the mere name in the nominative case. Thus, where *Pirie's Parchment Bank* was registered as a trade-mark, and the two latter words were disclaimed, Lindley, L. J., held that *Pirie's* was not the name of a firm within the sub-section (*l*).

And as regards the registration of names in the possessive case, generally, Lord Herschell's Committee reported (*m*) that "complaints have also been made that where words have been refused as not being distinctive, they have afterwards been allowed where the applicant has applied for a mark consisting of the same word preceded by the applicant's name with an apostrophe. We think," they added, "that this course ought not to be pursued. Little or no mischief might result where the name of the applicant was an uncommon one; but where the name was a common one the result would be to deprive all persons bearing the same name of their right to use a common word in connection with their own name, and even if the name were an uncommon one it would be impossible to say that there were not other persons bearing it who might wish to use it in connection with the common word which it is sought to monopolise."

(*j*) Cf. *Thorncloe* v. *Hill*, (1894) 1 Ch. 569; 11 R. P. C. 61 (*John Forrest*—passing-off case).

(*k*) *Carroll's Application*, 16 R. P. C. 82 (1899), Kekewich, J. (*Princess Christian*), to some extent supports though it does not decide this. Portraits of well-known persons have, with their consent, been registered as trade-marks.

(*l*) *Pirie* v. *Goodall*, (1892) 1 Ch. 35; 9 R. P. C. 17; cf. *Colman's Tm.*, (1894) 2 Ch. 115; 11 R. P. C. 129, where Stirling, J., held that *Colman's* occurring in a label need not be disclaimed under sect. 64 (3) (1). An official notice was given in 1889 that names of persons in the possessive case in combination with the names of goods would not be accepted as trade-marks, Appendix, p. 731.

(*m*) Report of 1888, p. xii.

The report continues: "Evidence has been given that marks consisting of a combination of the applicant's name with the article he manufactures or sells are highly valued. There can be no doubt that if a manufacturer or vendor has obtained for his goods a reputation amongst the public, he could, by process of law, quite apart from the Trade-Marks Act, prevent goods that were not his from being offered to the public on the representation that they were so. But it would be quite a different thing to give, by virtue of registration under the Trade-Marks Act, a right to prevent another manufacturer or merchant honestly describing his own goods by his own name" (*n*).

The effect of the decision in *Pirie* v. *Goodall* (*o*) will, no doubt, be to put a stop for the future to the registrations which the committee thought objectionable.

Printed, &c. It may be assumed that *printed, impressed, or woven* must be construed to include any method of marking the name upon, or attaching it to, the goods which it is to distinguish.

Particular and distinctive manner. The word "distinctive," where it appears in this section, in sub-sect. (c), and in conjunction with "special" in sub-sect. (3) (ii.), has been repeatedly construed by the Court (*p*); but in the present clause it does not seem to present any difficulty. The intention of the requirement that the name should be printed (&c.) in a *particular and distinctive manner* was obviously to prevent a name from being so taken as a trade-mark that any trader might unintentionally infringe it by an honest use of his own name (*q*). This intention would be carried into effect by construing the words to mean "not ordinary, having regard to the practice in the trade concerned."

Ordinary type. A name printed in ordinary type (*r*), or in type in ordinary

(*n*) See *Hopkinson's Tm.*, (1892) 2 Ch. 116; 9 R. P. C. 102, Kekewich, J., where something like this seems to have been done by the registration of a name as an old mark.

(*o*) See note (*l*), *ante*, p. 127.

(*p*) See below, p. 132.

(*q*) See the extract quoted above from the report of Lord Herschell's Committee. As to the right of a man to trade under his own name, see clause 3 (1), and below, p. 202; but cf. *Hopkinson's Tm.*, note (*n*).

(*r*) *Carroll's Application*, 16 R. P. C. 82 (1899), (*Princess Christian* for needles).

use, as, for instance, capitals (*s*), or common ornamental letters (*t*), is not within the sub-section; and the addition of marks which are common to the trade makes the words no better as a trade-mark (*u*).

The name of a registered proprietor appearing on a registered trade-mark, and not being one of its essential particulars, may be altered under sect. 92, except perhaps in the case of an old mark (*x*).

(b) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade-mark. Signature of the applicant.

Under the Act of 1875 the latter words of the clause ran "of an individual or firm." The addition "applying for registration" was effected by the Act of 1883. One result of the alteration is, as Mr. Sebastian points out (*y*), that a trader cannot register the signature of his predecessor in business under this sub-section (*yy*). He may, however, if it falls within the terms of (3) (ii.) be able to register it as an old mark (*z*); and if the signature is printed (&c.) in a distinctive manner, he can register it under sub-sect. (a) (*a*), unless it should be held that it must be implied from the presence of this clause (b) that signatures were intended to be excluded from clause (a) (*b*); but this is not a necessary or, it is submitted, the true construction of the section. The object of the insertion of clause (b) may well have been to preclude any question whether a name, reproduced as ordinarily

(*s*) *Gianaclis' Tm.*, 6 R. P. C. 467; 58 L. J. Ch. 782 (1889), North, J., (*Gianaclis Cigarettes*).

(*t*) *Re Price's Patent Candle Co.*, 27 C. D. 681; 54 L. J. Ch. 210 (1884), Pearson, J.

(*u*) *Ibid.*, and *Bradley's Tm.*, 9 R. P. C. 205 (1892), Chitty, J.; (*Worth's Corsets*) printed between two co-axial ovals.

(*x*) *Stock-Owners' Meat Co. of New South Wales*, 14 R. P. C. 733 (1897), Romer, J.; and see below, Chap. XI., pp. 297 *et seq.*

(*y*) 4th edition, p. 36.

(*yy*) Nor can a trader register the name of the manufacturer of his goods, even with the latter's consent.

(*z*) Below, p. 184.

(*a*) Above, p. 124.

(*b*) Cf. *Exp. Stephens*, 2 C. D. 659; 46 L. J. Ch. 46 (1876), where, in refusing registration, under the Act of 1875, to the word *Acilyton*, Jessel, M. R., asked: "Why should a written signature be specified, if any signature will do?" And see *Holt's Tm.*, (1896) 1 Ch. 711; 13 R. P. C. 16 and 118.

signed by its owner, did or did not fall within (a), although, had (a) stood alone, it would not have been open to doubt that any characteristic signature was within it. Of course, the signature of a predecessor in business, properly registered by him and assigned or transmitted as a trade-mark, together with the goodwill of the business, is usually as available for use by the successors, and can be as readily protected, as if it had been originally registered by them (*bb*). The words "written signature of a firm" are construed by the Comptroller to mean a signature (actually used in the ordinary course of business) of the trading style under which the applicant has a *bonâ fide* right to trade, and which consists of a *personal name* or of *personal names*, and not to include mere descriptive trading styles, such as *The Excellent Tea Co.* or *The London Stout Co.* (*c*).

Requirements for a good trade-mark.

Copies of written signatures were frequently protected as trade-marks, or as material parts of trade-marks, before the Acts (*d*). As a man's signature has for several centuries been the mark in universal use to authenticate documents which are his, it might have been expected that it would have been used also to authenticate his goods, and that signatures would have occupied a more prominent place among trade-marks than they do. There are, however, several objections to a signature as a trade-mark. A good trade-mark must not only enable a customer to recognize the goods which bear it, when he sees them, as those of the manufacturer or trader with whom he wishes to deal, but must also enable him to describe and call for them. As regards the latter requirement, a signature is usually nothing more than a bare name-mark, for the manner of writing it will rarely be such as to enable even a person who could read and recognize it at sight to recollect and describe it; and it is obvious that for customers—some foreigners, for instance—who are unable to read the signature, it, or, indeed, any name-mark, fulfils neither

(*bb*) See Chap. XIII., p. 324, Assignment and Devolution of Trade-Marks.

(*c*) Notice in the Trade-Marks Journal, 1 Jan. 1896, printed in the Appendix, p. 733.

(*d*) As in *Farina* v. *Silverlock*, 1 K. & J. 509; 6 De G. M. & G. 214; 24 L. J. Ch. 632; 26 L. J. Ch. 11; and 4 K. & J. 650 (1855), Wood, V.-C., and Lord Cranworth.

of the requirements referred to. Another disadvantage of a signature as a trade-mark is that the protection afforded is very narrow. Thus, a trade-mark of which the signature of one of the complainers (it being a Scotch case), Daniel Crawford, was the essential particular was held not to be infringed by a facsimile of the signature of the respondent, Robert Crawford, and apparently the judgment would have been the same although the names had been identical. Lord Kyllachy, after pointing out that the case put forward was purely a trade-mark case, said: "Now it is new to me that a man who has a registered trade-mark or facsimile of his own signature can complain of another trader using as a trade-mark a facsimile of his own merely because the two names happen to be the same;" and, without hearing evidence, he decided that the case was not sustainable (*e*).

The signature itself, being an essential particular of a registered trade-mark, cannot be altered under sect. 92. A corresponding decision was given by Jessel, M. R., under the Act of 1875 (*f*).

(c) A distinctive device, mark, brand, heading, label, or ticket. Distinctive device, &c.

Brand did not appear in the Act of 1875. It was added by the Act of 1883. The latter Act contained also the clause "fancy word or words not in common use," which is now replaced by sub-sects. (d) and (e) (*g*).

Distinctive governs, and is to be read with, each of the words which follow it (*h*). It merely incorporates what was law before the Registration Acts, in so far as it requires that, in order to be a trade-mark, a symbol must be capable of distinguishing the goods upon which it is placed from

(*e*) *Crawford & Son* v. *Bernard & Co.*, 11 R. P. C. 580 (1894); and cf. *Barber* v. *Manico*, 10 R. P. C. 93 (1893), where Smith, L. J., sitting as a judge of first instance, held that the words *Edward Barber* were not an infringement of an old trade-mark consisting of the words *Era James Barber, Sheffield*.

(*f*) *Re Dewhurst*, 11th June, 1880, stated in Sebastian, 4th ed., p. 376.

(*g*) Below, p. 171.

(*h*) *Waterman* v. *Ayres*, 39 C. D. 29; 5 R. P. C. 368 (1888), C. A.; *Burland* v. *The Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J.; *Pirie* v. *Goodall*, (1892) 1 Ch. 35; 9 R. P. C. 17, C. A.

similar goods, so as to identify them with the business of the proprietor of the mark (*i*).

"Distinctive."

The word standing alone in this clause, and coupled with *special* in clause (3) (ii) (*k*), has been construed in a number of cases. In *Leonard and Ellis' Case*, Fry, L. J., expressed an opinion that the words *special and distinctive* of sub-sect. (3) (ii) "import the specializing of the make and manufacture of a particular maker from all other manufacturers, and distinguishing the manufacture of one person from the manufacture of all others" (*l*). In *Wood* v. *Butler* (*m*), Lindley, L. J., said that distinctive trade-mark "must mean some mark which distinguishes the goods to which it is attached as those made or sold by the person who uses the mark"; and Fry, L. J., repeated his definition from the earlier case. The whole Court held that it was not sufficient for the mark to be distinctive as regards the trade; it must be distinctive in the eyes of the ultimate customers, the consumers. "It ought," said Lopes, L. J., "to be a special and distinctive mark, not only recognizable by the trade, but also recognizable by the consumer, as connecting the article with the manufacturer." So that, as the proprietor of the mark had put upon the boxes in which his goods were enclosed words suggesting that they were made, not by him, but by a foreigner, although the suggestion was, as the trade knew, false, he had by his own act prevented the mark from being distinctive.

Lord Halsbury defined the word in similar language to that of Fry, L. J., quoted above; in *Perry-Davis & Son* v. *Harbord* (*n*), distinctive, he said, "means distinguishing a particular person's goods from somebody else's,—not a

(*i*) See Chap. II., p. 34; *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Ca. 479; 48 L. J. Ch. 707, (1879), and *Hopkinson's Tm.*, (1892) 2 Ch. p. 121; 9 R. P. C. 102, Kekewich, J.

(*k*) Below, p. 185. Also *Faulder's Tm.*, 18 R. P. C. 37 (1901), Kekewich, J.

(*l*) 26 C. D. p. 304; 53 L. J. Ch. 612 (1884), C. A., *Valvoline* for valvo oil.

(*m*) 32 C. D. 247; 3 R. P. C. 81 (1886), *Eton* for cigarettes, claimed as an old mark; followed in *Wolff* v. *Nopitsch*, 17 R. P. C. 321 (1900), Cozens-Hardy, J. (*Spanish graphite* pencils), a passing off case; see the decision of C. A., 18 R. P. C. 27.

(*n*) 15 App. Ca. p. 320; 7 R. P. C. 336 (1890). *Pain-killer* claimed as an old mark for medicine.

quality attributed to the particular article, but distinctive in that respect that it means that it is a manufacture of his distinguished from somebody else's" (*n*). And he held that the word *Pain-killer*, as applied to a patent medicine, was neither special nor distinctive (*o*).

"The essence of a trade-mark," said Kay, J., in *Richards* v. *Butcher*, "is that it is some distinctive thing which points out that the goods are the goods of A. B." (*p*).

And in *Hopkinson's Trade-Marks* (*q*) Kekewich, J., said: "In order to protect a trade-mark before the Act, you were obliged . . . to prove by evidence, and satisfy the Court, that the words used as a trade-mark were known in the market, and—I think it is Lord Westbury's phrase (*r*)—gave a vendible character to the articles to which they were attached, made these articles recognized as coming from a particular manufactory, and so gave them a character different from every other article in the trade. Therefore it seems to me that the legislature here (*s*) did no more than adopt the language of the cases."

In *The Dome Black Lead Case* (*t*) Lopes, L. J., put a some- *James' Tm.*
what different interpretation on the word *distinctive*. It means, he said, "that it must be a mark or device of such a kind as, in case of infringement, it shall be clear what it is that is being infringed, and that the mark is something distinct from all other marks used in the same class of goods." And the Court of Appeal there held, that, upon the evidence

(*n*) See note (*n*), *ante*, p. 132.

(*o*) So also did Lord Morris, in the House of Lords, and Fry and Lopes, L. JJ., in the Court of Appeal.

(*p*) (1891) 2 Ch. p. 536; 8 R. P. C. 249, Kay, J., and C. A. *Monopole* for wines. In each of the three cases last referred to, the marks were claimed as special and distinctive words used as trade-marks before 13th August, 1875. They were all rejected.

(*q*) (1892) 2 Ch. p. 121; 9 R. P. C. 102. *J. & J. Hopkinson* for pianos, claimed and allowed as an old mark. In *Dewar & Son, Ld.* v. *J. H. Dewar*, 17 R. P. C. 341 (1900), Lord Kyllachy said he was not satisfied that the words *Dewar's Whisky* were, assuming use prior to 1875, "special and distinctive."

(*r*) *The Leather Cloth Co.* v. *The American Leather Cloth Co.*, 4 De G. J. & S. 137; 33 L. J. 199 (1863), cited above, p. 51.

(*s*) *I.e.*, by the use of the phrase "special and distinctive" in the old mark clauses of the Acts.

(*t*) *James' Tm.*, 33 C. D. 392; 3 R. P. C. 340 (1886), C. A.

a sketch of a short cylinder terminated by a hemisphere was a distinctive design for black-lead, which was in fact made up for sale in pieces of the shape shown by the sketch. There is, however, no disagreement between the two interpretations, and on consideration it will be seen that the first assumes the second, for no mark can distinguish the goods which bear it from all similar goods, or can create a species within the genus, unless it has itself some recognizable and characteristic peculiarity to separate it from other marks which may be found upon some or all of them. Moreover, a mark which satisfies the second test, and possesses such a peculiarity as is referred to, if this is recognized with sufficient readiness as a peculiarity, must of necessity, when it becomes known, distinguish the goods which bear it in the manner required by the test suggested by the *dicta* first cited. In the case of new marks which have, and can have, acquired no connection by reputation with their owner, all that can be demanded of the mark is that it shall be capable of distinguishing the goods to which it is applied in the required manner, and this accords with the old law (*u*).

Meaning of "distinctive."

In order to be distinctive, then, a mark must be different from other marks used upon or in connection with the same goods, and the difference must be such as, in the case of a mark already used and known, to distinguish the goods which bear it as the goods of its proprietor; or, in the case of a new mark, to be capable of so distinguishing, and to be likely when used and known, to so distinguish, the goods. Three questions arise upon this:—(1) What are the other marks from which a mark under consideration is to differ? (2) What kind and degree of difference will suffice? and (3) What is the function of evidence in the determination of the inquiry? The second and third questions may be more conveniently considered in connection with the restriction put upon the registration of marks which too nearly resemble previously registered marks by sect. 72 (*x*).

Questions to be considered.

(*u*) See Chap. II., p. 34.
(*x*) Chap. X., p. 224. As to question (2), see also below, p. 140.

1. What Marks are to be distinguished.

Common marks.

In many trades there are a great number of common marks, which have been generally adopted for ornament or some similar purpose, or which—having been in the first instance appropriated as trade-marks—by abandonment (*y*), by wide-spread piracy (*z*), or, in the case of word-marks, by becoming the names (*a*), and therefore descriptive, of the goods, have become *publici juris*. And a mark, to be distinctive, must be distinguishable from all of these.

The Orr-Ewing Case.

Thus the committee of experts appointed under the Act of 1875 (*b*), to classify the marks tendered for registration in respect of cotton goods, rejected some marks bearing arrangements of elephants, lions, and crowns, on the ground that such devices or symbols in themselves, and by reason of the extensive use of lions and demi-lions, and crowns and elephants by the trade, were not private property, and did not possess a distinctive character; and on the appeal from the Registrar's refusal to register, evidence was given that among the marks rejected by the committee were 31 crowns used by 18 different firms, 52 elephants used by 30 different firms, and 137 lions and demi-lions used by 64 different firms (*c*). In the same case it was shown that triangular tickets in green and gold were in common use in the cotton trade.

In the early years of the existence of the Register, a number of common marks were accepted and placed upon it in ignorance of their true character. The committee of experts, to which reference has been made, was instituted to assist the Registrar, and, after 1884, the Comptroller, in determining what marks were common in the cotton class, and it was the practice of these officers in other cases to

(*y*) See below, p. 346.

(*z*) See *Ford* v. *Foster*, 7 Ch. 611; 27 L. T. N. S. 210 (1872), C. A. See p. 37, above; also *Ripley* v. *Bandey*, 14 R. P. C. 591 and 944 (1897), Kekewich, J. and C. A.; and Chap. XIV., p. 338.

(*a*) See Chap. II., p. 36.

(*b*) See Chap. VII., p. 112.

(*c*) *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Ca. p. 485; 48 L. J. Ch. 707, (1879); and see *Kuhn & Co.'s Tm.*, 53 L. J. Ch. 238, n. (1878); and *Hyde & Co.'s Tm.*, 7 C. D. 724; 54 L. J. Ch. 395, n. (1878), both Jessel, M. R.

consult the representatives of the trade concerned on the subject (*d*).

What marks are common.

It is clear that such marks as those above referred to, which are in common use in the trade, must be standards of comparison by which the distinctiveness of a new mark may be tested (*e*); and some assistance in determining when a mark is to be taken to be in common use, may be obtained from the decisions on other parts of the Act. Thus, sect. 64 (c) of the Act of 1883 (now repealed) allowed "fancy words not in common use" to be registered, and on this it was held, that use by several firms in the trade in question, and by others in different trades, was common use (*f*). Sect. 74 (*g*) authorizes the registration, as additions to a trade-mark, in the case of any mark used as a trade-mark before 13th August, 1875, of any distinctive (*h*) device, mark, brand, heading, label, letter, word, or figure, or combination of letters, words, or figures; and in the case of any mark not so used of any distinctive (*h*) word or combination of words, though the same be respectively common to the trade in the goods with respect to which the application is made. The section also provides that a mark which was, before the 13th of August, 1875, publicly used by more than three persons on the same or a similar description of goods shall, for the purposes of the section, be deemed common to the trade in such goods (*i*).

In *The Washerine Case* (*k*) Chitty, J., held, that marks might be *common to the trade* within sect. 74, though not

(*d*) Per Jessel, M. R., in *Kuhn's Case, supra.*

(*e*) See *Bryant and May's Tm.*, 8 R. P. C. 69; 59 L. J. Ch. 763 (1890), North, J.; the cases cited in note (*e*); *Anderson's Tm.*, 26 C. D. 409; 53 L. J. Ch. 664, Chitty, J.; affirmed on appeal, 54 L. J. Ch. 1084 (1884); and *Thwaites and Blakey's Tm.*, 10 R. P. C. 369 (1893), North, J. *Anchors* rejected because anchors were common in the trade.

(*f*) *Great Tower Street Tea Co.* v. *Smith*, 6 R. P. C. p. 172; 5 T. L. R. p. 232, North, J. (1889), *Tower Tea*; and see below, p. 168.

(*g*) See Chap. IX., p. 197, Additions and Disclaimers.

(*h*) This means *primâ facie* distinctive: *Burland* v. *Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J. (*Washerine*); *Thompson* v. *Miller*, 13 R. P. C. 35 (1895), Stirling, J., (*Roadster*).

(*i*) Sub-sect. (3). See below, pp. 207 and 214. The three mark rule.

(*k*) *Burland* v. *Broxburn Oil Co.*, 42 C. D. 271; 6 R. P. C. 482 (1889).

publicly used by more than three persons, as required by subsect. (3), and that the words do not mean "in common use in the trade," but "open to the trade," and this interpretation was adopted by Kekewich, J., in *The Apollinaris Case* (*l*). In an earlier case the last-named judge said: "Any word which the trade might have used at the date of the registration is, as I construe the Act, common to the trade. I think it means that a word, which might have been used for these particular goods by any other persons at the time is common to the trade" (*m*). Obviously this construction must be read with some limitation, otherwise no new mark could ever be registered, for every unused mark is open to the trade until it is monopolised by someone, either by registration or by user, as a trade-mark. It is submitted that what is meant is that a mark common to the trade is one known in the trade and not appropriated, and this is consonant with the contexts of the passages cited above, and Chitty, J., gives, as an example, the case of a mark widely used and then abandoned by all but two or three persons in the trade. In *The Apollinaris Case* the word in question was the name of a mineral water which might have been sold by the proprietors to other traders than the claimants of the mark, although they were, for the time, the sole importers of it. And in *The Herbalin Case* (*m*) the word had been extensively used before registration both by the plaintiff and by the defendant. The cases cited in this paragraph were all cases of descriptive words.

And in *The Roadster Case*, in which Stirling, J., followed the law as laid down by Chitty, J., in *The Washerine Case* (*n*), the learned judge held the word *Roadster* to be not obviously non-descriptive, and pointed out that it was a dictionary word (*o*).

In *The Stone Ales Case* (*p*) Lindley, L. J., expressed an

(*l*) (1891) 2 Ch. p. 209; 8 R. P. C. 137.

(*m*) *Humphries* v. *Taylor Drug Co.*, 59 L. T. 820; 5 T. L. R. 41, Kekewich, J. (1888), (*Herbalin*).

(*n*) See note (*k*), *ante*, p. 136.

(*o*) *Thompson* v. *Miller*, 13 R. P. C. 35 (1895).

(*p*) *Thompson* v. *Montgomery*, 41 C. D. p. 49; 6 R. P. C. 404 (1889). In *Ripley* v. *Bandey*, 14 R. P. C. 591 (1897), (*Oval Blue*), the defendants were proceeded against for selling blue in an oval shape similar to that employed by the plaintiff, from which his goods had acquired the

opinion that a mark used by one person in the trade only could not be common to the trade.

How far marks which are or have been used by one or more persons in the trade, but which are not commonly used, or common to the trade in the sense just suggested, and which are not trade-marks, ought to be regarded—in judging whether a mark tendered for registration is distinctive—is unsettled.

Other trade-marks, registered or unregistered.

Where any marks already in use are trade-marks, whether registered or unregistered, it is clear that they are obstacles to the registration of any mark which so closely resembles them as to be calculated to deceive, unless the applicant has an independent trade-mark right in the mark he puts forward (*r*). This is expressly enacted by sect. 72, in regard to registered trade-marks (*s*); and it follows, in the case of such unregistered trade-marks as are words, from the prohibition placed by sect. 73 upon the registration of any words, the use of which, by reason of their being calculated to deceive or otherwise, would be deemed disentitled to protection in a Court of Justice (*t*). Apart from these sections, however, it is clear that a mark which is calculated to deceive the public by leading them to believe that it is the trade-mark of some person other than its proprietor, or that the goods sold under it are the goods of another person, cannot be distinctive in accordance with the explanations of the term given in the judgments cited above (*u*). In the very extraordinary circumstances of the case of *Monson* v. *Bochm* (*x*), it was held that a trade-mark which had been registered at a time when a similar and previously acquired unregistered trade-mark for the same goods was in existence might be allowed to remain

name *Oval Blue*. Kekewich, J., held that the name had not fallen into common use, although the oval shape had been used by three other persons, but he also held that the plaintiff failed owing to his neglect to enforce his rights against the other users—a result tantamount to holding the shape to be common. On an appeal the case was settled: 14 R. P. C. 944.

(*r*) Cf. Chap. XV., pp. 384 *et seq.*, Infringement.

(*s*) Chap. X., p. 211.

(*t*) Page 253.

(*u*) See below, Deceptive Marks, pp. 253 *et seq.*

(*x*) 26 C. D. 398; 53 L. J. Ch. 932 (1884), Chitty, J. The facts are stated below, p. 385.

on the Register, on the ground that the later mark had been registered in good faith and in ignorance of the earlier unregistered mark, and had remained unchallenged on the Register for two years, during which time it had been extensively used in its proprietor's business; but the case was treated as exceptional, and the earlier trade-mark was admitted upon the Register also.

Abandoned trade-mark.

But an abandoned unregistered trade-mark is, as such, no obstacle to the registration of a similar mark (*y*), that is, unless it has become a common mark in the trade.

Marks used in advertisements.

Besides common marks and trade-marks, there are, however, other marks used by traders in their businesses; for instance, marks employed in advertisements, or in the "get up" of his goods by a single trader. Are these to be taken as standards in estimating the distinctiveness of a new mark? This, it is submitted, depends upon the extent to which they are known and used. On the one hand, it would be absurd to compel a trader to collect and discriminate all the marks used by his fellow-traders, otherwise than as recognized trade-marks, in or in connection with their businesses, on peril of finding that the mark he has selected or invented for registration is bad; and, on the other hand, it would be a great hardship, to take a single example, to compel a rival trader to omit a material part of a well-known advertisement of his trade, because someone had registered it as a trade-mark. If a mark is well known in connection with a particular trader, though not used as a trade-mark by him, its use upon the goods of another would be likely to identify them with him rather than with the latter, and it would not, therefore, be distinctive in regard to such goods, in the sense explained above. Thus, in a recent case (*z*), Kekewich, J., refused to direct the registration, as a trade-mark for wire-bound india-rubber hose, of a device consisting of a sketch of an elaborate knot of the hose, on the ground that it too closely resembled a picture of similar hose printed by the opponents in their price lists, notwithstanding that the device in question had

(*y*) See the last case and *Paine & Co.* v. *Daniells & Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 217, C. A., (*John Bull beer*).

(*z*) *The Sphincter Co.'s Tm.*, 10 R. P. C. 81 (1893).

been employed as an advertisement by the applicants in their own price lists, and was registered as their copyright design.

2. What Degree of Distinctiveness is required.

What degree of distinctiveness is required.

The question, what degree of difference from other marks will entitle a mark to be registered, is considered in the chapter dealing with restrictions on registration, and, in particular, with sect. 72 (*a*). In addition to what is there said, it may be pointed out that, although a mark offered for registration may be fairly distinguishable from each of several others, yet the existence of these, if they are in use, opposes a cumulative weight of objection to any new mark which has an apparent resemblance to a number of them (*b*).

Secondary distinctive meaning.

It has never been decided that a secondary meaning acquired by user in connection with the applicant's goods, which would have sufficed to create trade-mark rights in an apparently descriptive mark before the Acts (*c*), will enable such a mark to be registered under them, unless it was used as a trade-mark before the 13th of August, 1875; and in *The Stone Ales Case* (*d*) the mark *Stone Ale* was removed from the Register on the ground that there was no evidence of its separate user as a trade-mark before the date mentioned, although its secondary meaning was not only fully established, but was the basis of the injunction granted against the defendant in the case.

Descriptive Marks.

Descriptive marks.

According to the construction placed upon the Acts, a descriptive mark cannot be distinctive. So that any mark which describes the goods, their quality, or the purpose to which they are to be applied, is not registrable, and this rule has been applied far more strictly than that which rejected

(*a*) Page 224.
(*b*) Cf. below, pp. 238, 239.
(*c*) Chap. II., p. 36.
(*d*) *Thompson* v. *Montgomery*, 41 C. D. 35; 6 R. P. C. 404 (1889). There was no appeal on this point to the House of Lords. As to old marks, see below, p. 187.

mere descriptive words as trade-marks before the Acts (*e*). The subject is discussed under the head of Word-Marks, below (*f*).

Device.

Devices as trade-marks.

Devices have been registrable under all the Acts. They are the oldest, and, in many ways, they form the most valuable kind of trade-marks. Before the description of shops and factories by street and number became the common and convenient method of identification, every trader had his characteristic "sign," and it was an obvious and natural step to transfer the sign from the shop to goods which it was desired to show had come out of it. And this was done in very early days. Fragments of classic pottery bear the potter's mark of their maker, and, to come to later times, the early editions of the Aldine Classics bear the device of a dolphin wound round an anchor (*g*). A good trade-mark which has a device as its central feature has this peculiar advantage, that its use is not restricted to customers who speak any one language. It is not, of course, necessarily equally useful or distinctive everywhere. For instance, pictures of a stag and a buffalo, though perfectly different to people who are acquainted with the forms of both animals, might well be indistinguishable by the inhabitants of some of the Pacific islands where no quadruped is known which is larger than a pig, and who would have no name for either. The chief objection to a device trade-mark is the difficulty of choosing one which shall be sufficiently simple and striking to fix itself in the customer's memory, and which shall readily suggest a name or description by which it can be referred to, and yet, at the same time, be distinguishable from the other marks in use for the same goods or description of goods.

Word or letter is not a device.

It was decided under the Act of 1875, which did not, except in the case of old marks, provide for the registration of words, that a collection of English letters (*h*), or a single

(*e*) Chap. II., p. 36.
(*f*) Pages 156 *et seq.*
(*g*) Salaman on Trade-Marks, p. 1.
(*h*) *Exp. Stephens*, 3 C. D. 659; 46 L. J. Ch. 46 (1876), Jessel, M. R., (*Acilyton*).

letter (*i*), could not, but that a word printed in Oriental characters might, be registered as a device (*k*).

Colour.

The device must be distinctive, irrespective of the colours in which it is printed (*l*), although a trade-mark may be registered in any colour or colours, and such registration confers on the owner the exclusive right to use it in that or any other colour or colours (*m*).

Portrait of inventor.

The portrait of a person, for instance the portrait of the manufacturer of the goods in question, may be a distinctive device, and as such capable of registration (*n*). But a particular portrait may be common to the trade, for instance if it is that of the inventor of a process of manufacture which is open to the public, and if goods made according to the process are known and described by reference to the inventor. Thus in *Anderson's Case* (*o*) a device consisting of a portrait of Baron Liebig, with the words *Brand* above and *Baron Liebig* below it, was rejected as a trade-mark for Liebig's extract of meat, on the ground that the words *Baron Liebig* were open to the trade (*p*), and that the portrait of the inventor of the goods was descriptive of the goods. In this case, Chitty, J., found (*q*) that it was a common practice for those engaged in trade to place a photograph of the inventor on the particular article in order to show that he

(*i*) *Mitchell's Tm.*, 7 C. D. 36; 46 L. J. Ch. 876 (1877), Hall, V.-C., application to register A., as an old mark for pens, refused.

(*k*) *Rotherham's Tm.*, 11 C. D. 250; 14 C. D. 585; 49 L. J. Ch. 511 (1878), Bacon, V.-C., and C. A., (*Tod* in Arabic). Cf. *Gout* v. *Aleploglu*, 6 Beav. 69 n. (1833), (*l'essendede* (*i.e.*) *warranted* in Turkish).

(*l*) *Hanson's Tm.*, 37 C. D. 112; 5 R. P. C. 130 (1887), Kay, J., (*red, white, and blue* label).

(*m*) Sect. 67, below, p. 194, and *Société Anonyme's Tm.*, (1894) 1 Ch. 61, and 2 Ch. 26; 10 R. P. C. 436, and 11 R. P. C. 142, Stirling, J., and C. A., where a trade-mark having been registered for a star, it was held that the mark *Red Star Brand*, subsequently registered for the same goods, ought to be removed as being too near the other.

(*n*) *Rowland* v. *Michell*, (1897) 1 Ch. 71; 13 R. P. C. 457; 14 R. P. C. 37, Romer, J., and C. A.

(*o*) 26 C. D. 409; 53 L. J. Ch. 664, Chitty, J., and on appeal, 54 L. J. Ch. 1084 (1885); see *Liebig, &c. Co.* v. *Anderson*, 55 L. T. 206, Chitty, J.

(*p*) So held in *Liebig's Extract of Meat Co.* v. *Hanbury*, 17 L. T. N. S. 298 (1867).

(*q*) Basing his finding on the judgment of the Court of Appeal, and particularly of Cotton, L. J., in an action of *Liebig's Extract of Meat Co., Ld.* v. *Anderson*, 55 L. T. 206.

was the inventor, or to show in the particular case that the article was made according to his invention. But it would appear that having regard to *Rowland* v. *Michell* (*r*), if such a practice is relied on to show that a portrait is not distinctive, it must be proved to exist in the particular trade. Registration of a portrait as a trade-mark would only confer on the proprietor the right to stop the use of another portrait as being an infringement, if there was not a substantial difference between the two portraits (*s*).

Part of mark common to the trade.

The question whether something included in the registration is matter added to the essential particulars or to the mark, or is, on the other hand, part of the mark, is a very important one having regard to the existing provisions as to disclaimer. The subject will be found discussed at a later stage (*t*), but it may be noticed here that there is no express provision in the Acts for disclaimer, except disclaimers of certain added matter and of certain additions. In *Baker* v. *Rawson* (*u*), where a lighthouse, surrounded by two concentric circles, with initials and a date between them, had been registered in 1877 as a new mark, although the circles were in fact common to the trade, an application was made to remove the mark from the Register. North, J., held that the circles ought not to have been registered, but as the whole mark had been used for a number of years, instead of ordering its removal, he directed a note, stating that the circles were common to the trade, to be put upon the Register. It will be noticed that the mark had been registered under the Act of 1875, which contained no provision for disclaimer at all, but under which registration with disclaimer had been approved (*v*). Common matter can now be registered as an addition to a registered mark, under sect. 74, with a disclaimer of the exclusive right to use it, if the whole mark was used as a trade-mark before 13th August, 1875. In the case of marks not so used, additions expressly authorized are

(*r*) See judgment of Lindley, L. J., (1897) 1 Ch. 74; 14 R. P. C. 44.

(*s*) See note (*n*), *ante*, p. 142.

(*t*) Chap. IX., p. 197.

(*u*) 45 C. D. p. 533; 8 R. P. C. 89 (1890); see also *Kuhn's Tm.*, 53 L. J. Ch. 238 n. (1878), Jessel, M. R., where registration with a disclaimer was approved under the Act of 1875. See now sect. 74, Chap. IX., p. 204.

(*v*) By Jessel, M. R., in *Kuhn's Tm.*, 53 L. J. Ch. 238 n. (1878).

confined to words and combinations of words (*x*). The question what are additions within this section has recently been considered by Kekewich, J., and the Court of Appeal in *Clement et Cie.'s Trade-Mark* (*y*).

Furthermore, under sect. 64 as amended by the Act of 1888, to one or more essential particulars, any letters, words, or figures, or combination of letters, words, or figures, or of any of them, may be added subject to disclaimer (*z*).

Combination device.

A combination of devices which are common to the trade may form a new and distinctive device (*a*). The test by which any such combination must be tried is, it is submitted, correctly stated in the following passage from the report of Lord Herschell's Committee (*b*). The Committee say: "In this connection we may refer to a point which has been the subject of considerable controversy, namely, how far registered or common marks when combined together are to be regarded as a new mark. We think that the juxtaposition of two or more such marks is not, if there be nothing more than this, a combination constituting a new mark. An important test appears to be whether the existing marks are so combined as to suggest a new idea. For instance, assuming a cat and a fiddle to be each an old mark, we do not think that the mere representation of a cat and a fiddle together would be a new mark, but the representation of a cat playing upon a fiddle, the idea conveyed by which would be neither the cat nor the fiddle, but a cat playing upon a fiddle, would be a good combination, and might properly be registered. We think that this view differs somewhat from that which has been at times, at all events, entertained by the Board of Trade, but it appears to us to be the sound one."

(*x*) Chap. IX., p. 206, Additions and Disclaimers.

(*y*) (1900) 1 Ch. 114; 16 R. P. C. 173 and 611; see below, p. 201.

(*z*) See *Clement et Cie.'s Tm.*, *supra*, and Chap. IX., p. 198.

(*a*) The mark must be looked on as a whole: see Chap. X., p. 230, and below, p. 152, "Label," and, for an instance, where a number of common and some distinctive elements combined together did not form, as wholes, distinctive combinations: see *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Ca. 479; and Lord Cairns' judgment, p. 484 (quoted above, p. 122); 48 L. J. Ch. 707, 708 (1879); and see the order made, 4 App. Ca. p. 503.

(*b*) Report of 1888, p. ix. The passage follows that upon the "idea of a trade-mark," cited at p. 227.

Devices descriptive of the goods.

It has been held, in the case of word-marks, that descriptiveness is inconsistent with distinctiveness, and it would seem to follow generally, that marks which are descriptive of the goods to which they are to be applied are not within the Acts. In the opinion of Lord Herschell's Committee (*c*), such marks are not legitimate, and since the committee's report the Comptroller has refused to accept them. This opinion is in accordance with the judgment of Pearson, J., in *James' Case* (*d*), holding that a representation of the goods on which the mark was to be used was not a good mark. In that case the mark in question was a sketch of a cylinder with a dome top, which had been registered in 1861, as a design, and as a trade-mark in 1877. It was used as a trade-mark for black-lead, which was generally, but not exclusively, sold in blocks of the shape shown by the sketch, and upon which the words "registered shape" were stamped. The Court of Appeal reversed the decision of Pearson, J., but Cotton and Lindley, L. JJ., apparently differed from the learned judge in their view of the facts only. They held that the mark was not a mere representation of the goods, and they laid stress on the circumstance that it might be used, and it had occasionally been used, on blocks of shapes other than that shown by the sketch (*e*). Lindley, L. J., said: "I cannot see why, according to English law, a fish may not be a distinctive mark for a fishing-line, though I can understand that a picture of a fish may not be a distinctive mark of that particular kind of fish. Why a pig should not be, according to English law, a distinctive mark for lard, or something made out of a pig, I do not know. Supposing you tanned a pigskin into leather, I do not know why a pig should not be a good trade-mark for tanned pig's hide." Lopes, L. J., took the same view of the facts; but in the course of his judgment he asked: "Why is it (the mark) the less a distinctive device or mark because it represents the thing upon which it appears?" The sugges-

James' Case.

(*c*) Report of 1888, p. xii.

(*d*) 31 C. D. 340; 55 L. J. Ch. 915 (1885). It also accords with a number of American decisions: see Sebastian, 4th ed., p. 36. The Court of Appeal, however, thought that little assistance was to be obtained from the American cases; 33 C. D. 392; 3 R. P. C. 340.

(*e*) 33 C. D. 392; 3 R. P. C. 340. The appeal was heard *ex parte*, the respondents not appearing.

tion of this question is not only at variance with the opinion cited above, but also with the statement of Lindley, L. J., that a fish would not be a good trade-mark for fish of the same kind (*f*).

Devices comprising pictures of the goods.

But although descriptive devices, including mere representations of the goods upon which the mark is to be used, are objectionable, there seems to be no reason why pictures of the goods, worked up into a characteristic and uncommon design, should be refused. Thus a drawing of a mere ordinary coil of wire for wire, of a barrel for beer, a cricket-bat for cricketing materials, would be bad as trade-marks; but not a drawing of the wire woven up into a knot of new and striking design, or of several barrels or bats arranged in a particular and original manner (*g*).

Device representing name of goods.

In a case in which the word *Magnolia* had been registered as a trade-mark, and also a representation of a magnolia flower as another trade-mark, and the word at the time of its registration was the name of the alloy in respect of which it was registered, and that registration was therefore bad, it was held that nevertheless the registration of the flower was good (*h*).

It is somewhat difficult to define what degree of descriptiveness will make a mark objectionable, but the test is, it is submitted, to be found in the rule that, assuming the mark to be distinctive having regard to the marks already in use in the trade as already defined, it must not be such as to restrict the liberty of any trader to use any drawing, picture, or device, which he may fairly require to enable him to describe his goods to any class of his customers in the ordinary manner.

(*f*) See *The Sphincter Co.'s Tm.*, 10 R. P. C. 84 (1893), Kekewich, J.; and cf. *Ripley* v. *Bandey*, 14 R. P. C. 591 and 944 (1897), Kekewich, J., and C. A., where Kekewich, J., held the plaintiff to have established that *Oval Blue* meant his laundry blue, which was of an oval shape. In the Court of Appeal the case was settled.

(*g*) The question was discussed, but not decided, in *The Sphincter Co.'s Tm.*, 10 R. P. C. 84 (1893). The Comptroller refuses to accept for registration as trade-marks, pictorial representations of goods to which the marks are to be applied; see Appendix, p. 731.

(*h*) *Magnolia Metal Co.'s Tms.*, (1897) 2 Ch. 371; 14 R. P. C. 265, 621, Kekewich, J., and C. A.

The Comptroller refuses to register certain devices of a national character as trade-marks or prominent parts of new trade-marks (*i*).

Mark.

This word is sufficiently wide in its meaning, if it stood alone, to cover not only all the other symbols specified in the section, but any kind of mark whatever. The insertion of the other words must therefore be taken in some way to limit its meaning; but it is not easy to see what kind of symbol, not registrable under the other words of the clause, could be used as a trade-mark.

Brand.

This word was introduced by the Act of 1883, in consequence of the ruling of Jessel, M. R., that cigar marks burnt into the ends of the boxes could not be registered under the Act of 1875, and in order to allow such marks to be registered (*k*); but it has not been restricted in practice to marks burnt into the goods or their envelope. Thus, a number of word-marks were at one time accepted and registered in the tin-plate trade as brands, which would not have been accepted under any of the other heads (*l*), because the words were geographical words.

Brand.

Lord Herschell's Committee said, in their report (*m*): "Some controversy has arisen with reference to the meaning of the word *brand* as distinguished from the other words employed. There can be no doubt that the term derives its origin from the practice of producing some mark by means of burning, but it appears now to be in use in certain trades for the purpose of describing trade-marks no longer produced in this way, and differing in no respect from the labels and

(*i*) See Instructions 30, printed below in the Appendix, p. 728.

(*k*) See the evidence of the Comptroller before Lord Herschell's Committee, Q. 2993. The Comptroller stated that he did not see any reason for keeping up the distinction between brand and design or mark. Q. 3295.

(*l*) *Ibid.*, Q. 3294.

(*m*) Report of 1888, p. xi.

tickets mentioned in the section; nevertheless, a distinction has been made in the practice of the Office, and trade-marks have been allowed registration in certain trades as brands when they would not have been accepted in other classes as labels or tickets. We see no reason for this distinction. It does not appear to us to receive support from the language of the Act, and we think that, in future, brands should be dealt with in precisely the same way as labels or tickets."

Pirie v. *Goodall.*

This opinion corresponds with that expressed in the judgments delivered in *Pirie* v. *Goodall* (*n*). There the plaintiffs had, in 1885, registered the words *Pirie's Parchment Bank* for paper, disclaiming the exclusive use of both *parchment* and *bank*, which were words in common use in the trade. The defendants in an action for infringement moved to remove the mark from the Register, and the plaintiffs tried to support it (*inter alia*) as a brand. Vaughan Williams, J., held, that the word brand must be limited in some way; it could not include all words, whether, for instance, they were *fancy words* (*nn*) or not. "I think," he said, "that before you can register anything as a brand, there must be evidence that, in point of fact, it is as a brand, and as a brand only, that it is used." The use of the words as a watermark on paper was not, the learned judge thought, user as a brand; but, he added, "I see no reason why a brand should not be woven into the goods just as much as stamped on to them or burnt into them." He ordered the trade-mark in question to be removed from the Register. This decision was affirmed on appeal, and Lindley, L. J., who delivered the judgment of the Court, said he did not see why *mark* did not include *brand*, and he held that word-marks (*o*) could only be registered when they came within those parts of the section (64) which expressly relate to words, and consequently that they could not be registered as *brands* (*p*).

(*n*) (1892) 1 Ch. 35; 9 R. P. C. 17.

(*nn*) The mark had been registered under the Act of 1883.

(*o*) That is, marks consisting of a word or words, not headings, labels, or tickets, which comprise words.

(*p*) Cf. Lord Selborne's judgment in *Leonard & Ellis's Tm.*, 26 C. D. p. 295; and the judgments in *Holt's Tm.*, 13 R. P. C. 16 and 118; (1896) 1 Ch. 711, C. A., as to words that are also names.

In *Paine's Case* (*q*), the words *John Bull Brand*, registered in 1885 as a trade-mark for beer, were ordered to be removed. An attempt was made to support the mark as a brand, but Kekewich, J., pointed out that the mark claimed was the three words, not the first two, and that the addition of the last word did not make the whole a brand. Some question was raised in the cases cited above as to whether a brand-mark must not be registered as a brand, but there is no machinery for such registration, as no distinction is made between the different heads referred to in the section upon the Register.

The term *brand* was sometimes applied, before the Acts, to trade-marks branded on metal goods, or on wine casks, or corks (*r*), and its use to denote a class of some kinds of goods, as cigars, for instance, is very common; but these uses seem to have nothing to do with its meaning in the Act.

Heading.

The meaning of this term is not at all clear. The word is ordinarily used of a sentence or words placed at the top of a document either as a title or to describe the matter contained in it; and it has been held that the words *Family Salve*, printed thus, *Reinhardt's Celebrated Family Salve*, at the top of a wrapper used for patent medicine bottles, formed a distinctive heading (*s*). But it was held also, under the Act of 1875, which did not provide for the registration of words, that the single word *Valvoline* did not form a heading, on the ground that word-marks were specially provided for in the Act (*t*). If the first decision can be relied on, and if it

(*q*) W. N. (1892), p. 56; and 9 R. P. C. 130, Kekewich, J. The action in which the question arose is further reported: *Paine & Co.* v. *Daniells & Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 71, 217, Kekewich, J., and C. A.

(*r*) Sebastian, 4th ed. p. 33; *Millington* v. *Fox*, 3 My. & Cr. 338 (1838); *Seixo* v. *Provezende*, L. R. 1 Ch. 192 (1865).

(*s*) *Reinhardt* v. *Spalding*, 49 L. J. Ch. 57 (1879), Hall, V.-C. The mark had been registered in 1876 as an old mark. It would, under the later decisions, have been refused as descriptive, and also because it was not the whole mark used before the Act.

(*t*) *Leonard & Ellis's Tm.*, 26 C. D. p. 295 (1884), C. A.; see the judgment of Selborne, L. C.

indicates the whole significance of the word in the section, the operation of the section under this head is very limited, for documents attached to the goods or their envelope can themselves be registered as labels.

Line headings for cotton goods.

In the cotton trades a line heading means the pattern or marking woven at the end of a piece of cloth (*u*); and in *The Great Tower Street Tea Co.* v. *Smith* (*v*), North, J., said that this was what he understood by *heading* as used in this section. These line headings are of great importance in the Manchester trade, but are not registrable under the present Acts, since they are essentially colour-marks (*x*). A great deal of evidence as to the practicability of providing for their registration and protection was taken by Lord Herschell's Committee, and opposite opinions were expressed by the witnesses upon the subject. In the result, the Committee reported (*y*) that they were disposed to think the registration was not practicable, and that they did not recommend that it should be allowed.

Label.

A label consists of a number of words, or of a word or words combined with a device or devices, or of a device or devices alone, printed on paper or other substance, in order to be stuck upon or attached to the goods or their envelope.

A single word or several words, not registrable alone, and not forming any sentence, will not become registrable by being printed on a plain piece of paper. Thus North, J., said (*z*): "The plaintiffs would not be in any better position at all if they had put the words *Tower Tea* upon a piece of paper, otherwise blank, and fixed it on to their packages, than if they had, as they have done,

(*u*) *Harter* v. *Souvazoglu* (1875), W. N. 11, 101; *Carver* v. *Bowker*, Seb. Dig. p. 350 (1877); *Robinson* v. *Finlay*, 9 C. D. 487 (1877).

(*v*) 6 R. P. C. p. 168 (1889).

(*x*) See above, p. 142.

(*y*) Report of 1888, p. ix., because the headings are essentially colour-marks.

(*z*) *The Great Tower Street Tea Co.* v. *Smith*, 6 R. P. C. p. 170 (1889). Cf. Lord Selborne's judgment in *Leonard & Ellis's Tm.*, 26 C. D. 288 (1884). So a black label, bearing the descriptive word *Monobrut* in its centre, was removed from the Register in *Vignier's Tm.*, 6 R. P. C. 490; 61 L. T. 495 (1889), Kay, J.

impressed the words *Tower Tea* upon the packages themselves." And it would make no difference that the paper was surrounded by a conventional border, or was occupied by other indistinctive matter, not altogether forming a distinctive combination (*a*). Romer, L. J., in his judgment in *Re Clement et Cie.'s Trade-Mark* (*b*), in which the Court of Appeal decided that certain words formed part of a label and not additions to it, said: "I desire to say this, that this judgment will in no way, I think, give rise to any idea that it would sanction the registration of words which in themselves would not constitute a proper trade-mark, merely because some flourishes were put round them to try and make out a distinctive label—a compound label—when, in fact, what was really sought to be registered and intended to be registered were the words alone." Thus, the name of a firm printed in common letters on an ordinary label does not make a distinctive label (*c*).

Phrases and proverbs.

Lord Herschell's Committee reported (*d*) that "it is said that there is often a desire to register short phrases, such as proverbs, &c., and that owing to the difficulty of finding new marks, it is expedient that they should be allowed. We see," they added, "no objection to this, provided they be in no way descriptive of the character or quality of the goods, or of their place of origin, sale, or manufacture."

It is doubtful if such phrases are registrable under the present Acts. Possibly, since a mark in order to be registered has only to come within one of the essential particulars designated in sect. 64, which are to be treated as separate and distinct (*e*), such phrases, if distinctive, may be registered under sect. 64 (1) (e) as "words having no reference to the character or quality of the goods, and not being a geographical

(*a*) See above, p. 141.

(*b*) (1900) 1 Ch. 114; 16 R. P. C. 173, 611.

(*c*) *Price's Patent Candle Co.*, 27 C. D. p. 686 (1884), Pearson, J.; and *Bradley's Tm.*, 9 R. P. C. 205 (1892), Chitty, J., *Worth's Corsets*, between co-axial ovals. In *The Birmingham Vinegar Co.'s Tm.*, 11 R. P. C. 195; 70 L. T. 646 (1894), Kekewich, J., a label comprising a large H, some common words, and a small device, was held not to be, as a whole, a distinctive label.

(*d*) Report of 1888, p. xii.

(*e*) See the judgment of Lord Herschell, in *Eastman Photographic Materials Co.'s Application*, (1898) A. C. 571; 15 R. P. C. 476; and *supra*, p. 123.

name (*ee*)." If not registrable as such, it would seem to follow from the judgment of Romer, L. J., quoted above, that a label would not be capable of registration by reason only of the presence of such a phrase, but the phrase might, of course, contribute to make a label distinctive.

Ordinary arrangement of common parts.

An ordinary arrangement of parts which are in common use, each part remaining as a separate feature in the combination, does not form a distinctive label (*f*). So a label for match-boxes, bearing representations of a prize medal, with the words *Bryant & May's Royal Wax Vestas* printed in ordinary type, medals being common marks in the trade, was held not to be distinctive (*g*); and so also was a label bearing two co-axial ovals, with the words *Worth's Corsets* in ordinary type, and four dots arranged as a star at each end printed between them, ovals being common marks in the trade (*h*). In the last case, Chitty, J., held that the addition of the trade-name of the owner of the mark made it neither better nor worse, and he approved and followed *Price's Case* (*i*).

The Act permits the registration of a distinctive label, and it is, therefore, a sufficient qualification for a mark that it is such a label, but some difficulty arises when the question what is sufficient to render a label distinctive is considered. Ought the label to be looked at as a whole, or should it be analysed, in order to ascertain whether it contains one or more features which are in themselves distinctive? And, further, what must be the nature of such features? The decisions which have already been cited (*k*) are to the effect

(*ee*) *Uneeda* has been held equivalent to "you need a," and not so registrable: *National Biscuit Co.'s Application*, 18 R. P. C. 170 (1901), Cozens-Hardy, J.

(*f*) Cf. "combination of devices," above, p. 144, and the passage from the report there cited; also *Jamieson* v. *Jamieson*, 15 R. P. C. 169 (1898), Byrne, J., and C. A., a passing-off case, in which the Court of Appeal reversed the judgment of Byrne, J., for the plaintiff, on the ground that the similarity of the get-up of the defendant's goods to that of the plaintiff's was solely due to features common to the trade.

(*g*) *Bryant & May's Tm.*, 8 R. P. C. 69; 59 L. J. Ch. 763 (1890), North, J.

(*h*) *Bradley's Tm.*, 9 R. P. C. 205 (1892), Chitty, J.

(*i*) 27 C. D. 686; cited p. 151.

(*k*) *Orr-Ewing* v. *Registrar of Tms.*, 4 App. Ca. 479; *Price's Patent Candle Co.'s Case*, 27 C. D. 681; *Birmingham Vinegar Brewery Co.'s Application*, 11

that the label must be examined, and that to qualify for registration some separately distinctive feature must be found in it. Some of the decisions (*kk*) seem to go further, however, and to lay down the rule that such a distinctive feature must itself be an "essential particular" (other than a label) within the meaning of the Act. It is submitted, however, that this is not the true view and is contrary to the general rule of construction of the Act laid down by the House of Lords in the *Solio Case* (*l*), and that it is sufficient if there be found some distinctive feature or features in the label, which operate to make it, as a whole, distinctive. The Court of Appeal has not been called on to give a direct decision on the point, but it has on several occasions determined that a label must be looked at as a whole (*m*), and the question seems to be open, so far as that Court is concerned, unless the judgment of Lord Cairns in the *Orr-Ewing Case* (*n*) is, in this respect, binding, and is held to decide the point (*o*).

No disclaimer of parts of label.

No disclaimer of any part of a distinctive label is required by the Acts, for the whole label is an essential particular (*p*). Under sect. 64 (2), as amended by the Act of 1888, certain additions to the essential particulars in a mark may be registered, subject to a disclaimer of the exclusive use of the added matter; but, since a distinctive label is itself an essen-

R. P. C. 195; *Wright, Crossley & Co.'s Application*, (1900) 2 Ch. 218; 17 R. P. C. 386. See the quotations given above, p. 122.

(*kk*) See the cases in *note* (*k*), other than *Price's Case*. Chitty, J., in *Bradley's Tm.*, *note* (*h*), expressly distinguished the case of a combination distinctive as a whole.

(*l*) *Eastman Photographic Materials Co.'s Application*, (1898) A. C. 571; 15 R. P. C. 476; see *supra*, p. 123.

(*m*) *Apollinaris Co.'s Tms.*, (1891) 2 Ch. 186; 8 R. P. C. 137; *Pinto* v. *Badman*, 8 R. P. C. 181; and *Clement et Cie.'s Tm.*, (1900) 1 Ch. 114; 16 R. P. C. 173 and 611; of these, two were decisions on disclaimers and the third—*Pinto* v. *Badman*—on novelty.

(*n*) The passage is cited *supra*, p. 122.

(*o*) The actual decision was that the Registrar should proceed with the application to register the distinctive device on the labels, with the name and address of the Appellant's firm. It being found that the marks contained devices which were *primâ facie* distinctive. The case was under the Act of 1875.

(*p*) *Apollinaris Co.'s Tms.*, (1891) 2 Ch. 186; 8 R. P. C. 137; *Smokeless Powder Co.'s Tm.*, (1892) 1 Ch. 109; 9 R. P. C. 109; *Clement et Cie.'s Tm.*, (1900) 1 Ch. 114; 16 R. P. C. 173 611; and see *Pinto* v. *Badman*, 8 R. P. C. 181.

tial particular, that sub-section does not apply to anything forming part of the label (*q*).

Moreover, common words, that is, words which any one is at liberty to use, which appear in a label, need not be disclaimed under sect. 74, for that section applies only to additions to the trade-mark, and the whole label is itself the trade-mark (*t*). So, in *The Apollinaris Case*, it was held, by the Court of Appeal, that the name *Friedrichshall* occurring on a label need not be disclaimed (*u*), and this was followed by Chitty, J., in the case of the *Smokeless Powder Co.*'s trade-marks, where he refused to order the words *Smokeless Powder* to be disclaimed on the application of rival makers of similar powder (*x*). A dictum of Cotton, L. J., in an earlier case (*y*), decided under the Act of 1875, that such words ought to be disclaimed, was cited in the last-mentioned case; but Chitty, J., declined to follow it. The decision of Stirling, J., in *Edge's Case* (*z*), that the words *Filtered Blue*, which he held to be bad as a separate trade-mark, must be disclaimed when registered on a label, is also in conflict with the rule

(*q*) It is submitted that this statement of the law is in accordance with and follows from the decision of the Court of Appeal in *Clement et Cie.'s Tm.*, *supra*, note (*p*). In that case the label was registered under the Act of 1883, but the amendment of sect. 64 by the Act of 1888 does not appear to affect the decision so far as it has a bearing on that section. But in *Birmingham Vinegar Brewery Co.'s Application*, 11 R. P. C. 193; 70 L. T. 646 (1895), Kekewich, J., affirmed the Comptroller's decision requiring an applicant to state that, not his label, but a device contained in it, was the essential particular of the mark, and to disclaim the exclusive use of the other matter. And in *Wright, Crossley & Co.'s Application*, (1900) 2 Ch. 218; 17 R. P. C. 386, Byrne, J., held that there ought to have been in the application a statement of the essential particular and a disclaimer of added matter. He did not decide what form the statement and disclaimer should have taken.

(*t*) *Pinto* v. *Badman*, 8 R. P. C. pp. 188, 191 (1891), and *Clement et Cie.'s Tm.*, (1900) 1 Ch. 114; 16 R. P. C. 173, 611. As to the registration of common marks as added matter or additions, see above, p. 117, and Chap. IX., p. 205.

(*u*) (1891) 2 Ch. p. 233; 8 R. P. C. 137; see also *Atkins' Tm.*, 3 R. P. C. 164 (1886), Bacon, V.-C., C. A.; and *Paine & Co.* v. *Daniells & Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 71, 217, Kekewich, J., and C. A.

(*x*) (1892) 1 Ch. 590; 9 R. P. C. 109. See also *Faulder's Tm.*, 18 R. P. C. 37, (1901) Kekewich, J. (*Silverpan*).

(*y*) *Hudson's Tm.*, 32 C. D. 311; 3 R. P. C. 155 (1886), C. A.

(*z*) 8 R. P. C. 207 (1891).

stated above. None of the above-mentioned cases were, however, cited in *Edge's Case*, and it was not cited in the *Smokeless Powder Case*. *Burland* v. *Broxburn Oil Co.* (*a*), where, however, the point does not appear to have been argued, and *Thompson* v. *Miller* (*b*), are also in conflict with the rule. The point came before the Court of Appeal again in *Clement et Cie.'s Trade-Mark* (*c*), where the Court refused to order a disclaimer of the words *St. Raphael*, on the ground that the words formed part of and were not an addition to the mark (*d*). A distinctive label may accordingly be properly registered, although it contains words or names to the exclusive use of which no claim could be maintained (*e*).

Similar common words in another registered label is no objection to registration.

The presence of common words in a registered label does not prevent any trader registering a different label with the same or similar words. Thus *Valvoleum* printed across a label with a particular device was allowed, although *Valvoline* was already registered upon a label with a different device (*f*), Jessel, M. R., holding that each word was merely equivalent to *valve oil*.

Blanks in registered labels.

It is a common practice to register labels with blank spaces which in use are filled up by matter which is either not capable of registration, or which for some other reason it is not convenient to register, because, for example, it is changed from time to time (*g*). The practice is unobjectionable, and the use of the added matter, which forms, of course, no part of the trade-mark protected by registration, does not interfere with the protection of the label as registered (*g*). But in

(*a*) 6 R. P. C. 482; 41 Ch. D. 542 (1889), Chitty, J. (*Washerine*).

(*b*) 13 R. P. C. 35 (1896), Stirling, J. (*Roadster*).

(*c*) *Ubi supra*.

(*d*) Cf. also *Wright, Crossley & Co.'s Application*, *note* (*k*), above.

(*e*) *Hudson's Tm.*, *Atkins' Tm.*, and *Paine & Co.* v. *Daniells & Sons' Breweries*, *supra*.

(*f*) *Re Horsburgh & Co.'s Application*, 53 L. J. Ch. 237 (1878); see *Leonard & Ellis' Tm.*, 26 C. D. 288 (1884), C. A.; *Loftus' Tm.*, (1894) 1 Ch. 193; 11 R. P. C. 29; North, J. (*unco' guid whisky*).

(*g*) *Hammond* v. *Malcolm Brunker & Co.*, 9 R. P. C. 301 (1892); *Melachrino & Co.* v. *Melachrino Egyptian Cigarette Co*, 4 R. P. C. 215 (1887), both Chitty, J.; and see Chap. X., p. 236. A possible difficulty might arise if the whole mark, as filled up, were described upon the goods as a "registered trade-mark." See "misrepresentation" below, pp. 407 *et seq.*

considering whether a mark is a proper mark to register, regard must be had to the appearance it will present in actual use (*h*).

Ticket.

The only difference between a label and a ticket seems to be that a label is attached by sticking it on to the goods or their envelope, and a ticket by tying (*i*).

Word-Marks.

Words as trade-marks.

Words are highly valued as trade-marks, since when well chosen they combine the necessary quality of distinctiveness with convenience for being remembered and referred to, which is only equalled by such simple devices as, from their resemblance to common objects or to familiar geometrical figures, at once suggest appropriate names; and, while in many of the classes all, or almost all, the suitable devices are either already appropriated or have ceased to be distinctive, the number of new words which may be invented is practically unlimited.

Word-marks were common enough before the Registration Acts, and provision has been made in all of these for the registration of any special and distinctive word or words used as trade-marks before the 13th of August, 1875, the date on which the Act of 1875 came into operation, and also, under sections already considered, for the registration of the name of an individual or firm printed, &c., in some particular and distinctive manner, and of a written signature or copy of a written signature. Except such old marks, names, and signatures, no other word-marks could be registered under the Act of 1875 (*k*). This was altered by the Act of 1883,

(*h*) *Christiansen's Tm.*, 3 R. P. C. 54; 2 T. L. R. 31 (1886), C. A., the *Tændstikker Match Case*. And see Chap. X., p. 234.

(*i*) The words are used alternatively in *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Ca. 479; and *Great Tower Tea Co.* v. *Smith*, 6 R. P. C. 165.

(*k*) *Exp. Stephens*, 3 C. D. 659 (1876), Jessel, M. R., (*Acilyton*); *Rose* v. *Evans*, 48 L. J. Ch. 618 (1879), Hall, V.-C., (*Limetta*); see per Lindley, L. J., in *Van Duzer's Tm.*, 34 C. D. 623; 4 R. P. C. 31 (1887).

which allowed the registration of "a fancy word or words not in common use." The expression "fancy word," however, gave rise to considerable differences of opinion as to its meaning, and after the report of Lord Herschell's Committee it was struck out of clause (c), and the two new clauses (d) and (e) were substituted for it. Those clauses allow the registration of: (d) "an invented word or invented words"; and (e) a "word or words having no reference to the character or quality of the goods, and not being a geographical name."

The report of Lord Herschell's Committee on word-marks.

The portion of the report above referred to, which relates to this subject, was as follows (*l*):—"It will be convenient to consider first what words ought to be allowed as trade-marks. There can be no objection to permitting the registration of an invented word not to be found in the vocabulary of our own or any other country. It seems, further, that existing words may with advantage be permitted as trade-marks, subject to limitations which at once suggest themselves. It is manifest that no one ought to be granted the exclusive use of a word descriptive of the quality or character of any goods. Such words of description are the property of all mankind, and it would not be right to allow any individual to monopolise them and exclude others from their use. Again, geographical words, which can be regarded as descriptive of the place of manufacture or sale of the goods, are open to obvious objections. One manufacturer or merchant cannot properly be allowed to prevent all his competitors from attaching to their goods the name of the place of their manufacture or sale. The mischief would not be the same where the person seeking to register was the first person who had manufactured or sold the goods in the place the name of which he seeks to appropriate as a trade-mark. But there are objections to giving a monopoly even in that case, and to attempt to draw any such distinction would be likely to

Geographical names.

(*l*) Report of 1888, p. xi. On a question of construction of the Act of 1888, it is permissible to refer to this report in order to ascertain the evils which the Act was directed to remedy, per Lord Halsbury, L. C., in *Eastman Photographic Materials Co.'s Application*, (1898) A. C. 571; 15 R. P. C. 476. The passage given in the text was from the words "It is manifest," quoted by Lord Halsbury.

lead to difficulty and litigation (*m*). We think, therefore, that geographical names ought only to be permitted where they clearly could not be regarded as indicative of the place of manufacture or sale. We would add upon this point that we think that where any English word would be rejected as not entitled to registration, no person ought to be permitted to register its translation into any other language. The question has been raised whether a word having the same sound as one entered on the Register, though spelt differently and with a different meaning, should be registered. The question in such a case would seem to be whether the resemblance between the old mark and that applied for was such as to be calculated to deceive; if it were, it ought, of course, to be rejected."

Translated words.

Phonetic equivalents.

A Fancy Word or Words not in common use (*n*).

As already stated, the meaning of these expressions gave rise to considerable differences of opinion, and, since the marks registered under the Act of 1883 are still governed by that Act (*o*), it is necessary to consider the cases. Before the date of the amending Act a definition of *fancy word* had been laid down by the Court of Appeal which seemed to be fairly clear and precise.

Fancy words.

In *Lloyd & Sons' Trade-Mark* (*p*), Chitty, J., in the year 1893, summed up the result of the decisions to that time in the following passage: "To be a fancy word, the word must be obviously meaningless as applied to the article in question. On that principle the Court has held that the term *Gem* (*q*), with reference to a gun, is not a registrable fancy word; with reference to hair restorer, that the word *Melrose* (*r*) is

(*m*) See Chap. II. p. 47.

(*n*) A fancy word was a good trade-mark before the Acts. "The more ridiculous it is, the better it is"; Wood, V.-C., in *Young* v. *Macrae*, 9 Jur. N.S. 322 (1862).

(*o*) *Meyerstein's Tm.*, 43 C. D. 604; 7 R. P. C. 114 (1890), Kay, J., (*Satinine*); *Paine's Tm.*, 9 R. P. C. 134 (1892), Kekewich, J., and *Re Tm. Bovril*, (1896) 2 Ch. 600; 13 R. P. C. 382, Kekewich, J., and C. A.

(*p*) 10 R. P. C. 281 (1893), *Carnival* not a fancy word.

(*q*) *Re Arbenz's Application*, 35 C. D. 248; 4 R. P. C. 143 (1887), Kay, J., and C. A.

(*r*) *Van Duzer's Tm.* and *Leaf's Tm.*, *infra*.

not a fancy word; with reference to velveteen, that the word *Electric* (*s*) is not a fancy word; and with reference to lace, the opinion of Lord Justice Cotton appears to have been that the term *Alpine* (*t*) was not a fancy word. These are some of the numerous illustrations that may be given of what may be thought by some to be the severe and strict construction which the Courts put upon the 64th section. There is another case, which I may also usefully mention, which is the case of *Jubilee* with reference to note paper." The last-mentioned word was also held not to be a fancy word (*u*). The severity of construction, of which Chitty, J., spoke, has, however, been somewhat relaxed by later decisions of the Court of Appeal, referred to below, which appear to have the effect of confining the rules laid down by the earlier decisions of the Court to words which were either ordinary English words, or very slight modifications of such words (*v*), fancifully applied, or, perhaps it would be more correct to say, to words other than newly coined words.

Van Duzer's Case.

The leading cases are the consolidated appeals of *Van Duzer's Trade-Mark* and *Leaf & Son's Trade-Mark* (*x*), and the appeal in *Re Trade-Mark Bovril* (*y*), all in the Court of Appeal. The first case arose out of an application to register the words *Melrose Favorite Hair Restorer*, which had been adopted by the applicants in 1880, and which were identified by reputation with their goods, and with theirs alone. A label containing them had been already registered by the applicants. It was argued that, although *Melrose* happened to be the name of a place, it was registrable because of its secondary meaning, indicating the applicants' goods (*z*); that it was sufficient if the words were not "in common use" in connection with the goods in question; and that an earlier decision of Chitty, J., in *The Alpine Case* (*a*), holding that a

(*s*) *Van Duzer's Tm.* and *Leaf's Tm.*, *infra*.

(*t*) 34 C. D. p. 639.

(*u*) *Tourgood Bros.* v. *Pirie & Sons*, 4 R. P. C. 67; 56 L. T. 394 (1887), Chitty, J.

(*v*) As *Reversi*, see below.

(*x*) 34 C. D. 623; 4 R. P. C. 31 (1887), Cotton, Lindley and Lopes, L. JJ.

(*y*) (1896) 2 Ch. 600; 13 R. P. C. 382, Lindley, Lopes and Rigby, L. JJ.

(*z*) This was sufficient to make the words a trade-mark under the law before the Acts. See Chap. II., pp. 36 *et seq*.

(*a*) 29 C. D. 877 (1885). The right

word was a *fancy word* if it were fancifully used, was right. The Court of Appeal did not assent to any of these arguments.

The fancy word must be obviously meaningless.

To be a *fancy word*, Cotton, L. J., held, a word must be one "which obviously cannot have reference to any description or designation of where the article is made, or of what character it is." So that it is not enough that it should be shown by evidence that it, in fact, has no such reference, and the incorrect or inappropriate user of a word which is descriptive does not make it a fancy word. Lindley, L.J., said: "To be a fancy word I think the word must either have, to ordinary English people, to whom this Act of Parliament is addressed, no meaning, like the word *Eureka* or the word *Acilyton*, or if it has any meaning at all, it must be obviously non-descriptive (*b*) when used as a trade-mark"; and Lopes, L. J. (*c*), laid down the following conditions as necessary in order that a word should come within the term:—It must be obviously meaningless as applied to the article in question; it must be fanciful in its application to the article to which it is applied, in the sense of being so obviously and notoriously inappropriate as to be neither deceptive nor descriptive, nor calculated to suggest deception or description; and, further, it must have "an innate and inherent character of fancifulness, which must not depend on evidence, and cannot be supported by evidence, to show that, in fact, it is neither deceptive nor descriptive, or calculated to be deceptive or descriptive." It must speak for itself.

In *Leaf & Son's Case* the Court, applying these criteria, held that *Electric* for velveteens was not a fancy word.

The definitions given in these judgments have been cited and were followed in many subsequent cases turning upon the meaning of the expression. Thus, in *Waterman* v. *Ayres* (*d*), the Court of Appeal held, that *Reversi* was not a fancy word for a game. Ordinary Englishmen, Cotton, L. J., said, would

of appeal in this case was lost by a slip as to time.

(*b*) 34 C. D., p. 642; "non-descriptive" was substituted for "meaningless" after a suggestion by Cotton, L. J., of "obviously not intended to be descriptive," p. 645. See also *Meaby & Co., Ld.* v. *Triticine, Ld.*, 15 R. P. C. 1 (1898), North, J.

(*c*) Page 644.

(*d*) 39 C. D. 29; 5 R. P. C. 368 (1888).

consider it was in some way connected with reversing, and Fry, L. J., said that, by its likeness to *reverse*, it was calculated and intended to convey to the minds of persons who read it a notion of the character of the game, and it was, therefore, not a fancy word (*e*).

Whilst, however, there has not been, and could not have been except in the House of Lords, any dissent expressed from the definitions laid down in *Van Duzer's* and *Leaf & Son's Cases* (*f*), a limitation appears to have been drawn in the application of those definitions. In *Densham's Trade-Mark* (*g*), the Court was asked to expunge from the Register the word *Mazawattee* which had been registered in 1887 for tea, and subsequently for other articles, on the ground that the word was not a fancy word not in common use. It appeared that the word had been obtained by joining the Hindoo word *Mazadhar*, meaning luscious, to the Cingalese word *Wattee*, meaning garden or growth, and dropping out the syllable "*dhar*." It was contended that the word was descriptive, but the Court of Appeal, affirming Romer, J., held that it was clearly not descriptive, and was a fancy word. Lopes, L. J., whilst adhering to the previous definition of a "fancy word," expressed the opinion that the cases had gone far enough.

The Bovril Case.

In *The Bovril Case* (*h*), which also came before the Courts on a motion to expunge, the word *Bovril* had been on the Register for nine years in Class 42 for substances used as food. The word was new when registered, and had since been applied to meat extract and to other articles of food. Kekewich, J., refused the motion, and the applicants appealed.

(*e*) See also *Edge's Tm.*, 8 R. P. C. 207 (1891), (*Filtered Blue*); and *Hodgson* v. *Sinclair*, 9 R. P. C. 22; 8 T. L. R. 45 (1891), *Britannia*, for soap.

(*f*) See the judgment of North, J., in *Meaby & Co., Ld.* v. *Triticine, Ld.*, 15 R. P. C. 1 (1898).

(*g*) (1895) 2 Ch. 176; 12 R. P. C. 76 and 271, Romer, J., and C. A. (Lindley, Lopes and Kay, L. JJ.).

(*h*) *Re Tm. Bovril*, (1896) 2 Ch. 600; 13 R. P. C. 382, Kekewich, J., and Lindley, Lopes and Rigby, L. JJ. The word is an obvious derivation from *Bos* and *Virilis*. Bovine and virility are ordinary English words. The word "vril" is found in Lord Lytton's novel "The Coming Race." It is curious that the Court which rejected *Somatose* (see below, p. 179), should have accepted *Bovril*.

The decisions of the Court of Appeal in *Van Duzer's* and *Leaf's Cases* were cited, and it was contended that *Bovril* was not obviously non-descriptive. All the members of the Court (Lindley, Lopes and Rigby, L. JJ.) pointed out that in the cases relied on by the applicant, ordinary English words and not coined words were under consideration; they also all held that as a fact *Bovril* was not descriptive. Lindley, L. J., after saying that it would be wrong to substitute for the word "fancy word" "a non-descriptive word," but that they must ask themselves fairly whether *Bovril* was a non-descriptive word, said: "I think it is eminently and purely a question of fact. Now, I ask myself this: Supposing that a jury were asked whether, on the 2nd of November, 1886, *Bovril* was a fancy word not in common use, and supposing they said, upon a direction from the judge, which I think it would be the duty of the judge to give, that, if they were of opinion that it was really a descriptive word, it would not do, could they, with that direction, screw themselves up to say that it was not a fancy word not in common use? I do not think they could. That really settles the matter." Lopes, L. J., also said: "I say to myself, What would an intelligent jury say if they were asked if *Bovril* was a fancy word? If I had had to try the case I should have told them that they must keep in their minds that this word was placed upon the Register in 1886, and that they must regard it as it stood at that time. I should have told them that to be a good fancy word it must be non-descriptive and meaningless as applied to the article to which it was intended to be applied; and if I had so told them, I do not hesitate to say that I am confident that they would have come to the conclusion that the word was not descriptive, and that it was a good fancy word." It will be observed that, whilst the Court accepted the conditions previously laid down by it as applicable to an ordinary English word, it stated them somewhat less rigorously in the case of a newly coined word. However, in *Meaby & Co., Ld.* v. *Triticine, Ld.* (*i*), North, J., held that the principle to be

(*i*) 15 R. P. C. 1 (1898).

applied in the case of the word *Triticumina*, registered in Class 42, in respect of leaven and wheatmeal biscuits, &c., and derived from *triticum* (*j*), was that laid down in *Van Duzer's Case*, and that the word was not "obviously not intended to be descriptive," and he accordingly ordered it to be expunged. It is difficult to reconcile this decision with that in *The Borril Case*.

A list of words which have been held not to be "fancy words not in common use" is given on a later page (*k*).

The decisions are only restrictive.

The propositions laid down by the Court of Appeal in the cases cited do not amount to definitions from which tests to show affirmatively that any particular word is within the meaning of the Act can be drawn. They are negative propositions only. "To say that every word is a fancy word because it is unknown to an average Englishman, would be plainly to lay down a proposition which could not be for a moment maintained, (for) there are many good English words descriptive of articles which are unknown to an average Englishman, taking a rather high standard" (*l*).

Descriptive words.

It follows that a word descriptive of, or suggesting a description of the origin, qualities, or uses of the goods, is not a fancy word (*m*). The word *Gem*, therefore, having come into use to indicate excellence in the article to which it is applied, is not a fancy word (*n*). And on an application to register it as a trade-mark for air-guns, it was a further fatal objection that it had, by user, become descriptive of a particular class and make of gun (*n*).

Words in a foreign language.

The Acts are directed to ordinary Englishmen (*o*), and the

(*j*) Wheat.

(*k*) Page 170, below.

(*l*) Per Chitty, J., in *Davis* v. *Stribolt*, 6 R. P. C. p. 211; 59 L. T. 854 (1888), *Bökol*, the name of a Norwegian beer, rejected as a trade-mark for the beer.

(*m*) "Descriptive" does not necessarily mean accurately so, but descriptive for practical and popular purposes, per Rigby, L. J., in *Reddaway* v. *Banham*, (1895) 1 Q. B. 207; 12 R. P. C. at p. 91.

(*n*) *Arbenz's Tm.*, 35 C. D. 248; 4 R. P. C. 143 (1887). So held by the C. A., reversing Kay, J., whose judgment was delivered before that of the C. A. in *Van Duzer's Case*. *Reversi*, *Satinine*, *Carnival*, *John Bull*, *Roadster*, and *Beatrice* are other instances, below, p. 170.

(*o*) See the judgments of Lindley, L. J., in *Van Duzer's Case*, and Cotton, L. J., in *Waterman* v. *Ayres*, *supra*, and of Lindley, Lopes, and Rigby, L. JJ., in *Tm. Borril*, *supra*,

question whether the words put forward are obviously meaningless and non-descriptive in regard to the goods for which the mark is to be used, is to be tried, therefore, in the light of such information as ordinary Englishmen may be supposed to possess. It has, nevertheless, been held that *Monobrut*, which is a compound of *brut*, meaning "dry" as opposed to "sweet" in the French wine trade, and which in itself means "very dry," is descriptive, and therefore not a fancy word (*p*). As already stated, *Triticumina*, for wheaten food, was held by North, J., to be "obviously descriptive" having regard to its derivation from *triticum*, wheat, and to its use in advertisements (*q*).

Name of the goods in foreign language.

The name of the goods is not a good trade-mark apart from any objection under the Acts (*r*), and it cannot, of course, be registered under them (*s*). So that the introducers of a kind of beer, which was common in Sweden and Norway, were not allowed to retain on the Register the names by which it was ordinarily known in those countries, and under which it had been sold in England (*t*). "For the sake of caution limiting my proposition to the European languages," Chitty, J., said, "I am of opinion that, in reference to an article produced in a foreign country and imported into England where it was previously unknown and without a name, the word used in that foreign country as the common term to describe or

and of Kekewich, J., and Rigby, L. J., in *Magnolia Metal Co.'s Tms.*, (1897) 2 Ch. 371; 14 R. P. C. 265 and 621; *Lloyd & Sons' Tm.*, 10 R. P. C. 281 (1893), (*Carnival*); and *Burgoyne's Tm.*, 6 R. P. C. 227; 61 L. T. 39, *Oomoo*, cited below. Cf. the Report of Lord Herschell's Committee, cited *ante*, p. 157.

(*p*) *Vignier's Tm.*, 6 R. P. C. 490; 61 L. T. 495 (1889), Kay, J. Cf. *Jackson Co.'s Tm.*, 6 R. P. C. 80 (1888), where Kay, J., rejected the Chippeway Indian word *Kokoko* because it meant *Owl*, which was a common mark; but Romer, J., doubted whether he should have come to the conclusion that the word was descriptive, see *Densham's Tm.*, (1895) 2 Ch. 176; 12 R. P. C. at p. 82; and *Davis & Co.* v. *Stribolt & Co.*, *infra*.

(*q*) *Meaby & Co., Ld.* v. *Triticine, Ld.*, 15 R. P. C. 1 (1898), North, J.

(*r*) See Chap. II., pp. 34 *et seq.*, and the judgment of Chitty, J., in *Barlow* v. *Johnson*, 7 R. P. C. 395 (1890).

(*s*) Per Fry, J., in *Waterman* v. *Ayres*, *supra*, p. 160, note (*d*).

(*t*) *Davis & Co.* v. *Stribolt & Co.*, 6. R. P. C. 207; 59 L. T. 854 (1888), Chitty, J., (*Bökol* and the Swedish form of that word).

denote the article is not a fancy word within the meaning of the Act."

And it is clear that a word which, though not English, carries a well-understood descriptive meaning (*u*), such as *Sanitas* (*x*) or *Britannia* (*y*), is not a "fancy word."

This rule does not, however, extend to exclude words taken from a barbarous language. So that the word *Oomoo*, which was said to mean "choice" or "select" among some of the Aborigines of Australia, was held by Chitty, J., to be a fancy word notwithstanding. "If it does mean choice," the judge said, "or if it ever meant choice in the Aboriginal language of Australia, it does not mean choice to an ordinary Englishman, or to a sufficient number of Englishmen in this country, to enable me to say it has a meaning" (*z*).

Names of common marks.

The name suggested by a mark which is common to the trade is not a fancy word, and this rule was held to apply where the word was the name in the unwritten language of an uncivilized tribe, the Chippeway Indians, to whom the trade in the goods in question was not shown to have extended (*a*). It is, however, difficult to reconcile this with the rule already referred to, that the Acts are directed to ordinary Englishmen, or to reconcile with it the case last stated, which was decided a few months later.

Secondary distinctive meaning does not constitute a fancy word.

In *The Singer Cases*, and other cases of word-marks before the Acts, the contest was whether the name was that of the article merely, or whether it had acquired a secondary meaning identifying the article with the owners of the marks (*b*); but under the Acts such secondary meaning, so far as regards the right to registration (*c*), is

(*u*) Lord Herschell's Committee reported that, in their opinion, "where any English word would be rejected as not entitled to registration, no person ought to be permitted to register its translation into any other language." See the whole passage cited above, p. 157.

(*x*) *Sanitas Co.'s Tm.*, 4 R. P. C. 533; 58 L. T. 166 (1887), Kay, J.

(*y*) *Hodgson* v. *Sinclair*, 9 R. P. C. 22 (1891), Chitty, J.

(*z*) *Burgoyne's Tm.*, 6 R. P. C. 227: 61 L. T. 39 (1889); but cf. the case next cited.

(*a*) *Jackson Co.'s Tm.*, 6 R. P. C. 80 (1888), Kay, J., *Kokoko*, meaning owl; but see *supra*, note (*p*).

(*b*) Chap. II., p. 38.

(*c*) It may have an important bearing upon passing off cases, see *Reddaway* v. *Banham*, (1896) A. C. 199; 13 R. P. C. 218, and Chap. XVI., p. 477.

immaterial in the case of marks not used as trade-marks before the 13th of August, 1875. It cannot make a word a fancy word (*d*) (or an invented word).

Geographical words.

In *Van Duzer's Case* both Cotton and Lindley, L. JJ., refused to hold that no geographical name could possibly be a fancy word. And Lindley, L. J., said (*e*): "If you pick out some name which no Englishman ever heard of, such as *Penj Deh*, to which our attention was called some years ago, I do not know that that would not do. It conveys no meaning to an Englishman, and such a geographical name, for all I know, may be a fair and proper fancy word." But, as was held in that case, a name which is known to be that of a place from which the goods might come is not registrable (*f*). So, in *The Apollinaris Case*, the Court decided that the names of the springs from which the mineral waters came, and which were not the property of, or wholly controlled by, the traders who sought to appropriate the names as trade-marks, could not be registered (*g*). The word *Britannia* (*h*) has also been held to be objectionable on the ground that it is a geographical word.

If a word which would not ordinarily be understood to be geographical is also the name of a place, it is not necessarily to be treated as the name of a place for trade-mark purposes. Apart from special circumstances, as, for instance, a connection between the goods and the place, the question is what meaning the word would bear ordinarily to ordinary people (*i*). Thus, under the Act of 1888, the word *Magnolia* was not held to be a "geographical name," merely because there were several places of that name in the United States, from which country the goods came (*i*). And in *Clement*

(*d*) *Van Duzer's Tm.*, 34 C. D. 623; 4 R. P. C. 31 (1887), C. A.; *Sanitas Co.'s Tm.*, 4 R. P. C. 533; 58 L. T. 166 (1887); and see above, p. 140.

(*e*) 34 C. D. p. 643.

(*f*) See also *Batt's Tm.*, 6 R. P. C. 493 (1889), Chitty, J., *Brymbo*, for steel.

(*g*) (1891) 2 Ch. pp. 203, 221; 8 R. P. C. 137, C. A.

(*h*) *Hodgson* v. *Sinclair*, 9 R. P. C. 22 (1891), Chitty, J. Compare *Paine's Tm.*, 9 R. P. C. 130; 61 L. J. Ch. 365 (1892), Kekewich, J., in which *John Bull Brand* were held not to be "fancy words" because of their reference to England or the English. Kekewich, J., said that he was not sure that the words were not a geographical name.

(*i*) *Magnolia Metal Co.'s Tms.*, (1897), 2 Ch. 371; 14 R. P. C. 265

et Cie.'s Trade-Mark (*k*), Kekewich, J., held *St. Raphael* not to be geographical, as it was not shown that the words were adopted with the intention of referring to any place of that name. On the other hand, although the primary signification be not geographical, the real or imputed connection of the article with the locality may make the name a "geographical name" for the purpose of the Act of 1888 (*l*). It is submitted that the same considerations would be applicable in deciding whether such a word would be disqualified to be a "fancy word not in common use" by reason of being geographical.

It seems that the name of the factory from which the goods bearing the mark como is not a geographical word within the meaning intended (*m*).

"Geographical words," which can be regarded as descriptive of the place of manufacture or sale of the goods," Lord Herschell's Committee reported (*n*), "are open to obvious objections. One manufacturer or merchant cannot properly be allowed to prevent all competitors from attaching to their goods the name of the place of their manufacture or sale. The mischief would not be the same where the person seeking to register was the first who had manufactured or sold goods in the place the name of which he seeks to appropriate as a trade-mark (*o*). But there are objections to giving a monopoly even in that case, and to attempt to draw any such distinction would be likely to lead to difficulty and litigation. We think, therefore, that geographical names ought only to be permitted where they clearly could not be regarded as indicative of the place of manufacture or sale." And geographical names are accordingly not permitted to be registered under the present Act (*p*).

and 621, Kekewich, J., and Lindley, Lopes, and Rigby, L. JJ., and see "geographical name," below, p. 182.

(*k*) (1900) 1 Ch. 114; 16 R. P. C. 173; Court of Appeal, 16 R. P. C. 611. There was no decision on this point.

(*l*) *Magnolia Metal Co.'s Tms.*, *supra*.

(*m*) *Pinto* v. *Badman*, 8 R. P. C. 181 (1891), C. A.; and see *Hall* v. *Barrows*, 4 De G. J. & S. 150; 32 L. J. Ch. 548; 33 L. J. Ch. 204 (1863), Romilly, M. R., and Westbury, L. C.

(*n*) The whole passage is cited above, p. 157.

(*o*) See Chap. II., p. 48; and *Seixo* v. *Provezende*, and *Wotherspoon* v. *Currie* and other cases there cited.

(*p*) Sect. 64 (1) (e); and *infra*, p. 182, as to what is a "geographical name" within the Act.

Name of a person.

The name of a person (*q*), even though the person be a mythical person (*r*), is not a fancy word, and the name of an individual registrable under (a) cannot be registered under (c) as a fancy word (*s*).

Combination of words.

A combination of words, each of which is common to the trade, is not a "fancy word" (*t*).

Not in common use.

In order to come within sect. 64 (c) of the Act of 1883 the word or words not only must be a fancy word or fancy words, but must not be in common use. The time to be considered is the date of application (*u*).

In *The Alpine Case* (*x*) Chitty, J., took the view that the use referred to is to be understood to be use in the trade, and this view has been adopted also in a Scotch case, in which Lord Craighill said that the term "common use," as employed in the statute, does not necessarily import that the word must have been used commonly by all members of the community, or by people in all parts of the country. "What is enough, in my opinion," he added, "to establish common use, in the sense of the statute, is this: if it shall be shown that the word has been commonly used by persons who had occasion to use it, and who are connected more or less

(*q*) *Banks & James' Tm.*, 12 R. P. C. 333 (1895), *Shakspere*, Chitty, J.; and *Harris' Tm.*, 9 R. P. C. 492 (1892), Stirling, J., where *Beatrice*, for shoes, was held not to be non-descriptive; see, however, as to this case, *Holt's Tm.*, (1896) 1 Ch. 711; 13 R. P. C. 118. The early case in which *The Lanford* was allowed to be registered seems to be clearly in conflict with the later decisions; (1885) W. N. 124, Pearson, J.

(*r*) *Hodgson* v. *Sinclair*, 9 R. P. C. 22 (1891), *Britannia*, Chitty, J. The C. A., by consent, reversed the order to expunge this mark. And cf. *Paine's Tm.*, 9 R. P. C. 130, where Kekewich, J., held the words *John Bull* not to be fancy words.

(*s*) *Holt's Tm.*, (1896) 1 Ch. 711; 13 R. P. C. 16 and 118, North, J., and Lindley, Kay, and Smith, L. JJ.; the decision was on the amended Act, but the principle appears applicable also to the unamended Act.

(*t*) *Pirie* v. *Goodall*, (1892) 1 Ch. 35; 9 R. P. C. 17, V. Williams, J., and C. A.; *Pirie's Parchment Bank*; and see *Perry, Davis & Son* v. *Harbord*, 15 App. Ca. 316; 7 R. P. C. 336 (1890), (*Perry-Davis' Vegetable Pain Killer*).

(*u*) *Re Tm. Bovril*, (1896) 2 Ch. 600; 13 R. P. C. 382.

(*x*) 29 C. D. 877 (1885).

directly with the use of the commodity to which the term has been applied" (*y*). But it is submitted that the condition suggested by the last phrase is not in accordance with the later decisions as to what are fancy words cited above (*z*), and that the construction adopted by Kekewich, J., in the recent case of *Paine's Trade-Mark* (*a*), gives the correct meaning of the Act. "I cannot think," the learned judge said, "it means simply the use applied to this trade only. It cannot mean, I think, that words are not in common use if they are not used in the trade. It must mean something wider and larger than that, and seeing that *John Bull* are two words, or a combination of words, which are in common use wherever the English language is known, I think that I must hold them to be in common use within the meaning of the Act." In a later case Chitty, J., held that *Shakspere* was a word in common use, as being the name of many living persons (*b*).

Common use, whether in the trade or popularly.

The extent of user which amounts to "common use" has not been defined, but it was decided that the words *Tower Tea*, which were used by the plaintiff and the defendant in the case of the *Great Tower Street Tea Co.* v. *Smith*, and by three other persons in the tea trade, and of which the word *Tower* was used by several traders in other trades, were words in common use (*c*). On the other hand, the mere use by a single person, other than the applicant for registration, at an exhibition in this country, of a word which is not known in the trade concerned, does not amount to common use within the clause (*d*). The phrase may be compared with "common to the trade" in sect. 74 (*e*).

Words which are not entitled to registration as fancy words do not become so entitled by having the definite article

"The" prefixed to word.

(*y*) *Stuart & Co.* v. *Scottish Val de Travers Paving Co.*, 13 Sess. Cas. 4 Ser. 1 (1885), *Granolithic* stone. The word was held to be in common use.

(*z*) Pages 158 *et seq.*

(*a*) 9 R. P. C. p. 133: 61 L. J. Ch. 365 (1892), (*John Bull* beer).

(*b*) *Banks & James' Tm.*, 12 R. P. C, 333 (1895).

(*c*) *Great Tower Street Tea Co.* v. *Smith*, 6 R. P. C. 165; 5 T. L. R. 232 (1889), North, J.

(*d*) *Burgoyne's Tm.*, 6 R. P. C. pp. 230, 232; 61 L. T. 39 (1889), Chitty, J., (*Oomoo*); and see *Ripley* v. *Bandey*, 14 R. P. C. 591 and 944 (1897).

(*e*) See Chap. IX., p. 204.

prefixed to them (*f*). This is clear from the definitions cited above. A different view was taken by the Comptroller (*g*) when first the Act of 1883 came into operation, and before the decision of *Van Duzer's Case*.

Examples from decided cases.

The following words have been held not to be fancy words not in common use (*h*): ALPINE embroidery, p. 168; APOLLINARIS water, *Apollinaris Co.'s Tm.*, (1891) 2 Ch. pp. 202, 221; 8 R. P. C. 137; BEATRICE shoes, *Harris' Tm.*, 9 R. P. C. 492 (*i*); BEN LEDI whiskey, *Ainslie & Co.'s Tm.*, 4 R. P. C. 212; BÖKOL beer, p. 164; BRITANNIA soap, p. 168; BRYMBO iron (Brymbo being a place in Wales), p. 166; CARNIVAL cigarettes, p. 158; COMPACTUM for umbrellas, *Davis' Tm.*, 14 R. P. C. 903; ELECTRIC velveteen, p. 160; ELECTROID anti-fouling composition, *Hannay's Tm.*, 7 R. P. C. 46; EMOLLIO cream, *Grossmith's Tm.*, 6 R. P. C. 180; 60 L. T. 612; EMOLLIORUM dubbing, *Talbot's Tm.*, 11 R. P. C. 77; (1894) W. N. 12; FRIEDRICHSHALL water, *Apollinaris Co.'s Tm.*, *supra*; GEM air-guns, p. 163; GRANOLITHIC stone, *Stuart* v. *Scottish Val de Travers Paving Co.*, 13 Sess. Cas., 4 Ser. 1; HAND GRENADE FIRE EXTINGUISHER, *Harden Star, &c. Co.'s Tm.*, 3 R. P. C. 132; 55 L. J. Ch. 596; HERBALIN (a medicine), *Humphries* v. *Taylor's Drug Co.*, 59 L. T. 820; HUNYADI JANOS water, *Apollinaris Co.'s Tm.*, *supra*; JOHN BULL and JOHN BULL BRAND beer, p. 169; JUBILEE note paper, p. 159; KOKOKO cotton goods, p. 165; MANOR tin-plates, *Thompson's Tm.*, 6 R. P. C. 213; MELROSE hair restorer, p. 159; MONOBRUT champagne, p. 164; RED, WHITE AND BLUE coffee, *Hanson's Tm.*, 37 C. D. 112; 3 R. P. C. 130; REVERSI (for a card game), p. 160; ROADSTER (for boots), *Thompson's Tm.*, 13 R. P. C. 35; SANITAS (for a disinfectant), *Sanitas Co.'s Tm.*, 4 R. P. C. 533; 58 L. T. 166; SELF-WASHER and THE SELF-WASHER soap, *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 492; SHAKSPERE (for cigarettes, &c.), *Banks & James' Tm.*, 12 R. P. C. 333;

(*f*) *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A., (*The Self-Washer*).

(*g*) See the *Alpine Tm.*, 29 C. D. 877 (1885).

(*h*) The pages referred to are those of this book.

(*i*) This was on the ground that a reference to the Princess would be imputed. See, however, *Holt's Tm.*, (1896) 1 Ch. 711; 13 R. P. C. 118 (*Trilby* for gloves, blouses, &c.).

TOWER tea, *Great Tower Tea Co.* v. *Smith*, 6 R. P. C. 165; TRITICUMINA (for wheaton biscuits, &c.), *Meaby & Co., Ld.* v. *Triticine, Ld.*, 15 R. P. C. 1; WASHERINE soap, *Burland* v. *Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482; ZEPHYR ASIATIC WALNUT PIPE, *Friedlander's Tm.*, (1885) W. N. 85.

The only reported instances of words decided to be within the clause are the words ALPINE (for embroidery), p. 168, *Re Tm. Alpine*, 29 Ch. D. 877 (*k*); BOVRIL (for foods), p. 161, (1896) 2 Ch. 600; 13 R. P. C. 382; MAZAWATTEE (for tea), p. 161, *Densham & Son's Tm.*, (1895) 2 Ch. 176; 12 R. P. C. 75 and 271; OOMOO (for wine), *Burgoyne's Tm.*, 6 R. P. C. 227 (1889), Chitty, J.; and THE LAWFORD (for tennis racquets), (1885) W. N. 124 (Pearson, J.). The decision in *The Alpine Case* was subsequently disapproved by the Court of Appeal (*l*), and that in the last case is certainly not in accord with the interpretation subsequently put upon the clause under which the registration was allowed (*m*). Great numbers of words have, however, been registered by the Comptroller as fancy words without objection.

"(d) *An invented word or invented words.*"

Invented words.

This clause and the following clause (e) were substituted for "fancy word or words not in common use" by the Act of 1888, upon the recommendation of Lord Herschell's Committee which has been already quoted (*n*). The leading authority on the present clause is *The Solio Case* (*o*) in the House of Lords, in which several points were decided. Lord Halsbury, L. C., in his speech referred to the report of that Committee, and both he and Lord Herschell considered that the decisions on the expression "fancy word" had no bearing on the interpretation of the provisions substituted by the Act of 1888 (*p*). It will therefore be only necessary, in con-

The Solio Case.

(*k*) As to this decision see, however, *Van Duzer's Tm.*, and *Leaf's Tm.*, 34 Ch. D. 623; 4 R. P. C. 31.

(*l*) *Alpine Tm.*, 29 C. D. 877 (1885), Chitty, J.; see above, p. 168.

(*m*) See above, p. 168.

(*n*) Above, p. 157.

(*o*) *Eastman Photographic Materials Co., Ld.'s Application*, (1898) A. C. 571; 15 R. P. C. 476.

(*p*) This view had been previously expressed by Lindley, L. J., in *The Somatose Case, Farbenfabriken Vormals Bayer & Co.'s Application*, (1891) 1 Ch. 645; 11 R. P. C. 84.

sidering clause (d), to refer to the decisions on the Act of 1888. The House of Lords further overruled the decisions in several earlier cases, including that of the Court of Appeal (*q*) in *The Somatose Case*, to the effect that clauses (d) and (e) must be read conjunctively, and not as alternatives. *The Solio Case* came before the Courts on an appeal from the Comptroller's refusal to register the word *Solio* for photographic paper, the refusal being on the grounds (*inter alia*) that the mark did not consist of an essential particular, and that it had reference to the quality or character of the goods. Kekewich, J., and the Court of Appeal upheld the refusal to register (*r*), on the ground that the word suggested the sun, and had reference to the character and quality of the goods, and that therefore (following the decision of the Court in *The Somatose Case*) it was not registrable as an invented word. The Lord Chancellor did not deal with the point explicitly, but all the other members of the House who took part in the decision (*s*) said that clauses (d) and (e) must be treated as independent clauses, and there is no reason to suppose that the Lord Chancellor differed from their judgments. Lord Herschell said that he could not find any justification for qualifying the provision "(d) an invented word or words" by the condition that they should have no reference to the character or quality of the goods, and he went on to point out that under (e) any word in the English language might serve as a trade-mark, and that different considerations therefore arose under clauses (d) and (e). "If, then, the use of every word in the language was to be permitted as a trade-mark, it was surely essential to prevent its use as a trade-mark where such use would deprive the rest of the

(d) not qualified by (e).

(*q*) *Farbenfabriken, &c. Co.'s Tm., supra*, note (*p*), Lindley, Kay, and Smith, L. JJ., all concurring on this point; the other cases overruled are *Meyerstein's Application*, 43 C. D. 604; 7 R. P. C. 114 (1890), Kay, J.; and *Talbot's Tm.*, 11 R. P. C. 77; (1894) W. N. 12 (*Emolliolorum*), in which Stirling, J., followed the decision of Kay, J. In *Densham & Son's Tm.*, (1895) 2 Ch. 176; 12 R. P. C. 271, Lindley, Lopes, and Kay, L. JJ., took the same view, although, having regard to the facts, the point did not call for decision.

(*r*) 13 R. P. C. 707; (1896) W. N. 158, Kekewich, J.; and 14 R. P. C. 487; (1897) W. N. 48, Lindley, Lopes, and Rigby, L. JJ.

(*s*) Lords Herschell, Macnaghten, Morris, and Shand,

community of the right which they possessed to employ that word for the purpose of describing the character or quality of goods. But with regard to words which are truly invented words—words newly coined—which have never heretofore been used, the case is, as it seems to me, altogether different; and the reasons which required the insertion of the condition are altogether wanting. If a man has rightly invented a word to serve as his trade-mark, what harm is done, what wrong is inflicted if others be prevented from employing it, and its use is limited in relation to any class or classes of goods to the inventor? So far, then, from seeing no reason for a distinction between the particulars designated in (d) and (e), there seems to me abundant reason for not interpolating in (d) words which the Legislature has used only in relation to (e)."

Since *The Solio Case* the law is therefore settled that an invented word is not debarred from registration as a trade-mark by reason of its referring to the character or quality of the goods. Lord Macnaghten said:—"If it is an invented word—if it is 'new and freshly coined' (to adapt an old and familiar quotation)—it seems that it is no objection that it may be traced to a foreign source, or that it may contain a covert and skilful allusion to the character or quality of the goods. I do not think that it is necessary that it should be wholly meaningless." It was decided that the word *Solio* was an invented word, and accordingly capable of registration; and Lords Halsbury, Herschell and Macnaghten disapproved of the suggestion that the word referred to the character or quality of the goods; in fact, one of the main reasons given by Lord Halsbury for his judgment was that the word did not indicate the character or quality of the goods.

Quantum of invention.

Foreign word not necessarily debarred.

The determination of the standard of invention to be applied is both an important and difficult matter. It is clear from *The Solio Case* that the mere fact that the word exists in a foreign language, whether modern or classical, is not sufficient to exclude a word, if it really is invented. Thus, neither the fact of the existence of an Italian word *solio* meaning throne, or of a Latin word in the ablative case with the same meaning, prevented *Solio*, which had, in fact, been

invented for the purpose of a trade-mark, from being entitled to registration (*t*). On the other hand, the fact that the word is a foreign word does not make it an invented word in England (*u*). It was said in the same case that words which are in sound ordinary English words, but are misspelt, are not eligible (*x*). The following are passages from the judgments in *The Solio Case* on this point. Lord Halsbury said:—"I desire to give my opinion with reference to the particular word, and not to go behind it. I can quite understand suggesting other words—compound words, or foreign words—as to which it would be impossible to say that they were invented words, although, perhaps, never seen before, or that they did not indicate the character or quality of the goods, although as words of the English tongue they had never been seen before. Suppose a person were to attempt to register as a single English word *Cheapandgood*, or even without taking so gross an example, using a word so slightly differing from an ordinary and recognized word as to be neither an invented word nor, avoiding the prohibited choice of a word, indicating character or quality. The line must be sometimes difficult to draw; but, to my mind, the substance of the enactment is intelligible enough, and the Comptroller has to make up his mind whether in substance there has been an infringement of the rule." Lord Herschell, referring to the observation of Kay, J., in *The Satinine Case* (*y*), that there was extremely little invention, said:—"It may be that the word *Satinine*, which was there in question, was objectionable on other grounds, but if the word be an 'invented' one, I do not think the quantum of invention is at all material. An invented word is allowed to be registered as a trade-mark, not as a reward of merit, but because its registration deprives no member of the community of the rights which he possesses

(*t*) See also *Field, Ld.* v. *Wagel Syndicate, Ld.*, 17 R. P. C. 266 (1889), Buckley, J. (*Savonol*).

(*u*) See Lord Herschell's judgment quoted below, p. 175.

(*x*) See especially Lord Halsbury's judgment and that of Lord Herschell. The point had been so decided by Kekewich, J., and the Court of Appeal in *Ripley's Application*, 15 R. P. C. 151, (1898) (*Pirle*). Cozens-Hardy, J., has recently decided that *Uneeda* is not an invented word, being a mere mis-spelling of "You need a": *National Biscuit Co.'s Application*, 18 R. P. C. 170 (1901).

(*y*) *Meyerstein's Tm.*, 43 C. D. 604; 7 R. P. C. 114 (1890).

to use the existing vocabulary as he pleases. It may, no doubt, sometimes be difficult to determine whether a word is an invented word or not. I do not think the combination of two English words is an invented word, even although the combination may not have been in use before; nor do I think that a mere variation of the orthography or termination of a word would be sufficient to constitute an invented word, if to the eye or ear the same idea would be conveyed as by the word in its ordinary form (*yy*). Again, I do not think that a foreign word is an invented word simply because it has not been current in our language. At the same time, I am not prepared to go so far as to say that a combination of words from foreign languages so little known in this country that it would suggest no meaning except to a few scholars, might not be regarded as an invented word. It is in this respect that I desire to qualify my assent to Lord Justice A. L. Smith's proposition that an invented word can never have a meaning." A passage from Lord Macnaghten's judgment is quoted above (*z*). Lord Shand said:—" I agree . . . . in thinking, especially after the decision to be given in this case, that the Comptroller-General will be fully warranted in taking care that there shall not be admitted, under the guise or cover of words called 'invented' by the applicant, words really in ordinary use, which might, in a disguised form, have reference to the character or quality of the goods. There must be invention, and not the appearance of invention only. It is not possible to define the extent of invention required, but the words, I think, should be clearly and substantially different from any word in ordinary and common use. The employment of a word in such use, with a diminutive or a short and meaningless syllable added to it, or a mere combination of two known words, would not be an 'invented' word, and a word would not be 'invented' which, with some trifling addition or very trifling variation, still leaves the word one which is well known or in ordinary use, and which would be quite understood as intended to convey the meaning of such a word." In a recent case (*a*), much

(*yy*) See *Uneeda Case*, note (*x*).
(*z*) Page 173.
(*a*) *Field, Ld.* v. *Wagel Syndicate, Ld.*, 17 R. P. C. 266 (1900).

reliance was placed on the last-quoted passage by the applicants, who were applying to expunge the registration of the word *Savonol*, which had in 1890 been registered for common and soft soaps. They contended that the French word *savon* was used in the soap trade in this country, and that *Savonol*, being merely the word *savon* with a termination, was not an invented word. Buckley, J., held the word to be an invented word, even although *savon* had been used as alleged, and said that he did not understand Lord Shand as meaning to express anything differing from the other Lords.

Present practice of the Office.

Before the decision in *The Solio Case*, registration of a word as an invented word was difficult to obtain, but it has since become the practice at the Patent Office to accept for registration, as invented words, words which have very little invention indeed, but are merely ordinary English words having a slight variation in or a slight addition to them (*b*); in such cases, however, the Comptroller requires a disclaimer of the part formed by the common word, thus *Fireproofine* has been accepted with a disclaimer of "fireproof." There is no express provision in the Act for any such disclaimer, and whether or not the Comptroller has jurisdiction to require such disclaimers—a point which appears doubtful, and which applicants are not, of course, anxious to test—it may be hereafter held that, having regard to the judgments in *The Solio Case*, quoted above (*c*), and to the language of the Act, such a word as *Fireproofine*, for instance, is not an invented word, and that a disclaimer of the kind referred to does not help to qualify a word as an invented word, although it may protect the public from what would otherwise be the consequence of registration.

Whether applicant must be first user.

A further question with respect to the meaning of the expression "invented word" arises when a word has been invented but not invented for the purpose of a trade-mark,

(*b*) See an article entitled "Words as Trade-Marks" in the Solicitors' Journal (1900), Vol. XLIV. 548, in which the following examples are given, namely, *Perfumette* for perfumes, *Enameline* for blacking, &c., *Detergene* for goods in Class 47, *Glazo* for creams and polishes for leather, and *Fireproofine* for a fireproofing liquid.

(*c*) Page 174.

or so used until after its use for other purposes. In *Holt's Trade-Mark* (*d*), Kay, L. J., expressed an opinion that if the person who is seeking to register a word as an invented word has not been the inventor, or first user, he is not entitled to register it (*e*), and this is to some extent supported by a passage in Lord Herschell's judgment (*f*). A different view was, however, adopted by Cozens-Hardy, J., in the *Linotype Co.'s Application* (*g*), where he also held that it was not necessary, in order that a word may be an "invented word," that there should have been no prior publication of it within the jurisdiction. If this be correct, it would seem to be a question of fact in each case whether such a word has ceased by being so published, to be an "invented word," and has come into such use as to lose that character (*h*).

A word already in existence cannot properly be said to be an "invented word," merely because the person claiming to have invented it was not aware of its existence (*i*).

The following words have been held to be invented words within the meaning of the Act:—KYNITE, *Kynoch & Co.'s Tm.*, 14 R. P. C. 905 (1897); MAZAWATTEE, p. 161, *Densham's Tm.*, (1895) 2 Ch. 176; 12 R. P. C., 75 and 271; SAVONOL, p. 176, *J. C. & J. Field, Ld.* v. *Wagel Syndicate, Ld.*, 17 R. P. C. 266 (1900); SOLIO, pp. 174, 175, *Eastman Photographic Materials Co.'s Application*, (1898) A. C. 571; 15 R. P. C. 476; TACHYTYPE, p. 177, *The Linotype Co.'s Application*, (1900) 2 Ch. 238; 17 R. P. C. 380.

The following words have been held not to be invented words within the meaning of the Act:—APOLLINARIS, *Apollinaris Co.'s Tms.*, (1891) 2 Ch. 186; 8 R. P. C.

(*d*) (1896) 1 Ch. 711; 13 R. P. C. 118 (*Trilby*, the heroine of Du Maurier's book of that name).

(*e*) See also the judgment of Smith, L. J., but Lindley, L. J. (and perhaps Smith, L. J.), decided the point on the ground that the word had become a well-known word. See also the *Formalin Hygienic Co.'s Application*, 17 R. P. C. 486 (1900), where *Formalin* was held to be the name of the article.

(*f*) "Words which are truly invented words—words newly coined—which have never therefore been used," see above, p. 173.

(*g*) (1900) 2 Ch. 238; 17 R. P. C. 380.

(*h*) And see the judgment of Lindley, L. J., in *Holt's Tm.*, *ubi supra*.

(*i*) Per Chitty, J., in *Sir Titus Salt & Co.'s Application*, (1894) 3 Ch. 166; 11 R. P. C. 517 (*Eboline*).

137 (*i*); EROLINE (*jj*), *Sir Titus Salt & Co.'s Application*, (1894) 3 Ch. 166; 11 R. P. C. 517 (*k*); ELECTROZONE (*jj*), *British Electrozone Co.'s Application*, 13 R. P. C. 447 (1896) (*l*); EMOLLIOLORUM (*jj*), *Talbot's Tm.*, 11 R. P. C. 77; (1894) W. N. 12 (*m*); FORMALIN (*mm*); PIRLE (*jj*), *Ripley & Sons' Application*, 15 R. P. C. 151 (*n*); SATININE (*jj*), *Meyerstein's Tm.*, 43 C. D. 604; 7 R. P. C. 114 (*o*); SOMATOSE (*jj*), *Farbenfabriken, &c. Co.'s Application*, (1894) 1 Ch. 645; 11 R. P. C. 84 (*p*); TRILBY, *Holt's Tm.*, (1896) 1 Ch. 711; 13 R. P. C. 118 (*q*); UNEEDA, *National Biscuit Co.'s Application*, (1901) 1 Ch. 550; 18 R. P. C. 170 (*r*).

Words having no reference to character or quality of goods.

"(e) *A word or words having no reference to the character or quality of the goods, and not being a geographical name.*"

Test to be applied.

The question under this clause is not whether the word which it is sought to place or retain on the Register has in fact any reference to the character or quality of the goods, but whether it has such a reference in appearance. For if it have, it must be either descriptive or deceptive, and in either case it is not entitled to be on the Register (*s*).

As stated above in reference to clause (d), the Act of 1888 was intended to make a fresh start in regard to word-marks, and therefore the decisions on the unamended section are not to be treated as authorities on the amended section. A large number of the decisions on clause (e) have been in relation

(*j*) *Friedrichshall* and *Hunyadi* were admittedly on the same footing as *Apollinaris*.

(*jj*) Decided before *The Solio Case*.

(*k*) *Eboli* was shown to be the name of an Italian town of 11,000 inhabitants, and the application was for silk goods.

(*l*) The word was admittedly well known in the United States.

(*m*) The word was, in fact, registered under the Act of 1883.

(*mm*) As to the particular ground, see note (*r*), *supra*.

(*n*) This case was decided on the ground of the word being a mere misspelling of "pearl" which could not itself be registered. Kekewich, J., did not decide whether it was an invented word or not, and the decision of the Court of Appeal does not absolutely cover the point.

(*o*) See, however, Lord Herschell's judgment in *The Solio Case*.

(*p*) Lord Herschell, in *The Solio Case*, said that he thought it an excellent illustration of an invented word.

(*q*) That is to say, not at the date of registration.

(*r*) Held to be a mere mis-spelling of "You need a."

(*s*) *Edge's Tm.*, 8 R. P. C. 207 (1891) (*Filtered Blue*), Stirling, J.

to words which now, under the decision in *The Solio Case* (*t*), could be registered as invented words independently of the question whether or not they have a reference to the character or quality of the goods. Thus, in *The Solio Case* (*u*), Lords Halsbury, Herschell, and Macnaghten, differing from the view adopted by the Court of Appeal (*x*) that *Solio* would suggest the sun, and had therefore some reference to the character or quality of the goods for which it was used, namely, photographic paper, held that it had no such reference; and, in substance, the House of Lords overruled the earlier decision in *The Somatose Case* (*y*), of the Court of Appeal (*z*) that, having regard to the Greek word *σωμα*, meaning *body*, *Somatose* was not a word having no reference to the character or quality of the goods, which included preparations made from meat. On the other hand, the Court of Appeal held that *Mazawattee*, which was compounded of the Cingalese word for *garden* and part of a Hindustani word meaning *delicious*, had no reference to the character or quality of the goods which included tea (*a*). The decision in *The Solio Case* that clauses (d) and (e) are to be read independently makes the decisions on words of the type of those just mentioned of less practical importance; since that case there has been no decision under clause (e) on any word of such a nature (*aa*). The object of the clause was to permit ordinary English words to be registered subject to the maintenance of the right of the public to employ them in their ordinary meanings; if there would be interference with such right, registration is not to be permitted (*b*). Although the clause makes it a condition of registration that the word should have no reference to the character or quality of the goods, this means that in the general understanding of ordinary

(*t*) See clause (d), p. 171.

(*u*) *Eastman Photographic Materials Co.'s Application*, (1898) A. C. 571; 15 R. P. C. 476.

(*x*) 14 R. P. C. 487, affirming Kekewich, J., 13 R. P. C. 707.

(*y*) *Farbenfabriken Co.'s Application*, (1894) 1 Ch. 645; 11 R. P. C. 84.

(*z*) Smith and Kay, L. JJ., Lindley, L. J., dissenting.

(*a*) *Densham's Tm.*, (1895) 2 Ch. 176; 12 R. P. C. 75 and 271.

(*aa*) See, however, *The Uneeda Case*, below, p. 181.

(*b*) See the judgment of Lord Herschell in *The Solio Case*, *Eastman Photographic Materials Co.'s Application*, quoted *supra*, p. 172.

English people it must bear no such reference (*e*). And the fact that an ingenious mind, knowing the class of goods to which the word is applied, can find some reference through etymology or otherwise to the character or quality of the goods is not fatal to registration (*d*). Thus, the suggestion that *Trilby*, the name of the heroine in Du Maurier's book of the same name, when used as a mark for gloves, blouses, &c., would be taken to have a reference to such articles as were fit for such a person as the book describes, was said by Lindley, L. J., to be too fanciful and far-fetched (*e*). Another example is the word *Kynite*, which has been held not to contain, by reason of the resemblance of the first syllable to the root of the word *kinetic*, a reference to the character of the goods in question, namely, explosives (*f*). If a word, not originally importing a reference such as the clause contemplates, comes to be known as the name of the article, it does not, by that fact, come to have a reference to the character or quality of the goods within the meaning of the section (*g*); thus, although *Magnolia* had come to be known as the name of an alloy, it was held not to refer to the character or quality of the goods. But, of course, a word which is descriptive of the goods is not entitled to registration (*h*). And the business of the proposed user of the word may be regarded as well as the goods; thus, Kekewich, J., held that *Typograph*, a dictionary word meaning a type-

(*c*) See the judgment of Rigby, L. J., in *Eastman Photographic Materials Co.'s Application*, 14 R. P. C. 407, and of Kekewich, J., in *The Linotype Co.'s Application*, 14 R. P. C. 900, (1897) (*Typograph*).

(*d*) See the judgment of Lord Herschell in *The Solio Case*, *supra*.

(*e*) *Holt & Co.'s Tm.*, (1896) 1 Ch. 711; and 13 R. P. C. 118. As to names generally, in 1889 the Office published an official notice to the effect that a mere surname or combination of surname and christian name, or christian name in use as a surname would not be accepted for registration as a new trade-mark unless rendered in some particular and distinctive manner in accordance with sect. 64, sub-sect. 1 (a); see Appendix, p. 731.

(*f*) *Kynoch's Tm.*, 14 R. P. C. 905 (1897), Kekewich, J.

(*g*) *Magnolia Metal Co.'s Tms.*, (1897) 3 Ch. 371; 14 R. P. C. 621, Lindley, Lopes, and Rigby, L. JJ., differing from Kekewich, J., on this point.

(*h*) Thus, *Filtered Blue* for laundry blue is inadmissible, *Edge's Tm.*, 8 R. P. C. 207 (1891), Stirling, J. *Roadster*, for boots, held not to be a fancy word, in *Thompson* v. *Miller*, 13 R. P. C. 35 (1896), Stirling, J., would probably be sufficiently descriptive not to come within clause (e).

making and type-setting machine, would, if registered by the Linotype Company for metals used in manufacture, have reference to the character or quality of the goods (*i*).

A word that would be understood to be commendatory will not satisfy the condition imposed by clause (e) (*j*), and a word that is a mere misspelling of a word that is not capable of registration is not admissible (*k*).

The following words have been held not to be within (e) on the ground that they could not be said to have no reference to the character or quality of the goods (*l*) :—APOLLINARIS, for natural mineral waters, *Apollinaris Co.'s Tms.*, (1891) 2 Ch. 186, 8 R. P. C. 137 (*m*) ; EDGE'S FILTERED BLUE, for laundry blue, *Edge's Tm.*, 8 R. P. C. 207 (1891) (*n*) ; EMOLLIOLORUM, for harness, &c., *Talbot's Tm.*, 11 R. P. C. 82; JOHN BULL, for fermented liquors and spirits, *Paine's Tm.*, 9 R. P. C. 130 (*o*) ; NECTAR, for tea, coffee and cocoa, *Harrisons and Crosfield's Application*, 18 R. P. C. 34; PIRLE, for cloth, &c., *Ripley's Application*, 15 R. P. C. 151 (*p*) ; SATININE, for starch and soap, *Meyerstein's Application*, 7 R. P. C. 114 ; SOMATOSE, for a pharmaceutical product principally consisting of ingredients of meat, *Farbenfabriken Co.'s Application*, p. 179 ; TYPOGRAPH, for metals and certain machinery, *Linotype Co.'s Application*, 14 R. P. C. 900 ; UNEEDA, for biscuits and other goods in Class 42, *National Biscuit Co.'s Application*, (1901) 1 Ch. 550; 18 R. P. C. 170. All the above cases, except the NECTAR and UNEEDA cases, were decided before the decision of the *Solio Case* in the House of Lords.

(*i*) *Linotype Co.'s Application*, 14 R. P. C. 900 (1897).

(*j*) See the observations of Rigby, L. J., in *Ripley & Son's Application*, 15 R. P. C. 151 (*Pirle*) ; *Harrisons and Crosfield's Application*, 18 R. P. C. 34 (1901), Byrne, J. (*Nectar*) ; and *National Biscuit Co.'s Application*, (1901) 1 Ch. 550 ; 18 R. P. C. 170, Cozens-Hardy, J. (*Uneeda*).

(*k*) See the *Pirle* and *Uneeda* cases cited in the last note, and the judgments in *Eastman Photographic Materials Co.'s Application*, (1898) A. C. 571 ; 15 R. P. C. 476.

(*l*) The pages referred to are those of this book.

(*m*) The mark was intended to be used for water from the *Apollinaris* spring. *Friedrichshall* and *Hunyadi Janos* were admittedly on the same footing.

(*n*) This mark was registered under the Act of 1883 ; the argument, as in *Talbot's Tm.*, *infra*, must therefore have been that as it was good under the Act of 1883, it ought not to be expunged.

(*o*) The mark was actually registered under the Act of 1883, but see note (*n*).

(*p*) As being equivalent to pearl.

The following words have been held to have no reference to the character or quality of the goods:—KYNITE, for explosives, *Kynoch's Tm.*, p. 180 (*i*); MAGNOLIA, for a metal alloy known by that name, *Magnolia Metal Co.'s Tms.*, p. 180; MAZAWATTEE, for tea, *Densham's Tm.*, p. 179; SOLIO, for photographic paper, *Eastman, &c. Co.'s Tm.*, p. 179 (*k*); TRILBY, for gloves, blouses, &c., *Holt's Tm.*, p. 180. In addition to these decisions, in *Pinto* v. *Badman*, 8 R. P. C. 181, it was objected that the words *El Destino* on a label for cigars indicated, by the fact that the words were Spanish or Mexican, the character or quality of the goods, but this objection failed both at the trial and in the Court of Appeal. Also, Chitty, J., in *Burgoyne's Tm.*, 6 R. P. C. 227, came to the conclusion that, if the Act of 1888 applied, which he held was not the case, the word *Oomoo* would have been capable of registration under it, and presumably, therefore, he considered that it had no reference to the character or quality of the goods.

Not being a geographical name.

It is a further condition that the word should not be a geographical name. The report of Lord Herschell's Committee was to the effect that the registration of such names ought only to be permitted where they clearly could not be regarded as indicative of the place of manufacture or sale (*l*), but the Act contains no such limitation of the prohibition. The words "geographical name" are not equivalent to the "name of any place," and a word does not become a geographical name simply because some place of the earth's surface has been called by it. In *The Magnolia Case* (*m*), it appeared that in the United States, whence the metal had been imported, there were several places known by the name "Magnolia," but it did not appear that the goods had any connection with any of those places. Rigby, L. J., said: "It is, no doubt, shown by the evidence, that there are places in the United States called by the name 'Magnolia,' and if 'geographical name'

Magnolia Case.

(*i*) The pages referred to are those of this book.

(*k*) Per Lord Halsbury, L.C., and Lords Herschell and Macnaghten, although this was not the ground of the decision, which was that the word was an invented word within (d).

(*l*) Quoted above, p. 157.

(*m*) *Magnolia Metal Co.'s Tms.*, (1897) 2 Ch. 371; 14 R. P. C. 265 and 621, Kekewich, J., and Lindley, Lopes and Rigby, L. JJ.

in sect. 64, sub-sect. (e), were equivalent to the name of any place, 'Magnolia,' as the name of places mentioned in the evidence, would fall within the exception. But in our judgment the phrase 'geographical name' in sect. 64, sub-sect. (e), ought not, in general, to receive so wide an interpretation. It must, we think, in the absence of special circumstances, be interpreted so as to be in accordance, in some degree, with the general and popular meaning of the words, and a word does not become a geographical name simply because some place upon the earth's surface has been called by it. For example, we agree with Mr. Justice Kekewich that the word 'Monkey' is not proved to be a geographical name by showing merely that a small and by no means generally known island has been called by that name. If, indeed, in its primary and obvious meaning, the word has reference to a locality, as the word *Melrose* in *Van Duzer's Case*, or the word *Eboli* in *Sir Titus Salt & Co.'s Case* (from which Mr. Justice Chitty declined to distinguish the derivative *Eboline*), it may well be a geographical name within the meaning of the sub-section. Even when the primary signification is not geographical, if the name is really a local name (however little known the locality may be), and the name is given because of the connection of the article with the locality, whether that be real or imputed only by those who give the name, it may well be a geographical name within the meaning of the sub-section. An instance of this is to be found in the case of the word *Apollinaris*, given to the water from a spring known as the Apollinaris Spring. So, if 'Magnolia' had been the name of a place where the metal was manufactured, we should have been by no means inclined to say that it would not be a geographical name when applied to the article manufactured in the place having the name" (*n*).

The prohibition in clause (e) of the registration of a geographical name is not confined to the noun substantive, but extends to the adjectival form (*o*). But the mere fact that

(*n*) See also *Clement et Cie.'s Tm.*, (1900) 1 Ch. 114; 16 R. P. C. 173, 611 (1899), Kekewich, J. (*St. Raphael*). On appeal, it was not necessary, in the view the Court took, to decide the point whether the words were geographical, 16 R. P. C. 611.

(*o*) *In re Sir Titus Salt's Application*, (1894) 3 Ch. 166; 11 R. P. C. 84, Chitty, J. (*Eboline*).

part of a word is a foreign word, and might therefore have some reference to the country where the word is known, does not make the word a geographical name (*oo*).

The decisions on the unamended Act of 1883 arising on the question whether a geographical word could be registered as a "fancy word not in common use," will be found referred to above (*p*).

The following words have been held to be geographical names within the meaning of (e): APOLLINARIS, *Apollinaris Co.'s Tms.*, (1891) 2 Ch. 186; 8 R. P. C. 137; EBOLINE, *Sir Titus Salt & Co.'s Application*, (1894) 3 Ch. 166; 11 R. P. C. 517 (*q*). The following words have, on the other hand, been held not to be geographical names within the meaning of (e): MAGNOLIA, p. 182, *supra*; MAZAWATTEE, *Densham's Tm.*, p. 161, *supra* (*oo*). Also in *Pinto* v. *Badman*, 8 R. P. C. 181, the words EL DESTINO were objected to on a label on the ground of being geographical, but this objection was overruled.

Old Marks.

Old marks.

By **sect. 64** (3) (ii.) (*r*):

> "Any special and distinctive word or words, letter, figure (*s*), or combination of letters or figures, or of letters and figures, used as a trade-mark before the 13th day of August, 1875 (*t*), may be registered as a trade-mark under this part of this Act."

This clause is co-ordinate with the clauses (a) to (e) of sub-sect. (1). It is taken verbatim from the Act of 1883. Provision was made in the original Act for the registration of old marks. The clause corresponding to the present clause in that Act was as follows:—

Special and distinctive.

> "Any special and distinctive word or words, or com-

(*oo*) *Re Densham & Son's Tm.*, (1895) 2 Ch. 176; 12 R. P. C. 75 and 271 (*Mazawattee*).

(*p*) *Ante*, p. 166.

(*q*) See p. 183, note (*e*).

(*r*) Act of 1888, s. 10.

(*s*) *Figure* means *numeral*, per Jessel, M. R., in *Exp. Stephens*, 3 C. D. 659 (1876); *Wright, Crossley & Co.'s Application*, (1900) 2 Ch. 218; 17 R. P. C. 386.

(*t*) Date of commencement of the Act of 1875.

bination of figures or letters, used as a trade-mark before the passing of this Act may be registered as such under this Act" (*u*).

The amendment (letter, figure) was made in consequence of the decision that, under the sub-section as it originally stood, a single letter, although an old mark, could not be registered (*x*). It has been said that it was the intention of the Act to allow to be registered anything which was protected as a trade-mark under the old law, and could not be registered under the other clauses of the section (*y*).

But it has been recently decided that the proviso does not extend to all old marks, and that an old mark, consisting of, or even containing, a device, does not come within the proviso, and is not entitled to registration unless it consists of or contains one of the essential particulars enumerated, and that it is, in that case, subject to the requirements of the previous sub-sect. (2) which have already been discussed (*z*). And, similarly, it would seem that any old mark registered under the Act of 1875 or 1883, if not within the corresponding proviso, must conform to the general requirements of the Act under which it was registered. This decision is contrary to the previous practice of the Patent Office, which had treated all old marks as having a right to registration, and as free from the requirements of sub-sect. (2), and, as pointed out by Byrne, J., in his judgment, some of the results to which the language of the clause leads are anomalous.

The requirement that the mark shall be "special and distinctive" only embodies the old law (*a*). *Special* means of such a character that the mark "separates the article to which it is applied from all others of the same class or character; something which points out the article as

(*u*) Act of 1875, s. 10.

(*x*) *Mitchell's Tm.*, 7 C. D. 36 (1877), Hall, V.-C., *A.*, for steel pens.

(*y*) *Barrows' Tm.*, 5 C. D. 353 (1877), per Malins, V.-C.; *Bodega Co.* v. *Owens*, 6 R. P. C. 241, Chatterton, V.-C. (1888), in Ireland.

(*z*) *Wright, Crossley & Co's Application*, (1900) 2 Ch. 218: 17 R. P. C. 386, Byrne, J., who also held that sect. 74 did not apply in that case, if the mark could be registered under sect. 64 (3) (ii). It is settled that if the application is to register as an old mark, the words must have been used alone, see below, p. 191.

(*a*) *Re Hopkinson's Tm.*, (1892) 2 Ch. 116; 9 R. P. C. 102, Kekewich, J.; see as to this, *ante*, p. 132.

standing alone, which makes the man who sees or reads the word understand that the article has a special standing, a special existence, and is not one of the general class, for instance, of pianos, but belongs to a class of a particular character" (*a*). *Distinctive* means that the mark is a distinctive thing which points out that the goods are the goods of A. B (*b*). Thus, in *The Eton Cigarette Case*, Fry, L. J., said: "It appears to me, that to satisfy the requirement of (this) definition the word or words must be distinctive in this sense, that they distinguish the manufacture of the person who has registered the trade-mark from the manufacture of all other persons" (*c*).

The decisions on the word "distinctive," where it occurs in the earlier part of the section, have been already considered (*d*).

Deceptive mark not distinctive.

Where, therefore, a cigarette manufacturer had registered the word *Eton* as an old mark, but had sold the cigarettes in boxes bearing the words *St. Petersburg—P. Mavrogordato & Co.*, as well as *Eton*, thereby suggesting to purchasers that the goods were not of his manufacture, but were made in Russia, although the mark was known in the trade as, in fact, indicating his manufacture, it was held that he was not entitled to have it registered, and it was accordingly ordered to be removed (*e*).

Descriptive words.

It follows that words which were merely descriptive of the goods to which they are applied cannot be registered as old trade-marks under the clause, for, in fact, they could not be trade-marks at all (*e*). So, where fusees were manufactured under a patent which expired in 1881, and were called *braided fixed stars* (*fixed stars* being a common name for fusees, and *braided* descriptive of the process by which the particular goods were manufactured), and the words were registered as

(*a*) See note (*a*), *ante*, p. 185.

(*b*) *Richards* v. *Butcher*, (1891) 2 Ch. p. 536; 8 R. P. C. 249, Kay, J.; and per Halsbury, L. C., in *Perry, Davis & Son* v. *Harbord*, 16 App. Cas. p. 320; 7 R. P. C. 336 (1890).

(*c*) *Wood* v. *Lambert*, 32 C. D. p. 262; 3 R. P. C. 81 (1886), followed as to the effect of the plaintiff himself putting the name of a third person on the goods by Cozens-Hardy, J., in *Wolff* v. *Nopitsch*, 17 R. P. C. 321 (1900), a passing off case, affirmed on other grounds by C. A., 18 R. P. C. 27.

(*d*) Above, pp. 132 *et seq.*

(*e*) See Chap. II., pp. 36 *et seq.*

an old mark in 1877, they were ordered to be removed from the Register, on this as well as on other grounds (*f*).

Word with a secondary distinctive meaning.

Before the Acts words which were *primâ facie* descriptive might be acquired as trade-marks, if, by use as such, in connection with the goods of a particular trader, they, in fact, acquired a secondary distinctive meaning distinguishing the goods as his (*g*); and such words may still be so acquired as a "common law trade-mark" apart from registration (*h*). And it is submitted that wherever such words had been used and acquired as trade-marks before the 13th of August, 1875, they are "special and distinctive," and therefore capable of registration within the clause.

This was directly decided by Kekewich, J., in a case (*i*), in which he held the words *J. & J. Hopkinson*, printed in ordinary type, to be "special and distinctive," and to be properly registered as an old mark. "In order to protect a trade-mark before the Act," he said, "you were obliged to prove by evidence and satisfy the Court that the words used as a trade-mark were known in the market, and, to use Lord Westbury's expression in *Leather Cloth Co.* v. *American Leather Cloth Co.* (*k*), gave a 'vendible' character to the articles to which they were attached, made those articles recognized as coming from a particular manufactory, and so gave them a character different from that of every other article in the trade. Therefore, it seems to me, that the Legislature in the Act of 1875 did no more than adopt the language of the cases, by reducing them into a compressed form, and say really that what the Court would have held to be a trade-mark independently of the Act should now be capable of registration as a trade-mark under the Act, provided only that the mark had been used as a trade-mark before the passing of the Act." And this accords with the opinions expressed by several other judges (*l*). *The Monopole Case*

(*f*) *Palmer's Tm.*, 24 C. D. 504 (1882), C. A.; and see *Chesebrough Manufacturing Co.'s Tms.*, 18 R. P. C. 191 (1901), Buckley, J., *Vaseline*, registered in 1877, removed from the Register on the ground that it was then descriptive of the goods; also the cases cited below.

(*g*) See Chap. II., p. 36.

(*h*) *Reddaway* v. *Banham*, (1896) A. C. 199; 13 R. P. C. 218 (*Camel Hair Belting*). See below, p. 477.

(*i*) (1892) 2 Ch. 116; 9 R. P. C. 102.

(*k*) Above, p. 50.

(*l*) Mulins, V.-C., in *Barrow's*

was discussed (*n*) on the assumption that the word, though in itself descriptive, could be registered if it were shown to have been used before the Act of 1875 as a trade-mark; and in *The Stone Ales Case* (*o*) the only ground upon which the Court of Appeal proceeded in removing the mark *Stone Ale* was the want of proof of such user.

On the other hand, in *Perry, Davis & Son* v. *Harbord* (*p*), the question was treated as an open one by two of the Lords Justices, for Fry, L. J., said: "It is not necessary now to inquire whether the words must be special and distinctive from their own proper nature and internal force *ex vi terminorum*, or whether they may acquire a distinctive character by user as applied to the goods"; and Lopes, L. J., made use of similar language, and added: "Speaking for myself, I should be inclined to think (the word tendered for registration as an old mark) must be inherently special and distinctive" (*q*). And on the further appeal, Halsbury, L. C., and Lord Morris held that the words in question in the case, *Pain Killer* for a medicine, were not special and distinctive; the Lord Chancellor, on the ground that they were descriptive of a quality attributed to the goods to which they were applied (*r*). This decision is not in conflict with the conclusion stated above, for there was no finding or evidence that the medicine of the plaintiffs was distinguished from the same medicine made by others by use of the words *Pain*

Tm., 5 C. D. 353 (1877), and Porter, M. R., in *Watt* v. *O'Hanlon*, 4 R. P. C. p. 15 (1887); and Chatterton, V.-C., in *Bodega Co.* v. *Owens*, 6 R. P. C. 241 (1888), both Irish cases. In *Leonard & Ellis' Tm.*, 26 C. D. p. 295 (1884), Lord Selborne said: "As to the word *Valroline*, I for my part am not disposed to doubt that, if that word had been used in the United Kingdom as a trade-mark before the passing of the Act, it might have been registered under the Act." See also p. 189, note (*s*).

(*n*) Fry, L. J., expressly reserved this question, *Richards* v. *Butcher*, (1891) 2 Ch. p. 547; 8 R. P. C. 249, Kay, J., and C. A.

(*o*) Page 190, note (*y*).

(*p*) 5 R. P. C. 333, Kay, J., and C. A. (1888); and 15 App. Cas. 316; 7 R. P. C. 336, H. L.

(*q*) The question was also referred to by Kay, J., in *Grossmith's Tm.*, 6 R. P. C. 180; 60 L. T. 612 (1889), (*Emollio Cream*). Cf. *Wright, Crosley & Co.'s Tm.*, 15 R. P. C. 131 (1898), where Romer, J., held that *Wright, Crossley & Co.*, which had been registered as an old mark, was not on the face of it an illegal or improper mark. In the Court of Appeal this point was not decided; 15 R. P. C. 377.

(*r*) Cf. *The Nourishing Stout Case*, *Raggett* v. *Findlater*, L. R. 17 Eq. 29 (1873), Malins, V.-C.

Killer; on the contrary, it appeared that there was no competition in its manufacture. It would appear, therefore, that the present state of the law is that laid down by Kekewich, J., in the case cited above, and this is, it is submitted, the proper construction of the Act.

So a geographical word may be registered if it was used as a trade-mark and had acquired a secondary distinctive meaning before the 13th of August, 1875 (*s*).

Examples of old word-marks.

The following words have been held not to be special and distinctive words: EMOLLIO cold cream, *Grossmith's Tm.*, 6 R. P. C. 180; 60 L. T. 612; BAFFLE safes, *Talbot* v. *Webley*, 3 R. P. C. 276; PERRY-DAVIS' VEGETABLE PAIN KILLER, *Perry, Davis* v. *Harbord*, 15 App. Cas. 316; 7 R. P. C. 336; VASELINE, *Chesebrough Manufacturing Co.'s Tms.*, 18 R. P. C. 191 (*t*).

And the following have been admitted to registration as such: FRIGIDOMO, for a hot-house plant wrap, *Edgington's Tm.*, 6 R. P. C. 513; 61 L. T. 323; FAMILY SALVE, *Reinhardt* v. *Spalding*, 49 L. J. Ch. 57; EXCELSIOR SPRING MATTRESS, *Chorlton and Dugdale's Tm.*, 53 L. T. 337; J. & J. HOPKINSON (for pianos), *Hopkinson's Tm.*, (1892) 2 Ch. 116; 9 R. P. C. 102.

Used as a trade-mark.

Used as a trade-mark.

What is use as a trade-mark has already been considered in Chapter II. The following paraphrase by Lord Esher (*u*) of the judgment of the Court of Appeal in *Palmer's Case* (*x*) sums up the rules there stated: "Let us see what was used in the trade, and let us see whether any article was ever in the market made by these people with these words

(*s*) See the judgments of Cotton, L. J., in *Van Duzer's Tm.*, 34 C. D. p. 635; 4 R. P. C. 31 (1887); and of Kay, J., in *Compagnia General de Tobacos* v. *Rehder*, 5 R. P. C. 61 (1887), (*Carite*).

(*t*) In *Dewar & Sons, Ld.* v. *J. H. Dewar*, 17 R. P. C. 341 (1900), a Scotch case; Lord Kyllachy said that he was not satisfied that the words *Dewar's Whisky* were sufficiently "special and distinctive," but did not decide the point. And in *Day* v. *Riley*, 17 R. P. C. 517, the question was discussed but not decided, whether the words "Day & Son's Black Drink" were special and distinctive. Cf. *Taylor* v. *Taylor*, 23 L. J. Ch. 255 (1854) (*Taylor's Persian Thread* in a label).

(*u*) *Spencer's Tm.*, 3 R. P. C. p. 74; 51 L. T. 659 (1886).

(*x*) 24 C. D. 504 (1883), (*Braided Fixed Stars*).

only on them. If we find these words on goods in the market, which are said to be distinguishing marks on the goods, and on the same goods other marks, and never on any goods these words alone, then the conclusion of fact is that what was used upon the goods to distinguish them was all that was on the goods; and we are not going to inquire whether part of what was put on all the goods to distinguish them was at one end of the goods or at the other end of the goods, or whether they were an inch or half an inch apart, or even whether part was at the top and lapping over the side, or whether part was on one side and part on the other. If you find that they are on goods for the purpose of distinguishing the goods, that makes the user one user."

In accordance with these principles, it has been held that words used only as a description of the goods (*y*), for instance, in ordering them from the applicant, are not used as trade-marks, and that a device employed as a pattern or design mark (*z*) is not so used either.

Use on bottles or boxes only.

So also it has been considered that the use of words upon rough packing-cases containing bottles of wine (*a*), or sauce (*b*), or medicine for animals (*c*), or upon the side of a wine cork where they cannot be seen (*d*), is not a use of them as a trade-mark, since it does not "sell the goods" (*e*), although in some cases, for example, where the goods are cigars, soap, or the better classes of candles, the trade-mark may be, and almost invariably is, put not upon the goods themselves, but on the boxes which contain them (*f*). But in such cases the

(*y*) *Hayward's Tm.*, 54 L. J. Ch. 1003 (1885), Kay, J., (*Coker Canvas*); *Talbot* v. *Webley*, 3 R. P. C. 276 (1886), Bacon, V.-C., (*Baffle Safes*); *Montgomery* v. *Thompson*, 41 C. D. 35; 6 R. P. C. 404 (1889), C. A., (*Stone Ale*); *Powell's Tm.*, (1893) 2 Ch. 388; 10 R. P. C. 63, 195 (*Yorkshire Relish*), Chitty, J., and C. A., aff. by H. L. (1894), A. C. 8; 11 R. P. C. 4.

(*z*) *Harrison's Tm.*, 42 C. D. 691; 7 R. P. C. 25 (1889), Kekewich, J., (*Albion*).

(*a*) *Richards* v. *Butcher*, (1891) 2 Ch. 522; 8 R. P. C. 249, Kay, J., and C. A.

(*b*) *Powell's Tm.*, *supra*.

(*c*) *Day* v. *Riley*, 17 R. P. C. 517 (1900), Buckley, J.; and see *European Blair Camera Co.'s Tm.*, 13 R. P. C. 600, below, p. 192.

(*d*) *Kinahan's Tm.*, 10 R. P. C. 393, above, p. 30.

(*e*) Chap. II., p. 30.

(*f*) *Powell's Tm.*, *supra*.

boxes go into market and are bought with their contents by the purchasers, to whose attention the marks are directed.

Where the applicant has another trade-mark.

The use by the applicant of a trade-mark other than and distinct from the marks which he is seeking to place or maintain on the Register as an old mark is a circumstance to be considered in determining whether he used the mark in question as a trade-mark, but it is not conclusive that he did not, for traders often have numerous trade-marks and they not infrequently use two or more of them on the same goods at once (*g*).

Old mark must have been used as registered, and alone.

And, as stated in the passage quoted above (*h*), the mark sought to be registered must have been used, in the form in which it is offered for registration (*i*), and as a separate mark complete in itself (*j*), as a trade-mark before the 13th of August, 1875 (*k*). So that words taken out of a label which was an old trade-mark (*l*), and words which had been used as a trade-mark when combined with a device (*m*), or with the name of the proprietor (*n*), or with other words (*o*), and which were not shown to have been separately used as trade-

(*g*) *Powell's Tm.*, (1893) 2 Ch. pp 394, 406, 411; 10 R. P. C. 63 and 195; (1894) A. C. 8; 11 R. P. C. 4, Chitty, J., C. A. and H. L., (*Yorkshire Relish*); *Richards* v. *Butcher*, (1891) 2 Ch. 522; 8 R. P. C. 249, Kay, J., and C. A., (*Monopole*); *Leather Cloth Co.* v. *American Leather Cloth Co.*, 11 H. L. C. 523; 35 L. J. Ch. 53 (1865).

(*h*) Page 190.

(*i*) *Mens' Application*, (1891) 1 Ch. 41; 8 R. P. C. 25, Chitty, J., (*Key Brand Geneva*); *Fuente's Tm.*, (1891) 2 Ch. 166; 8 R. P. C. 214, Romer, J., both combination marks. As to the alteration of an old mark under sect. 92, see Chap. XI., p. 297.

(*j*) *Spencer's Tm.*, 3 R. P. C. 73; 54 L. T. 659 (1886), Chitty, J., and C. A., and the cases next cited.

(*k*) Small user is, of course, sufficient, *Wright, Crossley & Co.'s Application*, (1900) 2 Ch. 218; 17 R. P. C. 386, Byrne, J.

(*l*) *Palmer's Tm.*, 24 C. D. 504 (1883), C. A., (*Braided Fixed Stars*); and see *The Stone Ale* and *Yorkshire Relish Cases*, *supra*.

(*m*) *Spencer's Tm.*, *supra*, *Diamond Cast Steel* combined with a cutler's mark; *Leonard & Ellis' Tm.*, 26 C. D. 288 (1884), Pearson, J., and C. A., (*Valvoline*).

(*n*) *Richards* v. *Butcher*, (1891) 2 Ch. 522; 8 R. P. C. 37, 249 (1891), Kay, J., and C. A., *Monopole*, with *Heidsieck & Co.*

(*o*) *Perry, Davis* v. *Harbord*, 15 App. Cas. 316; 5 R. P. C. 333; 7 R. P. C. 336 (1888), Kay, J., C. A. and H. L., (*Perry-Davis' Vegetable Pain Killer*); and *John Dewar & Sons, Ld.* v. *J. H. Dewar*, 17 R. P. C. 341 (1900), Court of Session, where *Dewar's Whisky* had been registered, but it was held that the name under which the whisky had been sold was *Dewar's Perth Whisky* or *John Dewar's Perth Whisky*.

marks, apart from the other matter, have been refused registration or removed from the Register.

Use for the same goods.

The mark must, moreover, have been used as a trade-mark for the class of goods in respect of which it is to be registered (*p*), for it is only in respect of them that it is an old mark; and if registration is applied for in other classes the application, so far as regards such other classes, must be treated on the footing that the mark was not used before the 13th of August, 1875 (*q*). But use on goods essentially the same as those in the class to which the application relates, although they pass under a different name owing to slight variations in size or shape, is sufficient to qualify a mark as an old mark. Thus a mark used on hatchets and augers has been admitted as an old mark for axes and gimlets (*r*).

Use in the United Kingdom.

The use must have been use as a trade-mark in the United Kingdom (*s*), and mere importation into a British port for the purpose of re-shipment and transportation is not sufficient (*s*).

(*p*) Chap. V., p. 96.

(*q*) *Jelley, Son & Jones' Application*, 51 L. J. Ch. 639 n.; 46 L. T. 381 n. (1878), Jessel, M. R.; and see *Leonard & Ellis' Tm.*, 26 C. D. 288 (1884), C. A., cited pp. 155 and 188; *Harrison v. Woodroffe*, 42 C. D. 691; 7 R P. C. 25 (1889), Kekewich, J., and *Batt's Tm.*, (1889) A. C. 428; 16 R. P. C. 411.

(*r*) *Jackson & Co. v. Napper*, 35 C. D. 162; 4 R. P. C. 45 (1886), Stirling, J.

(*s*) *Meens' Application*, (1891) 1 Ch. 41; 8 R. P. C. 25, Chitty, J.; *Monck's Application*, 50 L. T. 12 (1884), Chitty, J. In *Jackson & Co. v. Napper*, 35 C. D. p. 177; 4 R. P. C. 45, (1886) Stirling, J., said: "You must make out user *in England*"; but the learned judge probably used the name of the only part of the United Kingdom in which user had been suggested, without intending to exclude user in Scotland or Ireland. The question whether foreign user was sufficient was raised as early as *Leonard & Ellis' Tm.*, 26 C. D. 288 (1884), C. A. In *The European Blair Camera Co.'s Tm.*, 13 R. P. C. 600 (1896), Stirling, J., a foreigner sold to an importer and sent the goods into this country in cases bearing the word *Bull's-eye* and his trade-name, and also used the word in pamphlets sent with the goods; the importer himself sold the goods apart from the cases, and to the public the word had become known only in connection with goods sold by the importer. It was held that there had been such use of the word in connection with the goods in this country as would have entitled the foreigner to oppose the registration of the word by the importer, and the registration which had been effected in the name of the latter was expunged. The case does not decide that there was user of the word *as a trade-mark*. As to user on cases, see p. 190.

User which was commenced and continued in fraud of the rights of the owner of another trade-mark cannot qualify a mark for registration (*t*). The registration of the mark in such case would, besides, almost necessarily be within the prohibition of sect. 72 or sect. 73, as calculated to deceive. Fraudulent user.

The owner of an old trade-mark does not lose his title to register by merely ceasing to use it for a time (*u*), provided that the cessation of user does not amount to abandonment (*v*), or because other traders have infringed his right (*x*), unless the infringements have been so extensive as to make the mark common (*v*). Temporary cessation of user.

Slight evidence of user as an old mark will be accepted, it is said, even the production of a single label (*y*), at any rate after the mark has been registered and used for a long time. And where a mark has stood upon the Register unchallenged for years, and important witnesses have died who might have given evidence of qualifying user before 1875, the Court accepts evidence of non-user, put forward by any one who seeks to procure the removal of the mark from the Register, with considerable hesitation (*z*). Slight evidence of user sufficient.

Where, on a motion to expunge, the owner of the mark does not appear to defend it, the onus is still on the applicant to prove non-user, and he may be in some difficulty in making out such a case (*a*). But although the onus of proving non-user before 1875 is, at all events in the case of an old trade-mark which has been five years on the Register, on the person attacking the validity of the mark, the onus may be

(*t*) *Heaton's Tm.*, 27 C. D. 570 (1884), Kay, J., (*Hoop L Iron*); *Monck's Application*, note (*s*).

(*u*) *Mouson* v. *Boehm*, 26 C. D. 398 (1884), Chitty, J., cited p. 385; cf. also *Daniel & Arter* v. *Whitehouse*, (1898) 1 Ch. 685; 15 R. P. C. 134, Barnes, J., a passing off case.

(*v*) Chap. XIV., p. 338.

(*x*) See *Heaton's Tm.*, *supra*.

(*y*) *Chorlton & Dugdale's Tm.*, 53 L. T. 337 (1888), Pearson, J.; *Palmer's Tm.*, 21 C. D. 47; 24 C. D. 504 (1882), Chitty, J., and C. A. The usual evidence is the production of old prints and dies or blocks for printing.

(*z*) *Edgington's Tm.*, 6 R. P. C. 513; 61 L. T. 323 (1889), Kay, J.

(*a*) In *Royal Baking Powder Co.'s Tms.*, 14 R. P. C. 425 (1897), Romer, J., where the applicants were successful, they showed that they had on first hearing of the mark some years before cautioned a person who represented the registered proprietor against using the mark, and heard no more of it for ten years afterwards.

shifted. Thus, in a Scotch case in which the owners of the mark led in the proof, but called no evidence to show such user, and the mark had not been registered till 1891, and the evidence showed that during the period which it covered, commencing at some date subsequent to 1875, and down to the date of the proceedings a different trade-mark had been used (*b*), it was held that the onus was shifted on to the owners, and that, as they had not discharged it, the presumption was that there had been no user prior to the 13th of August, 1875 (*c*).

Colour.

Trade-marks may be registered in any colour.

By sect. 67—

"A trade-mark may be registered in any colour [or colours] (*d*), and such registration shall (subject to the provisions of this Act) confer on the registered owner the exclusive right to use the same in that or any other colour [or colours]" (*d*).

This provision was introduced by the Act of 1883, and the words "or colours" were added in 1888. Under the Act of 1875 colours could not be registered (*e*).

Registration in colours.

A trade-mark propounded for registration in colours must, however, be distinctive within the meaning of sect. 64, independently of the colours (*f*). An oblong label divided into three sections, which were respectively printed in red, white, and blue, was accordingly held not to be distinctive (*g*). Colour, said Kay, J., is treated as an accident, and if the

(*b*) *Dewar's Perth Whisky*, the registered trade-mark being *Dewar's Whisky*.

(*c*) *John Dewar & Sons, Ld.* v. *J. H. Dewar*, 17 R. P. C. 311 (1900), Court of Session.

(*d*) Act of 1888, sect. 11.

(*e*) See *Robinson's Tm.*, 29 W. R. 31 (1880), Jessel, M. R. The decision that a gold coin mark could not too nearly resemble a silver coin mark in this case is inconsistent with the later authorities cited below.

(*f*) See above, p. 142.

(*g*) *Hanson's Tm.*, 37 C. D. 112; 5 R. P. C. 130 (1887), Kay, J. But the same mark, registered without colours, *i.e.*, as a label with three parallel stripes and the words *red, white and blue*, had been protected from infringement by the use of a similar coloured label comprising the same words, *Hanson* v. *British Tea, &c. Association* (1884), Bacon, V.-C., and C. A.; Sebastian, 4th ed. p. 338.

mark were registered the applicant might use it in any colours he chose. "You may register a mark, which is otherwise distinctive, in colour, and that gives you the right to use it in any colour you like; but you cannot register a mark of which the only distinction is the use of a colour, because, practically, under the terms of the Act, that would give you a monopoly of all the colours of the rainbow."

The difficulties of registration in connection with mere colour marks, such as the line headings for cotton piece goods are referred to in the earlier part of the chapter (*h*).

Bearing of colour upon the resemblance of marks.

The colours in which a mark is actually used, or is likely to be used, have often a material bearing upon questions of alleged resemblance calculated to deceive, or of infringement (*i*); for instance, a design similar in outline to that of the device in another mark, but filled up in a totally different manner, may have the distinctive filling up obscured by the use of a deep colour in printing (*k*). Again, registration of a mark which contained Oriental words meaning *The Golden Fan Brand*, was refused on account of the presence on the Register of a fan mark, which in use was in gold colour (*l*), and the refusal was upheld by the Court of Appeal. The fact that a registered owner may use his mark in any colour must also be taken into consideration. Thus, the words *red star brand* were directed to be removed from the Register on the ground that they constituted a mark having such resemblance to a star device mark, which might be coloured red in actual use, as to be calculated to deceive (*m*).

In some cases marks have been allowed to be entered or retained on the Register upon the proprietors undertaking to use them in particular colours only, a note of the undertaking

(*h*) Above, p. 150.

(*i*) *Mitchell* v. *Henry*, 15 C. D. 181 (1880), C. A.; *Turney & Sons' Tm.*, 11 R. P. C. 37 (1893), North, J. See also *Lever Bros., Ld.* v. *Bedingfield*, 16 R. P. C. 453; affirmed as to infringement, 16 R. P. C. 3, (1898) Kekewich, J., and C. A.

(*k*) *Worthington's Tm.*, 14 C. D. 8 (1880), C. A.; *Biegel's Tm.*, 4 R. P. C. 525; 57 L. T. 247 (1887), Chitty, J., *Turney & Sons' Tm.*, *supra*.

(*l*) See *Deuchurst's Application*, (1896) 2 Ch. 137; 13 R. P. C. 288.

(*m*) *Société, &c. de l'Étoile's Tm.*, (1894) 1 Ch. 61; 2 Ch. 26; 10 R. P. C. 436; 11 R. P. C. 142; Stirling, J., and C. A.

being placed on the Register (*n*). It is, however, doubtful whether the Court would now order registration with such a note (*o*).

(*n*) *Re Jeffrey & Co.*, 18 May, 1888, Stirling, J., registration allowed with note binding applicants not to use mark in black, or any colour so dark as to resemble black; *Re Johnson, Philpott & Co.*, 21 Feb. 1888, North, J., Register rectified by consent, by adding note that the proprietor was only to use his mark in blue and white. Both cases are cited Sebastian, 4th ed. p. 338.

(*o*) Page 195, note (*l*).

CHAPTER IX.

ADDITIONS AND DISCLAIMERS.

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It is provided by sect. 64 of the Act (*a*) that a trade-mark for registration under the Act must consist of, or contain, one at least of the essential particulars enumerated in that section. The trade-mark is not, however, necessarily confined to such essential particulars, but it may comprise other matter also, as, for instance, statements of quality or price (*b*), or descriptive or ornamental matter (*c*), and most trade-marks do, in fact, comprise some such additions to the parts of the marks which are claimed and protected as their essential particulars. All the

(*a*) Chap. VIII., p. 117.
(*b*) Cf. sect. 66, series of marks, above, p. 100.
(*c*) See, however, below, p. 199.

Acts have provided for such additions; the provision in the present Act (*cc*), which, with immaterial verbal changes, is the same as the corresponding sections of the Acts of 1875 (*d*) and 1883 (*e*), being in the following terms:—

Additions to the essential particulars.

"There may be added to any one or more of *these* [the essential] particulars [mentioned in this section] any letters, words, or figures (*f*), or combination of letters, words, or figures, or any of them" (*g*).

Lord Herschell's Committee on additions and disclaimers.

Remarking upon this provision, Lord Herschell's Committee reported as follows (*h*):—"It is said, and we think truly, that it is not easy to understand what is the exact status of the added matter provided for by sect. 64. Where the added words are not common to the trade in the goods with respect to which the application is desired, the right of exclusive user need not be disclaimed (*i*), yet it is presumed that the proprietor of the trade-mark could not object to their use by any other person except in connection with the essential particular of his trade-marks. What purpose then do they serve? Perhaps they may be useful in the case of a colourable imitation of the essential particular. If, with such an imitation, the added words were used, it would assist the proprietor in establishing that his trade-mark had been infringed. But the added matter may, it is assumed, be of so distinctive a character as to form an essential part of the trade-mark so that its use might be an infringement. We think it would clearly be desirable that the added matter, which the proprietor does not claim the exclusive use of, should be disclaimed, so that the public may know exactly what is the trade-mark registered. We think, too, that all disclaimers should appear in connection with the mark in the official journal."

In consequence of the recommendation above quoted, what

(*cc*) Sect. 64 (2), Act of 1888, s. 10.

(*d*) Sect. 10.

(*e*) Sect. 64 (2).

(*f*) "Figures" here means numerals, *Exp. Stephens*, 3 C. D. 659 (1876), Jessel, M. R.

(*g*) The word in italics was repealed, and the words in brackets were added by the Act of 1888, which added also to the sub-section the provision for identification of essential particulars and disclaimer of additions referred to below.

(*h*) Report of 1888, p. xii.

(*i*) That is, of course, under the Act of 1883, as unamended.

is now the latter part of sect. 64 (2), and also sect. 64 (3) (i) were added by the Act of 1888. The former provides that—

Disclaimers to be made in the application to register.

["The applicant for registration of any such additional matter must state in his application the essential particulars of the trade-mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the Register."] (*j*).

Stirling, J., speaking of sub-sects. 64 (2) and (3) (i), said: "Now, the object of that seems to have been this: that persons who are owners of trade-marks, or desire to have them registered, are to be entitled to register them, not, so to speak, as bare trade-marks consisting of the essential particulars defined by sub-sect. (1); but are to be allowed to make statements with reference to any matters which might occur to them in reference to the goods themselves, obviously with reference to those who manufactured them; obviously also with reference to the place where they were manufactured, and it seems to me to have been the object, having regard to the proviso contained in sub-sect. (3), to enable the owner of the trade-mark to state on the face of the mark who was the owner, that is to say, the manufacturer of the goods to which the mark applied and the place at which they were manufactured, so as to identify the goods denoted by that mark with that particular manufacturer and that particular place of manufacture" (*k*).

Devices.

It is noticeable that devices are not expressly included among the things that may be registered as added matter under sect. 64. But there appears to be no reason why they should be excluded by the Act. The only case in which the question whether a device can be registered as added matter has been discussed under sect. 64 is, it is believed, *Re König and Ebhardt's Tm.* (*l*), where Stirling, J., allowed the mark to be registered with a disclaimer (which the applicants

(*j*) Statements and disclaimers under this section and sect. 74 have since 1891 been advertised with the marks. See Official Notice, Appendix, p. 732.

(*k*) *Colman's Application*, (1894) 2 Ch. 115; 11 R. P. C. 129.

(*l*) (1896) 2 Ch. 236; 13 R. P. C. 449. The applicants contended that the crown was a part of their distinctive device, not an addition to it. The distinction between the treat-

offered) of a crown. If a device can be registered as added matter, it must be by reason of the discretion in the Comptroller, and not of express words under the Act.

Disclaimers in respect of additions which are *primâ facie* distinctive, but are in fact common to the trade in question, were already required by the Act of 1883, and they are dealt with by a separate section of the Act, sect. 74, which is set out below. In that section the additions which it authorizes are referred to as additions to the *mark*. Whether or not there is intended to be a distinction between additions to the *mark* and matter added to the *essential particulars* of it (which is the form of phrase in sect. 64), is discussed below (*l*).

The reason for requiring the essential particulars of a mark tendered for registration to be specified, and the remaining matter contained in it to be disclaimed is, then, that the exact status of the latter may be defined. It is an advantage to traders to have the whole trade-mark, with all the common marks and words, the descriptive additions and the other added matter, if any, all reproduced upon the Register as it is printed when the trade-mark is in actual use (*m*); and, on the other hand, it is material that the public should know what parts of the mark as registered may be lawfully used by others than the proprietor. The statement and disclaimer are also of service to enable the Comptroller and the Court to more readily determine whether a mark which it is sought to place upon, or to remove from, the Register does or does not comply with the requirements of sect. 64. In *Colman's Application* (*n*), Stirling, J., expressed the view that, whilst it might be that when a person came to register a trade-mark, and had to make out that it contained an essential particular, the Act ought to be read in the strictest manner against him, and he ought not to be allowed to register unless he made out clearly that he had one of the

ment of old and new marks under sect. 74 is mentioned below, p. 205. See also *Baker* v. *Rawson*, 8 R. P. C. 89, in which, the mark having been registered under the Act of 1875, a disclaimer of a common device was ordered to be entered on the Register.

(*l*) See below, p. 209.

(*m*) See *Kuhn & Co.'s Tm.*, 53 L. J. Ch. 238 n. (1878), Jessel, M. R.

(*n*) (1894) 2 Ch. 115; 11 R. P. C. 129.

essential particulars, as regards the added matter which was to be disclaimed there was no necessity for reading the Act so strictly.

It has been recently decided that this sub-section applies to such old marks as do not come within sect. 64 (3) (ii) (*o*).

The "essential particulars" of a registered trade-mark are not necessarily all its distinctive parts.

It is necessary to guard against a possible confusion which may arise from the use of the words "essential particulars" with somewhat different meanings in connection with trade-marks. All the material and distinctive parts of a trade-mark, and all its prominent features are sometimes spoken of as its essential particulars, and these may include items which do not fall within the list of symbols in sect. 64 (1); for instance, they may comprise words which, although distinctive, are not capable of registration under sect. 64 (1) (d), or sect. 64 (1) (e). It follows, however, from the sub-section set out above, that all the items of a composite trade-mark which are not referable to any of the classes enumerated in the list contained in the Act, are to be treated as "added matter," and that no exclusive rights in regard to such items are conferred by the registration. Of course, the trade-mark may, as a whole, fall into one of the classes—for example, as a distinctive label or an old mark falling within the proviso contained in sect. 64 (3) (ii).

Additions to labels.

In *Clement et Cie.'s Tm.* (*p*) it was contended that the words *St. Raphael* on a registered label should be considered as an addition, and disclaimed under sect. 74, but the Court of Appeal, affirming Kekewich, J., held that, the registered thing being the whole label, the words were not an addition to the mark but part of it (*q*). In this case the mark as actually used was printed on two separate labels which were affixed to the goods in the same relative position as shown in the mark, one being above the other. The lower label contained the words *Saint-Raphael Tannin Wine*, with a description of the wine, and a signature *St. Raphael*;

(*o*) *Wright, Crossley & Co.'s Application*, (1900) 2 Ch. 218; 17 R. P. C. 386, Byrne, J.; and see *supra*, p. 185.

(*p*) (1900) 1 Ch. 114; 16 R. P. C. 173 and 611, Kekewich, J., and Lindley, M. R., Sir F. Jeune, and Romer, L. J.

(*q*) The Court held that there was a label as distinguished from words coupled with mere flourishes and so on. See also below, p. 203.

Romer, L. J. (*r*), expressed the opinion that this label was an addition to the mark within sect. 64 (2).

Disclaimer on appeal.

The provision that the statement and disclaimer shall be contained in the application is not merely directory. It cannot be waived by the Court on an appeal from the comptroller (*s*). The two earlier cases cited were both decided on sect. 74, and in respect of applications made before the Act of 1888 came into operation, and therefore after advertisement of the application; but the terms of sect. 74 and sect. 64 (2), as amended by the last-mentioned Act, correspond, and in *Wright, Crossley & Co.'s Application* (*s*), Byrne, J., put the same construction on the latter section.

It is further provided by sect. 64 (3) (i) that—

The proprietor need not disclaim his own name.

["A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business; but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof"] (*t*).

Trade-name.

This provision was also added by the Act of 1888. A trader has, as is shown elsewhere (*u*), a right to the exclusive use of his own name, limited by the rights of other traders so to honestly use their own names, or the names which they honestly adopt, as not to pass off their goods as his. This exists independently of the law of trade-marks, and the report of Lord Herschell's Committee in reference to the present clause, shows that it was intended to leave such right unaffected. The Committee say: "Some misapprehension might perhaps arise if the person registering the mark were compelled to disclaim his own name, or the foreign equivalent of it. We think, therefore, this might be excluded from the necessity of disclaimer; but it should

(*r*) The mark was registered under the Act of 1883, so no question of disclaimer under sect. 64 arose.

(*s*) *Goodall's Tm.*, 42 C. D. 566 (1889), North, J.; *Re Meens' Application*, (1891) 1 Ch. 41; 8 R. P. C. 25, Chitty, J.; *Wright, Crossley & Co.'s Application*, (1900) 2 Ch. 218; 17 R. P. C. 386, Byrne, J.; *Players' Application*, (1901) 1 Ch. 382; 18 R. P. C. 65, Cozens-Hardy, J. See, however, *König and Ebhardt's Tm.*, cited p. 199. As to the Comptroller's power of amendment, see Chap. IV., pp. 78 and 84.

(*t*) Act of 1888, s. 10.

(*u*) See Chap. XVI., p. 500.

be provided that the proprietor of the mark should not thereby acquire the right to prevent any other person *bonâ fide* using his own name in connection with his goods."

Effect of the registration of a trade-name as part of a trade-mark.

It will be observed that the restriction on the rights of a registered proprietor arising out of the saving clause is more limited than that which a disclaimer, if registered, would create. Apart from the Act, as already stated, a trader can only be restrained from using a name which is similar to that of another trader if he uses it so that his business would in the ordinary course of human affairs be likely to be confounded with that of the other (*v*). Under the Act, however, if the name or the description of the place of business registered as parts of the trade-mark are material parts, it is presumed that section 76 would confer on the proprietor exclusive rights to the use of the name and description under all circumstances, save only as against "an owner of the same name" (*x*), and, of course, only for use in connection with the goods for which the mark is registered (*y*).

Descriptive trade-name.

It has been held under this proviso that a company need not disclaim common words which describe the article it deals in, and which appear upon its trade-mark, if they form part of its name and appear on the mark as such (*z*). And also that it is not necessary that the whole of the applicant's name should appear in order that he should have the advantage of the proviso. If he is fairly using a part of his name he need not disclaim it (*a*). And this applies to a firm name, at all events in the case where the part of the name enters into the name of each partner (*a*); but it would not, of course, apply in a case in which the mark, by reason of the use of part of the name instead of the whole, was calculated to deceive (*a*). It would seem that the trade-name of an applicant is within the privilege of the proviso (*a*), but not

Part of name.

(*v*) *Hendriks* v. *Montagu*, 17 Ch. D. 638 (1881) C. A.; and see *Tussaud* v. *Tussaud*, 44 C. D. 678 (1890), Stirling, J., and the cases there cited, and *Valentine Meat Juice Co.* v. *Valentine Extract Co.*, 17 R. P. C. 1 and 673 (1900). See also Chap. XVI., p. 500.

(*x*) Sect. 64 (3) (i).

(*y*) See Chap. XII., p. 306.

(*z*) *The Smokeless Powder Co.'s Tm.*, (1892) 1 Ch. 590; 9 R. P. C. 109, Chitty, J.

(*a*) *Colman's Application*, (1894) 2 Ch. 115; 11 R. P. C. 129, Stirling, J. (*Colman's Mustard*).

Name in possessive case.

the name of his predecessor in title, as such, although he be entitled to the exclusive use of such name (*aa*). The applicant's name in the possessive case occurring in a label need not be disclaimed (*b*).

Additions which are common to the trade.

Additions are further provided for by sect. 74 of the Act of 1883, which deals with additions "common to the trade" in the goods with respect to which the registration is made.

The section is in the following terms:

Saving for power to provide for entry on Register of common marks as additions to trade-marks.

"**74.** (1.) Nothing in this Act shall be construed to prevent the Comptroller entering on the Register, in the prescribed manner, and subject to the prescribed conditions, as an addition to any trade-mark—

Common addition to old mark;

"(a) In the case of an application for registration of a trade-mark used before the 13th day of August, 1875—

"Any distinctive device, mark, brand, heading, label, ticket, letter, word, or figure (*c*), or combination of letters, words, or figures, though the same is common to the trade in the goods with respect to which the application is made;

to new mark.

"(b) In the case of an application for registration of a trade-mark not used before the 13th day of August, 1875—

"Any distinctive word or combination of words, though the same is common to the trade in the goods with respect to which the application is made;

"(2.) *The applicant for entry of any such common particular or particulars must, however, disclaim in his application any right to the exclusive use of the same, and a copy of the disclaimer shall be entered on the Register.*

Disclaimer.

"[(2.) The applicant for registration of any such addition must, however, state in his application the essential particulars (*d*) of the trade-mark, and must

(*aa*) *Birmingham Vinegar Brewery Co.'s Application*, 11 R. P. C. 193 (1894), Kekewich, J.

(*b*) *Colman's Application*, (1894) 2 Ch. 115; 11 R. P. C. 129, Stirling, J. (*Colman's Mustard*).

(*c*) *I.e.*, numeral, p. 198, n. (*f*).

(*d*) See p. 199, above.

disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the Register.]

"[Provided that a person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof.] (*e*)

"(3.) Any device, mark, brand, heading, label, ticket, letter, word, figure, or combination of letters, words, or figures, which was or were, before the 13th day of August, 1875, publicly used by more than three persons on the same or a similar description of goods shall, for the purposes of this section, be deemed common to the trade in such goods."

The three mark rule.

Sub-sect. (2) of the original section was replaced by the present sub-sect. (2) in order to bring the requirements of this section into accord with the corresponding provisions of sect. 64 as amended, which are in the same words (*f*).

The registration of common words in a trade-mark confers no monopoly.

Under the Act of 1875, the disclaimer of common additions could not be forced upon an applicant who refused to consent to it as a condition of registration (*g*), although the fact of registration gave him no right to the exclusive use of them (*h*), and the present section was, no doubt, introduced in order that the Register might be made to show that the additions were not appropriated by the registration.

Common additions to old and to new marks.

It will be seen that the section distinguishes between old marks used before the 13th of August, 1875, and new marks first used since that date; the distinction is not, as in sect. 64 it has been held to be (*i*), between old marks falling within sect. 64 (3) (ii) and other marks. As to all old marks, the policy of the Act is to put them upon the

(*e*) Act of 1888, s. 16, above, p. 202.

(*f*) As to the effect of the alteration, see below, p. 209.

(*g*) The Register might have been rectified by placing a disclaimer upon it. See *Re Haycard's Tm.*, 54 L. J. Ch. 1003 (1885), Kay, J.; and *Baker* v. *Rawson*, 8 R. P. C. 89; 45 C. D. 529 (1891).

(*h*) *Hudson's Tm.*, 32 C. D. 311; 3 R. P. C. 155 (1886) C. A., decided upon the Act of 1875, though after that of 1883 was passed.

(*i*) *Wright, Crossley & Co.'s Application*, (1900) 2 Ch. 218; 17 R. P. C. 386.

Register exactly as they were used (*j*); and accordingly, while the addition authorized for new marks by the section is confined to "any distinctive word or combination of words," that authorized for old marks is "any distinctive device, mark, brand, heading, label, ticket, word, or figure, or combination of letters, words, or figures." So that while, apparently, the section adds nothing to what is allowed to be registered by sect. 64 (2) as an addition, namely, "any letters, words, or figures, or combination of letters, words, or figures, or any of them," in the case of new marks, it considerably increases the list in the case of all old marks.

Distinctive means *primâ facie* distinctive.

The section is expressed to apply only to additions which are distinctive, but as those which are really distinctive (*k*) cannot be at the same time "common to the trade," distinctive must here mean *primâ facie* distinctive (*l*), that is to say, the section applies to additions which would be distinctive if they were not common to the trade.

Common to the trade.

"Common to the trade" does not mean merely "commonly used in the trade," but "open to the trade to use," so that a word which has been once largely used in the trade, but has subsequently fallen out of use by all but one or two persons (*m*), or a word which is descriptive of the goods to which the mark is to be applied (*n*), if *primâ facie* distinctive, must be disclaimed under the section. Of course, any word may lawfully be used by any trader until it has been appropriated by use or registration as a trade-mark, so

Words used by one trader only.

(*j*) *Phillip's Tm.*, (1891) 3 Ch. 139; 8 R. P. C. 469, Chitty, J.; *Henry Clay & Co.'s Tm.*, (1892) 3 Ch. 549; 9 R. P. C. 449, Kekewich, J. Under the Act of 1875, the descriptive words *Filtre Rapide* were allowed to be registered, with a signature; *Maignen's Tm.*, 28 W. R. 759 (1880), Jessel, M. R. In *Wright, Crossley & Co.'s Application*, note (*h*), *supra*, Byrne, J., took the view that, as to old marks, sect. 74 only applies to additions to the mark as used.

(*k*) See Chap. VIII., p. 135. The word refers back to sect. 64, see the next case.

(*l*) *Burland* v. *Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J. (*Washerine*); *Thompson* v. *Miller*, 13 R. P. C. 35 (1896), Stirling, J., (*Roadster*); and *Faulder's Tm.*, 18 R. P. C. 37 (1901), Kekewich, J. (*Silverpan* held not to be distinctive). See also the judgment of Romer, L. J., in *Clement et Cie.'s Tm.*, (1900) 1 Ch. 114; 16 R. P. C. 611.

(*m*) *Burland* v. *Broxburn Oil Co.*, *supra*.

(*n*) *Humphries* v. *The Taylor Drug Co.*, 59 L. T. 820 (1888), Kekewich, J., (*Herbalin*).

that the statements in the cases just cited must be taken to mean that words, &c., which might lawfully be, and have been, used by traders other than the applicant for registration, or his predecessors in title, or which are incapable of appropriation—as descriptive words are—are "common to the trade." And this accords with the view expressed in the Court of Appeal in *Thompson* v. *Montgomery*, that the words *Stone Ale*, having never been used by any trader other than the trader who claimed them as a trade-mark, were not common to the trade (*o*). Lindley, L. J., said in that case: "Nothing, I apprehend, can be common to the trade, which is only used by one person in the trade."

The three mark rule.

It was held also in *The Washerine Case* (*p*) that the phrase in question is not controlled by the three mark rule of sub-sect. (3). That sub-section contains a rule for the particular case to which it refers, not a definition. "It might have been a question whether user by three or four, or five or six (*q*) persons would have made a word or combination of words common to the trade, and the proviso is introduced merely for the purpose of settling that question, which might have been a difficult one of fact, and saying that where you have user in the trade by more than three persons, then the name so used shall be deemed to be common to the trade" (*r*). The three mark rule was originally introduced by the Commissioners of Patents, but it was repeatedly recognized by the Courts before the present Act was passed (*s*). It applies whether the marks used by the three persons are precisely, or only substantially, similar, and whether they have been used as trade-marks or otherwise, provided that they have been used on the same or a similar description of goods (*s*). But use abroad does not fall within the rule (*t*).

(*o*) 41 C. D. 35; 6 R. P. C. 404 (1889).

(*p*) See note (*l*), *ante*, p. 206.

(*q*) As to the right of all or any of concurrent owners of a mark to sue, see below, p. 300.

(*r*) Per Chitty, J., 42 C. D. 280; 6 R. P. C. 402 (1889).

(*s*) See *Jelley's Application*, 51 L. J. Ch. 630 n. (1878); *The Walkden, &c. Co.'s Application*, 54 L. J. Ch. 394 n. (1877), both Jessel, M. R.; and *Wragg's Tms.*, 29 C. D. 551 (1885), Pearson, J.

(*t*) See *Münch's Application*, 50 L. T. 12 (1884), Chitty, J.

Common words in a distinctive label need not be disclaimed.

Words comprised in a distinctive label, which are common to the trade within the meaning of the section, need not be disclaimed (*t*), although Cotton, L. J., seems to have expressed a contrary opinion in *Hudson's Case* (*u*), for the label does not consist of each particular part of it, but consists of the combination of all the parts (*v*). The rule may now be regarded as settled by the cases cited, but in the earlier case of *Burland* v. *The Broxburn Oil Co.* (*x*), an order was made that the descriptive word *Washerine*, appearing in a registered label, should be disclaimed; and this was followed in *Thompson* v. *Miller* (*y*), where a similar order was made as to *Roadster* (*z*). In neither of these cases, however, was it alleged that the mark formed a distinctive whole capable of registration as an essential particular.

Common additions are not part of the trade-mark.

In *The Washerine Case* (*b*) Chitty, J., expressed an opinion that additions registered under sect. 74, are not part of the trade-mark to which they are attached, and Fry, L. J., appears to have held the same opinion (*c*). The Court of Appeal, affirming Kekewich, J., has since adopted that view (*d*). It would seem to follow that no exclusive rights in the additions are conferred by registration, since sect. 76 grants such rights in the trade-mark only, and consequently the provision for the disclaimers required by the section was unnecessary, except for the purpose of showing that the registered proprietor has no such rights upon the face of the

(*t*) *Smokeless Powder Co.'s Tms.*, (1892) 1 Ch. 590; 9 R. P. C. 109, Chitty, J.; *Apollinaris Co.'s Tms.*, (1891) 2 Ch. 186; 8 R. P. C. 137, C. A.; *Clement et Cie.'s Tm.*, (1900) 1 Ch. 114; 16 R. P. C. 173 and 611, Kekewich, J., and C. A. (Lindley, M. R., Sir F. Jeune and Romer, L. J.).

(*u*) 32 C. D. 311; 3 R. P. C. 155 (1886); see above, p. 154.

(*v*) Per Lord Esher, M. R., in *Pinto* v. *Badman*, 8 R. P. C. 181 (1891), see Chap. X., p. 230.

(*x*) 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J. A similar order was made in *Edge's Tm.*, 8 R. P. C. 207 (1891), Stirling, J., (*Filtered Blue*).

(*y*) 13 R. P. C. 35 (1896), Stirling, J., (*Roadster* for boots).

(*z*) See, however, *Wright, Crossley & Co.'s Application*, (1900) 2 Ch. 218; 17 R. P. C. 386; and cf. also *Birmingham Vinegar Brewery Co.'s Application*, 11 R. P. C. 195 (1894), Kekewich, J.

(*b*) See *supra*, note (*x*).

(*c*) *Apollinaris Co.'s Tms.*, (1891) 2 Ch. 233; 8 R. P. C. 165; *Pinto* v. *Badman*, 8 R. P. C. at p. 188.

(*d*) *Clement et Cie.'s Tm.*, *supra*. So, per North, J., in *Rosenthal* v. *Reynolds*, *infra*.

Register. The additions allowed to the essential particulars enumerated in sect. 64 are referred to in the section in different language, and they are clearly part of the trade-mark itself where they are distinctive.

Act of 1888.

The decision last referred to related, however, to the Act of 1883, and the section, as altered by the Act of 1888, is more difficult to construe. Sub-sect. 74 (2) as amended adopts the language of sect. 64 as amended; "essential particulars" are to be stated, and "added matter" is to be disclaimed, whereas the disclaimer was formerly of "such common particular or particulars." But in spite of the change of language in sub-sect. 74 (2), the words "addition to any trade-mark" in sub-sect. (1) appear generally to govern the section, and there is the further consideration that if the added matter of sect. 64 and the additions to the mark are synonymous, the provisions of sect. 74, so far as they relate to new marks, are pure surplusage; for if any words may be added subject to disclaimer under sect. 64, it is, on the assumption, unnecessary in sect. 74 to provide in particular for either the addition or disclaimer of distinctive words. Apparently, therefore, notwithstanding the alteration of language, sect. 74 is, under the Act of 1888, still intended to deal with additions to the mark (*e*) and not with additions to essential particulars. The distinction may not, however, be of practical importance.

Effect of registration with disclaimer.

The effect of a disclaimer is that the proprietor of the registered trade-mark cannot claim any trade-mark rights under the Acts, in respect of the parts of the mark to which the disclaimer relates (*f*), so that, for instance, no action for infringement lies in respect of the use or imitation of the disclaimed particulars. In one case (*g*) North, J., refused an interlocutory injunction in a passing off case on the ground

(*e*) See Fry, L. J., in *Pinto* v. *Badman*, *supra*. In that case the mark was registered under the Act of 1888.

(*f*) *Pirie* v. *Goodall*, (1892) 1 Ch. 35; 9 R. P. C. 17, V. Williams, J., and C. A., *Pirie's Parchment Bank*, the plaintiffs disclaimed *parchment* and *bank*, but sought to set up some right to the combination: as to this see *Hubbuck* v. *Brown*, 17 R. P. C. 638, (1900) C. A.; also *Baker* v. *Rawson*, 45 C. D. 529; 8 R. P. C. 89 (1890), North, J.

(*g*) *Rosenthal* v. *Reynolds*, (1892) 2 Ch. 301; 9 R. P. C. 189, North, J. See also *Packham* v. *Sturgess*, 15 R. P. C. 669 (1898), North, J.

that the plaintiff was relying on certain letters the exclusive use of which he had disclaimed. The Scotch Court of Session has, however, refused to follow North, J., on the point, and has held that such a disclaimer does not affect the registered proprietor's common law rights (*gg*). The mere presence of the disclaimed words in a second mark tendered for registration does not make it resemble an earlier registered mark within the meaning of sect. 72 (2) (*h*).

Advantages of registration with additions.

In comparing two marks which are alleged to resemble each other too closely, some account must be taken of elements common to the trade which are included in both (*i*), and on this ground the registration of a trade-mark, with the common words or other particulars which are actually used with it, may secure it a more efficient protection under sect. 72 against the subsequent registration of similar marks in the same class than would be obtained by the registration of its distinctive elements only (*k*). Beyond this, it is difficult to see what substantial bearing upon the proprietor's rights in this country (*kk*) the registration of disclaimed additions with a trade-mark can have; for if the places occupied by the matter which would have to be disclaimed are left blank upon the Register,

Registration with blanks.

the proprietor forfeits none of his exclusive rights to the use of the registered and distinctive parts of the mark by filling up the blanks, in actual use, in any manner he pleases (*l*).

As already stated, traders prefer to register their marks as they are actually used (*m*), both because it saves the expense and trouble of preparing special prints for registration only, and for convenience of reference. On the latter ground, there seems to be good reason for making the registration of trade-marks as they are actually used compulsory in all cases.

(*gg*) *Bayer* v. *Baird*, 15 R. P. C. 615 (1898), (*C. B. Corsets*). Cf. also *Thompson* v. *Miller*, 13 R. P. C. 35 (1896), Stirling, J. (*Roadster*), with *Burland* v. *Broxburn Oil Co.*, 6 R. P. C. 482, Chitty, J. (*Washerine*), and see also *Packham* v. *Sturgess*, 15 R. P. C. 669 (1898), North, J., and C. A. (*Sparkling Lime Wine*).

(*h*) *Loftus' Tm.*, (1894) 1 Ch. 193; 11 R. P. C. 29, North, J. (*Unco' Guid* in each of two quite distinct labels); and the cases in note (*f*).

(*i*) See Chap. X. p. 240.

(*k*) And see the passage from the Committee's report above, p. 198.

(*kk*) But in some countries abroad the mark can only be registered exactly as registered in the country of origin, see App. 776.

(*l*) *Melachrino & Co.* v. *The Melachrino Egyptian, &c. Co.*, 4 R. P. C. 215 (1887); *Hammond* v. *Brunker*, 9 R. P. C. 301 (1892), both Chitty, J.; and see Chap. XV. p. 391.

(*m*) See above, p. 200.

CHAPTER X.

RESTRICTIONS ON REGISTRATION.

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The Comptroller's discretion is not limited by the express restrictions.

NOTHING can be entered upon the Register which is not authorized by the sections set out and commented on in Chapter VIII. (*a*), and, as stated in that chapter, the Comptroller has a discretion, subject to appeal, to refuse to register marks which he thinks ought not to be accepted, although they comply with the provisions of the enabling sections. This discretion is, as has been shown, general, and it extends beyond the letter of the restrictions imposed by other sections of the Acts which are the subject of the present chapter (*aa*).

The most important sections to be considered in this chapter, sects. 71, 72, and 73, are substantially the same as the corresponding sections of the Act of 1875, sects. 5 and 6.

I. Duplicate Marks for the same Goods.

Sect. 71.

Conflicting claims to registration.

It is provided by **sect. 71** that—

"Where each of several persons claims to be registered as proprietor of the same trade-mark, the Comptroller may refuse to register any of them until their rights have been determined according to law, and the Comptroller may himself submit or require the claimants to submit their rights to the Court."

And by **sect. 72** (*1*) that—

Sect. 72 (1).

Identical marks not to be registered without leave.

"Except where the Court has decided that two or more persons are entitled to be registered as proprietors of the same trade-mark, the Comptroller shall not register in respect of the same goods or description of goods a trade-mark identical with one already on the Register with respect to such goods or description of goods."

(*a*) Page 115, sects. 64 and 74, see "reasons for refusal," p. 68.

(*aa*) Certain restrictions on registration are contained in the Instructions 28 to 31, App. p. 728. As to the force of such restrictions, *supra*, p. 70, note (*n*).

It will be observed that, while the former section gives the Comptroller a discretion, the latter is imperative; and that sect. 71 relates to concurrent claims to registration, whilst the limitation contained in sect. 72 is only applicable where at least one of identical marks is already on the Register (*b*).

Duplicate claims to the same mark.

Where several applicants claim to be proprietors (*c*) of the same mark the Comptroller may require them to state their cases in writing, and to appear before him and give oral explanations with respect to such matters as he may require (*d*). And if the dispute is submitted to the Court under sect. 71, it is provided by the Rules that the procedure to be adopted, unless the Court shall otherwise order, shall be that of a special case (*e*), which may be settled if need be by the Comptroller (*f*); but in practice the application is always made by summons or motion, the summons or notice of motion asking for leave to have the question determined in that way (*g*).

In deciding cases under the sections the Court will consider public interests as well as the rights of the applicants *inter se*, and, unless the former are protected, will not give effect to an agreement for concurrent registrations of identical new marks, at all events in the absence of special circumstances. In *Ehrmann's Trade-Marks* (*h*) the applicants had formerly been partners, and certain marks which were registered had been used by the firm. The partnership was dissolved by an agreement that one partner should carry on business under one trade-name which had been used by the firm, and the others under another trade-name which had also been used by the firm, and each party was to be entitled to use the firm's marks with certain alterations to be made by them respectively, and applications were to be made by each party for registration of such marks; the agreement also provided for the cancellation of the former registrations

(*b*) See *Ehrmann's Tms.*, referred to below.

(*c*) See "proprietor," p. 65.

(*d*) Rule 43, p. 699.

(*e*) Rule 44.

(*f*) Rule 45

(*g*) See Sebastian, 4th ed. p. 344, and *Simpson, Davies & Son's Tm.*, 15 C. D. at p. 527 (1880), Jessel, M. R.

(*h*) (1897) 2 Ch. 495; 14 R. P. C. 665, Stirling, J.

if that should be necessary for the fresh registrations. On the applications for registration being made, the Comptroller required the respective applicants to submit their rights to the Court, whereupon the applicants appealed. On the appeals being referred to and coming before the Court, the Comptroller raised objections to registration—first, on the ground of the existing registrations, but, having regard to the view which the Court took, this was not finally dealt with; and, secondly, on the ground that identical new marks ought not to be registered in the names of different persons—whilst the applicants relied on the special circumstances as giving them a right to the registrations. Stirling, J., held that in such a case the Court should consider the protection of the public, and ought to be satisfied that there was no reasonable probability of harm resulting, and he dismissed the appeals.

The three mark rule.

Before the introduction of registration, when trade-mark rights could, except in a few special trades and in particular places (*i*), be acquired only by user, the duplication of marks for use in connection with the same description of goods, by use in different districts, was very common, and many duplicate old marks have been admitted on to the Register. A limit was put to the number of such duplicates which would be accepted by the adoption of the three mark rule which has been already referred to (*k*).

This rule was introduced by the Commissioners of Patents, under the Act of 1875, and it was repeatedly recognized by Jessel, M. R., and other judges (*l*), and its test is adopted, with respect to additions common to the trade, by sect. 74 (3). According to the rule, three, but not more than three, identical or substantially identical (*m*) old marks may be registered for use upon the same, or substantially the same, class or description of goods, provided that the marks have been honestly and lawfully

(*i*) *E.g.*, the cutlery trade in Sheffield.

(*k*) Chap. IX. p. 205; Act of 1883, s. 74 (3).

(*l*) *Walkden, &c. Co.'s Application*, 54 L. J. Ch. 394, n. (1877), Jessel, M. R.; *Jelley's Application*, 51 L. J. Ch. 639, n. (1878), Jessel, M. R.; and *Wragg's Tm.*, 29 C. D. 551 (1885), Pearson, J.; *Benbow* v. *Low*, 44 L. T. 875 (1881), Bacon, V.-C.

(*m*) *White Rose Tm.*, 30 C. D. 505 (1885), Kay, J.

acquired and used. So that a mark which was originally unlawfully copied from another cannot claim registration along with the other under cover of the rule (*n*). If more than three such marks had been so acquired and used before the 13th of August, 1875, they were all treated as common to the trade (*o*); but the use of a mark abroad did not fall within the rule (*p*).

Lord Herschell's Committee on the three mark rule.

"Prior to the passing of the Act of 1883," say Lord Herschell's Committee (*q*), "the late Master of the Rolls had laid down the rule that the Comptroller might register three old marks, *i.e.*, marks in use prior to August, 1875, without the necessity of the parties resorting to the Court. It is suggested," they add, "that this worked well; and although there is not complete unanimity of opinion on the point, we think the preponderance of reasons is in favour of reviving the practice as regards old marks." The Committee seem to have been in error as to the power of the Comptroller to register a second mark without the leave of the Court under the old Act, for sect. 6 of that Act laid down substantially the same rule as sect. 72 (1) set out above. The rule was that, upon proof of the title of a second or of a third trader to the mark, leave to register it was granted notwithstanding the presence of a first or second prior registration of the same mark for the goods in question (*r*), and no alteration has been made in regard to this by the present Acts. There cannot, one may suppose, be now remaining and unregistered any very large number of marks used before the 13th of August, 1875, which are likely to be put on the Register under cover of the three mark rule; but the rule is still important, since questions as to the propriety of existing registrations are continually arising under sect. 90.

The rule does not apply to new marks.

The rule has never been applied to marks first invented

(*n*) *Jelley's Application*, p. 216.

(*o*) See *Burland* v. *Broxburn Oil Co.*, 42 C. D. at p. 280; 6 R. P. C. 274 (1889), Chitty, J.

(*p*) *Münch's Application*, 50 L. T. 12 (1884), Chitty, J.; and see *Jackson & Co.* v. *Napper*, 35 C. D. at p. 178; 4 R. P. C. 45 (1886), Stirling, J.

(*q*) Page xiii.

(*r*) See per Jessel, M. R., *Jelley's Application*, 51 L. J. Ch. at p. 640, n. (1878).

or used since the 13th of August, 1875 (*s*), for the Registration Acts make proper registration itself (*t*) equivalent to public use, and evidence of the registered proprietor's right to the exclusive use of the mark (*u*). Title to a mark can still, however, be acquired by use, although registration is a condition precedent to any action by the proprietor in respect of its infringement (*v*). It is quite possible, therefore, that the circumstances which led to the adoption of the rule might arise in connection with new marks. If, for instance, the same mark is adopted by two traders for use upon the same class of goods, but in different districts, and there is no proof as to which first adopted it, then, according to the present practice, if one obtains registration the other cannot do so (*x*). It was suggested to Lord Herschell's Committee that this should be altered (*y*), but no change has been made.

Application of the rule.

Leave to register a second old mark is granted as of course, if an independent and honestly acquired title to the mark as a trade-mark is shown. In *Jelley's Case* (*z*), Jessel, M. R., said: "I have often had the case of a man in one town not knowing that another man in another town has the same mark, and he has got his trade-mark registered. The second applicant must prove his title, that is all. The leave of the Court mentioned in sect. 6 (*a*) is not a capricious leave. The rule of the Court which I have just stated is always followed, and it merely means that the second man must show his title. You cannot deprive him of his trade-mark. Look at the monstrous injustice that would be done if a man who had a trade-mark for,

(*s*) *Jackson & Co.* v. *Napper*, 35 C. D. p. 169: 4 R. P. C. 45 (1886), Stirling, J. And see *Re Ehrmann's Tms.*, (1897) 2 Ch. 495; 14 R. P. C. 665; and p. 213, *ante*.

(*t*) Under the Act of 1888, application for registration is substituted for registration, see sect. 17.

(*u*) Act of 1883, ss. 75 and 76; Act of 1875, ss. 2 and 3.

(*v*) Act of 1883, s. 77; and p. 312, below.

(*x*) See *Currie's Application*, 13 R. P. C. 681 (1896), Kekewich, J., where the applicants alleged user for eleven years as against thirteen by the respondents, but the mark was refused.

(*y*) See the evidence of the Comptroller, Sir H. Reader Lack, Q. 3161.

(*z*) 51 L. J. Ch. 639, n. (1878).

(*a*) *I.e.*, of the Act of 1875, now sect. 72 (1).

perhaps, forty years, should lose it, because another man who had it for four years had happened to register it first."

After five years' registration of opponent's mark.

Registration of an old mark may be allowed although a similar mark has been on the Register for more than five years (*b*).

Sect. 72 is not limited by the register classes.

The operation of sect. 72 is not limited by the classes into which goods are divided for the purposes of registration. And in this respect the wording of the present Act is wider than that of the corresponding section of the Act of 1875, for that section contained the words "the same goods or classes of goods" in place of the words "the same goods or description of goods." Thus, in *The Australian Wine Importers' Case*, the question arose whether an application to register a label containing a device and the words *Golden Fleece* for wine, could be opposed on the ground of the prior registration of what were held to be similar labels for spirits, both wine and spirits being in the same register class (42), and Kay, J., held that, whether sect. 72 applied or not, the use of the mark tendered, having regard to the presence on the Register of the other marks, would be calculated to deceive within the meaning of the next section, and that it ought not to be registered. The Court of Appeal affirmed the decision, and Lindley, L. J., said (*c*): "For the purpose of deciding whether two sets of goods are of the same description, we must not, it appears to me, lay too much stress on the classification in the schedule to the rules. You find there goods of the same description in different classes, and goods of different descriptions in the same class. For example, if you turn to classes 26—29, you will find that flax and hemp are in one class, and jute in another, though all of them are fibrous, and more or less of the same description for trade purposes. Then, if you turn to class 22, you will find bicycles and railway carriages in the same class. Now, for trade purposes, can you have any goods more different than bicycles and railway carriages?

(*b*) *Jackson & Co.* v. *Napper*, 35 C. D. 162; 4 R. P. C. 45; *Bancroft & Co.'s Tm.*, 5 R. P. C. 209 (1888), both Stirling, J. See further, as to the registration of old marks, Chap. VIII. pp. 184 *et seq.*

(*c*) 41 C. D. p. 291; 6 R. P. C. 311 (1889).

Of course, they are utterly different things, and yet they are put by the framers of these Rules into the same class, so that we cannot be guided by their classification in construing the words 'same goods or description of goods,' which are the words used in sect. 72." And the judges were all inclined to think that wines and spirits were of the same description of goods, although they did not decide the point. And North, J., in a subsequent case, expressed the opinion that beer and rum are the same description of goods within the meaning of the section (*d*). Still more recently (*e*) Romer, J., found as a fact that there was an intimate connection between the bicycle and camera trades, and he ordered a trade-mark, which had been registered in class 22 for bicycles, to be expunged on the application of a company which had used the mark for bicycle cameras and had registered marks containing the word in question in classes other than class 22. On the other hand, in *Braby & Co.'s Applications*, North, J., allowed a new mark to be registered for galvanized iron sheets, although a similar mark was already registered and used for bar iron and wire, which goods were within the same register class as the iron sheets (*f*). The true test would seem to be supplied by the question—are the two sets of goods so commonly dealt in by the same trader that his customers, knowing his mark in connection with one set and seeing it upon the other, would be likely to suppose that it was used upon them also to indicate that they were his goods (*g*)? It has

(*d*) *Turney & Sons' Tm.*, 11 R. P. C. 37; 10 Times L. R. 175 (1893), North, J.

(*e*) *Eastman, &c. Co., Ld.* v. *John Griffiths Cycle Corporation, Ld.*, 15 R. P. C. 105 (1898), (*Kodak*). As to this case see also below, p. 256; and see *Eno* v. *Dunn*, 15 App. Cas. 252, 7 R. P. C. 311 (1890), where the registration of "Dunn's Fruit Salt Trade Mark Baking Powder" was refused for baking powder in class 42 by reason of a prior use of the words "fruit salt" for a medicinal drink; and *Eno* v. *Dunn*, 10 R. P. C. 261 (1893).

(*f*) 21 C. D. 223 (1882); and see *Jelley's Application*, 51 L. J. Ch. 639, n. (1878), Jessel, M. R.; see also *Edward* v. *Dennis*, 30 Ch. 454, where a mark which had been used only for sheet iron was held not to be infringed by use of a somewhat similar mark for wire; and cf. *König and Ebhardt's Tm.*, 13 R. P. C. 449; (1896) 2 Ch. 236, where Stirling, J., allowed registration of a mark in class 39 on the application being confined to account books, ruled paper, and other paper for use in books.

(*g*) See per Kay, J., 41 C. D. at

Use or registration for part of a register class.

already been stated that the proprietor of a mark used for only part of a register class, even though it be registered for the whole, and *à fortiori* if the registration as well as the user is limited within the class, cannot by virtue of his registration prevent the use of the mark by other traders upon other descriptions of goods, although they may be included in the same register class (*h*). But the fact that an opponent of an application for registration could not get an injunction to restrain the use which the registration sought is intended to cover, is by no means conclusive upon the question of the right to registration (*i*).

Registration of a second mark by agreement.

A second mark has often been admitted to registration by agreement with the proprietor of a mark already registered, who might otherwise oppose it under sect. 72 or 73, on the terms that it shall be limited to part only of the register class. The limitation is effected by placing a note on the Register (*k*). And in the same way marks have been allowed to be registered on the terms of being used in a particular manner, so as not to be confused with a mark already registered (*l*), or for use in a particular district (*m*). And

Note on the Register.

the Comptroller has in some cases been directed to put a note, in accordance with the agreement, upon the Register (*m*). These last-mentioned cases, however, were decided under a Rule not now in existence; and the Court of Appeal has since disapproved of placing any territorial limitations on the Register on the grounds both of the want of jurisdiction to do so, and of the inexpediency of such a course having regard to the duty of protecting the public (*n*). The objection will apply to all cases of annexing conditions to registration, or

p. 281, in the *Australian Wine Importers' Case*.

(*h*) See p. 97, sect. 65; and see *Hargreaves* v. *Freeman*, (1891) 3 Ch. 39; 8 R. P. C. 237, Chitty, J.

(*i*) See *The Australian Wine Importers' Case*, *supra*, and p. 221, below.

(*k*) See *Re Rabone Bros. & Co.*, Seb. Dig. p. 395 (1879), Jessel, M. R.

(*l*) *Whiteley's Tm.*, 43 L. T. 627, n. (1879), Jessel, M. R.; *Sykes & Co.'s Tms.*, *ibid.* p. 626 (1880), Hall, V.-C.

For restrictions as to colour, see Chap. VIII. p. 195.

(*m*) *Keep's Tm.*, 26 C. D. 187 (1884), Pearson, J.; *Mitchell & Co.'s Tm.*, 28 C. D. 666 (1884), Chitty, J.; *Whiteley's Tm.*, 43 L. T. 627 (1879), Jessel, M. R.

(*n*) *Dewhurst's Application*, (1896) 2 Ch. 137; 13 R. P. C. 288 (Lindley, Lopes, and Kay, L. JJ.); and cf. *Ehrmann's Tms.*, *supra*, p. 213.

entering notes on the Register in relation to other limitations, except the description of goods. In the same case it was decided that the consents of proprietors of other marks do not determine the question whether such marks constitute an objection to a proposed registration, but at the most afford some evidence that the proposed registration will not interfere with the trade of such proprietors (*o*). Where identical or similar marks are registered for different goods in the same register class, it is an infringement for the proprietor of either to use his mark upon the goods for which the other is registered (*p*).

II. Mark resembling a Registered Mark.

Sect. 72 (2), mark resembling a registered mark.

It is further provided by sect. 72 (2) that—

> "[Except as aforesaid] (*q*) the Comptroller shall not register with respect to the same goods or description of goods (*q*) a trade-mark *so nearly resembling* [having such resemblance to] (*r*) a trade-mark already on the Register with respect to such goods, or description of goods, as to be calculated to deceive."

The sub-section corresponds to a part of sect. 6 of the Act of 1875. The words "except as aforesaid" refer back to sect. 72 (1) (*s*), and the exception is where the Court has decided that two or more persons are entitled to have identical, or substantially identical marks registered, for instance, on the ground that trade-mark rights in them have been independently acquired. The words were added by the Act of 1888. The Act just cited also substituted "having such resemblance" for the words "so nearly resembling," which occurred in the Acts of 1875 and 1883. The change was in each instance made upon the recommendation of Lord Herschell's Committee, and in the latter was supported by the reasons stated in the extract from the report set out below (*t*).

(*o*) See also *König & Ebhardt's Tm.*, (1896) 2 Ch. 236; 13 R. P. C. 449, Stirling, J. And as to compromise on an application to expunge, see below, p. 274.

(*p*) *Upper Assam Tea Co.* v. *Herbert*, 7 R. P. C. 183 (1890), C. A.

(*q*) See above, p. 212.

(*r*) Act of 1888, sect. 14.

(*s*) Page 212.

(*t*) Page 227.

It is difficult, however, to see in what way the effect of the sub-section has been altered by the amendments.

What is meant by the same goods or description of goods has already been considered (*u*).

The provision of the sub-section embodies the old rule, that a mark which from its resemblance to an existing trade-mark is calculated to deceive cannot be protected as a trade-mark, for its use is an infringement of the other mark, which would be restrained by the Court (*x*). But the restriction extends beyond the rule, and it does not follow, because an opponent could not obtain an injunction against the use by the applicant of the mark which he tenders for registration, that it is not calculated to deceive within this sub-section. Thus, in *Speer's Case* (*y*), Kay, J., said: "I could quite conceive a case in which the similarity would not be such as would induce the Court, on that fact alone, to grant an injunction, but in which the Comptroller would still be entirely within his duty in saying that these marks are so nearly resembling one another, at any rate, that I will not, by allowing the registration, encourage the use of a mark which may lead to litigation hereafter. It seems to me that is a matter which the Comptroller ought to consider." And this is fully in accord with the judgments of the law lords in *The Fruit Salt Case* (*z*).

The section extends beyond infringing marks.

The restrictions on registration of deceptive marks are not only for the protection of owners of marks on the Register, but also of the public, and therefore, notwithstanding the consents of owners who might oppose the registration, a mark may be refused on the ground of the likelihood of confusion with their marks, and the consents are only some evidence as to the probability of deception (*a*).

(*u*) Page 217, above.

(*x*) *Seixo* v. *Provezende*, 1 Ch. 192 (1865), Cranworth, L. C.; and see *Cope* v. *Evans*, L. R. 18 Eq. 158 (1874), Hall, V.-C., and the cases there cited. Deceptive trade-marks are not protected, see Chap. XV. p. 397.

(*y*) 4 R. P. C. at p. 524; 55 L. T. 880 (1887); and see *The Australian Wine Importers' Tm.*, 41 C. D. 278; 6 R. P. C. 311 (1889), C. A.

(*z*) *Eno* v. *Dunn*, 15 App. Cas. 252; 7 R. P. C. 311 (1890). See also *Société, &c. de l'Étoile's Tm.*, below, note (*c*).

(*a*) *Dewhurst's Application*, (1896) 2 Ch. 137; 13 R. P. C. 288, C. A.

Marks used in different Markets.

Limitation to particular market.

The question has been raised whether a mark which is sufficiently distinguishable from an opponent's mark everywhere except in a particular country or market, but has there such resemblance to it as to be calculated to deceive, on account of the local circumstances of the trade, for instance, because goods bearing the latter mark have locally acquired a particular name (*b*), falls within the section, and ought, therefore, to be refused registration (*c*). The question has not been directly decided(*d*), but it is submitted that the objection would be sufficient to justify the rejection of the mark, especially as the Courts will not now enter on the Register a limitation of the area of user of the applicant's mark, or even, apparently, any note of an arrangement between the parties for such limitation (*e*). The authorities cited below (*f*) show that probability of deception in England only is not all that is to be considered in cases of infringement; and it cannot be supposed that a mark would be admitted on to the Register if it were shown that the proprietor would forthwith, upon the application of the opponent, be restrained from using it. It is true that, where old marks have been in use simultaneously for years in different markets, the injunctions granted in infringement cases have occasionally been locally limited (*g*), and such limitations have the support of a dictum of Cotton, L. J., in *Johnston* v. *Orr-*

(*b*) See p. 240, below.

(*c*) In *Société Anonyme des Verreries de l'Étoile*, (1894) 1 Ch. 61; 10 R. P. C. 436, the trades of the applicants for rectification and of the respondents were in fact competing in the colonies, and Stirling, J., held that the use of the applicants' mark on goods shipped in English ports for the colonies was in use in England, where the respondents' main trade was. Aff. by C. A., (1894) 2 Ch. 26; 11 R. P. C. 142.

(*d*) In *Dewhurst's Application*, (1896) 2 Ch. 137: 13 R. P. C. 288, C. A., Lindley, Lopes, and Kay, L. JJ., similar questions were discussed, and it was pointed out by Kay, L. J., that there might be deception in Burma, but the Court thought that there might be deception outside Burma, and proceeded on that ground.

(*e*) See the case last cited.

(*f*) Page 225.

(*g*) *Carver* v. *Boucker*, Seb. Dig. p. 350 (1877), Little, V.-C.; *Barber* v. *Manico*, 10 R P. C. 93 (1893), A. L. Smith, L. J., a passing off case.

Ewing (*h*); but in that case, on appeal, Lord Cairns expressed a doubt whether the rightful and *bonâ fide* trade-mark of the trader using it could be excluded by injunction from particular markets (though unimpeachable everywhere else), merely because in those markets it might be liable to be called by a name which the mark of another had already acquired there (*i*). And it seems clear that the principle upon which the limitation of the injunctions in the cases referred to was based cannot avail to enable a new mark to be registered, which in any market is deceptive, by reason of the existence of a mark with which it might there be confused. Moreover, as regards registered marks, registration confers rights unlimited as to locality; and, although the owner of a previously registered mark may not yet have extended his trade to the particular market in question, it is open to him to do so (*j*). Thus, in *The John Bull Beer Cases*, where the two marks concerned were used by the plaintiffs and the defendants respectively in different districts of England, the more lately adopted mark was refused registration, and subsequently an injunction was granted to restrain the use of it (*k*). So, too, in *The Jackson Co.'s Case* (*l*), registration of a word was refused because it was the name of a common mark in the cotton trade among the Chippeway Indians, to whom the English cotton trade had not then extended. In *Deuchurst's Application* (*m*), the Court of Appeal refused registration of a mark, having as an essential particular the words *The Golden Fan Brand* in the Burmese language and characters, on the ground of the presence on the Register, in respect of the same goods, of a fan which in fact, as used, was coloured gold. In this case the owner of the latter mark had consented to the registration, and the applicants were willing to submit to a condition that the mark should only be put on goods exported to Burma, and they adduced evidence that part of

(*h*) 13 C. D. p. 464.

(*i*) 7 App. Ca. p. 227. To that proposition, he said, he could not assent.

(*j*) See *Deuchurst's Application*, *supra*, note (*d*).

(*k*) *Paine & Co.* v. *Daniells & Son's Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 71, 217.

(*l*) 6 R. P. C. 80; 60 L. T. 93 (1888), Kay, J., (*Kokoko*).

(*m*) (1896) 2 Ch. 137; 13 R. P. C. 288.

the mark was already known there as *The Golden Fan Trade-Mark*. The broad ground on which the Court acted was that a second mark should not be placed on the Register containing a mere verbal description of an existing mark, because of the danger of purchasers being deceived (*n*).

Deceptive Resemblance.

Calculated to deceive.

"Calculated to deceive" may mean either "intended to deceive" or "likely to deceive," and the prohibition applies where the case falls within either meaning (*o*), although the latter, which is, of course, the more inclusive meaning, is sufficient to dispose of most, if not all, of the questions that arise under the section. The words are not equivalent to "capable of being used to deceive" (*p*), for it must be assumed, until the contrary is shown, that the applicant will make an honest use of his marks (*o*). A trade-mark is calculated, by its resemblance to another already on the Register, to deceive, if in the course of its legitimate use in the trade it is likely to do so.

Two important questions are suggested by the section: A. Who are the persons whom the resemblance must be calculated to deceive? and, B. What rules of comparison are to be adopted in judging whether such resemblance exists?

A. What Persons are to be considered.

Whom the mark must be calculated to deceive.

In accordance with the cases decided in suits and actions for the infringement of trade-marks before the Registration Acts, it is held that the persons to be considered in estimating whether the resemblance between the marks in question is calculated to deceive are all of those who are likely to become purchasers of the goods upon which the marks are used. So

(*n*) The decision expressly left it open for the Comptroller, if he thought fit to do so, to allow the words to be registered as additional words subject to a disclaimer. In the application the words had been claimed as an essential particular.

(*o*) *Kutnow's Tm.*, 10 R. P. C. 401 (1893), North, J., (*Carlsbad Salts*); and see the next case.

(*p*) *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102 (1886), C. A.

that, if such persons, using ordinary care (*q*) and intelligence, are likely to be deceived, then the Comptroller ought not to accept the mark.

The ultimate purchasers.

It is clearly not enough for the applicant to show that retail dealers buying his goods for resale would not be deceived, since they might themselves fraudulently or carelessly make use of the ambiguous character of the trade-mark to deceive their customers, the ultimate purchasers (*r*). In fact, dealers who buy from the manufacturers in order to sell by retail are generally aware of attempted infringements, and are parties to the fraud (*s*).

Foreigners.

Nor is the inquiry to be confined to England, or to persons acquainted with the English language, in cases where the goods in question have a foreign market (*t*).

Persons of ordinary ability and carefulness.

It must not be assumed that a very careful or intelligent examination of the mark will be made (*u*), and

(*q*) *Christiansen's Tm.*, 3 R. P. C. 54 (1886). See per Esher, M. R., p. 62, quoted below, p. 230.

(*r*) *Wilkinson* v. *Griffith*, 8 R. P. C. at p. 374 (1891), Romer, J. See the judgment of Mellish, L. J., in *Ford* v. *Foster*, 7 Ch. 616 (1872); and the judgment of Lord Selborne in *The Singer Manufacturing Co.* v. *Loog*, 8 App. Ca. 15 (1882); and *Powell* v. *Birmingham Vinegar Brewery Co.*, (1896) 2 Ch. 54; 12 R. P. C. 496; 13 R. P. C. 235; and in the House of Lords, (1897) A. C. 710; 14 R. P. C. 720; especially the judgment of Kay, L. J., 13 R. P. C. 250; and *Hubbuck* v. *Brown*, 17 R. P. C. 645 (1900), C. A.

(*s*) *Anglo-Swiss, &c. Co.* v. *Metcalf*, 31 C. D. 454; 3 R. P. C. 28 (1886), Kay, J.; *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), C. A. "In my opinion the whole gist of the complaint against the defendants is, 'You have sold a weapon calculated to be used fraudulently by the middlemen'" (Cotton, L. J.). If ultimate purchasers do not know who is the manufacturer of the goods which they have been accustomed to purchase, that circumstance might contribute to make the mark of a rival trader deceptive. Cf. *Powell* v. *Birmingham Vinegar Brewery Co*, *supra*, note (*r*); especially Lord Watson's judgment, 14 R. P. C. at p. 730.

(*t*) *Johnston* v. *Orr-Ewing*, 7 App. Ca. 219 (1882); *Wilkinson* v. *Griffith*, *supra*.

(*u*) "Unwary purchasers": *Wotherspoon* v. *Currie*, L. R. 5 H. L. 508 (1872), Lord Chelmsford; *The Singer Manufacturing Co.* v. *Loog*, 8 App. Ca. 15 (1882), Lord Selborne. "Ordinary purchasers purchasing with ordinary caution": *Seixo* v. *Provezende*, L. R. 1 Ch. 192 (1866), Cranworth, L. C. "Ordinary or unwary purchasers": *Powell* v. *Birmingham Vinegar Brewery Co.*, 13 R. P. C. at p. 258, Lindley, L. J.; not "persons of an ideal character who either are particularly innocent or too easily deceived": *Payton* v. *Snelling*, 17 R. P. C. at p. 57, Romer, L. J., whose judgment was approved by the H. of L., 17 R. P. C. 628; and see the judgments of Kekewich, J., in *Marshall* v. *Sidebotham*,

if it were shown that the class of persons who bought the goods were illiterate, that would be a material fact in cases where printing entered into the marks (*v*); but, on the other hand, it can hardly be a bar to the admission of a mark that unusually stupid people (*x*), "fools or idiots" (*y*), may be deceived (*z*). If some parts of the mark are common, one must consider whether people who know the distinguishing characteristics of the opponent's mark would be deceived (*a*). The cases cited are nearly all cases of infringement or passing off, and, as already said, a weaker case than would entitle a plaintiff to succeed in an action for infringement will enable an opponent to successfully object to the registration of a new mark.

B. Rules of Comparison.

What amount of resemblance is calculated to deceive.

It is impossible to discover from the decided cases any criterion as to the amount of resemblance which will suffice to cause the rejection of a mark more definite than that expressed in the section itself, and probably no test could

18 R. P. C. 43 (1901), and *Alaska Packers' Association* v. *Crooks*, 18 R. P. C. 129 (1901). "The unwary customer is extremely difficult to find": see the last case.

(*v*) See *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 492. The proposition is not contrary to the following passages from the judgments in *Singer Manufacturing Co.* v. *Loog*, where the fact of illiteracy of the customers was not established. "Whatever be the class of persons who buy these things (sewing machines), we must at all events assume that they are persons capable of reading and writing, or of reading, at all events": per James, L. J., 18 C. D. p. 413. "The possibility of such a mistake is not a cause of action (for passing off). The same thing might happen if the defendant issued circulars that his were *not* Singer sewing machines. For however large he printed the *not*, some one might not see it": per Lord Bramwell, 8 App. Ca. p. 42. In one case in which the goods (lemonade powders) were largely bought by children, and it was suggested that they would be more easily deceived than adults, Byrne, J., expressed the opinion that, having regard to the nature of the goods, which they would be likely to purchase for themselves, they would be less likely to be deceived than grown-up people: *Clark* v. *Sharp*, 15 R. P. C. at p. 149 (the case was settled on appeal, 15 R. P. C. 263 (1898)).

(*x*) *Payton & Co., Ld.* v. *Titus Ward & Co., Ld.*, 17 R. P. C. at p. 67, Romer, L. J. (1900).

(*y*) Jessel, M. R., 2 C. D. at p. 447.

(*z*) See note (*v*), *ante*.

(*a*) See the judgments of Romer, L. J., in *Payton & Co., Ld.* v. *Snelling & Co., Ld.*, 17 R. P. C. at p. 57; and *Same* v. *Titus Ward & Co., Ld.*, 17 R. P. C. at p. 67 (1900) (passing off cases); the former judgment being approved by the H. of L. on appeal, 17 R. P. C. 628; also *Alaska Packers' Association* v. *Crooks*, and *Marshall* v. *Sidebotham*, note (*u*), above.

usefully be stated (*b*); but a perusal of the reported cases shows that the Comptroller and the Court now apply the restriction much more strictly against new marks than formerly, and, as already shown, it is settled that the onus of proving that there is no reasonable probability of deception is cast on the applicant (*c*). In comparing the marks, the Comptroller must, as appears from the authorities referred to below, take into account all the circumstances of the case, and must consider whether, as a whole, the applicant's mark is substantially different from the opponent's. The report of Lord Herschell's Committee on this point admirably states what are conceived to be the critical tests, and it shows also what the amendment of the Act (*d*) was intended to effect. It will be useful to set out the whole passage.

1. The "Idea of the Mark" is to be regarded.

Lord Herschell's Committee on the principle of comparison.

"We have given very careful consideration to the evidence which has been laid before us by those interested in the trade of Lancashire. The number of marks registered in classes 23, 24, and 25, which are commonly described as the Cotton Classes, is very large; and the administration of the Act (*e*) in relation to these classes is of great importance to the trade. There can be no doubt that the working of the Trade-Marks Act has not given satisfaction in Lancashire. Even if at times there may have been a disposition to expect too much, we think there have been substantial grounds for the dissatisfaction which has prevailed. The great bulk of the goods manufactured in Lancashire, in respect of which trade-marks are used, is exported to other countries, and there can be no doubt that these marks fulfil important functions in the trade between Lancashire and India and other countries. One chief complaint has been that the usages of the trade and the character of the markets where the marks are intended

(*b*) "What degree of resemblance is necessary (to constitute an infringement) is, from the nature of things, a matter incapable of definition *à priori*": per Cranworth, L. C., in *Seixo* v. *Provezende*, L. R. 1 Ch. 192 (1866).

(*c*) *Eno* v. *Dunn*, 15 App. Ca. 252; 7 R. P. C. 311 (1890).

(*d*) Substituting "having such resemblance" for "so nearly resembling."

(*e*) *I.e.*, the Act of 1883.

to serve their purpose have not been sufficiently kept in view by the Patent Office. By sect. 72, sub-sect. (2), the Comptroller is directed not to register, with respect to the same description of goods, a trade-mark so nearly resembling a trade-mark already on the Register with respect to such description of goods as to be calculated to deceive. It is on the question whether marks do so nearly resemble one another as to be calculated to deceive, and what extent of resemblance to an old mark ought to cause the rejection of an application, that the chief difference has arisen between the trade and those to whom the administration of the Act has been entrusted. The tendency of the Office has been to construe the words of the Act more favourably towards applicants for new marks than the trade have thought right. We think the difference has arisen in part from the wording of the Act. The Comptroller has felt unable to say that two marks 'so nearly' resemble each other as to be calculated to deceive. He has thus not considered himself at liberty to take into consideration to the extent he otherwise might, the character of the market in which the mark is to serve its purpose. Two marks, when placed side by side, may exhibit many and various differences, yet the main idea left on the mind by both may be the same; so that a person acquainted with the mark first registered, and not having the two side by side for comparison, might well be deceived, if the goods were allowed to be impressed with the second mark, into a belief that he was dealing with goods which bore the same mark as that with which he was acquainted. Take, for example, a mark representing a game of football; another mark may show players in a different dress, and in very different positions, and yet the idea conveyed by each might be simply a game of football (*f*). It would be too much to expect that persons dealing with trade-marked goods, and relying, as they frequently do, upon marks, should be able to remember the exact details of the marks upon the goods with which they are in the habit of dealing.

The idea of each mark to be considered.

"In order to avoid misapprehension in the future, we recommend, even though it may not be absolutely necessary,

(*f*) Cf. *Barker's Tm.*, 53 L. T. 23 (1885), Kay, J. (*Huntsman*, or *Sportsman's* cherry brandy).

a slight amendment of the Act, substituting for the words 'so nearly resembling' the words 'having such resemblance to'; and further, we would suggest that when the question arises whether a mark applied for bears such resemblance to one on the Register as to be calculated to deceive, it should be determined by considering what is the leading characteristic of each. The one might contain many, even most, of the same elements as the other, and yet the leading, or it may be the only, impression left on the mind might be very different; whilst, on the other hand, a critical comparison of two marks might disclose numerous points of difference, and yet the idea which would remain with any person seeing them apart at different times might be the same."

The principle is adopted by the Court.

It is conceived that the principles which should guide the Comptroller, and the Court on appeal from him, and also on applications under sect. 90, to remove a trade-mark from the Register as offending against this sub-section, are here stated in accordance with the leading cases on the subject.

The Two Elephant Case.

Thus, in *Johnston* v. *Orr-Ewing* (*g*), where both the plaintiffs' and the defendants' marks consisted of tickets bearing pictures of two elephants with a banner between them, the figures being differently arranged, Lord Selborne said (*h*): "Although the mere appearance of these two tickets could not lead anyone to mistake one of them for the other, it might easily happen that they might both be taken by natives of Aden or of India, unable to read and understand the English language, as equally symbolical of the plaintiff's goods. To such persons, or at least to many of them, even if they took notice of the differences between the two labels, it might probably appear that they were only differences of ornamentation, posture, and other accessories, leaving the distinctive and characteristic symbol substantially unchanged. Such variations might not unreasonably be supposed to have been made by the owners of the plaintiff's trade-mark themselves for reasons of their own."

(*g*) 7 App. Cas. 219 (1882).

(*h*) Page 225. See also *Bauchiera's Tm.*, 33 Sol. J. 469; 5 T. L. R. 480 (1889), Chitty, J., where the ground of rejection was that "the dominating portion of each mark was a lion, and the goods were designated by the prevailing feature according to the custom of the trade."

The Tuendstikker Case.

And in *The Tuendstikker Case* (*i*), where the Court of Appeal, reversing the decision of Chitty, J., held that a label for match-boxes so nearly resembled an older label registered for the same goods as to be calculated to deceive, the judgment of the Court proceeded on the ground that the net impression produced by both labels was the same. The appellant's label as registered consisted of a black oblong, bearing the word *tuendstikker* printed at the bottom, and the word *nitedals* at the top, and a small geometrical device having two overlapping medals on each side of it in the middle. The respondents' label as registered showed the same elements, with the word *medals* instead of *nitedals*, two blank spaces having the same outline as the medals, and a cross instead of the device, the blanks and cross corresponding in size and shape with the medals and device. It was shown that in practice the respondents printed representations of medals over the blanks.

Lord Esher's judgment.

"The trade-mark," said Lord Esher, "is the whole thing —the whole picture on each. You have, therefore, to consider the whole. Mr. Justice Chitty has looked at the distinguishing features. He, I think, only looked at it to see whether, with that distinction, the whole was like or unlike. That is what he did, but the argument raised by Mr. Romer, and which was not only shadowed but plainly put forward by his skilful cross-examination, was this: the moment there is any distinction in any part, the things are at once unlike. That is his point. Therefore he cross-examined the people thus:—The lamps (*j*) or the medals are alike, and they are common?—Yes. The two things in the middle are unlike? —Yes. The word at the bottom is common to the trade, and it is the same in both?—Yes; but it is common to the trade. Therefore, he says, everything but the words *medals* and *nitedals* is common, and those two are different, and therefore the whole is different. It seems to me he has fallen into this fallacy—he takes each thing by itself, and says either it is common or it is the same, and leaves out altogether the mode in which the things are put together in the two pictures."

The marks to be compared as wholes.

There may be general resemblance with many differences in details.

And Lindley, L. J., said: "The difference here, looking

(*i*) *Christiansen's Tm.*, 3 R. P. C. 54 (1886).

(*j*) *I.e.*, the blank spaces.

at the boxes, is simply this, that the word *medals* is used instead of the word *niledals*, all the rest being, according to the evidence, common. Now I do not think that is a dissimilarity which is sufficient in this case, because, although I rather agree with the view taken by Chitty, J., that the leading feature is the name at the top or bottom of the label, one must not be misled by that. The question is, notwithstanding that, what is the effect of the use or introduction of that distinguishing character on the whole? When you look at the wholes, then it appears to me, I confess, that the dissimilarity is not enough to make the wholes dissimilar" (*k*).

Included common marks are not to be disregarded.

So that, where common marks are included in the trade-marks to be compared, or in one of them, it appears, from the judgments just quoted (*l*), that the proper course is to look at the marks as wholes, and not to disregard the parts which are common, although Cairns, L. C., in *The Orr-Ewing Case*, expressed a different opinion (*m*).

Parts of the contrasted marks common to the trade not to be disregarded.

Farrow's Case (*n*) is a good illustration of Lord Esher's rule (*o*). There both the applicant and the opponent were mustard merchants, and both used square boxes covered with yellow labels printed in black and red, for these boxes were common to the trade. The applicant placed upon his labels a picture of a charging buffalo, and the opponent a picture of a bull's head; both pictures were contained within silver rings, and these rings were also common to the trade. Stirling, J., said that the buffalo and the bull's head, as printed in the *Trade-Marks Journal*, were very different, but when they were placed upon the coloured labels, the applicant's label too closely resembled that of the opponent to be admitted to the Register.

(*k*) "Though no one particular mark was exactly imitated, the combination was very similar and likely to deceive": Hatherley, L. C., in *Abbott* v. *The Bakers', &c. Association*, W.N. (1872) 31. Cf. with the *Tandstikker Case* that of *Lever* v. *Bedingfield*, 15 R. P. C. 453; and 16 R. P. C. 3 (1899), Kekewich, J., and C. A., in which it was held that there was no infringement of the mark as a whole, although some features had been taken from the plaintiffs' label.

(*l*) *Christiansen's Tm.*, 3 R. P. C. 54 (1886), above, p. 230; and see *Baker* v. *Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1890), North, J.

(*m*) 4 App. Ca. 479 (1879).

(*n*) *Farrow's Tm.*, 7 R. P. C. 260; 63 L. T. 233 (1890), Stirling, J.

(*o*) Page 230, above.

But if the only resemblances between the two marks are in parts which are common, so that the owner of the one has taken nothing which is peculiar to the other, then there is at all events no infringement (*p*), unless possibly the plaintiff had a distinctive arrangement of common elements. Thus, in *Payton & Co., Ld.* v. *Snelling, Lampard & Co., Ld.*, a passing off case, Lindley, M. R., said (*q*) the plaintiffs "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." And in *Payton & Co., Ld.* v. *Titus Ward & Co., Ld.*, the same learned Judge said (*r*): "When what is called the plaintiffs' get-up consists of two totally different things combined, namely, a get-up common to the trade, and a distinctive feature affixed or added to the common features, then what you have to consider is not whether the defendants' get-up is like the plaintiffs' as regards the common features, but whether that which specially distinguishes the plaintiffs' has been taken by the defendants. A defendant may take it more or less. It is very seldom that he copies it. Of course

(*p*) *Jamieson & Co.* v. *Jamieson*, 15 R. P. C. 169 (1898), C. A., Lindley, M. R., Rigby and Vaughan Williams, L. JJ., reversing Byrne, J.; *Payton & Co., Ld.* v. *Snelling, Lampard & Co., Ld.*, 17 R. P. C. 48, (affirmed by H. of L. 17 R. P. C. 628); *Payton & Co., Ld.* v. *Titus Ward & Co., Ld.*, 17 R. P. C. 58, both C. A. (1900), Lindley, M. R., Sir F. Jeune and Romer, L. J., all passing off cases; *Marshall* v. *Sidebotham*, and *Alaska Packers' Association* v. *Crooks*, above, note (*a*) (trade-mark and passing off). See also *Hubbuck & Son, Ld.* v. *Brown*, 17 R. P. C. 148 and 638 (1900); and *Wolff* v. *Nopitsch*, 17 R. P. C. 321 and 18 R. P. C. 27 (1901).

(*q*) 17 R. P. C. 52.

(*r*) 17 R. P. C. 63.

he does not do that, but if he so nearly takes it that when you look at it as a whole you can say that the defendant's goods are calculated to be taken for the plaintiff's goods when properly looked at—if you can say that—then the plaintiff is entitled to succeed." In the former case, Romer, L. J., pointed out that where a person used certain leading features, which are common, another person commencing to use the same leading features ought to be careful that his goods can, by their own distinguishing features, be distinguished. If this is not done the later comer would certainly not be entitled to register his mark.

The fact that there has been actual copying of part of the plaintiff's mark is a matter to be considered, but it does not constitute infringement (*s*), nor would it necessarily make the new mark deceptive.

Ear as well as eye to be considered.

The resemblance between two marks must be considered with reference to the ear as well as to the eye. Thus, if a star be registered, the word *star* for the same goods would be calculated to deceive, and further, since the registered proprietor of the device of a star could, under sect. 67, use it in any colour, the words *Red Star* were held to be as objectionable as the word *star* by itself (*t*). So, also, the words *The Golden Fan Brand* were refused registration as an essential particular of a mark, on account of the presence on the Register of a fan which was in fact coloured gold in use (*u*); and a mark containing prominently the representation of half an apple on account of the words *Apple Brand* in two registered marks (*v*).

A good illustration of the principle that the idea of the marks must be considered is afforded by the *Currie & Co.*'s *Application* (*x*). There the registered mark included the words *The Cock o' the North*, with the picture of a cock in a defiant attitude, and the applicants' mark also included a

(*s*) *Lever* v. *Bedingfield*, 16 R. P. C. 3; 80 L. T. 100 (1899), C. A., Lindley, M. R., Chitty and Vaughan Williams, L. JJ.

(*t*) *Société Anonyme des Verreries de l'Etoile's Tm.*, (1894) 1 Ch. 61; 10 R. P. C. 436, Stirling, J.; (1894) 2 Ch. 26; 11 R. P. C. 142, Lindley, Kay and Smith, L. JJ. (*Red Star Brand*).

(*u*) *Deuchurst's Application*, (1896) 2 Ch. 137; 13 R. P. C. 283, Lindley, Lopes and Kay, L. JJ.

(*v*) *Application of Pomril, Ld.*, 18 R. P. C. 181 (1901), Joyce, J.

(*x*) 13 R. P. C. 681 (1896), Kekewich, J. (*Cock o' the North* label).

somewhat similar cock, both marks being for Scotch whisky. They contained other prominent features which were different in the two marks, but Kekewich, J., held that the Comptroller was justified in refusing registration of the applicants' mark, as it included in a central position the thing which caught the eye in the registered mark.

2. The Marks are to be compared as fairly used in Practice.

Marks not to be merely compared side by side on a view;

It is also clear that the Comptroller or the Court ought not merely to look at the marks as they stand side by side, for, from the nature of the case, they will not be so put before any customer whom it is sought to deceive by means of either of them. He can only contrast the mark upon the goods offered to him with his recollection of the mark used upon those he is seeking to buy, and allowance must be made for this in estimating the probability of deception. Any other rule would be of no practical use (*y*). Moreover, variations in details might well be supposed by customers to have been made by the owners of the trade-mark they are already acquainted with for reasons of their own (*z*).

but as seen and remembered in actual use.

In comparing the marks, therefore, regard must be had not only to their form as they appear on the Register (*a*), but also to the appearance they would present in actual use when fairly and honestly used; to the nature of the goods upon which they are to be employed; to the character and size of the marks themselves, and to the probability of their becoming partially or wholly blurred or modified as ordinarily stamped or printed, or by ordinary wear and tear (*b*).

(*y*) *Seixo* v. *Provezende*, 1 Ch. 192 (1866), Cranworth, L. C.; *Wilkinson* v. *Griffith*, 8 R. P. C. 370 (1891), Romer, J., and Lord Alverstone, M. R., in *Hubbuck* v. *Brown*, 17 R. P. C. at p. 645.

(*z*) *Johnston* v. *Orr-Ewing*, 7 App. Ca. 219 (1882), Lord Selborne, *ante*, p. 229.

(*a*) Jessel, M. R., held, in several cases, that the Register only should be looked at: *Re Jelley*, 51 L. J. Ch. N.S. 639, n. (1878); *Robinson's Tm.*, 29 W. R. 31 (1880); *Mitchell* v. *Henry*, 15 C. D. 181 (1880); but in the latter case the C. A. dissented from his opinion and overruled his decision; *Christiansen's Tm.*, 3 R. P. C. 54 (1886), Chitty, J.

(*b*) *Rosing's Application*, 54 L. J. Ch. 975, n. (1878), C. A.; *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102 (1885), C. A.; *Haines, Batchelor & Co.'s Tm.*, 5 R. P. C. 669 (1888), Chitty, J.; *Lambert's Tm.*, 5 R. P. C. 542; 6 R. P. C. 344; 61 L. T. 138 (1889), C. A. In *Hubbuck* v. *Brown*, 17 R. P. C. 148 and 638, the plain-

For instance, a mark which is used for hardware goods, and is stamped upon them with a die, is not likely to appear so definitely or to be so readily distinguishable from a similar mark as one which is engraved or printed upon a paper label, and so attached to the goods (*c*). In the former case, too, the mark will necessarily be used in a small size only (*c*). As regards size, however, even under circumstances in which, from the nature of the goods, large sizes showing the design distinctly can be, and generally are used—since it is open to a registered proprietor to use his mark in any size—size would not seem to be a material element in the comparison (*d*). It must not be assumed against the applicant or registered proprietor that he is going to use his mark unfairly, in the sense that he is going to use something different (*e*), by leaving out or obliterating any parts of the mark, for instance, so as to make it more like that of the opponent (*f*), for the Court presumes that a trade-mark will be used fairly and without fraud (*g*). But the Comptroller or the Court must consider any alterations which the applicant lawfully might make, without altering the essential features of his mark or losing the protection which would be conferred by registration (*h*). Thus he may use the mark in any colour, and in *Worthington's Case* (*i*) a triangular frame with the picture of a church inside was rejected on the ground that it would, if the whole were coloured red, too nearly resemble Bass' well-known solid red triangle. And if it is shown that the applicant does actually use, or intend to use, his mark so

Size of mark.

Alteration of mark as used from mark as registered to be considered.

tiffs relied to some extent on the effect of stencilling, and see the judgment of Collins, L. J.

(*c*) See the two cases cited before *Hubbuck* v. *Brown*, in which, however, the opposition failed; and see *Re Jelley*, 51 L. J. N.S. Ch. 639 n. (1878), Jessel, M. R.

(*d*) *Speer's Tm.*, 4 R. P. C. 521; 55 L. T. 880 (1887), Kay, J.

(*e*) *Biegel's Tm.*, 4 R. P. C. 525; 57 L. T. 247 (1887), Chitty, J.

(*f*) *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102 (1886), C. A.

(*g*) *Lambert's Tm.*, 6 R. P. C. 344; 61 L. T. 138 (1889), C. A.; *Haines, Batchelor & Co.'s Tm.*, 5 R. P. C. 669 (1888), Chitty, J.; *Kutnow's Tm.*, 10 R. P. C. 401 (1893), North, J. (*Carlsbad Salts*).

(*h*) *I.c.*, making his mark so different as to be practically an unregistered mark.

(*i*) 14 C. D. 8 (1879), Jessel, M. R., and C. A.; and see *Hanson's Tm.*, 37 C. D. 112 (1887), Kay, J.; see "colour," p. 195.

altered as more nearly to resemble that of the opponent, as, for example, in *The Tuendstikker Case* (*k*), by filling up blanks left in the mark as registered, the mark so altered will, as against the applicant, be treated as the mark to be considered (*k*). On the other hand, such alteration of the opponent's mark, being something other than the ordinary effects of its lawful user in the registered form, is immaterial as against the applicant (*l*), for no one can extend the protection given to his registered mark by departing from the registered form. The fact that the objector uses his mark in a form different from that in which it appears on the Register is, however, no answer to an objection if the mark in question so nearly resembles the objector's mark, as it there appears, as to be calculated to deceive (*m*), for such use is legal, although, so far as the mark used is substantially different from the mark registered, it is not protected. Even if the user were illegal, it could hardly act as an estoppel (*n*); and if the opponent were using his mark improperly, for instance, in aid of a fraudulent or illegal trade, or if his mark as used by him were calculated to deceive (*o*), the applicant's proper course would be to remove the mark out of the way by an application to rectify the Register under sect. 90.

Variation in the use of the opponent's mark.

Alteration of the opponent's registered mark in use cannot increase the objection.

3. The Essential Particulars are to be specially attended to.

Regard must be specially directed to the essential particulars of the marks to be compared, for the remaining matter in any of them might, subsequently to registration, be changed on an application under sect. 92 (*p*). On this ground, Stirling, J., refused, in *Murphy's Trade-Mark* (*q*), to

(*k*) *Christiansen's Tm.*, cited above, p. 230.

(*l*) *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102 (1886), C. A.

(*m*) *Melachrino* v. *The Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215 (1887), Chitty, J.; *Hammond* v. *Malcolm, Brunker & Co.*, 9 R. P. C. 301 (1892), Chitty, J.; *Rowland* v. *Michell*, 13 R. P. C. 457, 14 R. P. C. 37 (1897), Romer, J., and C. A.; all cases of infringement.

(*n*) See *James' Tm.*, 33 C. D. 392; 3 R. P. C. 340 (1886), C. A.

(*o*) See *Newman* v. *Pinto*, 4 R. P. C. 508; 57 L. T. 31 (1887), C. A.

(*p*) See below, Chap. XI. at p. 297.

(*q*) 7 R. P. C. 163 (1890).

allow a mark consisting of a lion carrying a sheaf, together with other matter, to be registered, there being already on the Register another mark comprising a lion bearing a crown, because the lions were the sole essential particulars of both, although each mark had additional matter, and the general appearances of the two were different. The applicants in this case offered an undertaking that they would use their mark only in the form tendered for registration, but this was not deemed sufficient by the proprietors of the opposing mark, and, as the mark was a new one, the judge refused to accept the offer as an answer to the difficulty raised by the resemblance of the essential particulars (*r*).

Undertaking not to vary registered mark in use.

4. All the Circumstances of the Trade to be considered.

Further, the Court must have regard to all the circumstances of the trade in which the marks in question are employed, or are to be employed, and in particular to the nature of the market, whether a home or a foreign one; to the number of other trade-marks similar to the contrasted marks already circulating in connection with the same description of goods; to the common marks which are or may be combined with the contrasted marks or either of them; and, generally, to the customs and usages of the trade.

Marks deceptive in particular markets.

It is obvious that marks which are readily distinguishable by Englishmen, or persons who can read English, may so resemble each other as to be calculated to deceive foreigners whose language is not only different from English, but written in different characters and in a different manner (*s*). For them, if they are ignorant of English, the words upon a mark are only subordinate devices not readily distinguishable from other words occupying corresponding positions in any con-

(*r*) And cf. *Jamieson* v. *Jamieson*, 15 R.P.C. 169 (1898); *Clark* v. *Sharp*, 15 R. P. C. 141 (1898); *Payton & Co., Ld.* v. *Snelling, Lampard & Co., Ld.*, 16 R. P. C. 283; 17 R. P. C. 48 and 628; and *Same* v. *Titus Ward & Co., Ld.*, 16 R. P. C. 424; 17 R. P. C. 58 (1900); all passing off cases, in which a prominent and distinctive feature of the plaintiffs' get-up had not been taken; also *Marshall* v. *Sidebotham*, 18 R. P. C. 43 (1901), trade-mark and passing off.

(*s*) *Johnston* v. *Orr-Ewing*, 7 App. Ca. 219 (1882); *Wilkinson* v. *Griffith*, 8 R. P. C. 370 (1891), Romer, J.

trasted mark, and being of about the same length. But if the possible confusion between the marks in a particular market would arise entirely from a device, the use of which is open to the applicant for registration, *e.g.*, the Royal Arms, the opponent would fail (*t*).

The fact that a mark only becomes deceptive owing to the presence in it of words in a foreign language and only when the meaning of those words is understood, will not help the applicant, and the mark will be refused registration if the translation of the words in English would be deceptive, even although the language used is an Oriental one (*u*).

Numerous marks of the same kind on the Register.

In cases where there are a large number of marks similar to the mark propounded on the Register, the Court may think that, though the applicant's mark might be fairly distinguishable from the opponent's if there were no other, and perhaps also from each of the others taken alone, yet the extension of the number of such marks may lead to deception. Thus, in *Hargreaves' Case* (*x*), there being four anchor marks already on the Register in the same class, Hall, V.-C., refused to allow another anchor mark to be added to them, notwithstanding that the new mark was sought to be registered for bacon and hams, while those already registered were used for different articles of food, such as biscuits, potted meat, &c., and that it was said to be distinguishable from them all. But the extent of the class is a matter to be considered (*y*).

Similar marks belonging to the applicant.

The registration of other marks belonging to the applicant himself would not generally be material to defeat his application, since a trader often desires to register slightly differing marks

(*t*) *Hubluck* v. *Brown*, 17 R. P. C. 156, Kekewich, J., an infringement and passing off case, in which the plaintiffs alleged that their goods were known in Spanish-speaking markets as *Dos Leones*, by reason of their use of the Royal Arms. In the Court of Appeal, 17 R. P. C. 638, the decision was affirmed, it being held that there had not been a deliberate copying of the plaintiffs' particular form of the Royal Arms. The particular case could not now occur with a new mark, see Instructions, p. 728.

(*u*) *Deuhurst's Application*, (1896) 2 Ch. 137; 13 R. P. C. 288.

(*x*) 11 C. D. 669 (1879); *Thewlis and Blakey's Tm.*, and *Hughes and Young's Tm.*, 10 R. P. C. 369 (1893), North, J.; and see *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Ca. 479 (1879).

(*y*) *König and Ebhardt's Tm.* (1896), 2 Ch. 236: 13 R. P. C. 449.

to distinguish goods which are of different qualities or prices (*z*). Of course, the objection referred to in the present paragraph is much more material in the case of a new trade-mark than in that of an old one (*a*).

The distinction between the marks may be of a well-known kind.

In some cases, on the other hand, the existence of a number of marks, either as common marks or as trade-marks, may operate to render a finer distinction allowable than would otherwise be the case, for the persons concerned in the trade in question may have had their attention directed to the kind of distinction which exists between the mark propounded and any of the others, because it is analogous to the known distinctions existing between the latter. Thus, in *König and Ebhardt's Trade-Mark* (*b*) the mark applied for included a crown, and the evidence showed that there were twenty-seven marks registered in the same class which consisted of, or included a crown or coronet, but the registration was allowed with a limitation of the goods for which it was registered (*c*) and a disclaimer of the crown. And in *Mitchell* v. *Henry* (*z*), an action for infringement, the reasoning which led Jessel, M. R., to dismiss an application by the plaintiffs for an interlocutory injunction, was summed up by Cotton, L. J., as follows: "What is claimed by the plaintiffs is a double thread on a white selvage; if that is distinctive, then what the defendants are using, namely a triple thread upon a white selvage, must be a distinctive trade-mark, and therefore I cannot restrain the defendants" (*d*).

Line headings.

The case just referred to forcibly illustrates the difficulties

(*z*) See "series," sect. 66, Chap. V., p. 100; and per Cotton, L. J., in *Mitchell* v. *Henry*, 15 C. D. at p. 193 (1880): see, however, the decision of Cozens-Hardy, J., in *Players' Application*, 18 R. P. C. 65 (1901), where the Court upheld the Comptroller's refusal to register, one of the grounds being that a previous registration by the applicants covered their proposed registration; see also, North, J., in *Baker* v. *Rawson*, 8 R. P. C. p. 102 (1891).

(*a*) See Lord Blackburn's judgment in *The Orr-Ewing Case*, 4 App. Ca. 499; and that of Stirling, J., in *Murphy's Tm.*, 7 R. P. C. p. 166.

(*b*) *König and Ebhardt's Tm.* (1896), 2 Ch. 236; 13 R. C. P. 449. Cf. also *The Star Tobacco Case*, on p. 245.

(*c*) See also the judgment of North, J., in *Baker* v. *Rawson*, 8 R. P. C. at p. 107.

(*d*) 15 C. D. at p. 194 (1880). The application of this reasoning to the particular case was disapproved by the C. A.

which led Lord Herschell's Committee to recommend that the line headings woven at the ends of lengths of piece goods should not be admitted as trade-marks upon the Register (*dd*). As they are all constructed by weaving coloured threads into a narrow strip at the end of the piece, the range of possible variation is very closely limited, while the number of existing headings is extremely great, so that it was considered practically impossible to maintain effective distinctions between them, or to sufficiently identify and describe them on the Register.

Marks common to the trade may be material in estimating resemblance.

The bearing of marks common to the trade upon the distinctiveness of a mark propounded for registration has been already discussed (*e*); but besides affecting the right to registration in that way, the nature and number of the common marks with which it will be associated or contrasted may cause the mark propounded to be more or to be less distinguishable from a particular mark than if they did not exist. It is clear, therefore, that the Comptroller or the Court must have regard to the marks common to the trade in applying sub-sect. 72 (2) (*f*).

5. Where the Opponent's Goods are known by a Name suggested by the Mark.

Where the goods of a particular trader have become known by a name derived from his trade-mark, any other mark which would be likely to suggest the use of the same name for the goods on which it is used, so resembles the former as to be calculated to deceive.

Seixo v. *Provezende.*

Thus, where the trade-mark of the plaintiff was a crown and the word *Seixo*, and his goods had in consequence come to be known in the market as *Crown-Seixo* wine, the defendants were restrained from using marks which led their wine to be described by the same name (*g*), although evidence was given that *Seixo* was a common word in Portuguese. "The

(*dd*) Report of 1888, p. ix.; see Chap. VIII., p. 150.

(*e*) Page 135, above.

(*f*) Per Cotton, L. J., in *Mitchell* v. *Henry*, 15 C. D. 193 (1880).

(*g*) *Seixo* v. *Provezende*, L. R. 1 Ch. 192 (1866).

plaintiff," said Lord Cranworth, "had adopted a device or trade-mark which had caused his wines to obtain celebrity under a name descriptive of that trade-mark. The defendants have adopted a trade-mark which could not fail to lead purchasers to attribute to the wines so marked the same name as that under which the plaintiff's wines were known, and so to believe that in purchasing them they would be purchasing the wines of the plaintiff. Against the use of such a trade-mark the plaintiff has, I think, a right to have the injunction of this Court." So where a trade-mark consisting of the full-length figure of a milkmaid carrying two pails, one on her head and one in her right hand, with the words *milkmaid brand* above it, was registered for condensed milk, coffee and milk, cocoa and milk, chocolate and milk, and essence of coffee, and the goods upon which it was used were known as the *milkmaid* or *dairy-maid* brand, and subsequently another trade-mark consisting of a half-length figure of a woman carrying a pail under her right arm, with the words *dairy-maid* at the side of the figure, was registered for butterine and other fatty substances used as food or as ingredients in food, an order was made to rectify the Register by confining the second registration to goods other than those included in the first, and to restrain the use of the second mark upon any of the goods for which the first was registered (*h*).

The Dairy-Maid Milk Case.

(*h*) *Anglo-Swiss Condensed Milk Co.* v. *Metcalf*, 31 C. D. 454; 3 R. P. C. 28 (1886), Kay, J. *Orr-Ewing* v. *Johnston*, 13 C. D. 434; 7 App. Ca. 219 (1879), Fry, J., C. A., and H. L. (*Two Elephant Yarn*); *Speer's Tm.*, 4 R. P. C. 521; 55 L. T. 880 (1887), Kay, J. (*Dog, Tower, and Harp Linen*); *Read* v. *Richardson*, 45 L. T. 54 (1881), C. A. (*Dog Head Beer*); *Baschiera's Tm.*, 33 S. J. 469; 5 T. L. R. 480 (1889), Chitty, J. (*Lion Matches*); *Société Anonyme des Verreries de l'Étoile*, 10 R. P. C. 436; (1894) 1 Ch. 61; 11 R. P. C. 142; (1894) 2 Ch. 26, Stirling, J., and C. A. (*Red Star Glass*); *Wilkinson* v. *Griffith*, 8 R. P. C. 370 (1891), Romer, J. (*Red Medal Polish*); *Dewhurst's Application*, (1896) 2 Ch. 137; 13 R. P. C. 288, C. A. (*Golden Fan Cotton*); *Currie & Co.'s Application*, 13 R. P. C. 681 (1896), Kekewich, J. (*Cock o' the North Whisky*), are to the same effect. In *Cowie Bros.* v. *Herbert*, 14 R. P. C. 436 (1897), Court of Session, such a case was set up by the plaintiffs, but failed (*El Musjid*), as also did the plaintiffs in *Lever Bros., Ld.* v. *Bedingfield*, 16 R. P. C. 3, (1899), where the plaintiffs had a small picture of a laundry-maid on the label, and the defendant had the words *Red Maid*, and the plaintiffs relied (*inter alia*) on that. Cf. also *Application of Pomril, Ld.*, 18 R. P. C. 181 (1901), Joyce, J. (*Apple Brand* cider).

The objection is equally strong if the word suggested by the new trade-marks, although not the same as a word suggested by the older mark, yet so nearly resembles it, as to be calculated to deceive (*i*).

The cases just cited are cases where the name applied to the opponent's or plaintiff's goods was taken from the device used as a trade-mark. The rule applies also to cases where the name is taken from some word or words appearing upon the mark. *The Osman Towel Case* (*k*) is an illustration of this (*l*); *The Milkmaid Case* (*m*); *The Lion Soap Case* (*n*); and *Currie & Co.'s Application* (*m*), already cited, and *Meens' Application* (*o*), are instances belonging to both classes.

The cases referred to above include instances both of the applicant's (or defendant's) mark containing (*p*) and of its suggesting (*q*) a word contained in or suggested by the opponent's or plaintiff's mark.

Answers to objections founded upon names derived from marks.

Where the alleged resemblance is put upon the probability of the application of the same name to the goods of both the applicant and the opponent, it is often contended in reply, (a) that the name is in fact the name or description of the goods themselves; (b) that it is suggested by words, or devices, comprised in the marks, which are common to the trade, or is itself a word or the name of a mark which is common to the trade; or (c) that the proprietor of the opposing mark is seeking to secure a monopoly in the word under cover of his mark.

(*i*) *E.g.*, *Aneroas* for umbrellas in a new mark, was rejected because there were several old anchor marks: *Thevlis and Blakey's Tm.*, 10 R. P. C. 369 (1893), North, J.

(*k*) *Barlow* v. *Johnson*, 7 R. P. C. 395, W. N. (1890) 110, C. A.

(*l*) So also are *Hodgson and Simpson* v. *Kynoch, Ld.*, 15 R. P. C. 405 (1898), Romer, J. (*Lion Soap*), a trade-mark and passing off case, the plaintiff failing as to the former; *Cochrane* v. *McNish*, (1896) A. C. 225; 13 R. P. C. 100, P. C. (*Club Soda*), infringement and passing off; *Powell* v. *Birmingham Vinegar Brewery Co.*, (1897) A. C. 710; 14 R. P. C. 720, passing off. See also *Application of Pomril, Ld.*, 18 R. P. C. 181 (1901), Joyce, J. (*Apple Brand*).

(*m*) *Supra*, note (*h*).

(*n*) See note (*l*).

(*o*) (1891) 1 Ch. 41; 8 R. P. C. 25 (1890), Chitty, J. (*Key Brand Genera*).

(*p*) *Anglo-Swiss Condensed Milk Co.* v. *Metcalf*; *La Société Anonyme des Verreries de l'Etoile*; *Dewhurst's Application*; *Cochrane* v. *McNish*; *Saxlehner* v. *Apollinaris Co.*; *Barlow* v. *Johnson*; *Meens' Application*; *Powell* v. *Birmingham Vinegar Brewery Co.*; *all supra*.

(*q*) *Orr-Ewing* v. *Johnston*; *Speer's Tm.*; *Read* v. *Richardson*; *Wilkinson* v. *Griffith*; *Currie's Application*; *Application of Pomril, Ld.*

(a) The first objection is really included in the second, but may conveniently be stated separately. It is a question of fact whether the name concerned is the name of the goods or of some quality (*r*) attributed to them, having no reference to the traders by whom they are made or dealt in, or whether it conveys a representation that the goods are made or dealt in by the proprietors of the opposing mark. The question has already been discussed (*s*). All the authorities relevant to it before 1890 were discussed and commented on in *The Osman Towel Case* (*t*) by Chitty, J., and the Court of Appeal. As has been shown elsewhere (*u*), where a name was first given by a trader to goods in the manufacture or sale of which he had a monopoly, whether as of right under a patent (*x*), or in fact because he was the first inventor or introducer of the goods (*y*), the Court will more readily infer that the name is the name of the goods merely, and that it connotes no connection between them and the trader, and the probability that this is the case, is nearly, although not quite, as strong, where, in similar circumstances, the public themselves have taken the name from the trader's marks and applied it to the goods. Of course, it is much more difficult to make out that the name has no such connotation if it is not the only name applied to the goods in the market.

(a) Where the name is descriptive of the goods.

Where the opponent has had a monopoly in the goods.

(*r*) *E.g.*, excellence: *Arbenz' Application*, 35 C. D. 248; 4 R. P. C. 143 (1886), C. A. (*Gem Air-guns*); or size: *Wood* v. *Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A. (*Elon cigarettes*).

(*s*) Chap. II., p. 36; see per Lord Selborne, in *Singer* v. *Wilson*, 3 App. Ca. p. 376 (1878).

(*t*) *Barlow* v. *Johnson*, 7 R. P. C. 393; W. N. (1890), 110.

(*u*) Chap. II., pp. 43 *et seq.*

(*x*) *Wheeler & Wilson Co.* v. *Shakespear*, 39 L. J. Ch. 36 (1869), James, V.-C.; *Linoleum Co.* v. *Nairn*, 7 C. D. 834 (1878), Fry, J.; and *Pulmer's Tm.*, 24 C. D. 504 (1882), Chitty, J., and C. A.; *Slazenger* v. *Feltham*, 6 R. P. C. 531; 5 T. L. R. 365 (1889), C. A. (*Demon Racquets*) (a case of an invalid patent); *Magnolia Metal Co.'s Tms.*, (1897) 2 Ch. 371; 14 R. P. C. 265 and 621, Kekewich, J., and C. A. (*Magnolia Metal*); *Meaby & Co., Ld.* v. *Triticine, Ld.*, 15 R. P. C. 1 (1897), North, J. (*Triticumina biscuits*); *Formalin Hygienic Co.'s Application*, 17 R. P. C. 486 (1900), Farwell, J. (*Formalin*); *Cheseborough Co.'s Tms.*, 18 R. P. C. 191 (1901), Buckley, J. (*Vaseline*).

(*y*) *Leonard and Ellis' Tm.*, 26 C. D. 288 (1884), C. A. (*Valcoline*); *Arbenz' Application*, 35 C. D. 248; 4 R. P. C. 143 (1887), C. A. (*Gem Air-guns*); *Waterman* v. *Ayres*, 39 C. D. 29; 5 R. P. C. 368 (1888), C. A. (*Reversi*).

If the fact is made out that the name suggested by the marks is merely descriptive, and there is no other resemblance which is calculated to deceive, the second mark is not disentitled to registration. Thus, in *Horsburgh & Co.'s* application, Messrs. Leonard and Ellis, in 1873, adopted, and subsequently registered, a trade-mark comprising the word *valvoline;* four years later the applicants sought to register a different mark comprising the word *valvolcum*. The words were held to be substantially the same, and each of them to be descriptive of the valve oil in connection with which both marks were to be used, and Jessel, M. R., allowed the second mark to be registered (*z*).

(b) Where the name is suggested by matter in the mark common to the trade.

(b) Where the name is suggested by words or devices which are common to the trade and which occur in the trade-mark offered for registration, the words or devices must, if distinctive, in the case of a new mark (*a*), and unless they form part of the essential particulars (*b*), be disclaimed in the application (*c*), and if they form part of the oppouent's mark also, a disclaimer should be registered in connection with that mark, and the matter disclaimed cannot be, by itself, relied on to support the opposition (*d*). The last-mentioned rule may also be applicable if a word or device is saved from disclaimer only by being part of an essential particular, as, for instance, occurring in a distinctive label (*e*). But the presence of the

(*z*) 53 L. J. Ch. 237, n. (1878). The opponents had also registered *Valvoline* alone as a trade-mark. It was subsequently removed from the register; *Leonard and Ellis' Tm.*, 26 C. D. 288 (1884), C. A.; *Blair* v. *Stock*, 52 L. T. 123 (*Strathmore Blend Whisky*); *Loftus' Tm.*, above, p. 210, note (*h*).

(*a*) The same would apply to old marks in cases where statement of essential particular and disclaimer are necessary; as to this, see *supra*, p. 185.

(*b*) As, for instance, part of a distinctive label, *supra*, pp. 153, 205. Prior to the Act of 1888 they need not be disclaimed if part of the mark. As to the alteration made by that Act, see *supra*, p. 209.

(*c*) Sect. 64 and Sect. 74. Chap. IX., p. 197; *Meens' Application*, (1891) 1 Ch. 41; 8 R. P. C. 25, Chitty, J. (*Key Brand Genera*). Cf. *Player's Application*, 18 R. P. C. 65, Cozens-Hardy, J. (1901).

(*d*) *Pirie* v. *Goodall*, (1892) 1 Ch. 35; 9 R. P. C. 17, C. A. (*parchment bank paper*); *Rosenthal* v. *Reynolds*, (1892) 2 Ch. 301; 9 R. P. C. 189, North, J. (*W. R. corsets*); *Watt* v. *O'Hanlon*, 4 R. P. C. 1 (1886), Porter, M. R., an Irish case; *Loftus' Tm.*, (1894) 1 Ch. 193; 11 R. P. C. 29, North, J. (*Unco Guid Whisky*); *Hubbuck* v. *Brown*, 17 R. P. C. 148 and 638 (1900), Kekewich, J., and C. A. See, however, p. 209 above.

(*e*) *Semble*, per Romer, L. J., dur-

common elements in both marks may be an element in creating a general resemblance between them looked at as wholes (*f*). In one case, however, where there was no disclaimer on the Register, and no application to rectify, North, J., notwithstanding evidence that part of the opponent's registered mark was common to the trade, held that it was used distinctively (*g*).

The opponent cannot rely on disclaimed matter or words in his mark.

The Star Tobacco Mark Case (*h*) is an authority to show that the suggestion both by the mark of the applicant and by that of the opponent of a word which is common to the trade, because it is a name or description for the goods in connection with which both marks are used, is not a sufficient reason for refusing the application to register. There the opponents had registered as an old mark a characteristic eight-pointed star, and also, as a new mark, a label with the star, another device and the word *star*, and they asserted that their goods were frequently sold and ordered as star goods. The applicant's mark consisted of a sea-picture within a ring, having a small six-pointed star in the clouds at the top, and a conspicuously drawn anchor in the lower part of the picture, and the words *star of hope*. The judge found that the device of a star, although not the particular star of the opponent's old mark, was common to the trade, and he allowed the registration. "I think," he said, "that the use of the word *star* and the use of the figure of a star are matters *publici juris*, and have been *publici juris* at all material times, except so far as some particular trader may have appropriated a particular phrase in which *star* is used in some special manner, or may have appropriated a particular design in which the figure of a star has assumed a special form, or has been so combined with other matters as to produce a specific thing different from what may be called the ordinary image of a star."

Where the name is common to the trade.

In *Hubbuck* v. *Brown* (*i*) the plaintiffs sought to establish

ing the argument in *Clement et Cie.'s Tm.*, 16 R. P. C. 611 (1899).

(*f*) See p. 230.

(*g*) *Goodall's Tm.*, 42 C. D. 566 (1889), North, J. (*parchment bank paper*); cf. the rule that an application to rectify cannot be made by counterclaim, Chap. XI., p. 287.

(*h*) *Re Dexter's Application, Re Wills' Tm.*, (1893) 2 Ch. 262; 10 R. P. C. 269, Wright, J.

(*i*) 17 R. P. C. 148 (1899), Kekewich, J. (*Dos Leones*); affirmed by C. A., 17 R. P. C. 638.

that in certain foreign countries their goods had acquired the name *Dos Leones*, and that the defendant's mark would deceive, but they were in the difficulty that their goods had acquired the name from the presence of the Royal Arms in their mark, and that they could not restrain the use of such Arms by the defendant without setting up a monopoly in them to which they were not entitled (*j*).

(c) Where the name is said to give a practical monopoly.

(c) The third ground of reply has been also dealt with in several cases, and it is settled that a trader will not be allowed to acquire or use a mark which will probably lead to his goods being mistaken for those of another, even though this may make it difficult for him to truly describe the place of origin of his goods, or to present them to purchasers in the form in which they expect to receive goods of the class (*k*).

The Red Medal Polish Case.

Thus, in *Wilkinson* v. *Griffith* (*l*), an infringement case, Romer, J., in restraining the defendants from using their label, relied upon evidence that the plaintiff's goods were known as red stamp polish from the figures upon his labels, although it was urged on the defendants' behalf that the plaintiff's claim practically involved a claim to a monopoly in red labelled goods. The judge, however, expressly stated that the plaintiff was not entitled to any such monopoly. "I by no means hold, nor do I think, the evidence as a whole can fairly be said to establish," he said, "that any red mark on a label of the defendant would render that label deceptive. I can imagine many red marks, or even red medals, being so used as to prevent deception." But it is for the applicant for registration of the mark which is alleged to be deceptive to make it clear that such is not the case.

(*j*) Cf. also *Phillips* v. *Ogden*, 12 R. P. C. 325 (1895), Wills, J., a passing-off case, in which both plaintiffs and defendants had the right to use *Guinea Gold* for cigarettes, and otherwise the boxes were sufficiently distinguished.

(*k*) *Wotherspoon* v. *Currie*, L. R. 5 H. L. 508 (1872) (*Glenfield Starch*); *Montgomery* v. *Thompson*, (1891) A. C. 217; 8 R. P. C. 361 (*Stone Ales*). It is to be noted, however, that these were both cases of attempted frauds. *Johnston* v. *Orr-Ewing*, 7 App. Ca. 219 (1882), H. L. (*Two Elephant Yarns*). See also the last paragraph.

(*l*) 8 R. P. C. 370 (1891), Romer, J. (*Red Stamp Polish*).

Evidence (*m*).

Evidence material to the question of resemblance.

It follows that upon any question with respect to the registration of a mark which arises under sub-sect. 72 (2) it is material for the Comptroller or the Court to be furnished with evidence of the matters of fact involved in the propositions stated above wherever it is alleged that they tend to increase or diminish the resemblance referred to in the sub-section.

Expert evidence as to probability of deception.

Besides this evidence, the evidence of persons who are well acquainted with the trade concerned is constantly tendered by the parties to show that in the opinion of such persons, as experts, the alleged resemblance between the contrasted marks is, or is not, calculated to deceive. Judges have often expressed much impatience of evidence of this class (*n*), and certainly it frequently presents in an eminent degree the characteristic vices of expert testimony. It consists in general of opinions formed after the dispute has arisen; not upon any judicial balance of the opposing contentions, but upon a scrutiny of the subject directed to discover what can be said in favour of one side only. And where the question is as to the degree of a resemblance between two words or designs, or as to whether a difference in particular parts of two contrasted labels is substantial or immaterial, reasons can rarely be found by the witnesses to recommend an opinion to anyone who has not conceived it for himself without their assistance.

The judge must in the end act upon his own view on a comparison of the marks, having regard to the matters of fact referred to above (*o*); but it is settled that the expert evidence is admissible (*p*), and in particular cases it may be of import-

(*m*) As to the evidence upon applications to register generally, see Chap. IV., pp. 89 and 90. Where the appeal to the Court is by summons the evidence should be completed before the adjournment into Court: per Stirling, J., in *Jackson & Co.* v. *Napper*, 35 C. D. p. 166; 4 R. P. C. 45.

(*n*) *Re Jelley*, 51 L. J. Ch. 639, n., Jessel, M. R. (1878); *Pinto* v. *Badman*, 8 R. P. C. 181 (1891), C. A.

(*o*) The question is to be decided partly by the judge's eyesight, and partly by his view of the evidence: *Farrow's Tm.*, 7 R. P. C. 260; 63 L. T. 233 (1890), Stirling, J.

(*p*) In *North Cheshire & Manchester Brewery Co.* v. *Manchester Brewery Co.* (1899), A. C. p. 85 (a trade-

ance, for evidence of what are the surroundings of the marks and the circumstances of the trade concerned may not suffice to enable the Court to judge sufficiently of the influence which a practical acquaintance with such matters would have upon the impression made by the marks on the minds of persons engaged in the trade (*pp*). Thus, in *Mitchell* v. *Henry*, the case of the coloured thread marks woven into the selvages of cloth, Cotton, L. J., considered the probability of deception to be essentially a question of experts (*q*).

Direct evidence of probability of deception.

Evidence of ordinary members of the public who are not acquainted with the usages of the trade involved, or even of experts, that they think they would, or would not be deceived by the resemblance of one mark to another, is of little assistance in the determination of questions of alleged deceptive similarity (*r*).

name case), Halsbury, L. C., said: "Is this name so nearly resembling the name of another firm as to be likely to deceive? That is a question upon which evidence, of course, might be given as to whether or not there was another brewery either in the one place or in the other, or whether there were several breweries nearly resembling it in name; what the state of the trade was, and whether there was any trade-name. All these are matters which are proper to be dealt with upon evidence; but upon the one question which your Lordships have to decide, whether the one name is so nearly resembling another as to be calculated to deceive, I am of opinion that no witness would be entitled to say that, and for this reason: that that is the very question which your Lordships have to try." Referring to this passage, Lord Alverstone, L. C. J., in *The London General Omnibus Co., Ld.* v. *Lovell*, (1901) 1 Ch. 135; 18 R. P. C. 74, said: "I am satisfied that the Lord Chancellor did not mean to lay down any general rule that no evidence that things were calculated to deceive was ever to be required. In that case evidence had been given, and it was merely the comparison of the two names, which, one may say, speak for themselves," and in this case the Court allowed the defendants' appeal, on the ground that (the Judge having viewed the omnibuses) the plaintiffs had given no evidence that the defendant's "get-up" was calculated to deceive. The defendant's omnibus, except for one alteration, had been running for some years. See also *Hedley's Tms.*, 17 R. P. C. 719 (1900), and *Alaska Packers' Association* v. *Crooks*, 18 R. P. C. 129 (1901).

(*pp*) See *Hubbuck* v. *Brown*, 17 R. P. C. 148 (1900), Kekewich, J.

(*q*) 15 C. D. p. 195 (1880); and see *Christiansen's Tm.*, 3 R. P. C. 54 (1885), Chitty, J., and C. A.

(*r*) See *Kutnow's Tm.*, 10 R. P. C. 401 (1893), North, J. (*Carlsbad Salts*), and note (*p*), *supra*. In *Turton* v. *Turton*, Fry, L. J., compared this evidence to the oaths of compurgators in a mediæval trial: 45 Ch. D. at p. 149.

Evidence of actual deception.

If one or more cases of actual deception are made out to the satisfaction of the Court, this will, of course, afford very strong evidence that the resemblance of the marks in question is so close as to be calculated to deceive. But the absence of evidence of actual deception is a circumstance which varies greatly in weight according to the nature of the case. It is conceived that it can never be conclusive by itself (*s*); but where the marks have been circulating side by side in the market where deception is alleged to be probable, the fact that no one appears to have been misled is very material (*t*), unless the absence of such evidence is explained by the difficulty of procuring witnesses from a distant foreign market (*u*), or otherwise, satisfactorily. On the other hand, if one or both of the marks is new or nearly new, there can have been no opportunity, or little opportunity, for deception to occur.

Examples and illustrations.

The cases following, of marks held to have, or not to have, such resemblance to each other as to be calculated to deceive, illustrate the principles referred to above. Many of them have been cited already.

Contrasted Devices.

A pointer eating out of a pot, too near for registration to a similar dog standing by a pail with SPANCH beneath it; *Jelley's Application*, 51 L. J. Ch. 639, n. A twisted curved horn, with a twig bearing two roses, too near a similar untwisted horn with a cord having two loops in the same place as the roses in the twig; *Rosing's Application*, 54 L. J.

(*s*) *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185 (1863), Westbury, L. C.; *Compania Général de Tobacos* v. *Rehder*, 5 R. P. C. 61 (1887), Kay, J.; *Reddaway & Co.* v. *Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639; 9 R. P. C. 503, C. A.; *Paine & Co.* v. *Daniell & Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 71, C. A.

(*t*) *Cope* v. *Evans*, 18 L. R. Eq. 138 (1874), Hall, V.-C.; *Rodgers* v. *Rodgers*, 31 L. T. 285 (1874), Mellish, L. J.; *Estcourt* v. *The Estcourt Hop Essence Co.*, L. R. 10 Ch. 276 (1875), C. A.; *Lambert's Tm.*, 5 R. P. C. 556; 61 L. T. 138 (1888), North, J.; and *Baker* v. *Rawson*, 45 C. D. 519; 8 R. P. C. at p. 107 (1889), North, J.; *Talbot's Tm.*, *infra*, p. 252; *Phillips* v. *Ogden*, 12 R. P. C. 325 (1895), Wills, J.; but see *Liebig's Extract of Meat Co.* v. *Chemists' Co-operative Society*, 13 R. P. C. 635, 736 (1896), Kekewich, J., and C. A.

(*u*) *Wilkinson* v. *Griffith*, 9 R. P. C. 370 (1891), Romer, J. In *Cowie Bros.* v. *Herbert*, 16 R. P. C. 436 (1897), the Scotch Court of Session commented on the absence of such evidence.

Ch. 975, n. A triangular frame with words upon it and a church inside, too near Bass's solid triangle; *Worthington's Tm.*, 14 C. D. 8; so also a white diamond within a red diamond; *Turney and Sons' Tm.*, 11 R. P. C. 37. A half-length figure of a milkmaid, with the word *Dairy-maid*, too near a full-length figure of a milkmaid carrying two pails; *Anglo-Swiss Condensed Milk Co.* v. *Metcalf*, 31 C. D. 454; 3 R. P. C. 28. A woman's head wearing a helmet with ATHENA beneath, not too near a man's head with WAY beneath; *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102. A tower in an oval border, with a dog and harp, too near a tower, dog, and harp without any border; *Speer's Tm.*, 4 R. P. C. 521. An oval label containing interlaced triangular frames with a stag's head within them, too near an oval label with three superimposed solid triangles, although the lettering on the marks was conspicuously different; *Bicgel's Tm.*, 4 R. P. C. 525; 57 L. T. 247. A sheep suspended by its middle, with the words GOLDEN FLEECE, too near a somewhat different sheep with the same words; *The Australian Wine Importers' Tm.*, 41 C. D. 278; 6 R. P. C. 311. A pig in outline, and H. B. & Co., not too near shaded pointer dog, and STANCH; *Haines, Batchelor & Co.'s Tm.*, 5 R. P. C. 669. A tobacco pipe and dart, not too near a tobacco pipe alone; *Lambert's Tm.*, 5 R. P. C. 542; 6 R. P. C. 344; 61 L. T. 138. A charging buffalo, too near a bull's head, both being placed in silver rings on similar yellow wrappers; *Farrow's Tm.*, 7 R. P. C. 260; 63 L. T. 233. A mark having as its sole essential particular a lion bearing a sheaf, too near a mark having as an essential particular a lion with a crown; *Murphy's Tm.*, 7 R. P. C. 163. An elephant in a border with lettering round it, an infringement of a somewhat different elephant alone; *Upper Assam Tea Co.* v. *Herbert & Co.*, 7 R. P. C. 183. A label bearing a winged cross surrounded by two circles in its upper third, not an infringement of a similar label, being a lighthouse similarly surrounded and placed; *Baker* v. *Rawson*, 45 C. D. 519; 8 R. P. C. 89. A label with two red medals and a balloon, an infringement of a similar label with two red medals only, both labels being used for polish known in India, from the latter label, as red medal polish; *Wilkinson* v. *Griffith*, 8

R. P. C. 370. A label with a cock in the centre, the groundwork being a piece of plaid with the words *Prince Charlie, King o' the Hieland Hearts*, in the upper part, too near a label bearing in the upper part the words *The Cock o' the North* with a cock in a central position over a coat of arms, with a Highlander on one sido and a horse on the other; *Currie's Application*, 13 R. P. C. 681. A label bearing a representation of the Royal Exchange, Glasgow, and the words *Royal Exchange Whisky* below, refused registration because it would give the right to restrain a label bearing the same representation with the words *Bodega Special Whisky* below; *Rogers' Tm.*, 12 R. P. C. 149. C. B. & Co. and also C. B. D. held to infringe marks, one consisting of the device of a corset and the letters C. B. within a star, and the other of C. B. corsets; *Bayer* v. *Connell Bros.*, 16 R. P. C. 157 (*v*). The device of a red deer's head, not an infringement of a trade-mark consisting of a moose head; *Alaska Packers' Association* v. *Crooks & Co.*, 16 R. P. C. 503, and 18 R. P. C. 129. The device of the cut side of half an apple cut vertically, with the word *Pomril* across it, too near a mark containing a representation of an apple and the words "apple brand," both marks being for cider; *Pomril Ld.'s Application*, 18 R. P. C. 181.

Contrasted Words.

WHITE ROSE, too near ROSALINE; *White Rose Tm.*, 30 C. D. 505. CONDI-SANITAS and SANITANT, infringements of SANITAS; *Sanitas Co.* v. *Condy*, 4 R. P. C. 195 and 530; 56 L. T. 621. BOYD'S UNRIVALLED HARNESS COMPOSITION, in a label with the Arms of the City of Dublin, not an infringement of PROPERT'S IMPROVED HARNESS COMPOSITION in a label, with a fox's head, the labels being similarly got up; *Beddow* v. *Boyd*, 4 R. P. C. 310. APOLLINIS, an infringement of APOLLINARIS; *Apollinaris Co.* v. *Herrfeldt*, 4 R. P. C. 478. STEINBERG, an infringement of STEINWAY, the words being used with devices showing a general similarity; *Steinway* v. *Henshaw*, 5 R. P. C. 77. EMOLLIO, too near EMOLLINE; *Grossmith's Tm.*, 6 R. P. C. 180; 60 L. T. 612. EMOLLIOLORUM, not too near MOLLISCORIUM; *Talbot's Tm.*, 11 R. P. C. 77. SWIFT'S SPECIFIC occuring in a trade-mark,

(*v*) In Ireland before Porter, M. R. See also *Bayer* v. *Baird*, 15 R. P. C. 615 (1897), Sc. Ct. of Session.

not calculated to deceive merely because the words were descriptive of the opponent's drug; *Swift Specific Co.'s Tm.*, 6 R. P. C. 352. OOMOO, not too near EMU; *Burgoyne's Tm.*, 6 R. P. C. 229; 61 L. T. 39. KOKOKO, too near the common word COCO; *Jackson Co.'s Tm.*, 6 R. P. C. 80. DEMOTIC, an infringement of DEMON; *Slazenger* v. *Feltham*, 6 R. P. C. 531. DUNN'S FRUIT SALT BAKING POWDER, too near ENO'S FRUIT SALT; *Eno* v. *Dunn*, 41 C. D. 439; 15 A. C. 252; 7 R. P. C. 311; subsequently held to be an infringement, 10 R. P. C. 261. EL DEVINO, an infringement of EL DESTINO; *Pinto* v. *Trott*, 8 R. P. C. 173. Label with EL DESTINACION, an infringement of a similar label with EL DESTINO; *Pinto* v. *Badman*, 8 R. P. C. 181. Label with LONDON PICKLES, an infringement of similar label with LONDON PICKLE Co.; *Hammond* v. *Malcolm, Brunker & Co.*, 9 R. P. C. 301. STAFFORD, an infringement of TRAFFORD; FORT of FORTRESS; NEW MISTRESS, but not NEW MATRON, NEW MASTER, or MASTER, of MISTRESS; but SOUTH AFRICAN not an infringement of a mark consisting of a negro's head and the word AFRICAN; *Smith and Wellstood* v. *Carron Co.*, 13 R. P. C. 108. VINCALIS, not too near WINCARNIS, the goods being different in appearance and use; *Coleman & Co., Ld.* v. *Brown & Co.*, 16 R. P. C. 619 (passing off). TRITICUMINA, not infringed by TRITICINE; *Meaby & Co., Ld.* v. *Triticine, Ld.*, 15 R. P. C. 1. Signature ROBERT CRAWFORD, not infringement of signature DANIEL CRAWFORD; *Crawford* v. *Bernard & Co.*, 11 R. P. C. 580. MARGARITA, an infringement of LA FLOR DE MARGARETTA; *Benedictus* v. *Sullivan, Powell & Co.*, 12 R. P. C. 25. SAVOLINA, an infringement of SAVONOL; *Field, Ld.* v. *Wagel Syndicate, Ld.*, 17 R. P. C. 266. IVORY, calculated to be confused with IVY; *Goodwin* v. *Ivory Soap Co.*, 17 R. P. C. 689 (*x*). NIGHT CAP, not too near RED CAP or MOTHER RED CAP; *Hedley's Tms.*, 17 R. P. C. 719. VALTINE, too near VALENTINE; *Valentine Meat Juice Co.* v. *Valentine Extract Co. Ld.*, 17 R. P. C. 673, passing off (and see 18 R. P. C. 175). S. GRIFFITHS, three stars and I. X. L., not infringed by E. GRIFFITHS and three stars, the stars being common marks of quality; *Marshall* v. *Sidebotham*, 18 R. P. C. 43.

(*x*) The action was dismissed on other grounds.

III. Deceptive Marks.

Sect. 73. Deceptive marks.

It is provided by sect. 73 that—

"It shall not be lawful to register as part of, or in combination with a trade-mark any words the *exclusive* use of which would, by reason of their being calculated to deceive or otherwise (*y*), be deemed disentitled to protection in a court of justice, or any scandalous design."

This proviso is taken from sect. 6 of the Act of 1875, except that in the last line "justice" is substituted for "equity," "disentitled" is substituted for "not entitled," and the word "exclusive" which qualified "use," both in the old Act and in the Act of 1883, was removed, upon the suggestion of Lord Herschell's Committee, by the Act of 1888. The Committee say: "Words might be offered for registration in conjunction with a trade-mark for which the applicant did not claim, and of which he would not be entitled to claim the exclusive use, but the use of which might nevertheless be calculated to deceive, and so be disentitled to the protection of a court of justice."

"Exclusive use."

The restriction laid down by the section would not seem to be carried any further by sect. 86, which authorizes the Comptroller to refuse to register a trade-mark of which the use would, in his opinion, be contrary to law or morality.

The provisions of the section were, no doubt, intended to embody the old rule of the Court of Chancery, which refused protection to the owner of a deceptive trade-mark (*z*); and it was held, by Jessel, M. R., that their operation was confined to cases where the marks were in themselves inherently deceptive (*a*); but the Courts have held that the restriction is of wider scope than the old rule, or than this construction would suggest (*b*). The leading case in point is *Eno* v. *Dunn*

The section extends beyond the old rule of estoppel by misrepresentation.

The Fruit Salt Case.

(*y*) See p. 261, below.

(*z*) See Chap. XV., p. 297; and Lord Macnaghten's judgment in *Eno* v. *Dunn*, *infra*.

(*a*) *Horsburgh's Application*, 53 L. J. Ch. 237, n.; 50 L. T. 23, n. (1878) (*Valvoleum*).

(*b*) See the judgment of Cotton, L. J., in which the majority of the law lords concurred, in *Eno* v. *Dunn*, 41 C. D. p. 448.

Dunn (*c*), in which the House of Lords (Lord Halsbury and Lord Morris dissenting) overruled the judgment of the Court of Appeal (Lindley and Fry, L. JJ., Cotton, L. J., dissenting), and restored that of Kay, J. The question in that case was whether the words *Fruit Salt* occurring in a mark consisting of the words *Dunn's Fruit Salt Trade-Mark Baking Powder*, and in a mark consisting of a distinctive label, quite different in character from the device used by the opponent, Eno, and bearing the words *Dunn's Fruit Salt Baking Powder*, were calculated to deceive, having regard to the well-known use of the words as the name of Eno's Fruit Salt. Eno, in the first instance, based his opposition to Dunn's application to register his marks partially upon his title as the owner of the mark *Fruit Salt*, registered as "a proprietary medicine for human use," and also as a "dry preparation for making a non-intoxicating beverage"; but finding that he could not prove user of that mark before 1875, and that the words were consequently not capable of registration, he was driven to consent to its removal from the Register, and to rely wholly upon the alleged deceptiveness of the marks propounded by Dunn. The marks were normally used for different goods. Dunn's preparation was a baking powder, and Eno's an aperient effervescing powder; but evidence was given that, in a very few instances, Eno's salt had been used as a baking powder, although it was shown to be very unsuitable for the purpose. The majority of the law lords held that Dunn's marks were deceptive, and the application to register was dismissed. Lord Herschell and Lord Macnaghten based their judgments upon the discretion conferred on the Comptroller—apart from the sections considered in this chapter—to refuse marks from which it is not clear that deception might not result. Lord Herschell said: "I think it is enough to say that I am not satisfied that there would be no reasonable danger of the public being so deceived. The case was argued on behalf of the respondent,

Doubtful new marks to be rejected.

Lord Herschell's judgment.

(*c*) 15 App. Cas. 252; 7 R. P. C. 311; *Dunn's Tm.* (1889), subsequently an injunction was granted to restrain Dunn & Co. from using the words *Fruit Salt*: *Eno* v. *Dunn*, 10 R. P. C. 261 (1893), Kekewich, J.

as if he had an absolute right to have any trade-mark registered which was not proved to fall within the terms of either the 72nd or 73rd section of the Act. I do not so read the statute. Those sections prohibit the registration of a trade-mark in certain specified cases; but there is no duty cast upon the Comptroller of registering every other trade-mark that may be applied for. On the contrary, whilst he is in certain cases prohibited from registering, a discretion whether to register or not appears to me to be in all cases fairly conferred." And Lord Macnaghten said of the marks: "They are calculated, and I think designed, to create a confusion in the minds of those persons to whom Mr. Dunn's advertisements are addressed, and to lead the ordinary run of such persons to suppose that his baking powder is in some way or other connected with Mr. Eno's preparation"; and he held, therefore, that the marks ought to be rejected, for the "Comptroller ought to reject words which involve a misleading allusion or suggestion of that which is not strictly true, as well as words which contain a gross and palpable falsehood."

Lord Macnaghten's judgment.

Lord Watson, on the other hand, treated the case as one falling within the 73rd section. "These prohibitory clauses," he said, referring to sects. 73 and 72 (2), "cast upon the applicant the duty of satisfying the Comptroller, or the Court, that the trade-mark which he proposes to register does not come within their scope. In an inquiry like the present, (the applicant) does not hold the same position which he would have occupied if he had been defending himself against an action for infringement. There, the onus of showing that his trade-mark was calculated to mislead rests, not on him, but upon the party alleging infringement; here, he is *in petitorio*, and must justify the registration of his trade-mark by showing affirmatively that it is not calculated to deceive. It appears to me to be a necessary consequence that, *in dubio*, his application ought to be disallowed." And upon the question of fact, he said: "There would be a supposed connection in the minds of many persons, who would naturally assume that the baking powder had been manufactured with the appellant's fruit salt, and purchase it in that belief; so

Lord Watson's judgment.

that a batch of badly made baking powder might seriously injure the credit of the effervescing powder" (*d*).

Two recent cases deserve special notice. In *Dewhurst's Application* (*e*) the words *The Golden Fan Brand* in Burmese characters were refused registration as an essential particular of a mark, there being on the Register for the same goods a fan which in use was coloured gold; and Kay, L. J., expressly based his judgment on sect. 73, holding that the words would, in Burma, be calculated to deceive, in the event of the owner of the registered fan trading there. In *Eastman Photographic Materials Co.* v. *John Griffith's Cycle Corporation* (*f*), the last-named company had registered *Kodak* as a trade-mark for cycles, and the plaintiffs, who moved to remove the mark from the Register, had identified that name with themselves and their goods, and in particular with bicycle cameras, and the name was comprised in several of their trade-marks, but none of them was registered in class 22, which includes bicycles. Romer, J., held that the defendants intended, by the use of the name, to cause the public to think that they were connected with the plaintiff company, or that their goods were those of the plaintiff company, and, following *Eno* v. *Dunn*, he ordered the mark to be removed, as, when registered, being likely to deceive. Since, however, sect. 73 only relates to words proposed to be registered as part of or in combination with a trade-mark, and the defendant company's word was registered by itself, it would seem that the learned judge referred rather to the general discretion to refuse a deceptive mark than to any particular section of the Act (*g*).

Mark containing name of the opponent's goods not necessarily deceptive.

A mark is not calculated to deceive merely because it contains an ordinary description of an article of commerce which is occasionally used to describe a rival trader's

(*d*) See above, p. 69, "the Comptroller's discretion."

(*e*) (1899) 2 Ch. 137; 13 R. P. C. 288. See *supra*, p. 223.

(*f*) 15 R. P. C. 105 (1898), Romer, J.

(*g*) The case of a word-mark being deceptive otherwise than under sect. 72 seems to be a *casus omissus* under the Acts, although it is an *à fortiori* case to that dealt with in sect. 73. *Quære*, however, whether "as part of" should not be read as equivalent to "in." The reference to *Eno* v. *Dunn* in the judgment of Romer, J., seems to show that sect. 72 was not relied on.

goods (*h*). To hold otherwise would certainly be, as Fry, L. J., said in *The Fruit Salt Case*, to allow the objector "to enclose and appropriate as private property certain little strips of the great open common of the English language" (*i*). Thus, where *The Smokeless Powder Co., Ld.*, had registered a label bearing a target, with their name printed prominently upon it, supported on one side by the figure of a sportsman and on the other by that of a rifleman, an unsuccessful attempt was made by a rival powder-making company to have the mark removed from the Register, or to have a disclaimer of the words *Smokeless Powder* added to the registration. The application failed as to the disclaimer, because the words were not distinctive, and also because they were not additions within the meaning of sect. 74, and were part of the name of the proprietors of the mark. It was argued that the presence of the words in the label was in effect a claim of a monopoly of the words, although the manager of the respondent company stated that the company made no such claim; but Chitty, J., decided against the objection (*j*), and held that the use of the words in the mark was not calculated to deceive (*k*). No such identification of the words in question with the applicant's goods was proved in this case, as was shown in *The Fruit Salt Case* of the words *Fruit Salt* with Eno's powder, and in *The Stone Ales Case* (*l*) of the words *Stone Ales* with Joule and Sons' beer; but, apart from this, the case seems readily distinguishable, on the ground already mentioned, that the words concerned were the ordinary words which anyone would choose to describe the goods both of the applicants and the respondents, and words which, apart from the Acts, could never have become, for such goods, the subject of exclusive rights (*m*).

The Smokeless Powder Co. Case.

(*h*) See *Dexter's Application*, (1893) 2 Ch. 262; 10 R. P. C. 269, Wright, J. (*Star Tobacco*), above, p. 245.

(*i*) 41 C. D. at p. 455.

(*j*) See Chap. VIII., p. 154, "Label."

(*k*) So also in *Faulder's Tm.*, 18 R. P. C. 37 (1901), Kekewich, J., held that "Silverpan" in a mark registered for jam was descriptive and not calculated to deceive.

(*l*) (1891) A. C. 218; 8 R. P. C. 361.

(*m*) Chap. II., pp. 34 *et seq.* In *Faulder's Tm.*, *supra*, the respondents were seeking to restrain the applicants from using the word "Silverpan," but on the motion they stated that they did not claim any exclusive use by reason of their registration.

Device suggesting the name of the opponent's goods.

And as the presence of a common word in a label does not make the label deceptive, although the word is used of the opponent's goods (*n*), so neither does the presence of a device which suggests such a word. Thus, in *Kuthnow's Case* (*o*), a label which included a picture of the Deer-leap rock at Carlsbad —a well-known and remarkable object in the environs of the town—was allowed to be registered for use with Carlsbad Salts, the name of the salts being common property, and applicable both to the natural product of the springs at Carlsbad and to artificial imitations of it. The opponents in the case were the Municipality of Carlsbad,—who own both the springs and the rock in question,—and their lessees of the springs. They sought to show that the use of the picture by the applicant would be calculated to lead purchasers to believe that the goods upon which it appeared were their goods; but the judge held that it would only suggest that the goods were Carlsbad Salts. And this would be true if, as he was bound to anticipate, the applicant used his mark honestly. The opponents had no monopoly in Carlsbad Salts.

***Trade-mark* attached to part of the mark only may be deceptive.**

In *The Apollinaris Case*, Fry, L. J., in delivering the judgment of the Court of Appeal, expressed an opinion that a label which bears the word "trade-mark" so printed upon it as apparently to refer only to a device which forms part of the label, the whole label being, in fact, the trade-mark, is calculated to deceive (*p*), notwithstanding that the objection might have been, but was not, taken in the earlier case of *Hudson's Trade-Marks* (*q*), where the Court of Appeal decided in favour of the mark propounded; and in *Re Wills' Trade-Marks*, Wright, J., subsequently ordered a mark to be removed from the Register on this ground (*r*). This objection caused considerable uneasiness to proprietors of trade-marks, and led to several applications to the Court, under sect. 92, for leave to amend registered marks, for the word

(*n*) See above, p. 242.

(*o*) 10 R. P. C. 401 (1893), North, J. Cf. also *Hubbuck* v. *Brown*, 17 R. P. C. 148 and 638.

(*p*) (1891) 2 Ch. at p. 233; 4 R. P. C. 478.

(*q*) 32 C. D. 311 (1886).

(*r*) (1893) 2 Ch. 262; 10 R. P. C. 269. The order was made subject to an application to amend being made within a reasonable time, but no such application was made.

Trade-Mark is often printed upon labels and other trade-marks; but it is to be observed that it is only objectionable where its presence apparently implies that part of the actual mark is the whole trade-mark. In the mark to which Fry, L. J., was directly referring, the word was placed immediately under a red disc, which was the most prominent feature in the label. "It is a question of fact in every case where a man puts the term 'trade-mark' on his device, or some part of it, whether he does or does not so place the words as to indicate to the public that he is claiming a particular part of the trade-mark only." (*s*). In *Colman's Trade-Marks* (*t*), Kekewich, J., allowed "trade-mark" to be struck out of a number of labels, on condition that the proprietors should state what were and what were not the essential particulars of the marks (*u*). But in a later case (*x*), Chitty, J., refused to allow a similar alteration to be made in an old mark on the ground that, in accordance with the decisions of the Court, an old mark ought to be registered and kept registered, in all essential particulars, as it was used before the 13th of August, 1875. In the earlier case, two of the marks allowed to be altered had, in fact, been old marks, but in that case the Comptroller had raised no objection on this ground, as he did in the later case (*x*). In *Re Wills' Trade-Marks* (*y*), the mark was ordered to be expunged unless an application to amend was made within a reasonable time, but in *Day* v. *Riley and Whittaker* (*z*), Buckley, J., refused to give such an opportunity.

Alterations of marks to remove *trade-mark*.

Fry, L. J., also suggested, in *The Apollinaris Case* (*a*), that the indorsement, "imitations of this water will be prosecuted," upon a label registered for use in connection with a natural mineral water, *Hunyadi Janos*, caused the mark to be

Threats of prosecution in the mark may be deceptive.

(*s*) Per Chitty, J., in *Hammond & Co.* v. *Malcolm, Brunker & Co.*, 9 R. P. C. p. 307; and the observation of the same judge in *Gordon & Dilworth's Tm.*, 13 R. P. C. p. 634.

(*t*) (1891) 2 Ch. 402; 8 R. P. C. 209.

(*u*) Cf. sect. 64 (2); and see Chap. IX., p. 199.

(*x*) *Phillips' Tm.*, (1891) 3 Ch. 139; 8 R. P. C. 469; and see *Henry Clay & Co.'s Tm.*, (1892) 3 Ch. 549; 9 R. P. C. 449, Kekewich, J.

(*y*) *Supra*, note (*r*). The mark was a new one registered under the Act of 1883, as also was the mark referred to in the case next cited.

(*z*) 17 R. P. C. 520 (1900).

(*a*) *Supra*; (1891) 2 Ch. p. 226.

calculated to deceive, because it probably meant all imitations of the water, whether fraudulent or not, and was therefore addressed to artificial *Hunyadi Janos* waters which might have been legitimately made and legitimately sold under the name, provided that it was made clear that they were artificial waters (*a*).

The Comptroller refuses *registered*, *copyright*, &c.

It may be noted that the Comptroller refuses to register the words "registered," "registered design," "copyright," "entered at Stationers' Hall," or "to counterfeit this is a forgery" (*b*). And in the case of the word "registered" this refusal has been supported by the Court (*c*).

Mark referring to particular goods.

And when there appears on the face of a trade-mark an indication of the goods to which the mark is to be applied, the claim for its registration must be in respect of those goods only (*d*).

Deceptive representation as to origin of goods.

The questions—Who can register a trade-mark? (*e*), and, What is the implication of a trade-mark with regard to the origin of the goods? (*f*) are dealt with elsewhere. It has been held, that a mark comprising the consignees' names, and a representation of their house, which is used by the consignor, is calculated to deceive (*g*).

The case of *Hill's Trade-Mark* (*h*) furnishes a good illustration of a deceptive mark. The mark consisted of a fir tree, with the words *Forrest* above and *London* below it in large letters, and it was registered and used by a Coventry watch-maker, who had no connection with the business formerly carried on by Forrest in London. He alleged, in answer to an application to remove the mark, that the words in question were commonly used by the trade in Coventry, although, in a correspondence with the applicant, he had previously claimed an exclusive right to them. The

(*a*) *Supra*; (1891) 2 Ch. p. 226.

(*b*) Instructions, 29, p. 728.

(*c*) *Meikle's Tms.*, 46 L. J. Ch. 17 (1876), Hall, V.-C. In *Wright, Crossley & Co.* v. *Dobbin*, 15 R. P. C. 21; and *MacSymons' Stores, Ld.* v. *Shuttleworth*, 15 R. P. C. 748, it has been held both in Ireland and England that "registered" in a mark means registered in the United Kingdom.

(*d*) Instructions, 31; see *ante*, p. 98.

(*e*) Chap. IV., p. 65.

(*f*) Chap. II., pp. 52 *et seq.*; see also Chap. XV., p. 358, "Joint trade-marks."

(*g*) *Jones' Tm.*, 53 L. T. 1 (1885), C. A.

(*h*) 10 R. P. C. 113 (1893), Chitty, J.

judge held that the mark was calculated and intended to deceive (*i*).

On the other hand, a suggestion that "Mazawattee" was deceptive, as leading people to suppose from the character of the name that the tea came from a particular estate, did not prevail (*k*).

A mark which has been used fraudulently, or for the purposes of a fraudulent trade, if offered for registration, is open to the objection that its further use will tend to continue the old deceptions, and it is therefore a deceptive mark, and registration of it should be refused (*l*).

"Or otherwise."

The words "or otherwise" in the section, having regard to sect. 86, referred to above, and other parts of the Acts, seem to be merely redundant. They were, however, under the Act of 1875, held to be sufficient to exclude the registration, as part of a trade-mark, of words which are merely descriptive of the article upon which the mark is to be used, whether they are merely descriptive from their nature, or whether they have become descriptive by the course of the trade and in the market (*m*). But the decision in the case referred to rested upon the opinion of the learned judge that, if he allowed the words in question to be registered as part of the applicant's mark, he would be giving him a monopoly in the words to which he was not entitled. In the Act of 1883 the word "disentitled" was substituted for the expression "not entitled," and in a very recent case (*n*) the decision referred to was distinguished on the ground of the different wording of sect. 73 of the Act of 1883, and it was held that, although the word "Silverpan" was descriptive when used for jam, it was not thereby "disentitled" to protection within the meaning of this section.

(*i*) Its use was unquestionably an offence under the M. M. A. 1887; see Book II., Chap. I., p. 584. It appears from the report of *Thorneloe* v. *Hill* that the Comptroller afterwards refused to register the tree alone on account of its having been part of a fraudulent mark.

(*k*) *Densham's Tm.*, (1895) 2 Ch. 176; 12 R. P. C. 75 and 271; and *supra*, p. 184.

(*l*) *Fuente's Tm.*, (1891) 2 Ch. 166; 8 R. P. C. 214, Romer, J.; see further, as to trade-marks vitiated by misrepresentation, Chap. XV., pp. 397 *et seq.*

(*m*) *Anderson's Tm.*, 26 C. D. at p. 415 (1884), Chitty, J. (*Brand Baron Liebig*).

(*n*) *Faulder's Tm.*, 18 R. P. C. 37 (1901), Kekewich, J.

CHAPTER XI.

RECTIFICATION OF THE REGISTER.

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PROVISION is made for the rectification of the Register by three sections of the Act. Sect. 90 provides for cases where any person is aggrieved by the omission from, or by the entry upon, the Register of any particulars without sufficient cause, and enables the Court to direct the necessary rectification to be made; sect. 91 authorizes the Comptroller to correct clerical errors in the registration, and, at the request of the proprietor, to cancel the entry, or part of the entry, of a trade-mark on the Register; and sect. 92 enables the Court, upon application, to permit an addition to, or alteration of, a registered mark to be made in any non-essential particular. The Act also directs that after fourteen years from its registration a mark shall be removed from the Register unless the prescribed fee be paid. This provision is considered in another chapter (*a*).

(*a*) Sect. 79; see Chap. XIV., p. 349.

1. Rectification under Sect. 90.

Section 90.

Sect. 90 (*b*) is in the following terms:—

"(1) The Court may, on the application of any person aggrieved by the omission without sufficient cause of the name of any person [or of any other particulars] (*c*) from any Register kept under this Act, or by any entry made without sufficient cause in any such Register, make such order for making, expunging, or varying the entry, as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit.

"(2) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide for the rectification of a Register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

"(3) Any order of the Court rectifying a Register shall direct that due notice of the rectification be given to the Comptroller."

Decisions on the Act of 1875.

This section corresponds to parts of sect. 5 of the Act of 1875 (*d*), and is to the same effect, but is expressed in more general terms. No distinction between the construction of the two enactments appears to have been taken (*e*), but, on the contrary, decisions under the former are constantly cited and applied in cases falling under the present section (*f*).

"Any other particulars."

The amendment "or of any other particulars" was made upon the recommendation of Lord Herschell's Committee (*g*), so as to make the jurisdiction of the Court to rectify applicable to every particular which ought to be entered upon the Register.

(*b*) Cf. Companies Act, 1862, s. 35, and the Copyright Act, 1842 (5 & 6 Vict. c. 45), s. 14.

(*c*) Act of 1888, s. 23.

(*d*) Appendix, p. 685.

(*e*) Except that appeals from the Comptroller on applications to register are now governed by a separate section, sect. 62; see *Normal Co.'s Tm.*, 35 C. D. 231; 4 R. P. C. 123 (1886), Chitty, J., and C. A.

(*f*) See *Baker* v. *Rawson*, 45 C. D. at p. 531; 8 R. P. C. 89 (1890), North, J.

(*g*) Report of 1888, p. xiv.

Who are persons aggrieved.

All persons substantially inconvenienced if the registration is wrong.

The application to rectify the Register must be made by a person who is aggrieved by the entry or omission complained of if it is made without sufficient cause. In the more recent judgments, the phrase in the section has been very liberally construed, and except, perhaps, in the case of a mark consisting of a name (*h*), it would be difficult to find any person engaged in the trade concerned, or any allied or connected trade, who was prevented by the qualification which it requires from moving to rectify the Register. The persons who are aggrieved are, it is held, all persons who are in some way or other substantially interested in having the mark removed—where it is a question of removal—from the Register, or persons who would be substantially damaged if the mark remained. It is very difficult to frame a nearer definition than that (*i*).

The Apollinaris Case.

One of the leading cases on the subject is that of *The Apollinaris Co.'s Trade-Marks*. In that case, Fry, L. J., in delivering the judgment of the Court of Appeal, said: "We approach this question (Are the applicants persons aggrieved?) on the assumption, which is necessary, of course, to answer this question, that the trade-mark was wrongly on the Register; and, further, with these two observations: in the first place, that the question is merely one of *locus standi*; and in the second, that the words 'person aggrieved' appear to us to have been introduced into the statute to prevent the action of common informers, or of persons interfering from merely sentimental motives (*j*); but that they must not be so read as to make evidence of great and serious damage a condition precedent to a right to apply. Further, we are of opinion that, wherever one trader, by means of his wrongly registered trade-mark, narrows the area of business open to his rivals, and thereby either immediately excludes, or with

The question is one of *locus standi* only.

(*h*) See *Wright, Crossley & Co.'s Tm.*, 15 R. P. C. 131 and 377, cited below, p. 267.

(*i*) Per Bowen, L. J., in *Powell's Tm.*, (1893) 2 Ch. 388; 10 R. P. C. 195.

(*j*) See Lord Selborne's judgment, in *Rivière's Tm.*, 26 C. D. at p. 54 (1884), and the judgments of Lindley and Fry, L. JJ., on the subsequent hearing of the same case, 55 L. J. Ch. 545.

reasonable probability will in the future exclude, a rival from a portion of that trade into which he desires to enter, that rival is an 'aggrieved person'" (*k*). And in the same case the Court of Appeal held, that the fact that the applicants for registration of certain new marks had attempted to support their application by reference to other marks already registered by them, notwithstanding that they subsequently abandoned the attempt, made the opponents to the registration of the former marks persons aggrieved by the registration of the marks already registered, and therefore persons entitled to apply for the removal of them from the Register (*l*). They further held that an alleged infringer of a mark is always a person aggrieved by its registration (*m*).

Any person intimidated or harassed by the registration.

"The practical conclusion of this view," said Fry, L. J., "is, we think, a sound one. It will stop the practice, of which we have seen instances in this case, of a trader registering his mark without justification, using it as a means to intimidate or coerce other traders, and then, at the bar, alleging that the threat was idle, and the persons against whom it was used are not aggrieved thereby" (*n*).

Powell's Case.

The words in question have received their most liberal interpretation in the subsequent case of *Powell's Trade-Mark* (*o*). In that case the applicants were being sued to restrain them from passing off a sauce called *London Relish* as the goods of the registered proprietor of a mark consisting of the words *Yorkshire Relish* by means of a label said to resemble one of his trade labels. They moved to expunge the mark *Yorkshire Relish*, and they were held to be "persons aggrieved" notwithstanding that they did not trade in Yorkshire Relish Sauce, and had not even considered the question of trading in it, and that the Court thought it probable that they could not trade in it under the same name without wrongfully causing their goods to be taken for those of the respondent, the registered proprietor of the

(*k*) (1891) 2 Ch. p. 224; 8 R. P. C. 137.

(*l*) *Ibid.* p. 228.

(*m*) See also *Baker* v. *Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1890), North, J.

(*n*) (1891) 2 Ch. p. 229.

(*o*) (1893) 2 Ch. 388; (1894) A. C. 8; 10 R. P. C. 195; 11 R. P. C. 4, Chitty, J., C. A., and H. L.; followed in *Talbot's Tm.*, 11 R. P. C. 77 (1894), Stirling, J.

mark. Lord Herschell, in giving judgment, said that although the words were no doubt inserted to prevent officious interference by those who had no interest at all in the Register being correct, and to exclude a mere common informer, it was undoubtedly of public interest that they should not be unduly limited; and also he said: "Wherever it can be shown, as here, that the applicant is in the same trade as the person who has registered the trade-mark, and wherever the trade-mark, if remaining on the Register, would or might limit the legal rights of the applicant, so that by reason of the existence of the entry on the Register he could not lawfully do that which but for the existence of the mark upon the Register he could lawfully do, it appears to me he has a *locus standi* to be heard as a person aggrieved." Lord Watson, in his judgment, said that the fact that a trader deals in the same class of goods, and could use the mark, was, *primâ facie*, sufficient evidence of his being aggrieved, which could only be displaced by the person who registered the mark, upon whom the onus lay, showing that there was no reasonable probability that the objector would have used it, although he were free to do so.

But the grievance of the applicant must be substantial, and a fanciful suggestion of grievance is insufficient. Thus, in *Wright, Crossley and Co.'s Trade-Mark* (*p*), a firm had registered their firm-name of "Wright, Crossley and Co." as an old trade-mark, and a company, called the Royal Baking Powder Company, trading in the same trade, applied to remove it. There had been considerable litigation between the applicants and the registered owners as to the words "Royal Baking Powder," and it was suggested that the applicants had an interest as the mark was being used by the owners in connection with those words, and that there was a possibility of a wrongful user of the words "Trade Mark." It was also suggested that the applicants might at some time acquire the right to trade under the name Wright, Crossley and Co., or part of it. But Romer, J., and the Court of Appeal came to the conclusion that the suggestions

(*p*) 15 R. P. C. 131, 377 (1898), Romer, J., and C. A.

of possible injuries to the applicants were fanciful, and that the applicants were not persons aggrieved. Rigby, L. J., pointed out that the judgments in the House of Lords in the *Yorkshire Relish Case* did not support the contention that the mere fact that a man was in the same trade was sufficient to make him a person aggrieved. It is not necessary, however, for an applicant to show that he is interested in the sense of deriving any profit from his trade (*q*); and it is sufficient to constitute trading if he is trading by his agents (*q*).

Defendant in a passing off action.

A defendant charged in an action with passing off his goods as those of the plaintiff (*r*) is aggrieved by the registration of a trade-mark referred to in the plaintiff's pleadings, although no case of infringement is set up (*s*); and so also a trader who wishes or may wish to use the registered mark, not as a trade-mark, but as a description of his goods (*t*). And it is not necessary that the applicant should actually trade in the goods for which the mark is registered; it is sufficient if there is such a close connection between the business in those goods and the applicant's business that there is a probability that he may wish to extend his business to the other goods (*u*). And the applicant does not cease to be a person aggrieved because the registered proprietor offers to register a disclaimer, or to confine the use of the mark to particular goods in such manner that if the disclaimer or limitation were actually registered the applicant's grievance would be removed (*x*); for, as was pointed out by Fry, L. J., in the passage quoted above, the grievance is only necessary to give a *locus standi*, and it

Offer of a disclaimer is no answer to an application to rectify.

(*q*) *Harness' Tm.*, 17 R. P. C. 40 (1900), Farwell, J.

(*r*) See Chap. XVI., p. 446.

(*s*) *Gianaclis' Tm.*, 6 R. P. C. 467; 58 L. J. Ch. 782 (1889), North, J.

(*t*) *Ralph's Tm.*, 25 C. D. 194 (1883), Pearson, J. (*Homewasher*); *Rose* v. *Evans*, 48 L. J. Ch. 618 (1879), Hall, V.-C. (*Limetta*); *Powell's Tm.*, *supra*; *Talbot's Tm.*, 11 R. P. C. 77; 63 L. J. Ch. 264 (1894), Stirling, J. (*Emolliolorum*).

(*u*) *Eastman, &c. Co., Ld.* v. *John Griffiths Cycle Corporation, Ld.*, 15 R. P. C. 105 (1898), Romer, J. There was no express finding, however, as to the applicants being persons aggrieved; but it was held that they could have successfully opposed the registration.

(*x*) *Batt's Tm.*, 6 R. P. C. 493 (1889), Chitty, J.; *Baker* v. *Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1890), North, J.

exists if at the time when the application is launched the registration is such as to occasion it.

Exporter aggrieved by mark for home trade.

The exporter of goods made abroad, which are brought to England and then shipped to the Colonies, is a person aggrieved by the registration of a mark having such a resemblance to the mark which he has registered, and which he uses in his trade, as is calculated to deceive, although the mark objected to is employed in a trade confined wholly or almost wholly to England, and not extending to the Colonies (*y*).

Foreigner.

And a foreigner may be a "person aggrieved" by the registration of a mark. This was decided by the Court of Appeal, overruling the judgment of Pearson, J., in *Rivière's Case* (*z*), where the applicants, who carried on business in India, but did not trade or intend to trade in England, alleged that, on their request to register the mark in question for them, the registered proprietors had wrongfully registered it in their own names; and the Court, in holding that the applicants might be aggrieved, assumed, but did not decide (*a*), that, as foreign traders, the applicants could not themselves have registered the mark.

Wider view now taken than in the earlier cases.

On the further hearing of the case just cited (*b*), it was shown that the registered mark was an old mark belonging to the respondents, Rivière & Co., but that they had for many years allowed it to be used upon labels bearing the name of the applicants, McDowell & Co., for brandy manufactured by Rivière & Co., and shipped by them to McDowell & Co. for sale in India. The labels were used by McDowell & Co. upon brandy not made by or purchased from Rivière & Co., after the rupture of business relations between the parties, and Rivière and Co. had commenced

(*y*) *Société Anonyme des Verreries de l'Etoile*, (1894) 1 Ch. 61; (1894) 2 Ch. 26; 10 R. P. C. 436; 11 R. P. C. 142, Stirling, J., and C. A.

(*z*) 26 C. D. 48 (1884), decided on the Act of 1875. Also *European Blair Camera Co.'s Tm.*, 13 R. P. C. 600; 75 L. T. 63 (1896), Stirling, J., where the applicants' predecessor had used the mark in England.

(*a*) It is clear that the present Act contemplates registrations by foreign traders; see sects. 103 and 104, and sect. 8 of the Act of 1888.

(*b*) 55 L. J. Ch. 545; 53 L. T. 237 (1886).

proceedings in India for infringement in respect of this user. Under these circumstances, Pearson, J., and the Court of Appeal held that the applicants were not in fact aggrieved by the registration, but that it was rightly made, and they refused to annul it. Lindley, L. J. said: "Aggrieved in the sense of being annoyed (McDowell & Co.) certainly were, and, I think, not without cause; but aggrieved in the sense in which it is necessary they should be aggrieved—in the sense of sustaining legal damage either immediate or prospective—they have not shown that they were"; and Fry, L. J., said it was possible that they might be injured, but there was no reason to suppose that they would be, and therefore they were not within the section (*c*). In subsequent cases the section, and the phrase "person aggrieved," has been more stringently construed against the registered proprietor; and although there is no conflict between this decision (*d*) and the decisions cited above, it is plain that in them a view was taken of the section different from that acted upon in it.

Purity of the register.

In a recent case it was suggested that, although the applicant was not a person aggrieved, the Court would, in the interests of the public, rectify the Register if the mark was bad (*e*); but, even if the Court would, under any circumstances, take such a course in the absence of a person aggrieved (*f*), it would only do so in the case of a registration which was on the face of it illegal or improper (*g*).

Applicant entitled as successor of proprietor.

A refusal by the Comptroller to cause the name of a person who had become entitled by assignment, transmission, or other operation of law to a registered trade-mark to be entered as proprietor of the trade-mark in the Register under sect. 87 would constitute such person a "person aggrieved" and give the Court jurisdiction under sect. 90 to

(*c*) *I. e.*, sect. 5 of the Act of 1875.

(*d*) Because the Court held that the mark was properly registered.

(*e*) *Wright, Crossley & Co.'s Tm.*, *infra*, note (*g*).

(*f*) See the judgment of Bowen, L. J., in *Paine & Co. v. Daniells & Sons' Breweries*, quoted *infra*, p. 272. In that case, however, the defendants, being sued, were clearly persons aggrieved.

(*g*) *Wright, Crossley & Co.'s Tm.*, 15 R. P. C. 131, 377 (1898), especially the judgment of Romer, J.

order the entry to be made (*h*). But if a person applies to the Comptroller for an alteration in a case for which the Acts do not provide, and it is refused, he is not a "person aggrieved" (*h*).

The Exercise of the Jurisdiction under the Section.

Where the mark was incapable of registration it must be removed.

The question of the grievance of the applicant being merely one of *locus standi*, if on the face of the proceedings the applicant is enabled, as a person aggrieved, to bring his application before the Court, the Court has jurisdiction to rectify the Register, which, in the case of a mark not belonging to the class of marks admitted to registration under the Acts (*i*), it ought to exercise, even under circumstances in which the applicant is precluded from exercising the right with which the registration interferes. Thus, in *The Stone Ales Case* (*k*), the Court of Appeal removed the plaintiffs' mark, *Stone Ale*, from the Register on the application of the defendant, although they maintained the injunction granted by Chitty, J., restraining the defendant from selling goods not of the plaintiffs' manufacture under the name in question.

The conduct of the applicant is irrelevant.

And the demerits of applicant in any such case are irrelevant to the question whether rectification should be ordered or not, for the question is not between the applicant on the one hand and the respondent on the other, but between the public and the respondent. Where, therefore, a mark on the Register bearing the words *Forrest London* was shown to be deceptive, because it was used by a Coventry watch-maker who had no connection with the business of Forrest once carried on in London, Mr. Justice Chitty refused to enter

(*h*) *New Ormonde Cycle Co.'s Tm.*, (1896) 2 Ch. 620; 13 R. P. C. 475, North, J. See also *Patent Plumbago Crucible Co.'s Tms.*, 7 R. P. C. 282 (1890), Stirling, J.

(*i*) See Chap. VIII., p. 115.

(*k*) *Thompson* v. *Montgomery*, 45 C. D. 35; 6 R. P. C. 404 (1889). There was no appeal to the H. L. against this order. The words had not been used as a trade-mark before 13th August, 1875, and were not fancy words. See *Powell's Tm.*, (1893) 2 Ch. 388; 10 R. P. C. 63, 105; (1894) A. C. 8; 11 R. P. C. 4; Chitty, J., C. A. and H. L. (*Yorkshire Relish*), above, p. 266.

upon an inquiry whether the conduct and the trade of the applicant were tainted with fraud, as the respondent alleged. "I state my opinion," he said, "that directly it is apparent that any part of the trade-mark is calculated to deceive, it is the duty of the Court to order it to be removed" (*l*).

So an agreement by which the respondents, the registered proprietors of a mark, appointed the applicants sole agents for the goods which they sold under the mark, and the applicants agreed to sell no goods but those of the respondents under the mark, was held to furnish no answer to an application to remove the mark from the Register, and Chitty, J., said: "This is not a question of equity; this is a question of right under the statute; and the defence, which I find really a difficulty in appreciating, appears to me to fail altogether. I am at a loss to discover how any such agreement as this can displace the applicants' right to have the Register of trade-marks disencumbered of that which is not a trade-mark at all" (*m*).

Where the mark was capable of registration but might have been opposed.

***Paine* v. *Daniells*.**

But in cases where the mark attacked belongs to the class of symbols which are capable of registration, the Court has a discretion, under the Acts, whether to expunge or vary the registration or to refuse the application. This was decided by the Court of Appeal in the case of *Paine & Co.* v. *Daniells & Sons' Breweries* (*n*), where the matter was fully considered. In that case the defendants, in an action for infringement and passing off, applied to remove the words *John Bull* and *John Bull Brand* from the plaintiffs' registered labels. It appeared that at the time of the registration of the labels certain third persons, unknown to the plaintiffs, were using *John Bull* as a trade description of their goods in a district, in and around Sheffield, to which the plaintiffs' trade did not extend, but such user had wholly ceased before the date of the application to rectify. And it was assumed by the Court that these persons might have successfully

(*l*) *Hill's Tm.*, 10 R. P. C. 113 (1893); see also *Eno* v. *Dunn*, 15 App. Cas. 252; 7 R. P. C. 311 (1890).

(*m*) *Ainslie & Co.'s Tm.*, 4 R. P. C. 212 (1887).

(*n*) (1893) 2 Ch. 567; 10 R. P. C. 71, 217. See also *Wright, Crossley & Co.'s Tm.*, 15 R. P. C. 131, 377 (1898), Romer, J., and C. A.

opposed the registrations had they known of them and thought fit to do so. In the view which the Court of Appeal took, the defendants had been guilty for years of deliberate infringement of the plaintiffs' trade-mark. The Court refused to direct the marks to be removed, and the following passage from the judgment of Bowen, L. J., fully explains the grounds of their decision:—

The Court has a discretion.

"The purity of the Register of trade-marks—if one may use the expression—is of much importance to trade in general, quite apart from the merits or demerits of particular litigants. If on a motion like the present the attention of the Court is called to the entry on the Register of a trade-mark which cannot in law be justified as a trade-mark, it seems to me that the Court's duty may well be, whatever are the demerits of the applicant, to purify the Register and to expunge the illegal entry in the interests of trade, as was done in *The Stone Ales Case* (*o*). As a rule, the Court, on being seised of the matter, would doubtless put an end to the existence of a trade-mark which could not possibly be justified by law. But the matter is wholly different when the trade-mark complained of is one which is not in itself illegal or improper, although at the date of registration its registration might have been, perhaps, successfully opposed by some third party who did not in fact oppose it. In such a case, the defect in the Register is not a defect of which the law is bound to take cognizance at the instance of every complainant. Consent by the *Sheffield* company would, in the present case, have removed all difficulty in the registration of the plaintiff's trade-mark (*oo*). The defendants have no right, as it appears to me, to take the point that such consent was not in fact shown to have been given by the *Sheffield* firm, in order to displace a trade-mark which they have been meanwhile dishonestly infringing. I am of opinion that the Court is not bound under sect. 90 of the Act of 1883, on the application of an unmeritorious applicant, to displace

(*o*) *Supra*, p. 271. Any interest which the public may have in the matter is to be considered: *Harness' Tm.*, 17 R. P. C. 40 (1900).

(*oo*) The Sheffield company had not registered *John Bull* beer, and therefore the question of conflicting registered marks would not have arisen.

an entry on the Register, which, on the face of it, is not illegal, because the original registration might have been opposed on the ground of prior user by a third person who never opposed it on any such ground, and who, at the time of the motion to rectify, has discontinued his user."

The construction of sect. 90, here adopted, is certainly in accordance with the apparent meaning of the section, for its terms empower the Court to make "such order . . . as the Court thinks fit," or to refuse the application.

Independent title acquired by registration and user.

So, in a case where the registered proprietor of a mark had adopted and registered it in ignorance of the rights of the applicant, who previously possessed, but had temporarily ceased to use, a similar mark, and the proprietor had largely used his mark for two years, an application to remove it from the Register was refused. The applicant, however, was allowed to register his mark also (*p*).

There are, however, some reported cases which can hardly be reconciled with the view taken by the Court of Appeal in *The Stone Ales Case* (*pp*) by the distinction suggested in the judgments in *Paine* v. *Daniells* (*q*) between marks which are good marks under the Acts upon the face of them, although the registration of them might for some extrinsic reason have been opposed, and marks which are bad in themselves.

Mark allowed to remain in pursuance of a compromise.

Thus, in a case where Chitty, J., had ordered a mark to be removed from the Register, on the ground that it did not comply with sect. 64 of the Act, the Court of Appeal expressed a strong opinion that the applicant (the defendant) had made a binding agreement with the registered proprietor (the plaintiff) not to use the mark, and, the applicant consenting, they set aside the order for removal (*r*). And, in an earlier case (*s*), Kekewich, J., allowed an order expunging a mark from the Register to be varied (subject to any objection being made by the Comptroller) with the consent of the applicant, although he held that, having been used to

(*p*) *Monson & Co.* v. *Bochm*, 26 C. D. 398; 53 L. J. Ch. 932 (1884), Chitty, J.

(*pp*) See note (*k*), *ante*, p. 271.

(*q*) See note (*n*), *ante*, p. 272.

(*r*) *Hodgson* v. *Sinclair*, 9 R. P. C. 22 (1892).

(*s*) *Harrison McGregor & Co.'s Tm.*, 42 C. D. 691; 7 R. P. C. 25 (1889), (*Albion*). The variation is not stated in the Law Reports.

indicate a design, and not as a trade-mark, it ought not to have been registered.

The fact that the Comptroller has exercised his discretion in favour of the registration of a mark, and has allowed it to be registered, does not prevent the Court from ordering its removal if the registration was made without sufficient cause (*t*); but an applicant for rectification is in a somewhat less advantageous position than an opponent to registration (*u*).

The Comptroller's decision is no bar to rectification;

And it is elsewhere shown that sect. 90 is not limited by sect. 76, so that a mark registered without sufficient cause can be removed notwithstanding the fact that it has been five years upon the Register (*v*).

nor is five years' registration;

The delay of the applicant in coming to the Court to ask for rectification of the Register is not of itself any bar to his application (*x*), and marks have been removed or varied after being registered for long periods to the knowledge of the applicant (*y*). But where the objection alleged to a mark is that it is the same as that of the applicant, or that it has such resemblance to his as to be calculated to deceive, it will be some evidence against the applicant, on whom the burden lies of showing that the registration was made without sufficient cause, if he has stood by and allowed the registered proprietor to use the mark objected to for a length of time, especially if no case of actual deception is proved (*z*). Where an opposition to an application to register on such a ground would have been successful two things are to be considered: first, what was the reason of the delay in the application to expunge; and, secondly, whether any substantial injury has

nor, generally, is delay in making the application to rectify;

but delay may have a bearing on the evidence.

(*t*) *Arbenz' Application*, 35 C. D. p. 260; 4 R. P. C. 143 (1887), C. A. (*Gen*).

(*u*) See *Société, &c. de l'Etoile's Tm.*, note (*x*), and cases on delay.

(*v*) Chap. XII., p. 309.

(*x*) *Great Tower Street Tea Co.* v. *Smith*, 6 R.P.C. 165 (1889), North, J.; *Société, &c. de l'Etoile's Tm.*, (1894) 1 Ch. 61; 10 R. P. C. 436; (1894) 2 Ch. 26; 11 R. P. C. 142; *Talbot's Tm.* (1894), W. N. 12; 11 R. P. C. 77, Stirling, J.

(*y*) For instance, in *The Apollinaris Case*, some of the marks removed had been registered for fourteen years; (1891) 2 Ch. 186; 8 R. P. C. 137, C. A. See also *Paine & Co.* v. *Daniells & Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 71, 217, C. A.

(*z*) *Talbot's Tm.*, *supra*, note (*x*).

been caused by the delay to the person who has registered (*a*). Thus, if the objection depends upon proof of a state of facts at a given time—for instance, upon the question whether an old mark was used before the 13th of August, 1875, in the form registered—after a long lapse of time, and especially if important witnesses have died, the Court will receive the evidence of the applicant upon the point with hesitation (*b*).

Entry to be vacated or rectified if originally wrongly made.

An entry which has been made without sufficient cause ought to be expunged, even though, so far as appears at the hearing of the application to rectify, an application to re-register could be successfully made at once, for there ought to be fresh advertisements and a fresh opportunity for objectors to oppose the registration (*c*). So, where a misstatement as to the length of time during which the mark had been used was made, not fraudulently but through carelessness, in the application for registration, North, J., directed the registration to be vacated (*d*). And in *The Apollinaris Case*, in dealing with the objection that the company, when only importers, had registered marks belonging to the producers of the goods as their own, Fry, L. J., said (*e*) : "On behalf of the Apollinaris Co. an argument was addressed to us to this effect, that as they had, in the year 1881, become the sole owners of the produce of the spring, they could now get these marks on the Register, and that we ought not to remove marks which, as soon as we have taken them off, can be put on again. But even assuming that the respondents are *prima facie* entitled now to be placed on the Register, as to which

Judgment of Fry, L. J., in *The Apollinaris Case*.

(*a*) *Eastman Photographic Materials Co., Ld.* v. *John Griffiths Cycle Corporation, Ld.*, 15 R. P. C. 105, at p. 111 (1898), Romer, J. In *Société, &c. de l'Etoile's Tm.*, *supra*, three years' delay, which was explained by want of knowledge of the registration, was held by Stirling, J., and the Court of Appeal not to disentitle the applicant to relief.

(*b*) *Benjamin Edgington, Ld.* v. *John Edgington & Co.*, 6 R. P. C. 513 ; 61 L. T. 323 (1889), Kay, J.

(*c*) In *Hayward's Tm.*, however, where the objection was that the application on which the mark was registered ought to have been treated as abandoned, Kay, J., allowed the mark to stand, with a note limiting the date from which the five years should run before the registered proprietor acquired an absolute title to the date of actual registration ; 54 L. J. Ch. 1003 (1885).

(*d*) *Baker* v. *Rawson*, 45 C. D. 519 ; 8 R. P. C. 89 (1890).

(*e*) (1891) 2 Ch. p. 230 ; 8 R. P. C. p. 163.

we say nothing, we are of opinion that the course suggested is rendered impossible by the statutory provision for advertisements. To allow a mark which ought not to have been on the Register to remain on by reason of some intervening event would be to preclude the public from challenging the new title of the applicant for registration."

But the rule here laid down does not compel the Court to order the removal of a mark if the registration of a note, partial removal, or other variation meets the justice of the case (*f*).

Whether entry, originally rightly made, may be varied.

The Court of Appeal has recently taken the view that an order can be made under the section to remove from the Register a mark the presence of which on the Register is not legitimate, even although the original registration was proper. In *Batt's Trade-Marks*, Lindley, M.R., delivering the judgment of the Court, and referring to the words "entry made without sufficient cause in any such register," said: "We are not disposed to put a narrow construction on this expression, nor to read it as if the word 'made' were the all-important word, and as if the words 'made without sufficient cause' must be read as if they were 'made without sufficient cause at the time of registration,' so as to be confined to that precise time. If any entry is at any time on the Register without sufficient cause, however it got there, it ought, in our opinion, to be treated as covered by the words of the section" (*g*). It is, however, to be noticed that, as pointed out in the judgment referred to, in the view taken by the Court of the facts the decision of the point was not necessary to the decision of the case, and no order has been made, it is believed, for the removal of a mark originally rightly registered (*gg*). In a case decided under sect. 5 of the Act of 1875, where, after an application for

(*f*) See note (*c*) and the instances cited below, pp. 280 *et seq.*

(*g*) (1898) 2 Ch. 432; 15 R. P. C. 534, Lindley, M. R., Chitty and Collins, L.JJ. The case was affirmed in the House of Lords, but no decision was given on this point.

(*gg*) In *Valentine Extract Co.'s Tm.*, 18 R. P. C. 175 (1901), Farwell, J., the trade-mark *Valtine* was ordered to be removed from the Register, an injunction having been granted at the instance of the applicants against its use (Appendix, p. 760), but they could no doubt have successfully opposed the registration.

the registration of a mark belonging to a firm had been made, a change in the constitution of the firm took place, the Court refused to order the Register to be rectified by the entry upon it of the name of the new proprietors in place of that of the old. The proper course to be adopted was the registration of a transmission of title (*i*).

What Orders may be made under the Section.

The section empowers the Court to make "such order for making, expunging, or varying the entry," of the omission or registration of which complaint is made, as the Court thinks fit. The Court may therefore (1) direct an entry to be made on the Register; (2) order an entry already appearing thereon to be wholly removed; or (3) to be partially removed; or (4) to be modified by a disclaimer; or (5) by limiting it to particular goods; or (6) to be varied as to its form; or (7) date; or (8) the name of its registered proprietor.

New entries.

(1) The jurisdiction to order a new entry to be made seems to be specially referable to the preceding words of the section, "aggrieved by the omission without sufficient cause of the name of any person or of any other particulars" from the Register; but the Court is not empowered by the section to order to be entered upon the Register a mark which the Comptroller has refused, although under the corresponding section of the earlier Act it might have done so, for a special mode of appeal from the Comptroller's decision to the Board of Trade, and to the Court only by reference from them, is provided by sect. 62, and, consequently, no other appeal is permitted (*k*). And it cannot direct a new mark to be registered with regard to which the proper procedure by application and advertisement has not been resorted to (*l*). So far

New marks cannot be registered under the section.

(*i*) *Ward, Sturt, and Sharp's Tms.*, 50 L. J. Ch. 347 (1881), Hall, V.-C., and see below, p. 283.

(*k*) *The Normal Co.'s Tm.*, 35 C. D. 231; 4 R. P. C. 123 (1886), Chitty, J., and C. A.

(*l*) *Rivière's Tm.*, 55 L. J. Ch. 545; 53 L. T. 237 (1885), C. A.; and as to transfers from one name to another, see below, p. 283; and cf. p. 276. In *Jackson* v. *Napper* there was an application for registration, and the summons was not, as stated in 4 R. P. C. 45, an application to rectify under sect. 90, but an application to proceed under sect. 62. It seems to

as actual marks are concerned, the reference to entries to be made upon the Register must, therefore, notwithstanding the words quoted above, be taken to refer only to the variation of marks already registered by addition to them.

Total removal.

(2) Orders for total removal of entries from the Register have been made in a great number of cases, and many examples have been given already in this and the two preceding chapters. The entry is to be expunged if made without sufficient cause. What is a sufficient cause for refusing an application to register is considered in Chapter IV. (*m*), and generally the same reasons will afford grounds for removing an entry inadvertently made. But the Court has a discretion to refuse to vacate the registration of a mark, independently adopted and extensively used by the proprietor, if it falls within the class of symbols which may be registered as trade-marks, and the only objection is that it had been previously used or acquired as his trade-mark by another person (*n*). The proprietor of a registered mark stands, however, in a better position than an applicant for registration, since the Comptroller's discretion (*o*) has been exercised in his favour, and the onus of showing that the registration was made without sufficient cause is cast upon the person applying to vary it (*p*).

Reasons for removal.

The reasons for removing a mark may be classified as follows: namely, that the registered proprietor is not the person entitled to use it (*q*); the mark was not capable of registration (*r*), or it fell within the restrictions forbidding registration contained in the Acts (*s*); the registration was

have been irregular in any case, as there was no appeal from the Comptroller to the Board of Trade, so far as the report shows: 35 C. D. 162 (1886), Stirling, J.

(*m*) Page 69.

(*n*) *Monson* v. *Bochm*, 26 C. D. 398 (1884), Chitty, J.; *Paine & Co.* v. *Daniells & Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 217, above, p. 272.

(*o*) Chap. IV., p. 70; but see above, p. 275.

(*p*) See *Leonard and Ellis' Tm.*, 26 C. D. 288 (1884), C. A.; *Benjamin Edgington, Ld.* v. *John Edgington & Co.*, 6 R. P. C. 513; 61 L. T. 323 (1889), Kay, J. But the onus may be shifted in the course of the hearing: *Dewar & Sons, Ld.* v. *J. H. Dewar*, 17 R. P. C. 341 (1900), Court of Session.

(*q*) Chap. IV., p. 65.

(*r*) Chap. VIII., p. 115.

(*s*) Chap. X., p. 211.

procured by a material misstatement (*t*); or the person who registered had no *bonâ fide* intention to use the mark (*u*).

Alteration of circumstances subsequent to registration.

There does not appear to be any jurisdiction under the section to remove a mark because the registration, rightly made at its date, has by subsequent events become a cause of grievance to the applicant, unless the presence of the mark on the Register has become illegitimate (*x*). The Court of Appeal has held that the words "made without sufficient cause" do not relate merely to the date of registration (*y*), and that there is jurisdiction to rectify although there has been no mistake or error in the original registration (*y*). It has, however, been decided that no events subsequent to the date of registration can be appealed to by the registered proprietor to defend his mark (*z*). It would seem, therefore, that if a registered proprietor ceases to carry on business, or abandons all further intention to trade in the goods for which the mark is registered (*a*), or in any other way renders it improper that the mark should remain on the Register, it can be removed.

Abandonment or misuser of mark.

Partial removal.

(3) If part only of a composite mark is objectionable, that part may be removed. This course was adopted in *Biegel's Trade-Mark* (*b*), where the applicants, Younger & Co., complained that the use of three interlaced triangles in the respondent's label caused it to resemble too closely their own label, which contained three superimposed solid triangles similarly placed. The remainder of the label was distinctive, and the applicants did not complain of it. The order made was to strike out the triangular device. Where, however, the registered mark consisted of a fir tree, with the words

Deceptive mark wholly removed.

(*t*) *Baker* v. *Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1890), North, J.; *Gordon & Dilworth's Tm.*, 13 R. P. C. 629 (1896); *Eastman, &c. Co.* v. *John Griffiths Cycle Corporation, Ld.*, 15 R. P. C. 105 (1898), cited p. 256.

(*u*) Chap. VIII., p. 119.

(*x*) See the judgment of the Court of Appeal in *Batt's Tms.*, (1898) 2 Ch. 432; 15 R. P. C. 534; *supra*, p. 277.

(*y*) *Batt's Tms.*, see *supra*, p. 277; *Ward, Sturt, and Sharp's Tms.*, 50 L. J. Ch. 317 (1881), Hall, V.-C., was to the contrary effect.

(*z*) Above, p. 276.

(*a*) Cf. *Batt's Tms.*, *supra*, p. 277; and as regards the removal of an abandoned mark, see below, p. 348.

(*b*) 4 R. P. C. 525; 57 L. T. 247 (1887), Chitty, J.; *Blair* v. *Stock*, 52 L. T. 123 (1884), Kay, J.; *Strathmore* struck out of mark,

Forrest above and *London* below printed in large letters, and the proprietor, being a Coventry watchmaker, having no connection with the business formerly carried on by Forrest in London, the mark was deceptive, Chitty, J., directed the whole mark to be struck out, but without prejudice to any application the respondent might make to register the fir tree alone (*c*).

In the case last cited it was argued on behalf of the Comptroller that sect. 90 does not authorize the alteration of a registered mark, and that any application to vary must be made under sect. 92; but this contention is opposed to the express words of the first mentioned section, and it would leave unprovided for the large number of cases which do not fall within sect. 92, and among others all those arising on hostile applications.

Registration of a disclaimer.

(4) Registration with a disclaimer has already been discussed (*d*). *Edge's Trade-Mark* (*e*) is an example of the compulsory registration of a disclaimer. The respondent had registered the words *Edge's Filtered Blue*, and a label containing these words with certain devices. Mr. Justice Stirling held that the word *filtered* was either descriptive or deceptive, and that the respondent could have no exclusive right to use it. He accordingly directed the first mark to be removed from the Register, and the exclusive right to the use of *filtered* in the other to be disclaimed. So, an order for the disclaimer of the exclusive use of the words *white zinc* or the word *patent* or the Royal Arms was made in the case of an old mark (*f*). It has in some cases, at the instance of the Comptroller, been made a condition for granting leave to

(*c*) *Hill's Tm.*, 10 R. P. C. 113 (1893). Such an application was made, but refused: see the report of *Thorneloe* v. *Hill*, 11 R. P. C. 67.

(*d*) Chap. IX., p. 197.

(*e*) 8 R. P. C. 207 (1891), Stirling, J. (see above, p. 154); *Burland* v. *Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J. (*Washerine*); *Hayward's Tm.*, 54 L. J. Ch. 1003 (1885), Kay, J.; *Thompson* v. *Miller*, 13 R. P. C. 35 (1896), Stirling, J. (*Roadster*), are other instances. But see *The Smokeless Powder Co.'s Tm.*, (1892) 1 Ch. 590, 9 R. P. C. 109, Chitty, J.; *Clement et Cie.'s Tm.*, (1900) 1 Ch. 114; 16 R. P. C. 173, 611, Kekewich, J., and C. A. (*St. Raphael*), and *Faulder's Tm.*, 18 R. P. C. 37 (1900) (*Silverpan*), where disclaimers were not ordered.

(*f*) This appears in the report of *Hubbuck* v. *Brown*, 17 R. P. C. 148, where the mark is shown.

make alterations in a mark, that an entry be made of a statement of the essential particulars and a disclaimer of the exclusive use of the added matter (*g*); the principle being that the applicants should put themselves in the same position as if they were registering under the Act for the time being in force. As a rule the Comptroller opposes the registration of a disclaimer not authorized by the Act under which the mark was registered (*h*).

Limitation of the registration— to particular goods;

(5) A limitation restricting the registration of a trade-mark to those goods for which the registered proprietor actually used the mark, and to which alone the goodwill of the business transferred to him with the mark by the former proprietor extended, was adjudged to be notified upon the Register in *Edwards* v. *Dennis* (*i*). And in *The Milkmaid Brand Case* (*k*), where the defendant's mark too nearly resembled the previously registered mark of the plaintiffs, it was ordered that the registration of the former should be confined to goods for which the plaintiffs' mark was not registered. In *Banks and James' Trade-Mark* (*l*) the registration of a mark registered for cigars, cigarettes, and tobacco was, on a motion to rectify, and with the consent of the proprietor, ordered to be limited to cigars (*m*).

to particular market.

So the Court has under the section ordered a note of an undertaking by the registered proprietor restricting the use of the mark, in accordance with an agreement between the proprietor and the applicant, to be entered on the Register (*n*).

Variation in form of mark.

(6) The only variation in the form of a registered mark

(*g*) *Colman's Tms.*, (1891) 2 Ch. 402; 8 R. P. C. 209, Kekewich, J.; *Orlando Jones & Co.'s Tms.*, 12 R. P. C. 278 (1895), Stirling, J.

(*h*) See *Clement et Cie.'s Tm.*, 16 R. P. C. at p. 176.

(*i*) 30 C. D. 454 (1885), C. A.

(*k*) *Anglo-Swiss Condensed Milk Co.* v. *Metcalf*, 31 C. D. 454; 3 R. P. C. 28 (1886), Kay, J.

(*l*) 12 R. P. C. 333 (1895), Chitty, J.

(*m*) And in *Batt's Tms.*, 15 R. P. C. 534 (1898), one of the marks was only expunged as regards goods in one class.

(*n*) *Mitchell & Co.'s Tm.*, 28 C. D. 666 (1885), Chitty, J.; cross undertakings for local user. As to entering such undertakings or at all events those referring to locality, on the Register, see *Dewhurst's Tm.*, (1896) 2 Ch. 137; 13 R. P. C. 288, and *supra*, p. 219; and *Eastman, &c. Co., Ld.* v. *J. Griffiths' Cycle Corporation, Ld.*, 15 R. P. C. at p. 109 (the Comptroller's objection).

ordered under sect. 90 which occurs in any reported case is variation by striking out part of the mark (*o*). Any alteration which substantially changed the mark would be open to the objection that it would cause a new mark to be entered on the Register, the application for which had not been advertised (*p*), and which had not been approved by the Comptroller.

Variation of date of entry.

(7) A variation of the date of registration was directed in *Hayward's Case* (*q*). There a mark was registered in 1885 on an application made in 1879, and it was held that the registration, not having been completed within one year, ought to have been treated as abandoned, under sect. 63 of the Act of 1883. Kay, J., however, refused to expunge the registration, but ordered that the five years which make registration conclusive evidence of exclusive right of user should run from the date of the actual registration instead of from the date of the application to register.

Variation of name of proprietor.

(8) The Register cannot be rectified under sect. 90, where a mark has been wrongfully registered in the name of someone other than the proprietor, by expunging the name and substituting that of the person entitled to the mark. The whole entry may be expunged, but the true proprietor must be left to make a fresh application for registration, which will be advertised in the ordinary course, and may lead to opposition (*r*). So where an agent wrongfully registered his principal's trade-mark in his own name, Jessel, M. R., refused to order the name to be changed (*s*). And the same rule is applied where the entry is innocently made in the wrong name by mistake, as by a partner in his own name

Registration in the wrong name.

(*o*) See above, p. 280; and as to alterations under sect. 92, see below, p. 297.

(*p*) See above, pp. 276 and 278.

(*q*) 54 L. J. Ch. 1003 (1885), Kay, J.

(*r*) *Rivière's Tm.*, 55 L. J. Ch. 545, cited above, p. 269; *Harness' Tm.*, 17 R. P. C. 40 (1900), Farwell, J.

(*s*) *Marler's Tm.*, 44 L. T. 98, n. (1878). In the case of a design the name has been altered in the absence of fraud: *In re Grocott's Design*, 17 R. P. C. 139 (1900); but different considerations apply in the case of designs, and the case does not affect the practice as to trade-marks.

instead of his firm's (*t*), or by an agent acting for two principals, in the name of the wrong principal (*u*). In the former case the proper course is for the registered owner to assign, and for the assignee's name to be registered under sect. 87 (*v*). But in a case where a partner registered the mark in his own name thus—"Arthur Rust, trading as T. W. Rust & Co."—Jessel, M. R., allowed the names of all the partners to be substituted for "Arthur Rust" (*x*); and this case was distinguished in the later judgment, on the ground that the true proprietors, the firm, were there expressly mentioned on the Register. And where the owners of the mark changed the name under which they were carrying on business, Stirling, J., on an application under the section, allowed the new name to be entered, with a note that the firm formerly traded under the old name (*y*). But in a later case, North, J., held that on an alteration of the name of a limited company, the proprietors of a trade-mark, the Comptroller can enter the new name of the proprietors on the Register under sect. 87; and unless he refuse, the Court cannot order rectification under sect. 90 (*z*). In *Re The Australian Wine Co.* (*a*) a mark had been registered in his own name by the sole consignee of wines from a particular vineyard, the consignee intending to use the registration solely for the protection of such wines, and so long only as he should remain consignee. The mark was transferred by his trustee in bankruptcy, with the consignee's business, to a purchaser who procured the entry on the Register of his own name as proprietor. Subsequently, upon the application, under sect. 90, of the then owners of the vineyard, Chitty, J., directed their names to be entered as proprietors of the mark

(*t*) *Farina's Tm.*, 44 L. T. 99, n. (1881), Jessel, M. R.

(*u*) *Kingsford & Son's Application*, 6 R. P. C. 413; 41 L. T. 420 (1880), Kay, J.

(*v*) *Growers' Tm.*, 9 R. P. C. 93 (1892), Stirling, J.; and *Farina's Tm.*, *supra*. Sect. 70 (trade-mark to be assigned only with goodwill) is not an obstacle to such assignment: *Welcome's Tm.*, 32 C. D. 213; 3 R. P. C. 76 (1886), Chitty, J.

(*x*) *Rust's Tm.*, 44 L. T. 98, n. (1880).

(*y*) *Plumbago Crucible Co.'s Tm.*, 7 R. P. C. 282 (1890); followed by Kekewich, J., in *Burgon* v. *Wilkinson*, 40 Sol. J., p. 336 (1896); cf. applications under sect. 92, below, p. 297.

(*z*) *New Ormonde Cycle Co.'s Tm.*, (1896) 2 Ch. 520; 13 R. P. C. 475.

(*a*) 61 L. T. 427, n. (1888).

in lieu of that of the purchaser of the consignee's business, on the ground that the mark had been registered for the benefit of the owner of the vineyard, not for that of the owner of the business.

And in a case where the registered proprietor of a mark had assigned her business and the use of the mark for six years to the respondents, and they had procured the registration of their own names as assignees, upon their application it was ordered that the Register should be rectified by removing their names and restoring that of the original proprietor (*b*).

Where an assignor by mistake purported to assign a mark and goodwill after a previous agreement to assign to a third person, and the assignee was registered as proprietor, his name was expunged on the application of the executors of the person with whom the agreement had been made, the second assignment being inoperative by reason of there being no goodwill to assign (*c*).

Procedure on an Application under sect. 90.

"The Court."

"The Court" in England is Her Majesty's High Court of Justice (*d*), or, with reference to marks of which the registration was applied for in the Manchester Trade-Marks Office (*e*), the Palatine Court of Chancery (*f*); and those Courts have jurisdiction to rectify a registered mark, whether the registered proprietor is domiciled or resident in England, or in Scotland, or Ireland, or elsewhere (*g*); although where he is domiciled or resident in Scotland or Ireland, the Scotch or Irish Courts have, perhaps, a concurrent jurisdiction (*h*). This last point has not, however, been decided by an English Court, but it has been held in Ireland that

(*b*) *Re Arril*, 20th April, 1888, sect. 20. Stirling, J.; Sebastian, 4th ed. pp. 374, 382.

(*c*) *Harness' Tm.*, 17 R. P. C. 40 (1900), Farwell, J.

(*d*) Sect. 117.

(*e*) Chap. VII., p. 112.

(*f*) Sect. 112a; Act of 1888, sect. 20.

(*g*) *Re King & Co.'s Tm.*, (1892) 2 Ch. 462; 9 R. P. C. 350, Kekewich, J., and C. A. As to notice of motion in such cases, see below, p. 289.

(*h*) See the case last cited, and sect. 111 (2).

the jurisdiction is a special one conferred only on the High Court of Justice in England, and that the Irish Courts have no jurisdiction (*i*). In Scotland, however, although the jurisdiction was assumed in one case without objection (*k*), the point has not been otherwise decided, but it has been held that, assuming that the Scotch Courts have no jurisdiction under sect. 90, they have, nevertheless, jurisdiction to make a declaration as to the invalidity of an entry in the Register, and that an entry ought to be expunged, and that on such declaration sect. 111, sub-sect. 2, becomes applicable (*l*).

In practice, proceedings to rectify are almost always taken in the Chancery Division, except where they occur in the course of an action for infringement or passing off, commenced against the applicant in the Queen's Bench Division (*m*); and unless disputed questions of fact are involved which it is desirable to try by the aid of a jury, the Chancery Division will almost always be found to provide the more satisfactory tribunals for the trial of trade-mark questions.

Procedure by action.

Neither the Acts nor the Rules contain any regulations as to the manner in which the application to the Court must be made; and it follows the applicant must approach it by one of those means by which the High Court is usually approached, that is, either by writ or by originating summons, or by notice of motion (*n*). There is no reported English case where the application has been made by action (*l*); and in *Pinto* v. *Badman* (*m*), Bowen, L. J., suggested that to proceed in that way would be an abuse of the process of the Court. It may be assumed, at any rate, that the plaintiff in an action, unless he could show some good ground for adopting a course which is both unusual and, in general, unnecessarily ex-

(*i*) *Bayer* v. *Connell Bros.*, 14 R. P. C. 275 (1897), Porter, M. R.

(*k*) *Cowie Bros.* v. *Herbert*, 14 R. P. C. 436 (1897), Lord Kincairney (Lord Ordinary).

(*l*) *Dewar & Sons, Ld.* v. *J. H. Dewar*, and *J. H. Dewar* v. *Dewar & Sons, Ld.*, 17 R. P. C. 341 (1900), Lord Kyllachy (Lord Ordinary) and the Inner House (The Lord President and Lords Adam, Maclaren, and Kinnear). There was a claim for reduction of the entry in the Register, which the Court thought to be unnecessary.

(*m*) As in *Pinto* v. *Badman*, 8 R. P. C. 181 (1891).

(*n*) Per Kay, L. J., in *King & Co.'s Tm.*, (1892) 2 Ch. p. 488; 9 R. P. C. 350.

pensive, would have to pay the extra costs incurred, even though he were successful.

Not by counterclaim.

In the case last cited, it was held that the application could not be made by counterclaim, apparently on the ground that it did not fall within sect. 24 (3) of the Judicature Act of 1873.

By summons or motion.

Applications under the section are frequently made both by originating summons and by motion. Each mode of proceeding offers some advantages peculiar to it. A simple case, where there is no very determined contest between the parties, might be dealt with inexpensively and quickly in chambers, and, on the other hand, if the case is certain to be adjourned into Court, it can usually be brought to a hearing more rapidly on an application by motion. If an action is pending in the matter, however, the summons or motion will *almost always be adjourned to* the hearing of the action, and a summons will then be the cheaper course. And where there is no action in question, some judges object to dispose finally of an application affecting important property rights on motion day, and, if the application is by motion, and is to be decided on affidavit evidence, they direct it to be placed in the non-witness list.

The summons, unless taken out in a pending action, will be an originating summons (*o*). The notice of motion must, as the summons must, if issued in the Chancery Division, be marked with the name of a judge (*p*), and the notice must, unless special leave for short notice is given by the Court or a judge, be served *two days before the motion is made* (*q*).

Notice to the Comptroller.

In any case, by Rule 49 of the Trade-Mark Rules, four clear days' notice of every application to the Court under sect. 90 for the rectification of the Register must be given to the Comptroller, but it does not seem to be necessary to make him a respondent to the motion or summons (*r*), and he frequently does not appear on the hearing.

Service on the registered proprietor.

It is proper, when the registered proprietor of the trade-mark in question is resident within the jurisdiction, to serve

(*o*) Ord. 5, r. 9 (b); Rules of 1893, Ord. 54, rr. 4 (b) to (e).

(*p*) Ord. 5, r. 9 (b) (c); *King & Co.'s Tm.*, (1892) 2 Ch. 469; 10 R. P. C. 350. Form, p. 742.

(*q*) Ord. 52, r. 5.

(*r*) See *King & Co.'s Tm.*, *supra*, note (*n*).

him with the notice of motion or the summons (*r*); but if he is resident abroad, under the existing rule of Court this cannot be done, nor is it necessary to enable the Court to entertain the application in question (*s*). In the case of *La Cie. Générale d'Eaux Minérales, &c.*, notice of motion to remove a mark belonging to a foreign company not carrying on business in England was served upon the company in Paris; and Stirling, J., upon their application, set aside the service, because it would have founded a jurisdiction to give costs and damages against the company, and there is, he held, nothing in the Acts to warrant this in the case of such a respondent. The notice of motion had been served abroad without the leave of a judge, but that was really immaterial, as there is no jurisdiction under Ord. XI. or otherwise to grant leave in respect of the application in question. On a subsequent application the learned judge directed that the name of the company should be struck out of the notice of motion, leaving the Comptroller as the sole respondent, but that information of the application should be given to the company (*t*). This course was adopted and approved in *King & Co.'s Case* (*u*), where the registered proprietors of the mark in question were a company having its registered office and carrying on business in Ireland. In that case the Court of Appeal held that service of the formal notice of motion was not required to enable the Court to deal with the application, and that, as the Acts and Rules were silent on the subject, all that was required by natural justice, and therefore all that the Court would insist on, was that the persons interested in the mark should have actual notice of the application to be made respecting it (*x*). If they should take advantage of the notice to appear and oppose the application it was, the Court held, open to them to do so, but in that event they would be liable, if they failed, to be

Where the proprietor is resident abroad.

Notice of motion not to be served out of the jurisdiction.

Notice by letter only.

Foreigner appearing on the application may be made liable for costs.

(*r*) See *King & Co.'s Tm.*, *supra*, note (*n*).

(*s*) See *King & Co.'s Tm.*, *supra*; and *Royal Baking Powder Co.'s Tms.*, 14 R. P. C. 425 (1897), Romer, J. And the steps taken by the applicant in *Ashton's Tm.*, 48 W. R. 389 (1900), where the registered proprietor, resident abroad, could not be traced.

(*t*) (1891) 3 Ch. 451; 8 R. P. C. 446.

(*u*) *Supra*, note (*n*).

(*x*) Cf. Ord. 52, r. 3.

ordered to pay costs. Lindley, L. J., expressed a doubt whether it was necessary, in the case before Stirling, J., to strike out the name of the foreign respondents from the notice (*y*). He said, "If you go down to the root of the argument there is nothing in it except a false analogy based on the supposition that, because the notice of motion is marked by an English judge, the parties interested must be technically named at the foot of it as respondents, and you must get leave to serve them if they are to be affected by it. It appears to me that all that they want for the purposes of this Act is notice, and that they have had" (*z*).

Security for costs by foreigner.

It has been held that a foreigner who is the registered proprietor of a mark which it is sought to remove from the Register is entitled, on receipt of information as to the intended application to rectify, to appear upon the application without giving security for costs, on submitting to the jurisdiction (*a*); but if he appeal from an order made on the motion, he may be ordered to give security (*b*).

Action for infringement in Scotland or Ireland.

The Court has in several cases refused to allow actions for infringement to be brought or proceeded with in England where it has considered the Scotch or Irish Courts to be more convenient, notwithstanding that motions to rectify were pending in it with regard to the same matters (*c*).

Evidence on the Application.

The evidence is, in accordance with the usual rule, generally given in the first instance by affidavit, subject to cross-

(*y*) (1892) 2 Ch. p. 482.

(*z*) Cf. *Bancroft & Co.'s Tm.*, 5 R. P. C. 209 (1888), and *Robertson, Sanderson & Co.'s Tm.*, (1892) 2 Ch. 245; 9 R. P. C. 213, where notices of appeals from the Comptroller were sent to persons out of the jurisdiction, but the notices of motion were not served on them.

(*a*) *Société, &c. de l'Étoile's Tm.*, 10 R. P. C. 290 (1893), Stirling, J.; *Miller's Patent*, W. N. (1894) 4; 11 R. P. C. 55, Kekewich, J.

(*b*) In *Société, &c. de l'Étoile's Tm.*, 11 R. P. C. 142, an order was made by consent, the appellants having no place of business in England. On the other hand, in *Re Apollinaris Co.'s Tms.*, (1891) 1 Ch. 1, a foreign applicant who appealed was not ordered to give security, he having ample assets within the jurisdiction.

(*c*) *Kinahan* v. *Kinahan*, 45 C. D. 78; 8 R. P. C. 18 (1890), Kekewich, J.; *Marshall* v. *Marshall*, 38 C. D. 330 (1888), C. A.

examination of the deponents if ordered by the Court or a judge (*d*). But applications under the section are very frequently heard upon *viva voce* evidence given in Court. And the Court has, by the terms of the section (*e*), power to direct an issue to be tried for the determination of any fact arising upon the application, but this is rarely, if ever, done. Where an action is pending by the proprietor of the mark against the applicant, it is very usual, especially in cases where the application to rectify depends on questions of fact, to order the application to stand over until the trial, and to come on to be heard with the action, with leave to use the affidavits and cross-examine on them, and to adduce oral evidence.

Declarations of the proprietor.

Statutory declarations, or certified copies of declarations made on the application for registration of the mark sought to be removed or varied, and on the occasion of transfers of the mark by predecessors in title of the owner of the mark, may be put in evidence by the applicants, but not declarations made by persons who are neither parties to the application nor predecessors in title of the respondents (*f*).

Evidence to be completed before the summons comes into Court.

Where the application is made by summons the evidence on each side should be completed before the matter is adjourned into Court, and Stirling, J., announced that he would not allow the rule to be departed from by permitting evidence to be filed subsequently (*g*).

Discovery.

In a proper case discovery of documents may be ordered to be made by either party to the application (*h*). In *Wills' Trade-Marks* (*i*), on an application by notice of motion to remove certain marks from the Register, and after the evidence had been completed (except as to the cross-examination of two witnesses, which was to be taken in Court), the applicants took out a summons for an order for discovery of documents by the respondents, the proprietors of the marks. Kekewich, J., required the applicants to make a statement in writing of the grounds upon which they sought to have the

(*d*) Ord. 38, r. 1.

(*e*) Sect. 90 (2).

(*f*) *Thewlis & Blakey's Tm.*, 10 R. P. C. p. 373 (1893), North, J.

(*g*) *Jackson & Co.* v. *Napper*, 35 C. D. p. 166 (1886).

(*h*) Ord. 31, r. 12; see *Re Norwich Town Close Estate Charity*, 40 C. D. 310 (1889).

(*i*) (1892) 3 Ch. 301; 9 R. P. C. 346.

marks removed, and upon it formulated six questions relative to the use of the marks by the respondents, and ordered that a member of the respondents' firm should make discovery of the documents relating to the several questions, not disclosing all the documents, but only specimens representative of each class of them. The Court of Appeal held that this order, carefully limited as it was, was oppressive at the then stage of the proceedings, and upon the respondents undertaking to deliver to the applicants a statement of the labels on which they intended to rely, and to have the relevant documents in Court at the hearing, and not to object to produce them, the Court set aside the order, without prejudice to any order the judge at the trial might think fit to make as to discovery of documents.

Particulars.

If the case set up is that the mark objected to is deceptive, and it is alleged that it has in fact deceived certain persons, particulars as to the persons deceived may be ordered to be given (*k*).

Order to be served on the Comptroller.

An office copy of any order to rectify must be left forthwith at the Trade-Marks Branch of the Patent Office, and the Register is to be thereupon rectified or altered, or the purport of the order to be otherwise duly entered on the Register, as the case may be (*l*). The Comptroller is directed, if he thinks that the rectification or variation should be made public, to publish, by advertisement or otherwise, and in such manner as he thinks just, the circumstances attending the rectification or variation in the Register at the expense of the person applying for it (*m*).

Damages under section 90.

It is difficult to see what damages can be given under the section. In several of the older cases under sect. 35 of the Companies Act of 1862, upon which sect. 90 is founded, the difference between costs as between solicitor and client and

(*k*) *Humphries* v. *The Taylor Drug Co.*, 39 C. D. 693; 5 R. P. C. 687 (1888), Kekewich, J., an action for infringement. See also *Whitstable Oyster Co.* v. *Hayling Fisheries, Ld.*, 17 R. P. C. 461 (1900), Buckley, J., a passing off case.

(*l*) Rule 46.

(*m*) Rule 50.

as between party and party were given as damages (*n*); but these cases were overruled (*o*); and, though it has since been held (*p*) that solicitor and client costs may be given in the Chancery Division under the jurisdiction inherited from the old Court of Chancery in any proper case, there is no reason to suppose that the cases first referred to would now be followed.

Possibly in a case where the presence of the wrongly registered mark of the respondent upon the Register has caused the applicant to fail in proceedings taken to register a mark which he was otherwise entitled to register, the costs of those abortive proceedings might be given as damages under the section. There is no reported case in which damages have been given under the section.

In any event, it seems that damages could only be granted where an order for rectification is made (*q*).

Certificate.

A certificate that the right to the exclusive use of a trade-mark has come in question can only be granted under sect. 77 (a) in an action for infringement of the mark; but where the defendant in an action for infringement moved to expunge the plaintiffs' trade-mark, and the action and motion were ordered to be heard together on the same evidence, and the plaintiffs' trade-mark was held to be properly registered, it was held that, although the mark had been registered for five years, and the right to the exclusive use of it could only be challenged on the motion to expunge it, a certificate could, under the circumstances, be granted (*r*).

(*n*) *E.g.*, *Anderson's Case*, 17 C. D. 373 (1881).

(*o*) *Corkburn* v. *Edwards*, 18 C. D. 449 (1881); Buckley on the Companies Acts, 7th ed. p. 155.

(*p*) *Andrews* v. *Barnes*, 39 C. D. 133 (1888), Kay, J., and C. A.

(*q*) *Ottos Kopje Diamond Mines, Ld.*, (1893) 1 Ch. 618, a company case.

(*r*) *Field, Ld.* v. *Wayel Syndicate, Ld.*, (1900) 1 Ch. 651; 17 R. P. C. 260, Buckley, J.; and see Chap. XV. p. 436.

Costs (*s*).

The ordinary rule that the unsuccessful party must pay the costs of the proceedings is rarely departed from (*t*), and these costs include the Comptroller's costs, if he think fit to appear. The Comptroller is never directed to pay costs.

The Court has, however, a discretion whether to give costs or not, and, in the exercise of this discretion, Kekewich, J., refused to give costs to a successful applicant who could not have been interfered with in the slightest degree in his business had he allowed the mark to remain unaltered (*u*); and costs were refused to applicants who had asked by their notice of motion not only for the expunging of the proprietor's name, but also for the entry of their own names on the Register, and they were ordered to pay the Comptroller's costs (*v*); also, in a case where the defendant in an action for passing off his goods as those of the plaintiff successfully applied to expunge the plaintiff's registered mark, North, J., reserved the costs of the application till after the hearing of the action (*x*). And where in a similar case the plaintiff obtained an injunction against the defendant, on the ground of the fraudulent passing off of the latter's goods as his, and the defendant's motion to rectify failed, and was dismissed with costs at the trial, but, when urged on other grounds, succeeded in the Court of Appeal, no costs of the appeal on that point were

(*s*) See also Chap. IV. p. 93; and Chap. XV. p. 429.

(*t*) *Hyde & Co.'s Tm.*, 7 C. D. 724 (1878); *Kuhn & Co.'s Tm.*, 53 L. J. Ch. 238, n. (1878), both Jessel, M. R.; and where the mark is expunged costs may be given not only against the registered proprietor, but against another person who has claimed to be interested in the mark and brought proceedings in consequence: *Davis' Tms.*, 14 R. P. C. 903 (1897), North, J. (*Compactum*). As to whether an order for rectification is a "final judgment" within sect. 4, sub-s. 1 (8) of the Bankruptcy Act, 1883, cf. *Re Owen*, Sol. J. Vol. 45, p. 103, Dec. 8, 1900.

(*u*) *Humphries* v. *Taylor Drug Co.*, 59 L. T. 820 (1888), Kekewich, J. (*Herbalin*); see also *Perry Davis' Tm.*, 5 R. P. C. 337; 58 L. T. 695 (1888), Kay, J.

(*v*) *Harness' Tm.*, 17 R. P. C. 40 (1900), Farwell, J.

(*x*) *Gianaclis' Tm.*, 6 R. P. C. 467; 58 L. J. Ch. 782 (1889); and in *Thompson* v. *Miller*, 13 R. P. C. 35 (1896), Stirling, J., whilst giving the costs of the motion to the defendant in the action, added a direction that such costs were not to include the costs of the affidavits used, except so far as should be directed at the trial,

given, because the objection was not urged in the Court below, and the rest of the appeal was dismissed with costs (*y*).

In *Hill's Trade-Mark* the application to rectify was proceeded with at the applicant's instance, without waiting for the further investigation of charges of improper trading brought against him by the respondent, upon his undertaking not to ask for costs in any event (*z*).

In *Talbot's Trade-Mark* (*a*), where the application to rectify succeeded, no costs were given, because the applicant failed in regard to one of the grounds relied on, and he had delayed to move for three years.

As regards security for costs where the respondent is resident abroad, see above, p. 289.

Appeal.

An order made on an application under sect. 90 is a final order, and an appeal to the Court of Appeal against it must consequently be heard by not less than three judges (*b*), except under the Supreme Court of Judicature Act, 1899 (*c*), under which the consent of all parties is requisite. The appeal must be brought within fourteen days, and must be by a fourteen days' notice of motion (*d*).

Stay of execution.

The Court may stay execution of its order to rectify pending an appeal, and it will sometimes do so (*e*), but the

(*y*) *Thompson* v. *Montgomery*, 41 C. D. 35; 6 R. P. C. 404 (1888), Chitty, J., and C. A. (*Stone Ale*).

(*z*) 10 R. P. C. 113 (1893), Chitty, J.

(*a*) W. N. (1894) 12; 11 R. P. C. 77, Stirling, J. (*Emolliolorum*).

(*b*) *Rivière's Tm.*, 26 C. D. 48 (1884), C. A.; Judicature Act, 1875, sect. 12; see the notes to Ord. 58, rr. 3 and 15, in the Annual Practice.

(*c*) 62 Vict. c. 6. As to the necessary consents, &c., see *Re Hope*, 43 Sol. J. 649; W. N. (1899) 113.

(*d*) Ord. 58, rr. 3, 9 and 15; see *Re Blyth and Young*, 13 C. D. 416 (1879); and *Onslow* v. *The Commissioners of the Inland Revenue*, 25 Q. B. D. 465 (1890); and cf. *Arbenz' Tm.*, 35 C. D. 248; 4 R. P. C. 143 (1887), C. A., where it was held that an appeal on an application to proceed must be brought within twenty-one days (now changed to fourteen days, Orders of 1893).

(*e*) *Harrison* v. *Woodroffe*, 7 R. P. C. 25; 42 C. D. 691 (1889), Kekewich, J.; see also *In re Tm. Borril*, 13 R. P. C. 387; 74 L. T. 805 (1896), where Kekewich, J., said that if he had decided that the mark ought to be removed he should have stayed execution.

appeal itself does not act as a stay (*f*). In *Re Palmer's Application* (*g*) the Court of Appeal, having reversed the decision of the judge of first instance on a preliminary objection, refused to stay the proceedings on the merits before the judge pending an appeal to the House of Lords against their decision.

Security for costs of the appeal may be ordered under special circumstances (*h*).

2. Correction and Cancellation of Entries at the Proprietor's Request.

By sect. 91 (b) and (c) (*i*) the Comptroller is empowered to correct any clerical error in the name, style, or address of the registered proprietor, and to cancel the entry of a trade-mark on the Register, wholly or in part.

The sub-sections provide that—

Sect. 91.

"The Comptroller may, on request in writing accompanied by the prescribed fee (*k*)—

"(b) Correct any clerical error in the name, style, or address of the registered proprietor of a patent, design, or trade-mark.

"(c) Cancel the entry or part of the entry of a trade-mark on the Register: provided that the applicant accompanies his request by a statutory declaration (*l*) made by himself, stating his name, address, and calling, and that he is the person whose name appears on the Register as the proprietor of the said trade-mark."

Alteration of address.

Rule 48 directs the Comptroller to enter any alteration of the address of the registered proprietor on application (*m*) and payment of the prescribed fee (*m*).

(*f*) Ord. 58, r. 16.

(*g*) 22 C. D. 88 (1882).

(*h*) Ord. 58, r. 15. Security was ordered *In re Tm. Borril*, 13 R. P. C. p. 387. As to such security in the case of foreigners, see *supra*, p. 289.

(*i*) Sub-sects. (a) and (d) deal with the correction of errors in or in connection with an application to register, and the omission of any of the goods referred to in it.

(*k*) 5*s*.

(*l*) Rule 61. Forms O. and P., Appendix, p. 710.

(*m*) 5*s*. Form M., Appendix, p. 709.

Sub-sect. (b) only relates to the correction of clerical errors. Any other alteration of the Register must be effected under sect. 90, already discussed, or under sect. 92.

Amendment or cancellation only at the proprietor's request.

It is not expressly stated in sub-sect. (b) by whom the request is to be made, but obviously it is intended to be made by the registered proprietor only, and the forms attached to the rules and referred to above are drafted on the assumption that this is so. It is suggested that the proviso printed in the Act as part of sub-sect. (c) is to be construed as applicable to the whole section.

Cancellation of an entry.

Sub-sect. (c), providing for cancellation of an entry at the proprietor's request, corresponds to the rule of February, 1878, made under the old Act. A registered proprietor may wish to cancel the whole or part of a trade-mark registered in his name, because he has ascertained that it ought not to have been registered, and so to avoid the costs of any application under sect. 90 to expunge it which might be made by a person aggrieved, or because it stands in the way of some other registration he desires to be effected (*n*), or in pursuance of an arrangement with other traders, or to cancel part of a mark in order to more readily support the registration of the remainder.

Where the registered proprietor is desirous of cancelling the mark only with a view to another registration, as, for instance, a registration on dissolution of partnership, the existing registration being an obstacle to the intended registration, it is doubtful whether he could make an application under sub-sect. (c) for the cancellation conditional on the other registration being effected; but in the course of the proceedings for registration of the new mark the result might perhaps be arrived at, assuming no other objection to be taken by the Comptroller, by an acceptance by him conditional on the proper application for cancellation being made (*o*).

(*n*) Thus, on a dissolution of partnership, the partners might wish to get rid of a mark registered in the partners' names, in order to give effect to some arrangement between them on the dissolution, and this could no doubt be done under this section: *Ehrmann's Tms.*, (1897) 2 Ch. 495; 14 R. P. C. 665.

(*o*) The matter was considered in

3. Alterations in Non-Essential Particulars.

Sect. 92 provides that—

Sect. 92.

"(1) The registered proprietor of any registered trade-mark may apply to the Court for leave to add to or alter such mark in any particular, not being an essential particular within the meaning of this Act, and the Court may refuse or grant leave on such terms as it may think fit.

"(2) Notice of any intended application to the Court under this section shall be given to the Comptroller by the applicant; and the Comptroller shall be entitled to be heard on the application.

"(3) If the Court grants leave, the Comptroller shall, on proof thereof, and on payment of the prescribed fee (*p*), cause the Register to be altered in conformity with the order of leave."

This section corresponds to the rule 35 of the old code under the Act of 1875. It appears to be confined to alterations in a mark and not to extend to any alteration of an entry in the Register (*q*).

What is an essential particular.

The alteration can only be permitted in any particular which is not an essential particular within the meaning of the Act. Reference is obviously intended to be made to the essential particulars enumerated in sect. 64 (*r*), which must, under the Act of 1888, be stated in the application for the registration of any mark made subsequently to the 1st of January, 1889 (*s*).

Alteration of old marks.

As regards an old mark registered under sect. 64 (3) (ii.), no part of the mark is specified as an essential particular, and

Ehrmann's Tms., *supra*, where the Comptroller refused to accept an undertaking to cancel the existing marks.

(*p*) 10*s*.

(*q*) *New Ormonde Cycle Co.'s Tm.*, (1896) 2 Ch. 521; 13 R. P. C. 475, North, J. See, however, *National Wholesale Tea Supply Association's Tms.*, 10 R. P. C. 164, (1893) Chitty, J.; and *Patent Plumbago Crucible Co.'s Tms.*, 7 R. P. C. 282 (1890), Stirling, J.

(*r*) The proviso in the old rule ran, "so that he do not alter any one or more of the particulars in such mark which are declared by sect. 10 of the Act (of 1875) to be the essential particulars of a trade-mark." A signature mark, therefore, cannot be altered, above, p. 131.

(*s*) Chap. VIII. p. 124.

"essential" must therefore be read as equivalent to "substantial" (*l*) or "material." The section has accordingly a much more restricted operation in regard to old marks than in regard to marks first used since 13th August, 1875, and registered under the provisions applying to new marks. The policy of the Acts is that old marks should be registered and kept registered substantially as they were used before the date mentioned (*u*). In the absence of special circumstances, therefore, no alteration at all should be permitted (*x*). But the section allows some alterations to be made in old marks. For instance, the Court has authorized the addition of the word *limited* to an old mark where the proprietors had assigned their rights to a company bearing their old firm name with that addition (*y*); and has permitted the name of certain works abandoned by the proprietors to be struck out, and the name of other works retained by them to be printed in a different position in the registered mark (*z*); and has allowed the addition of *and Son* to a name, and the substitution of new addresses for former ones (*a*); and in *Orlando Jones & Co.'s Trade-Marks* (*b*), it allowed certain words to be added to two marks registered as old marks. But the Court has refused to expunge *trade-mark* so printed upon a label as to suggest that part only of the matter of the label was the trade-mark (*c*), in a case where the mark had stood for twelve years on the Register (*d*); or to strike out *patent* printed as part

"Trade-mark."

"Patent."

of the name of the goods upon a label, there being in fact no letters patent (*e*); or to substitute the name of one former proprietor of a mark for that of another in the mark (*f*). And in a mark consisting partly of Russian characters, alterations in the words on the mark, which were held to be alterations so material as to possibly prevent persons in England recognizing it, were refused (*g*).

Alterations allowed in new marks.

In the case of new marks, alterations in matters other than the essential particulars are more readily permitted, and in estimating the resemblance referred to in sect. 72 (2), it is proper to have regard to the possibility of such alteration (*h*).

None allowed to the prejudice of other persons.

But no alteration to the prejudice of other registered proprietors, or such as to cause the altered entry to infringe the restrictions of the Acts can be allowed. Thus, in *Heiss' Trade-Mark* (*i*), the applicants, having a registered combination device trade-mark bearing the words *Grass Bleach, Best Quality*, and having ceased to use the method of grass bleaching, desired to substitute for *Grass* their own trade-name, *Heiss*. The Comptroller required (*k*) them to inform the Court that there were certain other trade-marks containing the name *Heiss*, and North, J., refused to grant the application until he was satisfied that the altered mark would bear no resemblance to any of the marks referred to.

Instances of alterations.

Amongst the alterations allowed in reported cases are the addition of *limited* to a name (*l*); the correction of an

(*e*) [illegible] (1892) 2 Ch. 402; 9 R. P. C. 200, by Kekewich, J.; the proprietors of the mark undertaking to register a statement of the essential particulars of their marks and to disclaim the remainder of them. A similar application for certain alterations in a mark was made in [illegible] 13 R. P. C. 201 [illegible]

(*f*) [illegible] 13 R. P. C. 21 (1896), Romer, J.

(*g*) [illegible] 7 R. P. C. 149 (1890), Stirling, J.

(*h*) [illegible] 7 R. P. C. 422 (1890), Romer, J.

(*i*) The opposition was to registration on the ground inter alia of the [illegible]

(*k*) [illegible]

(*l*) [illegible]

English letter printed by mistake for a Russian letter (*m*); the omission of certain words (*n*); the alteration of the name of the proprietor's works (*o*); the substitution of the initials of the new name of a limited company for those of its former name (*p*); the substitution of certain words so as to change the old name of a limited company to its new name, such name not being printed in a particular or distinctive manner (*q*).

An application to omit two oval lines from a trade-mark was, in one case, refused, the Comptroller contending that the mark was a combination mark (*r*), and the addition of the words "superior quality," which were alleged to have been omitted on registration by the applicant's mistake, was refused, except on certain conditions as to disclaimer (*s*), the mark having been registered for eighteen years.

When a limited company, which is the registered proprietor of a trade-mark, changes its name, it should apply to the Comptroller, under sect. 87, to make the necessary alteration in the Register, and should not, where no alteration in the mark itself is desired, apply to the Court under sect. 92 (*t*).

Procedure on an Application under Section 92.

The procedure to be adopted is generally the same as that on an application under sect. 90 (*u*), with such differences as are occasioned by the fact that on applications under that section the registered proprietor is usually a respondent to

[illegible]

the application, while on applications under sect. 92 he is himself the applicant, and there is usually no respondent other than the Comptroller.

Notice of the application and order to the Comptroller.

Fourteen days' notice of the intended application must be given to the Comptroller (*x*), and if leave is granted the applicant is directed to forthwith supply to the Comptroller such a number of representations of the trade-mark, as altered, as the Comptroller may deem sufficient (*y*). The person in whose favour the order is made, or such one of them if more than one as the Comptroller may direct, must forthwith leave at the Patent Office, Trade-Marks Branch, an office copy of the order. The Register is thereupon to be rectified or altered, or the purport of the order to be otherwise duly entered on the Register, as the case may be (*z*).

Advertisement by the Comptroller.

The Comptroller must, if he thinks the rectification or variation should be made public, at the expense of the applicant, publish by advertisement or otherwise, and in such manner as he thinks just, the circumstances attending the rectification or variation of the Register (*a*).

The Comptroller may appear on the application.

The Comptroller is entitled to appear and to be heard on the application. If he thinks there is no objection to the alteration sought to be made, or that it is sufficient to see that the facts are brought before the Court (*b*) he does not usually appear. He frequently signifies to the applicant that he has no objection to the proposal, and his assistance is, of course, of material importance in inducing the Court to accede to the application.

The applicant must pay the costs.

The applicant is always directed to pay the costs of the Comptroller, if the Comptroller appears (*c*).

(*x*) Rule 92 (2), and Rule 61, p. 700.
(*y*) Rule 61.
(*z*) Rule 62
(*a*) Rule 63

(*b*) See *In re* [illegible], 5 R. P. C. 251 and *ante*, p. 299 note.
(*c*) Rule 64, and see *ante*, p. 299.

CHAPTER XII.

EFFECT OF REGISTRATION.

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The general object of the Registration Acts was not to

Object of the Acts

of protecting, trade-marks (*a*). Their main effects, however, have been (1) to provide a new way in which title to a trade-mark may be acquired, namely, by registration; (2) to simplify infringement actions, by making registration evidence, and, under certain circumstances, conclusive proof of title; and (3) to constitute registration, in general, a condition precedent to an action for infringement. The first of these changes was a substantive alteration of the old law.

The Acts have also defined and limited the classes of symbols which can be registered as trade-marks (*b*), and thereby, as a consequence of the third alteration just referred to, have restricted the number of marks in which trade-mark rights can, as such, be effectively protected (*c*).

1. Title to New Trade-Marks conferred by Registration.

Title to new mark.

Registration, if properly made in accordance with the Acts in force at the date of the application to register (*d*), confers upon the registered proprietor trade-mark rights in the registered mark in respect of the goods for which it is registered and upon which it is used, subject to the rights appearing from the Register to be vested in any other person (*e*), and subject, for five years from the date of the application to register, to the conflicting rights existing at that date of any other person in the same mark (*f*). And the rights so acquired date back to the date of the application to register.

Trade-mark acquired by user in five years after registration.

As registration gives an independent title, the owner of trade-mark rights acquired by user, when he has registered his mark, will only need to avail himself of his earlier title if the propriety of the registration is questioned, or if, within the five years, conflicting rights in the same or [illegible]

[illegible]

mark rights in it could be acquired (*g*). It was of the very essence of such rights (*h*), and it is provided, by sect. 75, that—

Sect. 75. Registration equivalent to user.

"[Application for] (*i*) registration of a trade-mark shall be deemed to be equivalent to public use of the trade-mark, [and the date of the application shall, for the purposes of this Act (*k*) be deemed to be, and as from the 1st of January, 1876, to have been, the date of registration]" (*l*).

The amendment of this section was effected upon the recommendation of Lord Herschell's Committee (*l*). The alteration was merely directed to give legislative authority to the rule already in force.

New and unused trade-marks may be registered.

A serious question arose on the construction of the original Act, of 1875, which contained no provision equivalent to sect. 75, as to whether new marks which had never been used could be registered under it (*m*); but the view expressed above, that the Act created a new mode of acquiring trade-mark rights, which had been acted upon from the first, was finally affirmed in *Hudson's Trade-Marks* (*n*). "In my opinion," Cotton, L. J., said in that case, "the language (of the Act), though not appropriate, means this, that a man who designs one of those special things pointed out in sect. 10 (*a*) is, as designer, to be considered as the proprietor of it, and if there is no one else who has used it, or who can be interfered with by the registration and subsequent assertion of title to the mark, then he is to be considered as entitled, within the meaning of the Act, to the exclusive use of that which, in fact, has never been in any way used, but which has only been designed by him, and which he can be treated as the person entitled to register, if no one else had so used it, as that his user would be interfered with by

Hudson's Case.

(*g*) [illegible]
(*h*) Hudson's Case, 33 L. T. 811, [illegible]
[illegible]
(*i*) Act of 1888, s. 11
(*k*) I.e., the principal Act, the Act of 1883, see Act of 1888, s. 21
(*l*) Report of 1888, p. 10
(*m*) See Edwards v. Dennis, 30 [illegible]
(*n*) 33 L. T. 811; Hudson's Case, 33 L. T. 811, [illegible]
[illegible]
(*a*) I.e. the application was made, and the case was decided, under the Act of 1875
(*a*) Sect. 10 of the Act of 1875

the registration" (*p*). And now marks have since been constantly registered. Any other construction of the Acts would have led to very strange results, for no length of user was required to be shown in the actions or suits for infringement before the Acts (*q*). In any case, sect. 75 makes the matter absolutely clear, for, having regard to sect. 76 of the Act of 1883, quoted below, and the corresponding section of the earlier Act, it is difficult to see what operation it could have except in regard to new marks.

Applicant for registration must intend to use the mark.

But, although actual use of the mark is not a condition precedent to registration, the applicant must intend to use it for the goods for which it is to be registered, and if he registers without such an intention the mark ought to be removed from the Register. Thus, where two marks had been registered for goods in class 42 for many years, but, on an application to remove them, Romer, J., found that there had been no real user before registration, and that there had been no real user in respect of such goods since registration, and that at the date of the registration there was no *bond fide* intention on the part of the applicants to so use the marks, he ordered the marks to be removed, and the decision was upheld by the Court of Appeal and the House of Lords (*r*). The intention, moreover, should be a definite and present intention to deal in certain goods or descriptions of goods (and to use the mark in respect thereof), and not a more general intention of extending business at some future time to the goods if it should be thought desirable (*s*). So if a mark be registered merely for the purpose of preventing other traders from using it, it will be removed (*t*). The effect of sect. 75 was, in *Hall's Case*, only explicitly referred to in the judgment of the Court of Appeal, where Lindley, M. R., who delivered

Sect. 76 refers to the time of registration.

the judgment, said: "Although sect. 75 of the Act of 1883 said that 'registration of a trade-mark shall be equivalent to public use of the trade-mark,' this language, even when in force, did not and could not mean that continued registration was equivalent to continued use. So to construe the language would lead to the irrational conclusion that a man might properly register a trade-mark for any goods he chose, although he carried on no trade or business in them at all. . . . Sect. 75 was addressed to the time of registration; it substituted registration for previous user and reputation gained by it." And it was pointed out that the alteration of the section by the Act of 1888 made the matter still plainer.

2. Registration as Evidence of Title.

Sect. 76 provides that:

Sect. 76. Registered proprietor of mark to have right to exclusive use of it.

"The registration of a person as proprietor of a trade-mark shall be primâ facie evidence of his right to the exclusive use of the trade-mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence of his right to the exclusive use of the trade-mark, subject to the provisions of this Act."

Comparison with the earlier Act.

Registration being declared by the preceding section of the Act to be equivalent to public user, the section is in accordance with the old law. It is identical in terms with sect. 3 of the Act of 1875, except that by a verbal amendment "proprietor" has been substituted for "first proprietor," and the proviso of the last clause is now general, whereas in the earlier Act it stood "subject to the provisions of this Act as to its connection with the goodwill of a business."

"Subject to the provisions of this Act."

The most important of the provisions of the Act referred to are the sections which enable a second person who has an [illegible] title to an old mark identical with or similar to a mark already registered, to [illegible] registration or proprietorship of it (or); the provisions of such [illegible] that a trade-mark must be

[illegible]

registered for particular goods; the provision of sect. 70 for the assignment of registered marks in connection with the goodwill of the business to which they belong; and the provision of sect. 90 for the rectification of the Register. It will be seen that the operation of the last-mentioned section is to very considerably diminish the value of five years' registration as conclusive evidence of title (*x*).

Right limited to goods for which the mark is registered.

The registration confers no rights except in regard to the goods for which the mark is registered, whether that be the whole or only part of a register class (*y*), and if the registration is limited by a note entered on the Register to some only of the goods which would be otherwise included under it, the rights conferred are limited also in the same way (*z*).

Registration restricted to goods for which the mark is used.

Edwards v. *Dennis.*

Further, if the mark is actually used for certain descriptions of goods only, although registered for others also, the exclusive rights conferred by the section do not extend to the latter. Thus, where the plaintiff in an action was the assignee of a mark registered for "unwrought and partly wrought metals used in manufacture," and, in fact, he only used it upon sheet iron goods, his business being confined to such goods, and the defendant was the agent of the proprietors of a similar mark subsequently registered for steel and iron wire, and had sold wire with the latter mark upon it, it was held that the plaintiff had no cause of action, and an order was made that the registration of the plaintiff's mark should be rectified by confining it to sheet iron (*a*).

In the case just cited the plaintiff was assignee of the registered mark, and the decision turned to some extent upon the rule that a registered mark can only be assigned in connection with the goodwill of the business concerned in the

below, p. 310, and the "three mark rule," Chap. X., p. 214.

(*z*) See p. 309.

(*a*) [illegible]

goods for which it has been registered (*b*), the plaintiff's business being confined, as already stated, to sheet iron goods; but all the judges in the Court of Appeal indicated an opinion that the rights of the original registered proprietor would in any case have been limited by his actual user of the mark (*c*). This opinion was subsequently adopted and followed by Chitty, J., in the case of *Hargreaves* v. *Freeman* (*d*); and in *Batt & Co.'s Trade-Marks* (*e*), the Court of Appeal considered that the principle of the decision in *Edwards* v. *Dennis* was that the original proprietor ought not to have registered the mark for goods with which he had no concern, and, applying it to the case before them, they upheld the removal of certain marks from the Register on the ground that there had been no user and no intention to use them (*f*).

Certificate of registration is evidence of title, *prima facie* or conclusive.

The main purpose of sect. 76 is to facilitate the proof of title by a plaintiff suing for an alleged infringement of his mark; in place of the evidence of user and reputation, by which he would have had to show his right to the mark before the Acts, he has only to produce the certificate (*g*) of registration of his mark, and that will be *prima facie* evidence of his title (*h*).

Evidence rebutted by the plaintiff's own case.

The evidence afforded by the registration may be rebutted, if the registration is less than five years old (*i*). Thus, in the case just cited (*k*), the plaintiffs were not content to rest their title, as in the first instance they might have, merely upon the registration, but they set out in their pleadings the steps by which they alleged that the trade-mark in question had been transferred to them, and thereby showed that the original proprietors of the mark, and of the cigar factory and business in connection with which it had been acquired, had purported to assign the trade-mark

(*b*) Sect. 70.

(*c*) And see *Hudson's Tm.*, 32 Ch. D. at p. 310 (1886), and *supra*, p. 306.

(*d*) (1891) 3 Ch. 39; 8 R. P. C. 237.

(*e*) And *supra*, note (*c*).

(*f*) The decision was affirmed in the House of Lords. See *supra*, note (*c*).

(*g*) And see, note (*b*).

(*h*) *Imp* v. *Hudson*, 8 R. P. C. 181 (1891), C. A.

(*i*) Thus, in *Lever* v. *Goodwin*, 36 Ch. D. 1; 4 R. P. C. 492 (1886), Chitty, J., held that the words *Self Winder*, although they had been two years on the Register, were not a trade-mark. The case nevertheless succeeded on the ground of passing off. See further the chapter on Infringement, p. 341, note (*d*).

(*k*) *Imp* v. *Hudson*, *supra*, note (*h*).

without assigning the goodwill of the business. It followed, therefore, that the assignment was a nullity (*l*), and, as the registration was less than five years old, the *primâ facie* title conferred by it was consequently rebutted by the evidence furnished by the plaintiffs' own case.

Five years' registration.

If the Register shows that the registration was five years old at the date when it is put in evidence (*m*), it will be conclusive evidence of the title of the registered proprietor, or, subject to sect. 70, of his assignee, so long as the registration stands; but it is open to the defendant, as a "person aggrieved" by the registration, if the registration has been made without sufficient cause (*n*), to apply by motion or summons, under sect. 90, to have it expunged or restricted. The application cannot be made by counterclaim in the action (*nn*). But as regards Scotland this statement as to the effect of five years' registration is subject to a qualification occasioned by a decision of the Court of Session to the effect that the Scotch Courts have jurisdiction, notwithstanding that a mark has been five years on the Register and that there is no application before the Court to remove it, to make a declaration that the registration of the mark was invalid (*o*). The decision was put upon the ground that the words "subject to the provisions of this Act" preserved, under sect. 111, to the Scotch Courts a jurisdiction to make such a declaration.

Register may be rectified at any time.

The words of sect. 76 appear to make that section subject to sect. 90, and therefore, to make the rights conferred by it subject to the rectification of the Register, even though the mark in question has been registered for five years, and this has been held to be the case. The same result was arrived at upon the construction of sect. 3 of the Act of 1875, notwithstanding the dictum to the contrary of Jessel, M. R., in *Hyde's Trade-Mark* (*p*), although the saving in that section applied in express terms only to a particular provision of the Act, namely, that relating to assignment. The following are

(*l*) Sect. 70, and Chap. XIII. p. 324.

(*m*) See *Maxwell's Case*, 64 L. J. Ch. 1003 (1895), Kay, J., where a note postponing the registration was inserted on the Register, cited above, p. 284.

(*n*) Chap. XI. p. 284.

(*nn*) Above, note (*k*).

(*o*) *Dewar & Sons, Ld. v. J. H. Dewar* (1900), 17 R. P. C. 341. See above, p. 284.

(*p*) 7 Ch. D. 724 (1878).

cases in which marks were removed or varied on the grounds stated, after being upon the Register for five years or more. As the cases are constantly referred to, it will be convenient to tabulate them.

Examples of trade-marks removed or varied after five years' registration.

The words BRAIDED FIXED STARS, removed, because they were descriptive and common to the trade, and because, though registered as an old mark, they had not been used alone before the Act of 1875, *Palmer's Tm.*, 21 C. D. 47 (1882), C. A.; 24 C. D. 504, C. A.; VALVOLINE, removed on similar grounds, *Leonard and Ellis' Tm.*, 26 C. D. 288 (1884), C. A.; LA MINERVA-HABANA, removed, because the words were common to the trade, *Lloyd and Sons' Tm.*, 27 C. D. 646 (1884), Chitty, J.; a syphon-bottle device, removed, because used by more than three persons before the registration, *Wragg's Tm.*, 29 C. D. 551 (1885), Pearson, J.; a Neptune and trident device, restricted to the goods over which the proprietor's rights extended, *Edwards* v. *Dennis*, 30 C. D. 454 (1885), C. A.; the word ETON, registered as an old mark, removed, because, as used by the proprietor, it was not "special and distinctive," *Wood's Tm.*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A.; the word ALBION, registered as an old mark, removed on the ground that it was descriptive of a particular pattern, and not used as a trade-mark, *Harrison, McGregor & Co.'s Tm.*, 42 C. D. 691; 7 R. P. C. 25 (1889), Kekewich, J.; a device, removed, because its registration was procured by material misrepresentation as to user before 1875, *Baker* v. *Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1889), North, J.; deceptive trade-marks removed, *Hill's Tm.* (*ante*, p. 260), and *Wills' Tm.* (*ante*, p. 258); device of anchor, removed, on the ground of being common to the trade when registered, *Hughes and Young's Tm.*, 10 R. P. C. 369 (1893), North, J.; SHAKSPERE, removed, because not a fancy word not in common use, *Banks and James* v. *Austic*, 12 R. P. C. 333 (1895), Chitty, J.; rectification of registration of mark containing ROADSTER by disclaimer of that word, *Thompson's Tm.*, 13 R. P. C. 35 (1896), Stirling, J.; marks removed on the ground that they had not been used before the Act of 1875, although registered as so used, *Gordon and Dilworth's Tm.*, 13 R. P. C. 629 (1896), Chitty, J.,

and *Royal Baking Powder Co.'s Tms.*, 14 R. P. C. 425 (1897), Romer, J.; COMPACTUM, and a mark containing that word, removed, because that word was descriptive of an article formerly patented, *Davis' Tms.*, 14 R. P. C. 903 (1897), North, J.; TRITICUMINA, removed, because not a fancy word not in common use, *Meaby & Co., Ld.* v. *Triticine, Ld.*, 15 R. P. C. 1 (1898), North, J.; marks removed as to one class on the ground that there had never been any *bonâ fide* intention of using them on goods in that class, *Batt & Co.'s Tms.* (*ante*, p. 305); DAY & SONS' BLACK DRINK, expunged, because not used before the Act of 1875 as a trade-mark, but registered as having been so used, *Day* v. *Riley and Whittaker*, 17 R. P. C. 517 (1900), Buckley, J.; mark expunged on proprietor's admission that it could not be supported, being deceptive, *Day* v. *Riley and Whittaker*, *supra*; VASELINE, removed, because it was the name of the article, *Chesborough Manufacturing Co.'s Tm.*, 18 R. P. C. 191 (1901), Buckley, J.

Sect. 76 is subordinate to sect. 90.

In most of the earlier cases just cited, it was urged, but unsuccessfully, that five years' registration constitutes, under sect. 76 of the Act of 1883, or sect. 3 of the Act of 1875, an indefeasible title; and in *Baker* v. *Ranson* it was contended that the previous decisions only applied where the mark sought to be removed was common to the trade, or otherwise incapable of registration, that they were all cases on the older Act (*q*), and that the present Act must be construed differently; but North, J., overruled all the objections, and held that the earlier decisions had finally concluded the question. It may, consequently, be considered as settled law that the conclusive evidence of title furnished by five years' registration is no answer to an application to rectify the Register by removing or varying the mark under sect. 90.

Registration conclusive if no application under sect. 90.

In the absence of an application to rectify, the five years' registration is conclusive evidence of title in an action for infringement, so that the defendant cannot allege that the mark in question ought not to have been registered (*r*).

(*q*) *Wragg's Case*, *ante*, p. 310, was decided under the Act of 1883.

(*r*) *Apollinaris Co.* v. *Herrfeldt*, 4 R. P. C. 478 (1887), C. A.; see also *Leahy, Kelly and Leahy* v. *Glover*, 10 R. P. C. 141 (1893), H. L. See as to Scotland, however, the case cited in note (*o*).

3. Registration as a Condition precedent to an Action for Infringement.

It is provided by sect. 77 that:—

Sect. 77.

"A person shall not be entitled to institute any proceedings to prevent or to recover damages for the infringement of a trade-mark unless, in the case 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) (*s*) an enactment repealed by this Act, has been refused. The Comptroller may, on request, and on payment of the prescribed fee, grant a certificate (*t*) that such registration has been refused."

The corresponding sections of earlier Acts.

The corresponding section of the Act of 1875 was part of sect. 1. It was in the following terms: "From and after the 1st day of July, 1876, a person shall not be entitled to institute any proceeding to prevent the infringement of any trade-mark, as defined by this Act, until and unless such trade-mark is registered in pursuance of this Act."

It was found that the time allowed between the commencement of the Act of 1875—namely, the 13th of August, 1875, and the 1st of July, 1876—was insufficient for the registration of the very numerous trade-marks already in use (*u*); and by the Act of 1876 (*x*), the period allowed for registration was extended, and at the same time the terms of the enactment were amended, so as on the one hand to make the prohibition extend to an action for damages, as well as to an action for an injunction, in respect of an infringement of a trade-mark as defined by the Act of 1875, and on the other hand to exempt from its scope any trade-mark in use before that Act which had been refused registration under it. This amendment was in accord with

(*s*) *Sic*, without the brackets.

(*t*) See p. 315.

(*u*) In 1879 there were still 44,000 applications to register pending and undisposed of in the Trade-Marks Office at Manchester; *Hazzopulo* v. *Kaufmann*, 23 Sol. J. 819.

(*x*) 39 & 40 Vict. c. 33, s. 1.

the policy of the Acts to preserve old trade-mark rights substantially without alteration (*y*).

By the Act of 1877 (*z*), and an Order in Council made thereunder, the time for registration, in the case of trade-marks used in the textile industries, was further extended to the 30th of June, 1878.

There does not seem to be any material difference between the amended section of the Act of 1876 and sect. 77 of the present Act.

Act of 1888.

The only Act, making provision as to what may be registered, repealed by the Act of 1883, is the Act of 1875. By the Act of 1888, the Act of 1883 is, as from the 1st of January, 1889, to take effect subject to the additions, omissions, and substitutions required by the later Act; but nothing in the later Act is to affect the validity of any act done, right acquired, or liability incurred before the date mentioned (*a*). So that the marks capable of registration under the present Act, within the meaning of sect. 77, are those described in sect. 10 of the Act of 1888.

The prohibition of the section does not in express terms extend to (a) any new (*b*) mark incapable of registration under the present Act, whether it was or was not capable of registration under a repealed Act, and whether it has been refused or never tendered for registration under any of the Acts; or to (b) any old mark which was incapable of, and was refused, registration under a repealed Act, but is capable of registration under the present Act.

New marks, incapable of registration,

(a.) Although the section does not expressly enact that a new mark, incapable of registration under the Act, that is, not falling within any of the classes of marks enumerated in sect. 64 (*c*), shall not be the subject of trade-mark rights, yet the general words of prohibition, as also the savings contained in the section, plainly show that this was the result contemplated by the draftsman. And the Acts have always

(*y*) See per Lord Blackburn, *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Ca. p. 498 (1879); see Chap. XI. p. 298.

(*z*) 40 & 41 Vict. c. 37.

(*a*) Act of 1888, ss. 27 and 28.

(*b*) *I.c.*, not used as a trade-mark before 13th August, 1875.

(*c*) Chap. IV. p. 63.

been regarded as limiting the classes of symbols in respect of which trade-mark rights can be, or since they came into operation can have been, acquired and enforced (*d*) by the descriptions comprised in their several definition clauses (*e*).

are within the prohibition.

Thus, Cotton, L. J., said, in *Van Duzer's Case* (*f*): "The Act was also intended to protect the public, by having a Register of marks, so that they might know what it was that was protected by the trade-marks adopted, and also by cutting down the numerous forms of words and other things, by the use of which traders tried to secure themselves exclusive rights."

And applications to expunge the plaintiffs' trade-marks from the Register have been constantly made in actions for infringement of the trade-marks, and have been treated as effectual defences if successful, unless in any case the plaintiff could make out a case of "passing off" (*g*) by the use of his trade-mark (*h*). The question has, however, so far as the writer is aware, never been directly raised and decided by the Court, and the term "common law trade-mark" has been judicially applied to marks which, being incapable of registration, have been protected in passing off actions (*i*).

But it has been held that trade-marks, whether capable of registration or not, may be acquired apart from registration (*j*), although proceedings for infringement cannot be taken.

(*d*) A trade-mark can still be acquired by use: *Sen Sen Co.* v. *Britten*, (1899) 1 Ch. 692; 16 R. P. C. 137; but the trade-mark rights cannot be enforced except as provided by sect. 77.

(*e*) In *The Normal Co.'s Tm.*, 35 C. D. 235; 3 R. P. C. 269 (1886), Chitty, J., said: "The result (of sect. 77) is that a person, who, I will assume, is entitled to be, but by some error has not been, put on the Register by the Comptroller or by the Board of Trade, loses his right, because it is useless to have a trade-mark which you cannot protect in case of infringement; as to old marks, however, a distinction is drawn. And where there has been a refusal, there is a right to institute proceedings to prevent infringement. . . . So that the validity of the old trade-marks does not depend on the (non-)registration."

(*f*) 34 C. D. 634; 4 R. P. C. 31 (1887); cf. *Apollinaris Co.'s Tms.*, (1891) 2 Ch. at p. 235; 8 R. P. C. 137, per Fry, L. J.

(*g*) See below, p. 317.

(*h*) Chap. XVI. p. 446.

(*i*) *Reddaway & Co.* v. *Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639; 9 R. P. C. 503, Lindley, L. J.

(*j*) *Sen Sen Co.* v. *Britten*, (1899)

It will be noticed that the wording of the first saving in terms refers only to marks capable of being registered under the Act of 1883, and does not expressly extend to marks capable of registration and registered under a repealed Act; but by sect. 114 the former Register is continued and the intention clearly seems to be to include all such marks (*k*). Moreover, the Act of 1883 is in only one respect (*l*) narrower, as regards the marks capable of registration, than that of 1875.

Old marks refused registration.

(b.) There is no ground, apparently, for a suggestion that an old mark once refused registration need be tendered again in order to escape the prohibition of the section, because it might possibly be accepted under an Act subsequently passed. There is, in fact, little probability of the question arising, although single letters and figures and combinations of letters and figures excluded by the Act of 1875, as old marks, are now admitted to registration (*m*).

Certificate of refusal.

Lord Herschell's Committee advised that the certificate of refusal should be altered to a certificate that the trade-mark is incapable of being registered under the Act, on the ground that the former tends to prejudice the proprietor of the mark, especially in proceedings abroad (*n*); but the suggestion was not adopted. The fees payable for the certificate of refusal

1 Ch. 692; 16 R. P. C. 137, Stirling, J.; and see *infra*, p. 316.

(*k*) See also sect 113.

(*l*) In respect of signatures.

(*m*) Lord Blackburn, in his judgment in *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Ca. pp. 498 and 499 (1879), seems to have regarded the Act of 1876 as barring all actions in respect of old marks which were incapable of registration, and the decision. It is submitted, however, that this view is inconsistent with the express words of that Act and of sect. 77. And, indeed, the word "other" in the latter section only seems to be satisfied by being read as referring to marks incapable of registration under the Act of 1883. If such be the correct construction the second saving only extends to old marks incapable of registration which have been refused, old marks capable of registration falling under the first saving if registered. It may be, however, that the words capable of being registered under this Act refer only to marks capable of being registered as new marks, and that any old mark might come under the later part of the section.

permission to sue if a certificate of refusal to register were given, as only intended to meet cases where the mark ought to have been registered, pending an appeal to the Court. He says the owner of the trade-mark "may seek for more speedy redress" by bringing his action for infringement instead of appealing against the Registrar's

(*n*) Report of 1888, p. xiii.

are 1*l.* for one mark, and 10*s.* in addition for each mark beyond the first. The form of application is Form L. (*o*).

It was suggested by Malins, V.-C., in *The Twentsche Stoom Bleekery Goor* v. *Ellinger & Co.* (*p*), that the prohibition of sect. 77 does not apply to foreign owners of trade-marks; but it is submitted that the suggestion is ill-founded, and that no distinction can be drawn between trade-marks owned by subjects, and those owned by aliens (*q*).

Registration a condition precedent to action;

The section makes registration, in the cases falling within it, a condition precedent (*r*) to an action for infringement. Where, therefore, the sole consignee of goods for which his consignors had a label registered as a trade-mark in France, sought to restrain the use of a name which formed a material feature in the label, it was held that the action was in substance an action to restrain an infringement of the label, and, as that might have been registered in England as a trade-mark under sect. 103 of the Act, it fell within the prohibition (*s*). An action to restrain the use of a registered mark on goods for which the registration does not avail is also within the prohibition, for it is in effect an action in respect of an unregistered mark (*t*).

not to acquisition of a trade-mark.

The section does not enact that a man shall not have a trade-mark until he registers (*u*), and it has been compared (*u*) to sect. 24 of the Copyright Act, 1842 (*v*), which is satisfied by a registration made subsequently to the wrongful act complained of, but before the commencement of the action. If a person has adopted and used words as a trade-mark in this country, but has not registered them as a trade-mark, it does not necessarily follow that, by describing such

(*o*) Appendix, p. 709.

(*p*) 26 W. R. 70 (1877).

(*q*) See *Goodfellow* v. *Prince*, note (*s*); and Chap. XV. p. 357.

(*r*) Per Lord Blackburn in *Orr-Ewing's Case*, note (*m*).

(*s*) *Goodfellow* v. *Prince*, 35 C. D. 9 (1887), C. A.

(*t*) *Hargreaves* v. *Freeman*, (1891) 3 Ch. 39; 8 R. P. C. 237, Chitty, J.; cf. *Jay* v. *Ladler* and *Hart* v. *Colley*, cited below, p. 319, note (*j*). That the registration was blocked by delay at the office was considered to be no excuse: *Hazzopulo* v. *Kaufmann*, 23 Sol. J. 819 (1879), Little, V.-C.

(*u*) *Sen Sen Co.* v. *Britten*, (1899) 1 Ch. 692; 16 R. P. C. 137, Stirling, J.; and per Chitty, J., in *Barlow* v. *Johnson*, 7 R. P. C. at p. 405 (1890). See also Cotton, L. J., in *Hudson's Tms.*, 32 C. D. at p. 320: 3 R. P. C. at p. 161 (1886).

(*v*) 5 & 6 Vict. c. 45,

words on the goods as his trade-mark, he is making a misrepresentation (*x*).

Only the registered owners, or the assignees of the registered owners, of the trade-mark can sue in respect of an infringement of it (*y*), but it is not necessary that an assignee should have registered the assignment before commencing his action (*z*).

Only the registered proprietor or his assignee can sue.

The judgment of North, J., in the case last cited seems to go further and to be founded on the view that an unregistered assignee can sue. In *The Magnolia Metal Company* v. *Atlas Metal Company* (*a*), however, Collins, J., dismissed the action as to trade-mark on the ground that the plaintiffs had not at the date of judgment been registered as proprietors of the marks sued on (*b*). *Ihlee* v. *Henshaw* (*z*) does not seem to have been cited, and the two cases appear to conflict, for sect. 77 expressly refers to the institution of proceedings, and therefore, if registration of an assignment is necessary at all, it would appear to be necessary before the action is commenced.

The Prohibition does not affect Passing Off Actions.

Sect. 77 has no application to actions to restrain a trader passing off his goods, or doing what is calculated to pass off his goods, as the goods of another. Two questions arise in trade-mark actions and in allied actions: first, is the defendant using a mark which is the same as, or which is a colourable imitation of, the plaintiff's registered trade-mark? and secondly, is the defendant selling goods so marked as to be designed or calculated to lead purchasers to believe that

(*x*) *Sen Sen Co.* v. *Britten*, *supra*, note (*u*), distinguishing and explaining *Lewis* v. *Goodbody*, 67 L. T. N. S. 194, Kekewich, J. See observations of Kekewich, J., on the last-mentioned case, in *Hubbuck* v. *Brown*, 17 R. P. C. at p. 156 (1900).

(*y*) *Richards* v. *Butcher*, 7 R. P. C. 288; 62 L. T. 687 (1890), Kay, J. Action by sole purchasers from registered proprietors. Leave to add the proprietors.

(*z*) *Ihlee* v. *Henshaw*, 31 C. D. 323; 3 R. P. C. 15 (1886), North, J.

(*a*) 14 R. P. C. 389 (1897).

(*b*) It appears from the report of *Magnolia Co.'s Tms.*, 14 R. P. C. at p. 266, however, that the plaintiffs were registered as proprietors on the day before the trial; but it is presumed that this fact was not in evidence in the action.

Distinction between trade-mark and passing off cases.

they are the plaintiff's goods (*c*)? The two questions are distinct, and the injunctions granted by the Court to meet the wrongs complained of are different in the two cases. Thus, in *Jay* v. *Ladler* (*d*), the defendant was restrained "from infringing the plaintiff's said trade-mark by issuing, publishing, or circulating, or causing to be issued, published, or circulated, any circular, advertisement, or notice containing or bearing the trade-mark in the pleadings mentioned, or any colourable imitation thereof, in connection with sealskin mantles and sealskin coats (the only goods for which the trade-mark was registered), or otherwise using the said trade-mark in that connection," and he was also restrained "from using the device of a lady and bear (the trade-mark in question), so as to deceive the public," that is, so as to lead the public to believe that the goods of the defendant were the goods of the plaintiff.

The jurisdiction to grant the last-mentioned injunction is part of the general jurisdiction of the Courts to prevent and to give compensation for frauds which cause injury to the person who comes to complain of them (*e*), and this jurisdiction, which was well established before the Trade-Marks Registration Acts, has not been taken away or altered by anything contained in them (*f*).

Unregistered trade-marks practically protected.

The Stone Ales Case.

It is no defence, therefore, to an action for passing off the defendant's goods as those of the plaintiff, that the grant of an injunction would practically confer on the plaintiff trade-mark rights in an unregistered trade-mark. This is well shown by *The Stone Ales Case*. There the plaintiffs had registered the words *Stone Ale* as a trade-mark, and they had other registered marks which comprised the same

(*c*) *Mitchell* v. *Henry*, 15 C. D. 181 (1880), Thesiger, L. J.; *Edwards* v. *Dennis*, 30 C. D. 454 (1885), Fry, L.J.; see Chap. I. p. 12, and Chap. XVI. p. 451.

(*d*) 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.

(*e*) See Chap. I. p. 1.

(*f*) *Mitchell* v. *Henry*, 15 C. D. 181 (1880), C. A.; *Singer, &c. Co.* v. *Loog*, 8 App. Ca. at p. 32 (1882), per Lord Blackburn; *Goodfellow* v. *Prince*, 35 C. D. 9 (1887), C. A.; *Montgomery* v. *Thompson*, (1891) A. C. 217; 8 R. P. C. 361 (*Stone Ale*); *Reddaway* v. *Banham*, (1896) A. C. 199; 13 R. P. C. 218; *Lever Bros., Ld.* v. *Bedingfield*, 16 R. P. C. 3; 80 L. T. 100 (1899), C. A.

words. An application was made by the defendant to vary the registration of the first-mentioned mark, by adding a disclaimer of the right to the exclusive use of the word *Stone*, and this application Chitty, J., refused. The Court of Appeal, however, ordered the mark *Stone Ale* to be removed from the Register altogether, on the ground that it was not shown to have been used separately as a trade-mark before the 13th of August, 1875, but they, and subsequently the House of Lords, nevertheless maintained the injunction granted by Chitty, J. The injunction (*g*) restrained the defendant from "carrying on the business of a brewer at Stone, under the title of 'Stone Brewery,' or 'Montgomery's Stone Brewery,' or under any other title, so as to represent that the defendant's brewery is the brewery of the plaintiffs, and from selling, or causing to be sold, any ale or beer not of the plaintiffs' manufacture, under the term 'Stone Ales,' or 'Stone Ale,' or in any way so as to induce the belief that such ale or beer is of the plaintiffs' manufacture, and from infringing the plaintiffs' registered trade-marks, or any of them."

Lord Herschell's judgment.

"The respondents," Lord Herschell said (*h*), "are entitled to ask that a rival manufacturer shall be prevented from selling his ale under such a designation as to deceive the public into the belief that they are obtaining the ale of the respondents, and he ought not the less to be restrained from doing so because the practical effect of such restraint may be much the same as if persons seeking the injunction had a right of property in the particular name" (*i*).

Passing off by the imitation of an unregistered trade-mark.

In the case just quoted the deception was practised by the use of the trade-name of the plaintiffs' goods upon the defendant's goods. The jurisdiction existing, apart from the Acts, extends equally to cases where it is practised by the adoption of the plaintiff's trade-mark, or of the "get up" of his goods, and it affords no ground of defence that the trade-mark (*j*),

(*g*) (1891) A. C. p. 218.

(*h*) (1891) A. C. p. 220.

(*i*) See also *Birmingham Vinegar Co.* v. *Powell*, (1897) A. C. 710; 14 R. P. C. 720, where the words *Yorkshire Relish* had been expunged from the trade-marks Register: and *Reddaway* v. *Banham*, (1896) A. C. 199; 13 R. P. C. 218 (*Camel Hair Belting*). These cases are fully discussed below in Chap. XVI.

(*j*) *Jay* v. *Ladler*, 40 C. D. 649;

or an essential part of the get up (*k*), might have been, but is not, registered under the Acts.

In *Thorneloe* v. *Hill* (*l*), where the plaintiff sued on trade-name, Romer, J., expressed the view that, as the name had been used only as a trade-mark the plaintiff could not sue on it, as it had not been registered; but a distinction seems to have been there made between setting up a pure right of property in a name and seeking protection from passing off by means of the name, and the latter ground of action failed for other reasons.

In *Birmingham Vinegar Co.* v. *Powell* (*m*), Lord Halsbury, after quoting Lord Justice Turner's words in *Burgess* v. *Burgess* (*n*), "that no man can have any right to represent his goods as the goods of another person," stated that that was the only question of law which could arise in such cases; all the rest were questions of fact.

Pinto v. *Badman.*

In the case of *Pinto* v. *Badman* (*o*), the jury found, as a fact, that the defendant had fraudulently sold his cigars as those of the plaintiffs, and also that he had infringed the plaintiffs' trade-mark, and Day, J., gave judgment in the plaintiffs' favour. The Court of Appeal reversed the decision and gave judgment for the defendant, on the ground that the trade-mark on which the plaintiffs relied had been assigned to them without the goodwill of the business in the goods to which it belonged. The question whether the plaintiffs were not, notwithstanding, entitled to retain their judgment on the ground of the finding of the jury, first stated above, does not seem to have been argued, and the plaintiffs' case appears to have been substantially based upon their assumed trade-mark right. The decision, therefore, cannot be regarded as conflicting with the proposition that passing off cases lie outside the Acts.

The operation of sect. 77.

The cases cited above have considerably limited the operation of the prohibition contained in sect. 77. Trade-mark rights, as was shown in the introductory chapter of this

6 R. P. C. 136 (1888), Kekewich, J.; *Hart* v. *Colley*, 44 C. D. 193; 7 R. P. C. 93 (1890), North, J.

(*k*) *Great Tower Street Tea Co.* v. *Langford*, 5 R. P. C. 66 (1887), Stirling, J.

(*l*) 11 R. P. C. 61 (1894).

(*m*) See note (*i*).

(*n*) 3 De G. M. & G. 204 (1853).

(*o*) 8 R. P. C. 181 (1891), C. A.

book (*p*), grew out of the right of a trader to prevent and to obtain compensation for deceptions practised upon the public, which caused, or were likely to cause, damage to him as an individual; and long after property in a trade-mark had been practically recognized by the judgment of Lord Cottenham in *Millington* v. *Fox* (*q*), Lord Westbury held that imposition on the public was the test of the property in a trade-mark having been invaded or injured, although it was not the ground on which the Court rested its jurisdiction (*r*).

The Registration Acts have altered the old law to this extent that, after five years' registration, they give the registered proprietor of a mark, so long as he remains registered, the exclusive right to the use of the mark on the goods for which it is registered, so that if it, or an essential part of it, is appropriated by another trader the proprietor can interfere to restrain the appropriation (*s*). But where the complaint is not the appropriation but the colourable imitation of his mark, the test to be applied is still—Is the defendant's mark, by its resemblance to the registered mark, calculated to pass off his goods as the goods of the plaintiff (*s*)?

The alteration is not, however, of substantial importance, for it was settled law, apart from the Acts, that if a trader has taken a substantial part of the trade-mark of another, the onus of showing that he is not using it in a manner calculated to deceive is cast upon him (*t*), and this onus he could hardly discharge if the mark had, in fact, become identified by use with the other trader. So that the change is, in effect, no more than the natural consequence of treating

(*p*) Page 1.

(*q*) 3 My. & Cr. 338 (1838): Chap. I. p. 4.

(*r*) *Hall* v. *Barrows*, *Leather Cloth Co.* v. *American Leather Cloth Co.*, cited below, p. 373; and see Lord Blackburn's judgment in *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Ca. at p. 494 (1879).

(*s*) Sect. 76; see per Cotton, L. J., in *Mitchell* v. *Henry*, 15 C. D. at p. 193 (1880); in *Edwards* v. *Dennis*, 30 C. D. at p. 471 (1885); and in *Lyndon's Tm.*, 32 C. D. at p. 117 (1886); and Chap. XV. p. 373.

(*t*) *Orr-Ewing* v. *Johnston*, 13 C. D. 434, C. A.; 7 App. Ca. 219 (1882). This case was begun in 1877, before sect. 1 of the Act of 1876 came into operation; it was therefore decided under the old law; see 7 App. Ca. p. 228.

registration as equivalent to public use of the registered mark (*u*).

Proof of fraud is not necessary to escape the prohibition.

In most of the cases where the Court has interfered to prevent the passing off of the defendant's goods as those of the plaintiff, the deception has been found to have been deliberately practised; but fraud is not necessary to enable the Court to act (*x*); accordingly, the presence of fraud does not constitute a material distinction between cases where actions in respect of the unlawful imitations of trade-marks do or do not fall within the prohibition of sect. 77.

Failure to register only deprives the proprietor of the advantages of the Acts.

It can rarely happen, therefore, that the prohibition of sect. 77 will prevent the owner of an unregistered mark, which has, in fact, become known to the public, or to a considerable although indefinite number of purchasers, as indicating that the goods upon which it appears are his goods, from protecting it against infringement, for the adoption of the mark, or of a substantial part, or a colourable imitation of it, can hardly fail to be calculated to pass off the goods of others as those of the owner; but the want of registration will cast upon the plaintiff in any action the necessity of proving that goods bearing the mark are known as his, and that goods bearing the mark complained of are likely, by reason of the resemblance between the marks, to be mistaken for his. And where an injunction is granted to restrain the use of a mark calculated to pass off the defendant's goods as those of the plaintiff, by reason of its resemblance to his unregistered mark, it should be so limited as to leave it open for the defendant to use any part, or the whole, of the plaintiff's unregistered mark, if he can do so, in any manner which is not calculated to lead to deception (*y*).

***Goodfellow* v. *Prince*.**

The case of *Goodfellow* v. *Prince* (*z*), which is the only

(*u*) Sect. 75.

(*x*) Chap. I. p. 4, and *Chivers & Sons* v. *S. Chivers & Co., Ld.*, 17 R. P. C. 420, (1900), Farwell, J. See Chap. XVI. p. 451.

(*y*) See the judgments in *Montgomery* v. *Thompson*, (1891) A. C. 217; 8 R. P. C. 361; *Reddaway* v. *Banham*, (1896) A. C. 199; 13 R. P. C. 218; and *Powell* v. *Birmingham Vinegar Co., Ld.*, 11 R. P. C. at p. 572; 12 R. P. C. at p. 517.

(*z*) 35 C. D. 9 (1887), C. A.

reported case (*a*) in which sect. 77 has proved fatal to a plaintiff where he sought relief on the ground of passing off, as well as in respect of an infringement of his trade-mark, turned upon the view taken by the Court of Appeal that, as both plaintiff and defendant were importers, not producers, of the goods in question, the mark complained of was not calculated to suggest that the goods sold by the defendant were those of the plaintiff, but only that they were those of the producer from whom he bought.

Unregistered trade-marks and the Merchandise Marks Act, 1887.

Failure to register a trade-mark, whether it be occasioned by the incapability of registration of the mark, having regard to the definition clauses, or be due to any other reason, is material on other grounds than those depending upon sect. 77, for the definition of a trade-mark contained in the Merchandise Marks Act, 1887, is, as regards Great Britain and Ireland, restricted to trade-marks registered under the Act of 1883, and an unregistered mark is consequently deprived of the very valuable protection, under the criminal law, constituted by the penalties and punishments provided by the former statute for forging trade-marks, falsely applying trade-marks to goods, or selling, exposing, or having in possession for sale, or for any purpose of trade or manufacture, any goods or things to which a forged trade-mark is applied. The provisions of the statute as to applying a false trade description do, however, extend to unregistered trade-marks (*b*).

(*a*) But see *Thorneloe* v. *Hill*, *supra*, p. 320.

(*b*) Sect. 3 (2); see Book II., Chap. I. p. 589.

CHAPTER XIII.

ASSIGNMENT AND DEVOLUTION OF TRADE-MARKS.

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A trade-mark is assignable only with the goodwill.

TITLE to a trade-mark cannot be assigned or devolve in gross; but, unless the mark connotes a personal connection between its original owner and the goods in connection with which it is used, it may be assigned and transmitted, together with the goodwill of the business in such goods.

This proposition was fully established before the first Registration Act was passed, and, as regards registered trade-marks, it was, in part, embodied in that Act. The section in question, sect. 2, so far as it related to assign-

ment and transmission, was identical in terms with the corresponding section of the present Act here set out.

By sect. 70—

Sect. 70.

"A trade-mark, when registered, shall be assigned and transmitted only in connection with the goodwill of the business concerned in the particular goods or classes of goods for which it has been registered, and shall be determinable with that goodwill" (*a*).

Until it was established that there could be property in a trade-mark, there could, of course, be no question of the assignment of trade-mark rights (*b*), although the successors of the original founders of a business no doubt took over and continued to use the old trade-marks employed in it, and were protected when other traders sought to pass off their goods as the goods of the lawful users of the marks (*c*). But as soon as trade-marks were recognized as the subjects of property, the alienation of them, as of any other property rights, was permitted, subject only to such limitations as were necessary to prevent the use of the marks becoming deceptive.

Transfer by implication with goodwill.

And, conversely, it was held that the sale and transfer of the goodwill of a business assigned the trade-marks used in the business to the purchaser and transferee by implication, and without any express grant being needed (*d*); but it is a question of intention, to be gathered from the assignment as a whole, whether the trade-marks do or do not pass, and an intention not to assign them may appear notwithstanding the use of the word "goodwill" in the assignment (*e*).

Hall v. *Barrows*.

The leading cases on the subject are, *Hall* v. *Barrows* (*f*), and *The Leather Cloth Co.* v. *The American Leather Cloth*

(*a*) As to the last clause of the section, "and shall be determinable with that goodwill," see the next chapter.

(*b*) See per Fry, L. J., in *Pinto* v. *Badman*, 8 R. P. C. at p. 194 (1891).

(*c*) See, for instance, *Webster* v. *Webster*, 3 Swan. 490 (1791), Thurlow, L. C.; and *Motley* v. *Downman*, 3 My. & Cr. 1; 6 L. J. Ch. N. S. 308 (1837), Cottenham, L. C.

(*d*) *Shipright* v. *Clements*, 19 W. R. 599 (1871), Malins, V.-C.

(*e*) *Roger's Tm.*, 12 R. P. C. 149 (1895), North, J.

(*f*) 32 L. J. Ch. 548; 33 L. J. Ch. 204; 4 De G. J. & S. 150, Romilly, M. R., and Westbury, L. C.

Co. (*g*). They were decided at the same time, in 1863, by Lord Westbury, and his judgment in the latter case was affirmed by the House of Lords; in the first case, the question at issue was whether, in determining the sum to be paid by the surviving partner of a firm who took over the partnership assets at a valuation under the articles of partnership, the value of the trade-mark used in the business ought to be taken into account, and the Lord Chancellor, reversing the decision of Romilly, M. R., held that it ought to be so taken, the valuation being made, however, on the footing that the surviving partner was entitled to carry on a similar business and to use the trade-mark in it without payment (*h*). The trade-mark consisted of the letters B. B. H. (the initials of the partners composing the original firm), surmounted by a crown, and the Master of the Rolls had held that it could not be sold, because it designated the firm which manufactured the particular goods. "It would," he said, "obviously be a fraud on the public if the Court of Chancery were to attempt to sell to another person the right of holding out to the public that the goods manufactured by him were, in fact, goods manufactured by another and distinct firm." And he distinguished the mark in question from marks indicating the manufacture of a particular factory, which might rightly be transferred with the factory. Lord Westbury dissented from the view that the trade-mark was a personal mark. "It must be borne in mind," he said, "that a name, although originally the name of the first maker, may in time become a mere trade-mark or sign of quality, and cease to denote or be current as indicating that any particular person is the maker." And he held, as a fact, that the connection represented by the mark was a connection with the business and the factory at which it was carried on, not a connection with the persons who were the owners of these, and that, accordingly, the

Trade-mark comprising the name of the original proprietor.

Lord Westbury's judgment.

(*g*) 1 H. & M. 271; 32 L. J. Ch. 721; 4 De G. J. & S. 137; 33 L. J. Ch. 199; 11 H. L. C. 523; 35 L. J. Ch. 53, Wood, V.-C., Westbury, L. C., and H. L. See also *Bury* v. *Bedford*, 32 L. J. Ch. 741; 4 De G. J. & S. 352; 33 L. J. Ch. 465 (1863), Romilly, M. R., and L. JJ.

(*h*) As to this, see also the cases discussed in Chap. XVI. below, pp. 496 *et seq.*

trade-mark belonged to the partnership as part of its property, and might be sold with the business and works.

The Leather Cloth Case.

In *The Leather Cloth Case* (*i*), the plaintiffs sued the defendants for an alleged infringement of their trade-mark, and Lord Westbury, reversing the decision of Wood, V.-C., dismissed the suit on the ground that the trade-mark of the plaintiffs contained material misrepresentations. The plaintiffs had purchased the marks from an American company—the Crockett International Leather Cloth Co.,—who were the successors of Crocketts & Co., and the marks contained the names both of the company and of the firm, as well as an American address which was not the address of the plaintiffs. The presence of the names and address amounted, in Lord Westbury's opinion, to a representation that the goods on which the mark was used were the goods of the original firm or of the American company, and the marks, therefore, could not be properly used by the plaintiffs, and consequently could not be validly assigned to them. And this judgment was fully indorsed by the House of Lords, although Lord Cranworth and Lord Kingsdown, on the appeal, based their judgments chiefly on the ground that there was in fact no infringement, and Lord Westbury placed his upon wider grounds than those he had adopted on the appeal from the Vice-Chancellor, namely, that the alleged trade-marks were in fact only advertisements and not trade-marks at all.

The mark is unassignable if deceptive when used by an assignee.

Lord Kingsdown's judgment in *The Leather Cloth Case.*

The following passage from Lord Kingsdown's judgment in the House of Lords (*j*) shows the principle upon which the assignment of trade-marks and trade-names, as well as the limitations restricting such assignment, are based:—"By the usage of trade, the name of a firm is understood not to be confined to those who first adopted it, but to extend to and include persons who had afterwards been introduced as partners, or persons to whom the original partners have transferred their business. The name of a firm continues to be used in many cases long after all the original traders have died, or have ceased to have any interest in the concern—as in the great banking houses of Child and Coutts, and many

(*i*) Note (*g*). The case is further stated at p. 50, above.

(*j*) 35 L. J. Ch. p. 64; 11 H. L. C. 523.

other mercantile houses. If a manufacturing company uses the name of the firm, and stamps the name of its firm upon its goods, though the name of the firm no longer represents the same persons as at first, it is no fraud upon the public for the reasons I have already mentioned. For the same reason, the use of the old trade-mark of the firm by the new partners or their successors (if the term 'trade-mark' be understood in what I have already said is its proper sense (*k*)) is no fraud upon the public; it is only a statement that the goods are the goods of the firm whose trade-mark they bear." And Lord Cranworth said: "The right to a trade-mark may, in general, treating it as property or as an accessory to property, be sold or transferred upon a sale and transfer of the manufactory of the goods on which the mark has been used to be affixed, and may be lawfully used by the purchaser" (*l*).

The mark used by the assignee must indicate what it indicated when used by the assignor.

In the recent case of *Pinto* v. *Badman* (*m*), Fry, L. J., stated the rule governing the assignment of a trade-mark in concise and definite terms: "It may be assigned," he said, "if it is indicative of origin, when the origin is assigned with it. It cannot be assigned when it is divorced from its place of origin, or when, in the hands of the transferee, it would indicate something different to what it indicated in the hands of the transferor."

A mark comprising the trader's name is assignable.

And as the judgments quoted above show, a trade-mark is not deceptive in the hands of an assignee of the business of the original proprietor and consequently unassignable, merely because it comprises the name or initials of the original proprietor, or of any of the former owners of the business (*n*). But in special cases, as for instance where the reputation of goods depends on the personal skill of an artist or artizan, the use of his name or mark by a successor might be a misrepresentation, and in such a case the name or mark is not properly assignable (*o*).

(*k*) *I.e.*, a symbol or emblem, come by use to be recognized in the trade as the mark of the goods of a particular person (above, p. 24).

(*l*) 35 L. J. Ch. p. 61.

(*m*) 8 R. P. C. 181 (1891), C. A.

(*n*) *Hall* v. *Barrows*; *Bury* v. *Bedford*, above, p. 326. See also *Hudson* v. *Osborne*, 39 L. J. Ch. 79 (1869), James, V.-C.

(*o*) Per Lord Kingsdown in *Leather Cloth Co.* v. *American Leather Cloth Co.*, *ubi supra*, and per Romer, J., in *Thorneloe* v. *Hill*, 11 R. P. C. at

So, the right to use a trade-mark for a sauce cannot be sold without the business in the sauce, or the secret of its manufacture (*p*), or the right to the use of a brand for cigars, without the factory and business of the manufacturer who first acquired it (*q*); and where a mark contains a special indication of the locality of the origin of the goods, it could not be properly assigned so as (using Lord Justice Fry's expression) to be divorced from such place of origin (*r*).

There must be a business to assign in the United Kingdom.

As already stated, an assignment of a trade-mark is inoperative if the assignor has no goodwill to assign (*s*). And the goodwill must be that of a business in the United Kingdom (*t*). The question whether an assignor has a goodwill of a business in the particular goods to assign may, of course, give rise to difficult questions of fact; but the words of the section as to goodwill are not to be construed narrowly (*u*). Thus, where a mark was registered for anti-friction metal bearings, but the registered proprietors, who were an American company, had never sold such bearings in the United Kingdom, but they had imported specimens and also ingots of the anti-friction metal, with the mark on them, for making bearings, such ingots being purchased by an English firm; and the American company had a special agreement with the English firm, under which, as the Court held, the latter were in some respects, and particularly as to trade-marks, agents of the company, and the goodwill was to revert on the determination of the agreement to the company; it was held that the

p. 70 (1894). See also the judgment of Lord Westbury in *Leather Cloth Co.* v. *American Leather Cloth Co.*, 4 De G. J. & S. 137; 33 L. J. Ch. 199, as to marks becoming deceptive on assignment.

(*p*) *Cotton* v. *Gillard*, 44 L. J. Ch. 90 (1874), Jessel, M. R.

(*q*) *Pinto* v. *Badman*, 8 R. P. C. 181 (1891), C. A.

(*r*) See judgment of Lord Westbury referred to in note (*g*), *supra*, and judgment of Fry, L. J., quoted on p. 328, and *Mason* v. *Queen*, 23 So. L. R. 641 (1886).

(*s*) *Harness' Tm.*, 17 R. P. C. 40 (1900), Farwell, J., is an example of an assignment being held inoperative on this ground. Cf. *Linotype Co., Ld.'s Application* (No. 2), 17 R. P. C. 380.

(*t*) See *Magnolia Metal Co.'s Tms.* below, note (*u*), where the point is assumed both by Kekewich, J., and C. A.

(*u*) Per Rigby, L. J., in *Magnolia Metal Co.'s Tms.*, (1897) 2 Ch. 371; 14 R. P. C. 621.

company had a business concerned with metal bearings sufficient to support an assignment by them of the trade-mark and goodwill (*v*). "The main object," Rigby, L. J., said, "of the restrictions upon assignments imposed by the Act was to prevent confusion or deception by suggesting that the articles to which the mark is applied continue to have some connection or other with the original registered owner."

Sale of trade-marks with the goodwill or part of the business.

Trade-marks used in a part of a business may be sold with the goodwill of that part only, and if the goodwill sold is restricted to some only of the goods in which the vendor dealt, the purchaser will only obtain the right to use the trade-marks assigned to him upon the goods in question, even though they be registered for other goods. Thus a mark was registered for "unwrought and partly wrought metals used in manufacture," and the proprietors assigned it together with their goodwill "in the trade or business of galvanized iron merchants and manufacturers"; but the business, in fact, being entirely confined to sheet iron, the assignor's rights were held to be restricted to that description of goods only (*x*).

Transfer of goodwill and trade-mark not necessarily contemporaneous.

It is not essential that the assignments of the trade-mark and the transfer of the goodwill should be exactly contemporaneous (*y*), or even that there should be any legal conveyance of the latter, if the assignee is equitably entitled to it. An assignment to the owner of the business in connection with which the trade-mark is used or intended to be used has, consequently, been permitted in some cases where the mark has been registered by mistake or accident in the name of a person other than that owner (*z*).

(*v*) *Magnolia Metal Co.'s Tms.*, above, note (*u*), Lindley, Lopes, and Rigby, L. JJ., reversing Kekewich, J., on this point. See also *European Blair Camera Co.'s Tm.*, 13 R. P. C. 600, where Stirling, J., held that there was user of the word *Ball's-eye* by a foreign importer in connection with cameras in this country, he having imported the cameras in cases which had the word on them, and having sent therewith to the consignee pamphlets containing the word. See above, p. 192.

(*x*) *Edwards* v. *Dennis*, 30 C. D. 454 (1885), C. A.

(*y*) *Welcome's Tm.*, 32 C. D. 213; 3 R. P. C. 76 (1886), Chitty, J.; *Hammond* v. *Malcolm, Brunker & Co.*, 9 R. P. C. 301 (1892), Chitty, J.

(*z*) See Chap. XI. p. 283; *Greenlees' Tm.*, 9 R. P. C. 93 (1892),

Trade-marks on bankruptcy and dissolution of partnership.

Upon the dissolution of a partnership, in the absence of special agreement (*a*), the trade-marks of the firm are part of its assets, and are saleable as such with the goodwill (*b*); but it seems that each of the partners is at liberty to make use of the trade-name of the firm, and of its trade-marks, provided he can and does do so in such a way as to avoid deceiving the public, or casting any risk or liability upon his late partners (*c*). Similarly, upon the death or bankruptcy (*d*) of a trader, his trade-marks may be sold with the goodwill of his business by his executors or trustees.

The Register of trade-marks comprises notifications of assignments, and of transmissions of trade-marks (*e*), and it is provided by sect. 87 that:—

Sect. 87. Registration of assignments.

"Where a person becomes entitled by assignment, transmission, or other operation of law (to a patent, or to the copyright in a registered design, or) to a registered trade-mark, the Comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of (the patent, copyright in the design, or) trade-mark, in the Register of (patents, designs, or) trade-marks (as the case may be). The person for the time being entered in the Register of (patents, designs, or) trade-marks as proprietor of a (patent, copyright in a design, or) trade-mark (as the case may be) shall, subject to [the pro-

Stirling, J.; *Leahy* v. *Glover*, 10 R. P. C. 141 (1893), H. L.; and see last note.

(*a*) For instances of this, see *Bury* v. *Bedford*, 32 L. J. Ch. 741; 4 De G. J. & S. 352; 33 L. J. Ch. 465; and *Hanson* v. *Game, Harrison and Larner, Ld.*, 9 R. P. C. 186 (1892). This topic is fully discussed below, Chap. XVI. p. 496.

(*b*) *Hall* v. *Barrows*, above, p. 326.

(*c*) See the last case, and *Hookham* v. *Pottage*, L. R. 8 Ch. 91 (1872), C. A.; *Thynne* v. *Shove*, 45 C. D. 577 (1890), Stirling, J.; and *Burchell* v. *Wilde*, (1900) 1 Ch. 551, Byrne, J., and C. A. Where a business is conducted at two places and the goodwill at each is sold separately without special stipulations, the purchasers might have concurrent rights to the use of the trade-name. In *Townsend* v. *Jarman*, 17 R. P. C. 649 (1900), Farwell, J., it was contended that such was the case, but in the particular case the defendant failed to establish a concurrent right with the plaintiff.

(*d*) *Hammond* v. *Malcolm, Brunker & Co.*, 9 R. P. C. 301 (1892), Chitty, J.

(*e*) Sect. 78.

visions of this Act, and to] (*f*) any rights appearing from such Register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with the same, and to give effectual receipts for any consideration for such assignment, licence, or dealing. Provided that any equities, in respect of such (patent, design, or) trade-mark may be enforced in like manner as in respect of any other personal property."

No notice of any trust is to be entered on the Register, or to be receivable by the Comptroller (*g*).

The proviso keeps all equities open, so that they may be enforced in like manner as in respect of any other personal property (*h*). Therefore in a patent case licensees who took their licence with notice of an agreement for assignment by the licensors and registered the licence were held not to have obtained a valid licence against the assignees, although the actual assignment was made subsequently to the licence, and no notification of the agreement was entered on the Register at the date of the licence (*h*).

Procedure.

The procedure by which the registration of assignments and transmissions of title to trade-marks is governed, is laid down in the following Rules (*i*).

Request by subsequent proprietor.

"**36.** Where a person becomes entitled to a registered trade-mark by assignment, transmission, or other operation of law, a request (*k*) for the entry of his name in the Register as proprietor of the trade-mark shall be addressed to the Comptroller, and left at the Patent Office, Trade-Marks Branch.

Signature of request.

"**37.** Such request shall in the case of an individual be made and signed by the person requiring to be registered as proprietor, and in the case of a firm or partnership by some one or more members of such firm or partnership, or in either case by his or their agent

(*f*) Act of 1888, s. 21, see below, p. 323.

(*g*) Sect. 85, Chap. III. p. 58.

(*h*) *New Ixion Tyre and Cycle Co., Ld.* v. *Spilsbury*, (1898) 2 Ch. 137, 484; 15 R. P. C. 380, 567, Kekewich, J., and C. A.

(*i*) The old Rules were 23 to 29 of the former code. The more important provisions of these have been incorporated in the Act.

(*k*) Form K. Appendix, p. 708.

respectively duly authorized to the satisfaction of the Comptroller, and in the case of a body corporate by their agent, authorized in like manner.

Contents of request.

"**38.** Every such request shall state the name, address, and description of the person claiming to be entitled to the trade-mark (hereinafter called the claimant), and the particulars of assignment, transmission, or other operation of law, by virtue of which he requires to be entered in the Register as proprietor, so as to show the manner in which, and the person or persons to whom, the trade-mark has been assigned or transmitted, and so as to show further that it has been so assigned or transmitted in connection with the goodwill of the business concerned in the particular goods or classes of goods for which the trade-mark has been registered.

Declaration to accompany request.

"**39.** Every such request shall be accompanied by a statutory declaration (*l*) to be thereunder written, verifying the several statements therein, and declaring that the particulars above described comprise every material fact and document affecting the proprietorship of the trade-mark as claimed by such request.

Further proof of title if required.

"**40.** The claimant shall furnish to the Comptroller such other proof of title and of the existence and ownership of such goodwill as aforesaid as he may require for his satisfaction."

"Subject to the provisions of this Act."

The amendment "subject to the provisions of this Act" in sect. 87 means, subject to the rule of sect. 70, that a trade-mark shall not be assigned or transmitted without the goodwill of the business in the goods for which it has been registered (*m*).

Refusal to register an assignment.

If the Comptroller refuses to enter an assignment upon the Register, the assignee can apply to the Court under sect. 78, and also under sect. 90, as a person aggrieved by the omission of his name without sufficient cause from the Register, for an order directing the registration. He must in any such case satisfy the Court that the goodwill of the

(*l*) See Rule 61, Appendix, p. 702. And as to the Comptroller's power to dispense with evidence, Rule 53, p. 701.

(*m*) Cf. sect. 76 above, p. 306.

business has been transferred to him (*n*), and that he is otherwise entitled to use the mark. Where a company which is the registered proprietor of a trade-mark changes its name, the Comptroller has power to enter the new name on the Register, and on his failing to do so the Court would have power to rectify the Register under sect. 90 (*o*).

Alteration of name of company.

Action before registration.

Registration of the assignment is not, as registration of the mark itself is, a condition precedent to any action for infringement by the assignee (*p*).

Alteration of registered mark in consequence of assignment.

In some cases the assignment of a trade-mark to new proprietors makes an alteration in its form necessary or advisable. In the case of registered marks, such alteration may be allowed by leave of the Court obtained under sect. 92, provided that the mark is not altered in an essential particular (*q*). Thus in *Guinness & Co.'s Trade-Mark* (*r*), Chitty, J., allowed the word *limited* to be added to the name upon an old mark, the business and trade-marks of the old firm having been taken over by a company bearing the name of the firm with "limited" added to it, and in other cases the same alteration has been allowed in new marks (*s*). But in the case of an old mark the Court is very unwilling to allow any alteration to be made, although it has jurisdiction to do so if special circumstances render it necessary, for a mark registered as an old mark ought to be kept on the Register as it was actually used before the 13th of August, 1875. So, in *Re Henry Clay, and Bock & Co.* (*t*), Kekewich, J., refused to allow an old mark to be altered by substituting, for the initials of one predecessor of the proprietors, the name of another and later predecessor, notwithstanding that the mark in its altered form had been registered

(*n*) *Bancroft's Tm.*, 5 R. P. C. 209 (1888), Stirling, J.

(*o*) *New Ormonde Cycle Co.'s Tm.*, (1896) 2 Ch. 520; 13 R. P. C. 475, North, J.; and see Chap. XI., p. 284.

(*p*) *Ihlee* v. *Henshaw*, 31 C. D. 323; 3 R. P. C. 15 (1884), North, J.; *Richards* v. *Butcher*, 7 R. P. C. 288 (1890), Kay, J. See, however, *Magnolia Metal Co.* v. *Atlas Metal Co.*, 14 R. P. C. 389, and above, p. 317.

(*q*) *Murphy's Tm.*, 7 R. P. C. 163 (1890), W. N. 84.

(*r*) 5 R. P. C. 316 (1888).

(*s*) See Chap. XI. p. 299.

(*t*) (1892) 3 Ch. 549; 9 R. P. C. 449.

for some years in Havanah, and had been extensively used by the applicants in England (*u*).

Licence to use a trade-mark.

The part of sect. 87 which relates to licences would seem to apply, not to trade-marks, but exclusively to patents and to copyright in designs, with which the section also deals, for a licence to use a trade-mark would be either unnecessary or illegal: unnecessary if the mark were to be put upon the goods made or dealt in in the business to the goodwill of which the trade-mark was attached, since any person may lawfully attach a trade-mark to the goods which are in fact the goods it indicates (*x*); illegal if it were to be put upon any other goods (*y*). This was the view of Lord Herschell's Committee, and they advised that the part of the section relating to trade-marks should be separated from the rest. The passage in their report is as follows. After quoting sects. 70 and 87, they say (*z*): "It has been suggested that this (sect. 87) gives power to assign, or at all events to grant licences to use, a trade-mark apart from the goodwill of the business concerned in the goods for which it has been registered. Probably the two sections read together may receive a consistent construction; but in order to avoid doubt it would be well to amend sect. 87 by dealing specifically with trade-marks, omitting the words as to granting licences, and providing that assignments are to be subject to the provisions of the Act." But the only amendment made by the Act of 1888 was the interpolation of the words quoted above.

Lease of goodwill and trade-marks.

If the goodwill of a business be leased for a term, the right to use the trade-marks identified with it would during the term pass to the lessee, in the absence of special agreement; and, if it were reserved, on the principles stated above the lessor could not rightly use the marks. It seems that the registration of the lessee as assignee of the marks without the consent of the lessor, would not, however, be rightly

(*u*) See further, Chap. XI. p. 298.

(*x*) See Chap. II. p. 32.

(*y*) *Oldham* v. *James*, 13 Ir. Ch. 393; 14 Ir. Ch. 81 (1862); and see remarks of North, J., in *Roger's Tm.*, 12 R. P. C. at p. 158; and *Thorneloe* v. *Hill*, 11 R. P. C. 61. The principle of sect. 70 would seem to be as applicable to a partial assignment as to an absolute assignment.

(*z*) Report of 1888, p. xiv.

made (*a*). Where a company, that had carried on business at Glasgow and elsewhere, sold its Glasgow businesses, and agreed not to carry on business there during ten years from the assignment, and expressly licensed the assignee to use certain trade-marks during that term, and the assignee applied to register a trade-mark containing a representation of Glasgow Town Hall similar to one that had appeared on labels for whisky bottled at Glasgow by the assignors (the label not being expressly mentioned in the assignment), and the assignors opposed the registration, as they did not admit the applicant's right to the exclusive use of the device, although they did admit his right to use it, the application for registration was refused (*b*).

Although if the whole goodwill of a business is leased, the lessor cannot as a rule use the trade-marks during the lease; yet where a foreigner, who had registered trade-marks for metal bearings, entered into an agreement with persons in this country under which they were during a term of years to purchase the particular alloy for the bearings from him, and were to have the exclusive sale in this country, and the agreement contained clauses under which the goodwill was on the determination of the agreement to revert to the foreigner, it was held that he had sufficient goodwill in bearings during the continuance of the agreement to support an assignment by him of the trade-marks and such goodwill (*c*).

Action by licensee.

The sole authorized dealer in goods bearing a particular trade-mark in the United Kingdom, who is in a sense a licensee of the trade-mark rights, cannot sue for infringement of the trade-mark (*d*). But a true licensee of the rights, if there can lawfully be such a person, could not sue either (*e*).

On an assignment for value of trade-marks and goodwill

(*a*) *Re Avril*, Stirling, J., 20th April, 1888; Sebastian, 4th ed. p. 374, cited above, p. 285.

(*b*) *Roger's Tm.*, 12 R. P. C. 149 (1895), North, J.

(*c*) *Magnolia Metal Co.'s Tms.*, (1897) 2 Ch. 371; 14 R. P. C. 265 and 621; see above, p. 329.

(*d*) *Richards* v. *Butcher*, 7 R. P. C. 288 (1890), Kay, J.

(*e*) *Heap* v. *Hartley*, 42 C. D. 461; 5 R. P. C. 603 (a patent case); *Woolley* v. *Broad*, (1892) 1 Q. B. 806; 9 R. P. C. 208, 429 (a design case).

the *ad valorem* stamp duty applicable to a conveyance or transfer on sale is payable.

Stamp on assignment of goodwill and trade-marks, &c.

In one case it was held that in the case of a foreign trader who had no place of business in the United Kingdom, but had registered a trade-mark here, and had sent goods into this country, the trade-mark and right to use it and the business connection here were property within sect. 59 of the Stamp Act, 1891, and, moreover, were not "property locally situate out of the United Kingdom" within the exception contained in the same section, notwithstanding that they were assigned with freehold premises in America (*f*). But the Court of Appeal has subsequently held that where goodwill and the exclusive right to use a trade-name are assigned with premises entirely situate out of the United Kingdom, the goodwill is *primâ facie* annexed to the premises, and is, in the absence of facts rebutting the *primâ facie* presumption, property locally situate out of the United Kingdom (*g*).

(*f*) *Brooke & Co.* v. *Commissioners of Inland Revenue*, (1896) 2 Q. B. 356, Pollock, B., and Bruce, J.

(*g*) *Muller & Co.'s Margarine, Ld.* v. *Commissioners of Inland Revenue*, (1900) 1 Q. B. 310; distinguishing *Smelting Co. of Australia* v. *Commissioners of Inland Revenue*, (1897) 1 Q. B. 175 (sole licence to work patent).

CHAPTER XIV.

DETERMINATION OF TRADE-MARK RIGHTS.

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Modes of determination.

THE right of the proprietor of a mark (subject to the rights of other proprietors, if any, of the same mark (*a*)) to the exclusive use of it upon the goods of the kind in respect of which the right existed is determined :—

(1) When the mark so used ceases to be distinctive ;

(*a*) See the three mark rule, p. 214, and sect. 87, p. 331.

(2) When the proprietor is no longer able to use it in the business in connection with which the right was acquired;
(3) When he has abandoned it; and
(4) When he has forfeited his claim to protection of his right by using the mark deceptively or in a fraudulent trade (*b*).

The proprietor may, in general, use the mark after his exclusive rights have determined.

In the first case the mark can no longer be the subject of trade-mark rights, and anyone may use it; but in the others, if there are any independent proprietors of the mark for the same class of goods, their rights will be unaffected by the determination; and in the third and fourth cases their rights will continue to be qualified by his right to use the mark himself on the goods, so long as he uses it in the business in connection with which it was acquired.

1. Loss of Distinctiveness.

The first case follows immediately from the definition of a trade-mark given in Chapter II. It is there shown that the function of a trade-mark is to distinguish the goods to which it is applied or attached from similar goods, and to identify them with a particular trader and his successors in business. And distinctiveness is an essential condition of capacity for registration under the Acts (*c*). Further, the test of infringement is that the use of the mark, or of a similar mark, by others than the proprietor, is calculated to cause their goods to be bought as his (*d*). So that, apart from the Acts, a mark which has ceased to be distinctive is incapable of being the subject of trade-mark rights, and no action for infringement could be successfully brought to prevent any trader using it, and if not already registered, it would be incapable of registration under the Acts.

The elements of distinctiveness have been considered at How dis-

(*b*) See Chap. XV., "the action for infringement," defences, pp. 397 *et seq.*

(*c*) Chap. VIII. p. 115.

(*d*) *Mitchell* v. *Henry*, 15 C. D. 181 (1880), James, L. J.; *Edwards* v. *Dennis*, 30 C. D. 454 (1885), Cotton, L. J.; see also *Ford* v. *Foster*, 7 C. D. 611, cited below, p. 342.

Distinctiveness may be lost.

length elsewhere (*c*), and it will be sufficient here to refer to some of the modes in which a mark may cease to be distinctive, and to give a few examples of cases in which the question has arisen. Marks are not distinctive if they are descriptive (*f*), and, in particular, if they have been adopted in the trade concerned as the names of the goods for which they are claimed as trade-marks (*g*), or are common marks (*h*), or marks common to the trade (*i*), or if they connect the goods not with their proprietor but with some other trader (*k*).

By the action of the proprietor.

Distinctiveness may be lost through the action of the proprietor, or by reason of successful piracy.

Thus, if the proprietor abandons his mark (*l*), it will almost inevitably become a common mark, unless there are other persons who have trade-mark rights in it which they assert (*m*). So, if he uses it himself as the name of the goods he deals in, the trade will probably adopt the same course, especially if he is for a time the only dealer in the goods (*n*).

Before the Registration Acts a difficult question of fact was often raised in trade-mark cases where admittedly a name or other mark had been introduced by the plaintiff, but it was alleged that it had by repeated use on the goods of other traders lost its original significance indicating a connection with the plaintiff, and had become *publici juris* (*o*). A case of this type recently came before the Privy Council on appeal from New South Wales in *The National Starch Manufacturing Company* v. *Munn's Patent Maizena, &c. Company* (*p*). The

(*c*) Chap. II., p. 34; Chap. VIII., p. 132.

(*f*) See above, descriptive marks, p. 36; devices, p. 145; words, p. 163.

(*g*) Page 36.

(*h*) Page 135; see also the "three mark rule," Chap. IX. p. 205.

(*i*) Page 206.

(*k*) *Wood* v. *Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A. (*Eton Cigarettes*); *Wolff* v. *Nopitsch*, 17 R. P. C. 321 (1900), Cozens-Hardy, J. (*Spanish Graphite*). See, however, in C. A., 18 R. P. C. 27 (1901).

(*l*) See below, p. 346.

(*m*) As, for instance, in *Daniel & Arter* v. *Whitehouse*, (1898) 1 Ch. 685; 15 R. P. C. 134; Barnes, J., a passing-off case, where the defendant lost a concurrent right by non-user for some years.

(*n*) *Linoleum Manufacturing Co.* v. *Nairn*, 7 C. D. 834 (1878), Fry, J.

(*o*) See *Ford* v. *Foster*, 7 Ch. 611 (1872); *Singer Manufacturing Co.* v *Wilson*, 2 C. D. 434; 3 App. Ca. 376 (1875).

(*p*) (1894) A. C. 275; 11 R. P. C. 281.

plaintiffs had invented the word *Maizena* for flour made from maize and had introduced flour under that name to New South Wales in 1863, but they had not registered the word there until 1889. The defendants' predecessors commenced to sell *Maizena* in New South Wales in 1867, and the plaintiffs took no steps against them there until the action, which was founded on the trade-mark and common law rights, but they had taken proceedings successfully in other countries to restrain the use of *Maizena* in connection with the defendants' flour. It was held that, in view of the use in New South Wales by the defendants and other firms of the word in question before 1889, it had become *publici juris*, and the action was dismissed and the mark removed from the Register. The plaintiffs contended that the defendants' user had been originally fraudulent and was continued in fraud, but this was not so found. On this point Lord Ashbourne said: "If during the period in question (*q*), the word was only used in the colony for the fraudulent purpose of counterfeiting their goods, the right of the appellants to register it as their trade-mark would not be impaired. If, on the contrary, it was used and understood before 1889 as a term descriptive of the article, as a product of maize, and did not denote such product to be the manufacture or merchandise of a particular person, then it must be regarded as having become, in the sense of law, *publici juris*." The difficulty is not so likely to arise in the case of a registered mark, since the public advertisement of the registration, and the readiness with which the infringement of a properly registered mark can be prevented under sect. 76, both tend to warn other traders against the use of the mark and to enable the proprietor to protect his rights.

By extensive piracy.

Extensive infringement by a single trader can hardly suffice to make a trade-mark common. "It has been said that one murder makes a villain, and millions a hero; but I think it would hardly do to act on that principle in such matters as this, and to say that the extent of a man's piratical invasion of his neighbour's rights is to convert his piracy

(*q*) 1865 to 1889.

into a lawful trade" (*r*). Nor will a few unprosecuted scattered infringements by several traders (*s*).

The test whether a mark has become *publici juris*.

"There is no doubt, I think," said Mellish, L. J., in *Ford* v. *Foster* (*t*), "that a word which was originally a trade-mark, to the exclusive use of which a particular trader, or his successors in trade, may have been entitled, may subsequently become *publici juris*, as in the case which has been cited of *Harvey's Sauce* (*u*). I think the test must be whether the use of it by other persons is still calculated to deceive the public (*x*), whether it may still have the effect of inducing the public to buy goods not made by the original owner of the trade-mark as if they were his goods. If the mark has come to be so public and in such universal use that nobody can be deceived by it, and can be induced from the use of it to believe that he is buying the goods of the original trader, it appears to me, however hard to some extent it may appear on the trader, yet practically, as the right to a trade-mark is simply a right to prevent the trader from being cheated by other person's goods being sold as his goods through the fraudulent use of his trade-mark, the right to the trade-mark must be gone" (*y*).

A mark may be *publici juris* in a particular branch of the trade only.

Upon the facts of the case, the Lords Justices held that the name in question had become *publici juris* to this extent, "that by the use of it in trade circulars, which are issued only to retail dealers, or by shirts being invoiced by the wholesale dealers as '*Eureka Shirts*,' no retail dealer would be likely to be deceived, or be led to buy shirts which were not made by Ford believing they were Ford's shirts," but that a considerable portion of the public who buy shirts for the purpose of wearing them would still be very liable to be

(*r*) Per James, L. J., in *Ford* v. *Foster*, L. R. 7 Ch. p. 625.

(*s*) *Kinahan* v. *Bolton*, 15 Ir. Ch. 75 (1863), Brady, C.; *Rowland* v. *Michell*, below, note (*a*).

(*t*) L. R. 7 Ch. p. 628 (1872).

(*u*) *Lazenby* v. *White*, 41 L. J. Ch. 354 (1871).

(*x*) So the long duration of fraudulent user is immaterial if it is still calculated to deceive: *Heaton's Tm.*, 27 C. D. 570 (1884), Kay, J. (*Hoop L Iron*); and the judgment of Lord Ashbourne in the *Maizena Case*, quoted above, p. 341.

(*y*) See also *Kuhn & Co.'s Tm.*, 53 L. J. Ch. 238, n.; and *Hyde & Co.'s Tm.*, 7 C. D. 724, both (1878), Jessel, M. R.

deceived by the use of the word *Eureka* on the shirt itself. And the injunction granted by the Court accordingly left the defendants at liberty to advertise the name *Eureka* as between themselves and the trade (*z*).

Where a plaintiff is alleged to have lost his rights by not interfering with infringers, the character and extent of the trade of the latter, as well as their position, must be taken into account in considering whether he is barred by his neglect to take proceedings (*a*).

2. Separation of the Mark from the Goodwill.

It has been shown in the last chapter that the trade-mark rights in a mark are inseparable from the goodwill of the business in the goods upon which the mark is used, for the function of the mark is to connect the goods with the trader who owns the business, and his successors (*b*). The indication of that connection is its original signification, and it cannot legally be used as a trade-mark with any other (*c*). It follows that if the goodwill is lost, or passes into other hands than those of the proprietor of the mark (*d*), the exclusive rights of the proprietor in respect of the use of the mark are determined, and this rule is recognized by the Acts in the case of registered marks. Sect. 2 of the Act of 1875, and sect. 70 of the present Act of 1883, enact that a trade-mark "shall be assigned and transmitted only in connection with the goodwill of the business concerned in the particular goods or classes of goods" for which it has been registered, and the latter section expressly adds "and shall be determinable with such goodwill." And, although an assignment of

Sect. 70.

(*z*) L. R. 7 Ch. p. 634; cf. *Singer, &c. Co.* v. *Spence*, 10 R. P. C. 297 (1893), Romer, J.

(*a*) *Rowland* v. *Michell*, 13 R. P. C. 457; 14 R. P. C. 37 (1897), Romer, J., and C. A.; and see also *Ripley* v. *Bandy*, 14 R. P. C. 591 (1897), Kekewich, J., where judgment was given for the defendant on the ground of the neglect of the plaintiff to assert his right against infringers. An appeal was settled, 14 R. P. C. 944.

(*b*) See the judgment of Mellish, L. J., in *Ford* v. *Foster*, cited above, and Chap. II., p. 23.

(*c*) See the judgment of Fry, L. J., in *Pinto* v. *Badman*, 8 R. P. C. 181 (1891), cited above, p. 328.

(*d*) *Thorneloe* v. *Hill*, 11 R. P. C. 61 (1894); and cf. *Harness' Tm.*, 17 R. P. C. 40 (1900).

a trade-mark be inoperative by reason of being an assignment in gross, the assignor may lose his right to the mark by such assignment, at all events if the assignee has acted upon the assignment. Thus, where an exclusive licence in gross for a term of years to use a trade-name was granted, it was held that the assignor had at the end of the term lost his right to claim that the name indicated his manufacture (*e*).

No exclusive right in a registered mark apart from the goodwill.

No question arises as to whether the registered owner of a trade-mark which has determined by separation from the goodwill of the business can sue for infringement; for sect. 76, which grants the right of exclusive use to the proprietor of a registered mark, makes the grant "subject to the provisions of this Act," and consequently subject to sect. 70.

Removal of mark when the goodwill is determined (*f*).

It was provided by Rule 34 of the Rules of 1876, for which the Rules of 1890 are now substituted, that—"The Court may, on the application of any person aggrieved, remove any trade-mark from the Register on the ground, after the expiration of five years from the date of the registry thereof, that the registered proprietor is not engaged in any business concerned in the goods within the same class as the goods with respect to which a trade-mark is registered." And in *Ralph's Case* (*g*), where the registered proprietor had not manufactured the machine for which the mark was registered for twenty-one months before the date of the application, Pearson, J., in accordance with the rule, directed the mark to be removed.

The rule has not been re-enacted, and there is now no express provision enabling a properly registered mark to be removed except for non-payment of fees after fourteen years (*h*), or at the request of the proprietor (*i*). But a mark is not properly registered, and it may be removed, if it was not registered with a *bonâ fide* intention to use it for the goods in respect of which it is registered (*k*); and the judgment of the Court of Appeal in *Batt's Trade-Mark*

(*e*) *Thorneloe* v. *Hill*, 11 R. P. C. 61 (1894), Romer, J.

(*f*) See below, p. 348.

(*g*) 25 C. D. 194 (1883), cited below, p. 345.

(*h*) Sect. 79.

(*i*) Sect 91.

(*k*) *Batt* v. *Dunnett*, [1899] A. C. 428; 16 R. P. C. 411; and *supra*, pp. 119 *et seq*.

supports the proposition that if at any time after registration the proprietor ceases to have such intention, the mark is on the Register without sufficient cause and may be removed (*l*).

Temporary separation from the goodwill or disuse of mark is immaterial.

A mere temporary cessation of business (*m*), or delay in the transfer of the goodwill (*n*), would not determine the trade-mark rights. The judgment of Pearson, J., in *Ralph's Case* (*o*), notwithstanding the repeal of the Rule on which it was founded, may be useful to indicate what length of cessation of a business determines the goodwill, and therefore also the trade-mark rights attached to it. "The only question I have to determine," he said, "is whether one year and nine months is sufficient cesser on the part of Mr. Ralph to show that he comes within the (44th) rule. I am of opinion that one year and nine months is quite sufficient. If I had any doubt about it, I am able by analogy to say that I should not be wrong in concluding that one year and nine months is sufficient, from the fact that under the Companies Act you may wind up a company if it has ceased to carry on business for a year. The legislature in that has shown by its enactment when a business is supposed to be carried on, and what amount of cesser shows that the business is not being carried on." And it made no difference, he held, that the cessation of business was due to the ill-health of the proprietor.

In a case where the licensees of a patent had, by arrangement with the patentees, registered a trade-mark and used it on the patented goods, and on the determination of the licence the patentees contended that the mark ought to be expunged from the Register on the ground that the goodwill of the licensees had determined, as they could not make the patented goods, the application was dismissed, it being held that the mark in fact indicated the licensees as the source of the goods (*p*).

(*l*) [1898] 2 Ch. 432; 15 R. P. C. 534.

(*m*) See the next page.

(*n*) *Welcome's Tm.*, 32 C. D. 76; 3 R. P. C. 213 (1886); *Hammond* v. *Brunker*, 9 R. P. C. 301 (1892), both Chitty, J.

(*o*) Above, p. 344.

(*p*) *Freeman Bros.* v. *Sharpe Bros. & Co., Ld.*, 16 R. P. C. 205 (1899), North, J.

3. Abandonment.

A trade-mark right, as any other right, can, of course, be abandoned by the owner; but, so long as he remained the registered proprietor of the mark and carried on the business to which the mark was attached, it would be difficult, if not impossible, to show abandonment, unless, either by repeated and undisturbed infringements, or by the use of the mark by the proprietor himself in some way inconsistent with the maintenance of its character as a trade-mark, it had become a common mark so as to fall under the first case (*q*), or a case could be made by any particular defendant sued for infringement by the owner to show that he had been led by the conduct of the plaintiff to believe that the mark was a common mark, and so to set up an estoppel (*r*).

Agreement to abandon trade-mark.

The possible case of an agreement by the proprietor to abandon his mark stands by itself. The other party to the agreement, if sued for infringement, could no doubt rely upon it as a defence, and might possibly, if the mark were registered, obtain the removal of the mark from the Register, or an order, by way of specific performance of an implied term in the agreement, that the proprietor should apply under sect. 91 to cancel the registration.

Not mere disuse.

Mere disuse of the mark does not amount to abandonment of trade-mark rights in respect of it. For "A man who has a trade-mark may properly have regard to the state of the market and the demand for the goods; it would be absurd to suppose that he lost his trade-mark by not putting more goods on the market when it was glutted" (*s*). Accordingly, in the

(*q*) Above, p. 339.

(*r*) See the next chapter: estoppel, p. 390; acquiescence, p. 392; and delay, p. 394. See also *Browne* v. *Freeman*, 12 W. R. 305; 4 New Rep. 476 (1864), Wood, V.-C., where the dismissal at his own request, of a previous suit by the plaintiff against the defendant, to restrain the use by the latter of *Chlorodyne*, was treated as conclusive against him that he had no exclusive right to use the word. He brought a third suit in 1873: W. N. 178.

(*s*) Per Chitty, J., in *Monson* v. *Bochm*, 26 C. D. 398 (1884). But if in the meantime the mark had come to indicate exclusively the manufac-

case cited, a mark was directed to be registered concurrently with a similar mark in the same class which had been previously registered, and which the Court refused to expunge, although the proprietor of the former mark, having adopted it in 1874 and used it largely in the two years following, from 1876 to 1882 had used it less and less, and had in the last-mentioned year forgotten and ceased to use it altogether. He had not, however, broken up the moulds he used for the marked goods, or erased the mark from his books or price lists. But if a proprietor ceases to have an intention of dealing in the goods for which the mark is registered, that would necessarily entail an abandonment of the mark so far as such goods were concerned (*t*).

Adoption of a new mark.

The adoption of a new mark may be evidence of the abandonment of an old one (*u*). But the fact of itself is not conclusive, for it is no justification for the defendant to say, "The plaintiff has two ways of identifying his goods, and I have only stolen one of them" (*x*). So where, in opposition to the registration in 1896 of a mark as an old mark, it was shown that a new label had been adopted in 1877, and it was contended that the old mark had been abandoned either then or previously, but it was proved that a large number of the old labels had been ordered in 1877, and that there had been occasional user of them since, and that the stock of them had never been exhausted, it was held that there had been no abandonment (*y*).

Use in connection with the proprietor's name.

The fact that the owner of a word-mark uses it always in connection with his own name is not conclusive to show that the mark is not a trade-mark, or that he has waived his rights in it as such (*x*).

Neglect to prosecute infringements.

Neglect to proceed in respect of infringements which do not amount to user sufficient to affect the distinctiveness of

ture of the registered owner, its use by another would have been deceptive. Cf. *Daniel & Arter* v. *Whitehouse*, [1898] 1 Ch. 685; 15 R. P. C. 134 (a passing-off case).

(*t*) *Batt's Tm.*, see above, p. 119.

(*u*) *Lea* v. *Miller*, Seb. Dig. p. 305 (1876), Jessel, M. R.

(*x*) Per Wood, V.-C., in *Braham* v. *Bustard*, 1 H. & M. 447; 9 L. T. N. S. 199 (1863) (*Excelsior White Soap*).

(*y*) *Wright, Crossley & Co.'s Application*, [1900] 2 Ch. 218; 17 R. P. C. 386, Byrne, J.

the mark does not affect the proprietor's rights if he is aware of the infringements (*z*), still less if he is not (*a*).

Old corporate mark.

A corporate trade-mark, not re-registered in the Sheffield Register before the 1st of January, 1889, is to be deemed to have been abandoned (*b*).

4. Forfeiture of Right to Protection.

The forfeiture of the right of the proprietor of a trade-mark to have his trade-mark protected by the Court is discussed elsewhere, under the head of defences to an action for infringement (*c*).

5. Removal of Mark from the Register.

Where the trade-mark has determined.

No provision is expressly made in the present Act or Rules for the removal from the Register of marks in which the trade-mark rights have determined, except for non-payment of fees. Rule 34 of the Rules of 1876 has not been renewed (*d*); and the Court is not constituted the custodian of the Register by any part of the Acts, but is expressly empowered by sects. 90 and 92 to make orders affecting it in the cases included under the sections respectively. It is submitted, however, that the Court has jurisdiction, even if sect. 90 does not apply, to order the registration of a mark which is no longer a trade-mark to be expunged, on the ground that the Register is intended by the Acts to be a register of trade-marks only (*e*). In *Welcome's Case* (*f*), Chitty, J., upon an application under sect. 78, directed an assignment to be registered, although that section contains no reference to the Court, or to rectifica-

(*z*) *Kinahan* v. *Bolton*, 15 Ir. Ch. 75 (1863), Brady, C.; *Ford* v. *Foster*, L. R. 7 Ch. 611 (1872), L. JJ.; *Rowland* v. *Michell*, 13 R. P. C. 457; 14 R. P. C. 37 (1897), Romer, J., and C. A.; and see above, p. 313.

(*a*) *Re Farina*, 27 W. R. 456 (1879), Hall, V.-C. See the next chapter, p. 394.

(*b*) Sect. 81 (9).

(*c*) Chap. XV., p. 397.

(*d*) Above, p. 344.

(*e*) See sect. 78.

(*f*) 32 C. D. 213; 3 R. P. C. 76 (1886); and cf. *New Ormonde Cycle Co.'s Tm.*, (1896) 2 Ch. 520; 13 R. P. C. 475.

tion of the Register; but the question of jurisdiction, so far as can be gathered from the report, was not argued. The Court of Appeal has, however, recently expressed the view that the words in sect. 90, "made without sufficient cause," do not refer exclusively to the time of registration, and that if an entry is at any time on the Register without sufficient cause, it may be removed or varied (*g*); and upon this construction of sect. 90 a mark in which the trade-mark rights have determined can, of course, be removed from the Register on the application of any person aggrieved.

It is provided by sect. 79, that:—

For non-payment of fees.

"(1.) At a time not being less than two months nor more than three months before the expiration of fourteen years from the date of the registration of a trade-mark, the Comptroller shall send notice to the registered proprietor that the trade-mark will be removed from the Register unless the proprietor pays to the Comptroller before the expiration of such fourteen years (naming the date at which the same will expire) the prescribed fee; and if such fee be not previously paid, he shall, at the expiration of one month from the date of the giving of the first notice, send a second notice to the same effect.

"(2.) If such fee be not paid before the expiration of such fourteen years, the Comptroller may after the end of three months from the expiration of such fourteen years remove the mark from the Register, and so from time to time at the expiration of every period of fourteen years.

Restoration of the mark.

"(3.) If before the expiration of the said three months the registered proprietor pays the said fee together with the additional prescribed fee, the Comptroller may without removing such trade-mark from the Register accept the said fee as if it had been paid before the expiration of the said fourteen years.

"(4.) Where after the said three months a trade-mark

(*g*) *Batt's Tm.*, [1898] 2 Ch. 432; 14 R. P. C. 534; and see Chap. XI., p. 277. In the view which the Court took of the facts the point did not actually arise for decision.

has been removed from the Register for non-payment of the prescribed fee, the Comptroller may, if satisfied that it is just so to do, restore such trade-mark to the Register, on payment of the prescribed additional fee.

Removed mark an obstacle to later registrations.

"(5.) Where a trade-mark has been removed from the Register for non-payment of the fee, or otherwise, such trade-mark shall nevertheless, for the purpose of any application for registration during *the five years* [one year] (*h*) next after the date of such removal, be deemed to be a trade-mark which is already registered [unless it is shown to the satisfaction of the Comptroller that the non-payment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under the proprietor or under his bankruptcy is using the trade-mark]" (*h*).

The section corresponds to Rules 30 to 33 of the old Rules of 1876.

Sub-sect. (5) refers to sect. 72 (*i*). It is directed to prevent the registration by another trader for the same goods or description of goods, of a mark the same as the removed mark, or having such resemblance to it as to be calculated to deceive, until such time after the removal of the other as is considered sufficient to allow the other to be forgotten, so that the new mark may not be taken for that of the proprietor of the old mark. The period provided for by the Act of 1883 was five years, but this was altered by the Act of 1888 to one year on the recommendation of Lord Herschell's Committee (*k*). With their approval also the proviso "unless, &c." was added at the end of the sub-section, it being considered unnecessary to refuse the re-registration of the mark for a year if the late proprietor were dead or bankrupt, and no one claiming under his bankruptcy were using the mark, and if any other successor to his business neglected to pay the fee.

A new mark may be de-

Notwithstanding the amendments, it is assumed that, so

(*h*) Act of 1888, s. 19.
(*i*) Chap. X., p. 211.
(*k*) Report of 1888, p. xiii.

long as the recollection of the removed mark survives in the trade, the use of it, or a mark resembling it, might be calculated to deceive, and might therefore be properly refused by the Comptroller under sect. 73, or in his discretion.

ceptive by resemblance to a removed mark.

It is provided by Rule 47 that: "Where a trade-mark has been removed from the Register for non-payment of the prescribed fee, or otherwise, under the provisions of sect. 79 of the said Act, the Comptroller shall cause to be entered in the Register a record of such removal and the cause thereof."

Cause of removal to be registered.

The fee for continuance of a registered mark at the expiration of fourteen years is 1*l*. Where the fee is not paid within three months after the expiration of the fourteen years there is an additional fee of ten shillings. The additional fee for restoration of a trade-mark where it has been removed for non-payment of the fee is 1*l*. (*l*). The forms of applications for continuance and restoration are Forms X, Y, and Z (*m*).

Fees.

Forms.

(*l*) Appendix, p. 703.

(*m*) *Ibid.* p. 714.

CHAPTER XV.

THE ACTION FOR INFRINGEMENT.

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IT is convenient to deal separately with actions which are brought to prevent or to recover damages for the infringement

Actions for infringement of trade-mark

and actions for passing off.

of trade-marks, and with what are compendiously described as "passing off actions." In an action of the first class the plaintiff complains that the defendant has infringed his trade-mark by taking it in its entirety, or by taking a substantial portion of it, or by colourably imitating it, and he relies on his title to the exclusive use of the mark in question for goods of a specified kind; in an action of the second class the plaintiff's case is less specialized, for he complains that the defendant is using means which are calculated to pass off, or to cause to be passed off, the goods of the defendant as and for those of the plaintiff, and the means may or may not comprise or consist of an infringement of a trade-mark to which the plaintiff has a title. The distinction between the two classes of actions has been accentuated by the provision, already discussed, which makes registration a condition precedent, in general, to the institution of actions ranking in the first class, that is, trade-mark actions proper (*a*). They are, however, closely connected, and in practice they are frequently combined, the statement of claim alleging both infringement and passing off. The first class is in reality a specialized variety of the second, having been divided off from other passing off actions when property in a trade-mark was first adopted as the ground of jurisdiction (*b*). Moreover, as the test of infringement is still whether, by reason of its resemblance to the plaintiff's mark, the defendant's mark is calculated to lead purchasers to believe that the goods on which it appears are those of the plaintiff, every case of infringement would be a case of passing off but for the fact that where the actual mark is taken, or an obvious imitation is made, the Court does not trouble to inquire whether deception is likely to result, and, in the former case, it seems that it is precluded from doing so by the provision that registration after five years shall give an exclusive title to the use of the registered mark (*c*).

(*a*) Chap. XII., p. 312.

(*b*) Chap. I., pp. 4 and 13.

(*c*) Sect. 76, Chap. XII., p. 306; *Edwards* v. *Dennis*, 30 C. D. 454 (1885), C. A.

1. Commencement of the Action.

In what Court a trade-mark action should be commenced.

The great majority of actions in respect of the infringement of trade-marks are commenced in the Chancery Division of the High Court (*d*), but such actions are not specially assigned to that division, and they have been occasionally transferred from it to the Queen's Bench Division in order to be there tried by jury (*e*). This was done by Kay, J., in a case where the defendant submitted to a perpetual injunction and the question of damages only remained, on the ground that in trade cases a jury is the best tribunal to assess damages (*f*); but in an earlier case, where the right to the injunction was contested, the defendants having given notice requiring the trial to be by a judge and a special jury, Bacon, V.-C., ordered that the action should be by a judge alone (*g*). The last-named judge also refused to order the complicated and difficult case of *The Singer Manufacturing Co.* v. *Loog* (*h*) to be transferred to the Common Law Division so that the issues involved might be there tried with a jury, on the ground that the questions to be determined involved matters of law as well as fact, and were unfit to be dealt with by a jury.

Jury.

Jurisdiction of the County Court.

An action for damages not exceeding *50l.* for infringement of a trade-mark might probably be brought in the County Court, for it is a personal action, and does not fall within any of the exceptions of the County Courts Act, 1888, s. 56. In practice, however, such a course is rarely, if ever, adopted, and it was certainly not contemplated when the Trade-Mark Acts were passed; for the Court upon which jurisdiction is conferred to rectify the Register, to grant certificates to a successful litigant entitling him to solicitor and client costs (*i*) in future actions respecting the

(*d*) Or the Court of Chancery of the County Palatine of Lancaster. This Court has jurisdiction under the Patents, &c. Acts, s. 112a (Act of 1888, s. 26).

(*e*) See *Re Martin, Hunt* v. *Chambers*, 20 C. D. 365 (1882); and Ord. 36, r. 6.

(*f*) *Fennessy* v. *Rabbits*, 56 L. T. 138 (1887).

(*g*) *Spratt's Patent* v. *Ward & Co.*, 11 C. D. 240 (1879).

(*h*) 11 C. D. 656 (1879). In *Fennessy* v. *Clark*, 37 C. D. 184 (1887), the issues of fact were ordered to be tried by a judge and special jury.

(*i*) Sect. 77a (Act of 1888, s. 18).

same mark, and for other purposes, is the High Court (*k*). It has been held that an action for the infringement of a patent, the validity of which is disputed, cannot be brought in the County Court, on the ground that a patent is a franchise within the section 56 above mentioned (*l*); and in the judgments in the case referred to, some stress is laid upon the fact that the Patents, Designs, and Trade-Marks Act of 1883 does not contemplate that patent actions should be brought in a County Court, but this was not, and, it is submitted, could not have been, the ground of decision; for if the jurisdiction to try either patent or trade-mark actions exists in the County Court it is much older than the Act of 1883, and as a trade-mark right is not a franchise, the decision does not affect the jurisdiction to determine trade-mark actions which is apparently conferred by the County Courts Act.

Service out of the jurisdiction.

Service of the writ out of the jurisdiction may be allowed if the case falls under any of the classes enumerated in Order 11, rule 1, for instance, if the plaintiff seeks an injunction to restrain infringements within the jurisdiction (*m*); but if the defendant carries on business in Ireland or Scotland, and not at all, or only to an inconsiderable extent, in England, leave to serve the writ upon him in either of the first-mentioned countries will be refused, and the plaintiff will be left to pursue his remedies in the local courts (*n*). On this ground leave to serve out of the jurisdiction has been refused even where an application to register the defendant's mark was pending before the Comptroller in London on which the same witnesses would be required as in the action (*o*), and also where a motion to expunge the defendant's mark was pending in the English Courts (*p*). In the

(*k*) Sect. 117; or the Palatine Court, sect. 112a.

(*l*) *Queen* v. *County Court Judge of Halifax*, (1891) 2 Q. B. 263; 8 R. P. C. 338, Pollock and Charles, JJ., and C. A.

(*m*) See *Badische Anilin* v. *Johnson*, (1896) 1 Ch. 25; 12 R. P. C. 535, C. A.

(*n*) *Kinahan* v. *Kinahan*, 45 C. D. 78; 8 R. P. C. 18 (1890), Kekewich, J. As to the rectification of the registrations of marks belonging to foreigners, see Chap. XI., p. 288.

(*o*) *Marshall* v. *Marshall*, 38 C. D. 330 (1888), C. A.

(*p*) *Kinahan* v. *Kinahan*, *supra*; cf. *King & Co.'s Tm.*, (1892) 2 Ch. 462; 9 R. P. C. 350.

former case (*q*) the refusal was based partly on the fact that if an injunction were granted it could not be enforced against the defendant personally in England, but only against his agents. But where a Scotch manufacturing company had three branches and an important business in England, leave was granted to sue them here (*r*).

Actions by foreigners.

An alien, not being a subject of a country actually at war with England, if he is the proprietor of a trade-mark which exists as such in this country, may sue in the English Courts in respect of infringements in England (*s*). But sect. 77, prohibiting actions in respect of the infringements of unregistered trade-marks applies to trade-marks belonging to foreigners (*t*).

Notice of action is unnecessary.

No notice need be given to the alleged infringer before the action is brought (*u*), and the plaintiff's right to bring the action is not affected by the ignorance of the defendant of the plaintiff's claim to the mark, or the readiness of the defendant to cease the infringement when called upon to do so (*x*). "A plaintiff in these cases," Chitty, J., said, in *Upmann* v. *Forester* (*y*), "is placed in circumstances of difficulty, because if he were to give notice there is great probability of the defendant at once getting rid of the spurious articles before the plaintiff could interfere; and the plaintiff therefore would in many instances be affording the defendant an opportunity of doing what the injunction would have prevented. I well remember that the late Master of the Rolls, Sir G. Jessel, stated that he was, when at the Bar, accustomed in cases like this to advise his clients not to give any notice, but to move at once" (*z*). And con-

(*q*) *Marshall* v. *Marshall*, 38 C. D. 330 (1888), C. A.

(*r*) *Burland* v. *Broxburn Oil Co.*, 41 C. D. 542; 6 R. P. C. 482 (1889), Chitty, J.

(*s*) *The Collins Co.* v. *Brown*, 3 K. & J. 423 (1857), Wood, V.-C.; *The Collins Co.* v. *Reeves*, 28 L. J. Ch. 56 (1858), Stuart, V.-C.

(*t*) See *Goodfellow* v. *Prince*, 35 C. D. 9 (1886), C. A.; and above, Chap. XII., p. 316; although Malins, V.-C., expressed a contrary opinion in *Twentsche, &c.* v. *Ellinger & Co.*, 26 W. R. 70 (1877).

(*u*) *Pierce* v. *Franks*, 15 L. J. Ch. 122 (1846), Knight-Bruce, V.-C.

(*x*) *Burgess* v. *Hately*, 26 Beav. 249 (1858), Romilly, M. R.

(*y*) 24 C. D. 231 (1883).

(*z*) *Ibid.* The very life of a trade-mark depends upon the promptitude with which it is vindicated. *Johnson* v. *Orr-Ewing*, 7 App. Ca. 219 (1882).

sequently the omission to give notice before action does not disentitle the plaintiff to costs (*a*).

Agents and partners of infringer.

The action is one of tort, and, consequently, every infringer is liable to be sued, whether he acted on his own behalf or as agent for a principal. But a mere servant should not, it seems, be added as a defendant (*b*). An innocent partner of the infringer defendant, who has repudiated the wrongful act of his co-partner, is not, it appears, liable to be sued (*c*).

2. The Plaintiff's Title.

The plaintiff must be owner of the trade-mark (*d*) which is alleged to have been infringed, and the onus of proving that he is entitled to the exclusive use of the mark for the particular class of goods (subject, if the case is so, to the concurrent rights of persons, other than the defendant, who are also owners of the same or a similar trade-mark) lies upon him (*e*). So where three persons, a manufacturer, a shipper and a foreign consignee, devised a trade-mark in concert, and used it for goods sent by the manufacturer through the shipper to the consignee, and afterwards the manufacturer began to use it for goods not sent through the shipper, and the shipper for goods not obtained from the manufacturer, and cross-actions for infringement were brought by the shipper

Joint trade-marks.

(*a*) See below, p. 429.

(*b*) *Daniel and Arter* v. *Whitehouse*, 16 R. P. C. 71 (1899), North, J. (a motion to commit).

(*c*) *Magnolia Metal Co.* v. *Atlas Metal Co.*, 14 R. P. C. 389 (1896), Collins, J., and C. A. A passing-off case in which the innocent partner had repudiated the acts of his co-partners and sought a dissolution, and had, of course, separated in his defence. It was said by Collins, J., and Chitty, L. J., that the passing-off was not within the scope of the authority given by one partner to another, but the same remark would apply to an innocent employer whose manager commits the wrong. Cf. *Grierson, Oldham & Co.* v. *Birmingham Hotel Co.*, 18 R. P. C. 158 (1901), Buckley, J.; and it is submitted that the case must not be considered as an authority for the general proposition that only partners who are aware of the wrongful acts can be sued. As to damages against an infringer who is innocent of fraud, see below, p. 426.

(*d*) The questions, What is a Trade-Mark, and, What can be Registered as a Trade-Mark, are discussed in Chap. II., p. 23; and Chap. VIII., p. 115.

(*e*) *Robinson* v. *Finlay*, 9 C. D. 487, (1877), C. A. As to concurrent rights, see below, p. 360.

and the manufacturer, it was held that neither of them could make out a title to exclusive use, and both actions were dismissed (*f*).

In a case where Messrs. Harper and Moore, the plaintiffs, had been the lessees of certain brickworks, and had been accustomed to make bricks of the clay produced by mines of which they were lessees also, and after the expiration of their leases, the defendants, who had obtained a lease of the brickworks only, advertised themselves as "E. & J. Pearson (late Harper and Moore)," thereby suggesting that they were successors to the old brick-making business, Wood, V.-C., granted an injunction to restrain the advertisements, and he said he would have granted it as a matter of course had the owner of the mines been plaintiff in the suit. The learned Vice-Chancellor seems, therefore, to have been of opinion that both he and the plaintiffs were interested in the old firm name (*g*).

A mere importer has no title to sue for infringement of the trade-marks of the consignor or producer (*h*).

Where the plaintiff is the sole purchaser from the proprietor.

The plaintiff does not become owner of the trade-mark, or acquire any interest in it sufficient to enable him to sue for infringement, by a contract with the proprietor for the exclusive purchase of the marked goods consigned to a particular district (*i*); but it is submitted that if the contract were for the exclusive purchase of all the marked goods manufactured by the proprietor, so that no goods could be rightly marked which did not pass through the plaintiff's hands (subject to any question of registration (*k*)), he might

(*f*) Last case. A custom in Manchester, by which the shipper, in the absence of agreement, was the owner of the trade-mark, was alleged but not proved. *Jones' Tm.*, 53 L. T. 1 (1885), C. A., is a similar case. See also *Rivière's Tm.*, 55 L. J. Ch. 545; 53 L. T. 237 (1884), Pearson, J., cited p. 269.

(*g*) *Harpers* v. *Pearson*, 3 L. T. N.S. 547 (1860); cf. *Motley* v. *Downman*, 3 My. & Cr. 1; 6 L. J. Ch. N.S. 308 (1837), Cottenham, L. C.

(*h*) *Hirsch* v. *Jonas*, 3 C. D. 584 (1876), Jessel, M. R.; see Chap. II., p. 53; Chap. IV., p. 66; and *Goodfellow* v. *Prince*, 35 C. D. 9 (1887), C. A.

(*i*) *Richards* v. *Butcher*, 7 R. P. C. 288 (1890), Kay, J., leave to add the proprietor as plaintiff granted; cf. *Woolley* v. *Broad*, (1892) 1 Q. B. 806, exclusive licensee of registered design; and *Heap* v. *Hartley*, 42 C. D. 461 (1889), exclusive local licensee of a patent cannot sue.

(*k*) *Goodfellow* v. *Prince*, 35 C. D. 9 (1887), C. A.

maintain the action against any person who used the mark, or a spurious mark infringing it, on goods which were not the goods of the manufacturer. The question whether a trader, exclusively entitled by contract with the proprietor to purchase his goods, could rightly register the proprietor's mark as his own, of course with the proprietor's assent, was discussed but left undetermined in *The Apollinaris Case* (*l*).

Action by one proprietor or by several.

One or more of several persons concurrently entitled may bring the action (*m*), and several plaintiffs so entitled may join together to sue although their interests are distinct and separate (*n*). But only a limited number of persons or firms can be concurrently entitled to a mark. If a large number, and, apparently, if more than three, become so entitled, the mark becomes a common mark (*o*).

Plaintiff must use or intend to use the mark.

It would seem that the plaintiff must be using, or intending to use, the mark, for no damage would otherwise be occasioned to him by the infringement. It has been held that a mortgagee who does not intend to use the mark cannot bring an action in respect of its infringement (*p*), and intention to use is one of the conditions precedent to proper registration (*q*).

Action survives to executors, and they may sue.

Infringement of a trade-mark is an interference with a right of property injuring the personal estate of the owner, and consequently the right of action in respect of it is not determined by the death of the owner, and proceedings may be begun or continued (*r*) by his executors. Of course, if the executors have possession of the goodwill of their

(*l*) (1891) 2 Ch. p. 231; 8 R. P. C. 137, Fry, L. J., cited above, p. 276.

(*m*) *Hine* v. *Lart*, 7 L. T. o.s. 41 (1846), Shadwell, V.-C.; *Dent* v. *Turpin*, 2 J. & H. 139; 30 L. J. Ch. 495 (1861), Wood, V.-C.; *Southorn* v. *Reynolds*, 12 L. T. N.S. 75 (1865), Wood, V.-C. As to passing-off actions, see below, p. 463.

(*n*) *Dent* v. *Turpin*, above, and *Universities of Oxford and Cambridge* v. *Gill*, (1899) 1 Ch. 55, Stirling, J.

(*o*) *Ehrmann's Tms.*, (1897) 2 Ch. 495; 14 R. P. C. 695, Stirling, J. The question was as to the rights of the partners on dissolution of a firm. And cf. sect. 74, sub-sect. (3), above, p. 205.

(*p*) *Beazley* v. *Soares*, 22 C. D. 660 (1882), Pearson, J., a trade-name case.

(*q*) *Apollinaris Co.'s Tms.*, (1891) 2 Ch. p. 233; 8 R. P. C. 137; see Chap. VIII., pp. 119 and 120, and *Batt's Tm.*, there cited.

(*r*) *Oakey* v. *Dalton*, 35 C. D. 700; 4 R. P. C. 313 (1887), Chitty, J.

testator's business, and are carrying on his trade, they can themselves be registered, and can sue as owners of the trade-marks employed in the business and attached to the good-will (*s*).

3. Registration.

Proof of registration of the trade-mark.

If the mark is capable of being registered, the plaintiff must, before the commencement of the action, or, at any rate, at the date of the hearing (*t*), be the registered proprietor, and if the mark is not capable of being registered, in the case of a mark in use before the 13th of August, 1875, the plaintiff must show that registration of it has been refused (*u*). In each case the registration and the name of the registered proprietor, or the refusal, may be shown by the certificate of the Comptroller (*x*), or by sealed and certified copies of or extracts from the Register (*y*).

Registration of assignment is unnecessary before action.

But the registration of the successor in title of the original proprietor—his assignee for instance—is not necessary to enable the successor to commence an action (*z*).

Registration as evidence of title.

The registration of a person as proprietor of a trade-mark is *primâ facie* evidence of his right to the exclusive use of his trade-mark, and is (in the absence of an application to rectify the Register (*a*)), after five years from the date of the application for registration (*b*), conclusive evidence of such right (*c*).

So that after five years (*d*), the question whether the mark

(*s*) See Chap. XIII., p. 324; and *Massam* v. *J. W. Thorley's Cattle Food Co.*, 6 C. D. 574; 14 C. D. 748 (1877), Malins, V.-C., and C. A.

(*t*) *Hazzopulo* v. *Kaufmann*, 23 Sol. J. 819 (1879), Little, V.-C.; *Magnolia Metal Co.* v. *Atlas Metal Co.*, 14 R. P. C. 389, at p. 394 (1896), Collins, J. See further, above, Chap. XII. p. 317.

(*u*) Sects. 76 and 77; see Chap. XII., p. 312.

(*x*) Sects. 77 and 84.

(*y*) Sects. 88 and 89.

(*z*) *Ihlee* v. *Henshaw*, 31 C. D. 323 (1886), North, J. See further, above, Chap. XII. p. 317.

(*a*) Chap. XII., p. 309.

(*b*) Sect. 75 (Act of 1888, s. 17).

(*c*) Sect. 76; Chap. XII., p. 306.

(*d*) In *The Apollinaris Co.* v. *Snook*, 7 R. P. C. 474 (1890), although the mark had not been registered for five years, Kekewich, J., at the hearing refused to listen to an argument that it ought not to have been registered; but, apparently, his attention was not called to the point in question. And in *Compagnie Générale* v. *Rehder*, 5 R. P. C. 61, at p. 65 (1887), Kay,

was capable of registration, and therefore the subject of trade-mark rights under the Acts, cannot be raised against the plaintiff (*e*), unless an application to rectify the Register is before the Court. Other objections may, however, be taken; it may be shown, for instance, that the plaintiff does not possess the goodwill of the business to which the mark is attached (*f*).

So, too, it is submitted, the question whether the registered proprietor was entitled to the mark when he caused it to be registered, cannot be raised after five years' registration except upon an application to rectify. The dictum of Fry, L. J., in *The Apollinaris Case*, that "a man who puts another's trade-mark on the Register cannot be a person entitled under the Act" (*g*), was made in a case founded on such an application, and was not, therefore, directed to the operation of sect. 76.

Registration modified by a disclaimer or otherwise.

But the registration is, of course, evidence only of such title as it shows, and the plaintiff's right is, accordingly, subject to the modification imported by any note or limitation entered upon the Register in connection with it. In particular, if there is a disclaimer of part of the registered mark, the registered proprietor has no title to sue in respect of an alleged infringement constituted by the adoption of such part of the mark, for the disclaimer is an indication to all the world that he has no monopoly, by reason of the registration, of the use of that part, at all events by itself (*h*).

J., took a similar course upon an application for an interim injunction. In *Stuart* v. *Scottish Val de Travers Co.*, 13 Ct. of Sess. Ca. 1 (1885); and *Lever* v. *Goodwin*, 4 R. P. C. 492 (1886), Chitty, J., objections to marks registered for less than five years were allowed at the hearing, there being no application to rectify. And in *Free Fishers of Whitstable* v. *Elliot*, below, p. 486 (not reported on this point), Stirling, J., decided that this could be done. Until the question is fairly argued and reported the present practice of moving to rectify in all such cases will probably continue. See also the Scotch case of *Dewar, Ld.* v. *Dewar*, 17 R. P. C. 341, where the Court entertained the objection, even after five years' registration, but this case turned on the question of an inherent jurisdiction in the Scotch Court.

(*e*) *Apollinaris Co.* v. *Herrfeldt*, 4 R. P. C. 478 (1887), C. A.; *Edwards* v. *Dennis*, 30 C. D. 454 (1885), C. A.

(*f*) *Pinto* v. *Badman*, 8 R. P. C. 181 (1891), C. A.

(*g*) (1891) 2 Ch. 186; 8 R. P. C. 137. The importers had registered the mark of the owners of the spring.

(*h*) *Rosenthal* v. *Reynolds*, (1892) 2 Ch. 301; 9 R. P. C. 189, North, J.;

And the right to exclusive use, of which registration is evidence, is subject to the concurrent and independent rights, if any exist, of other persons to use the mark upon obtaining registration (*i*). By concurrent rights.

The five years' registration does not, it is submitted, prevent the defendant, although he has made no application to rectify, or although the Court has no jurisdiction to entertain any such application which he has made, from setting up as a defence that the plaintiff's right has determined by abandonment or otherwise, or has been wholly assigned to another (*k*). And it is, of course, no answer to a personal bar which disentitles the plaintiff to sue. Plaintiff's title determined or barred.

4. What constitutes Infringement.

Infringement is the use by the defendant, for trading purposes (*l*) in connection with goods of the kind for which the plaintiff's right to exclusive use exists (*m*) (*i.e.*, goods for which his mark is registered and used), not being the goods of the plaintiff (*n*), of a mark identical with (*o*) the plaintiff's mark, or comprising some of its essential features, or colourably resembling it (*p*), so as to be calculated to cause the goods to be taken by ordinary purchasers (*q*) for the goods of the plaintiff.

It has long been settled that the question of the relative excellence of the plaintiff's and the defendant's goods is not Inferiority of the defendant's goods.

Pirie v. *Goodall*, (1892) 1 Ch. 35; 9 R. P. C. 17, C. A.; Chap. IX., p. 209. A dictum of Lord Alverstone in *Hubbuck* v. *Brown*, 17 R. P. C. 638 (1900), suggests that although the exclusive use of part of a mark is disclaimed, nevertheless the proprietor may rely on the whole combination; see also *Pirie* v. *Goodall*, (1892) 1 Ch. 35. As to passing off cases based upon disclaimed matter, see next chapter, p. 484.

(*i*) See below, p. 384.

(*k*) This is consistent with the fact that an unregistered assignee can sue, see p. 361.

(*l*) Page 365.

(*m*) Page 366.

(*n*) Page 368.

(*o*) It is usually so expressed. What is meant is, of course, "similar to"; but "similar to" and "resembling" are constantly used to convey the proper meaning of the latter word; see *Welch* v. *Knott*, 4 K. & J. 747 (1857), Wood, V.-C.

(*p*) Page 373.

(*q*) Page 378.

relevant to the right of the plaintiff to maintain either an action for infringement or "passing off" (*qq*), and this has, accordingly, no place in the above definition. It may, however, affect the amount of the damages to be recovered by the plaintiff if he succeeds, for damages are sometimes claimed and allowed in respect of injury occasioned to the trade reputation of the plaintiff by the defendant's infringement or fraud (*r*). If the defendant's goods are as excellent as his own, the reputation of the plaintiff cannot have been injured by a substitution of one for the other.

Single act of infringement.

The Court has refused to regard an isolated act, done at the request of the plaintiff's agent, who was laying a trap for the defendant, as an infringement (*s*). This must be taken as a special case, however, for, in general, proof of a single act of infringement by the defendant is sufficient to justify the plaintiff in bringing his action (*t*), and the evidence relied on is frequently the sale by the defendant of the spurious goods to the plaintiff or his agent, who has bought them merely for the purpose of procuring evidence (*u*). Whenever trap orders are resorted to, they should be scrupulously fair (*v*).

(*qq*) *Blofield* v. *Payne*, 4 B. & Ad. 410; 2 L. J. K. B. N. S. 68 (1833); *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185 (1863), Westbury, L. C.; and see *per* Lord Blackburn, in *Singer Manufacturing Co.* v. *Loog*, 8 App. Ca. p. 29.

(*r*) See for instance, *Alexander* v. *Henry*, 12 R. P. C. 360 (1895), Kekewich, J.

(*s*) *Hennessy* v. *Kennett*, Seb. Dig. p. 331 (1877), Malins, V.-C.; cf. *Leahy, Kelly & Leahy* v. *Glover*, 10 R. P. C. 141 (1893), where a single instance of the sale of goods by the defendant's shopwoman, not shown to have been with his authority, was considered insufficient to support a case of passing off; and *Rutter* v. *Smith*, 18 R. P. C. 49 (1901), Kekewich, J., a similar case. In *Tonge* v. *Ward*, 21 L. T. N. S. 480 (1869), Romilly, M. R.; and *Turcntsche* v. *Ellinger*, 26 W. R. 70 (1877), Malins, V.-C., the defendants were held liable for infringements by their agents committed without their knowledge; and in *Grierson, Oldham & Co.* v. *Birmingham Hotel Co.*, 18 R. P. C. 158 (1901), Buckley, J., for acts done contrary to the defendants' orders (*Big Tree Brand*). See above, p. 358, note (*c*).

(*t*) See, for instance, *American Tobacco Co.* v. *Guest*, (1892) 1 Ch. 630; 9 R. P. C. 218, where an injunction was granted but costs refused.

(*u*) *Dunlop Pneumatic Tyre Co.* v. *Neal*, (1899) 1 Ch. 807; 16 R. P. C. 247, North, J., a patent case, where the plaintiffs succeeded although the only infringement proved was done for their agent.

(*v*) *Californian Fig Syrup Co.* v. *Taylor's Drug Co.*, 14 R. P. C. 564 (1897), C. A.

Defendant must use or intend to use the marked goods for trading purposes.

The defendant must be shown to have used or intended to use the goods marked with the spurious mark for trading purposes, whether for sale or as samples to enable him to sell similar goods,—and whether these are or are not themselves so marked,—for the essence of the wrong is that purchasers of the spuriously marked goods are deceived, and the plaintiff incidentally suffers by the loss of their custom which would or might, but for the fraud, come to him (*w*). But the Court will not readily believe that the defendant does not intend to use vendible goods marked with the spurious mark for trading purposes if they are found in his possession, and either he is a trader in goods of the kind, or the quantity of the goods is considerable (*x*). So, where the defendant, a china manufacturer, had imported 5,000 spuriously marked cigars, he was held liable, although he did not know that the mark was spurious, and said that he intended the cigars "for family use."

Infringement must be within the realm.

And the infringement must occur within the realm (*y*). It is sufficient if the spuriously marked goods are brought by the defendant into this country for export to a country where the plaintiff's trade and marks are known (*z*), and it is, of course, sufficient if goods are spuriously marked by him in this country for export (*a*).

Whether infringement must be in plaintiff's market.

If the plaintiff's registered mark, or its essential particulars, are actually copied, it appears to be immaterial, in order to entitle the plaintiff to an injunction, whether the infringe-

(*w*) *Levy* v. *Walker*, 10 C. D. 436 (1879), C. A.; *Richards* v. *Butcher*, 7 R. P. C. 288 (1890), Kay, J.

(*x*) *Upmann* v. *Forester*, 24 C. D. 231 (1883), Chitty, J.

(*y*) Cf. the patent cases, *British Motor Syndicate* v. *Taylor*, (1900) 1 Ch. 577; (1901) 1 Ch. 122; 17 R. P. C. 189, 723, where goods were bought in England and sold abroad, with *Badische Fabrik* v. *Basle Chemical Works*, (1898) A. C. 200; 14 R. P. C. 919, where the defendants, who had effected a sale by post in Switzerland, and had despatched the goods addressed to an English trader from there, were held not to be liable. An English Court has no jurisdiction to prevent infringements which take place wholly abroad: *Morocco Bound Syndicate* v. *Harris*, (1895) 1 Ch. 534, Kekewich, J. (copyright).

(*z*) *Joseph Rodgers & Sons* v. *Rottgen*, 5 Times L. R. 678 (1889), Kay, J.; *Tm. of the Société, &c. des Verreries de l'Étoile*, (1894) 1 Ch. 61; 2 Ch. 26; 10 R. P. C. 436; 11 R. P. C. 142, Stirling, J., and C. A. (*Red Star Glass*).

(*a*) *Orr-Ewing* v. *Johnson*, 13 C. D. 434; 7 App. Ca. 219, is an illustration.

ment takes place within the area in which the mark is known or not, because the exclusive right conferred by the Act extends to the whole Kingdom.

If the case is one of colourable infringement, and the plaintiff's case is founded on the probability of deception in a particular market, the injunction granted might under special circumstances be limited to that market (*b*); but, except in such cases, it is submitted that the question whether there is a probability of deception must be considered on the assumption of the defendant's mark coming into competition with the plaintiff's mark, and that the fact that the marks had hitherto been respectively confined to different districts within the jurisdiction would not be a defence in law. The registration is, by the Act, declared to be the equivalent of public use, and this must mean, use throughout the realm. An injunction has been granted where the plaintiff's and the defendant's areas, though substantially local and distinct, were both within the realm and were beginning to overlap (*c*).

Defendant must use the mark upon the goods for which the plaintiff's right exists,

The use must be in connection with the goods for which the plaintiff's right exists. "There can be no right to the exclusive ownership of any symbols or marks universally in the abstract. Thus, an iron-founder who has a particular mark for his manufactures in iron could not restrain the use of the same mark when impressed on cotton or woollen goods; for a trade-mark consists in the exclusive right to the use of some name or symbol as applied to a particular manufacture or vendible commodity" (*d*). And the third essential ingredient for constituting an infringement, enumerated by

(*b*) In "*passing off*" cases where the plaintiff's mark has been used only in a limited area, he sometimes obtains an injunction restricted to such area. See next chapter, p. 517. In the *Orr-Ewing Case*, Cotton, L. J., thought that the injunction ought to have been limited to Eastern markets, had the defendants been trading in any others. It would rarely be practicable to give complete protection in such manner. See *Société V. de l'Étoile Tm.*, (1894) 1 Ch. 61, p. 67; 10 R. P. C. 441, Stirling, J.; and the observations of Kay, L. J., in the same case, during argument on appeal, 11 R. P. C. 145.

(*c*) *Paine & Co.* v. *Daniells & Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 71, 217 C. A. (*John Bull Beer*). The injunction was unlimited.

(*d*) *Per* Lord Westbury, in *Hall* v. *Barrows*, 4 De G. J. & S. 150; 33 L. J. Ch. 204 (1863).

Lord Westbury in *McAndrew* v. *Bassett* (*e*), is "that the defendants have imitated the mark for the purpose (*f*) of passing in the market other articles of a similar description."

The limits of the class of goods over which the right in respect of a registered mark extends have been discussed already (*g*), and the class has been shown to be not necessarily co-extensive with any register class (*h*), and it has also been shown that the registered proprietor's right ought to be limited and the registration restricted to the kinds of goods upon which he actually uses or intends to use the mark (*i*).

and is registered,

The plaintiff cannot sue for infringement in respect of goods for which his mark is not registered (*k*), although, if he can make a case, he may sue to restrain passing off.

and used.

And if his mark is registered generally for a register class comprising a kind of goods for which he does not use it, or for which it is unsuitable, it is not to be considered as registered for such goods. Thus, the proprietor of a mark registered for class 45, "tobacco whether manufactured or unmanufactured," used it only for cut tobacco, and the mark contained the words *Three Crowns Mixture*. It was held

(*e*) 4 De G. J. & S. 380; 33 L. J. Ch. 561 (1863).

(*f*) Fraudulent intent is not now essential, *post*, p. 375.

(*g*) Chap. V., p. 96, and Chap. XII., p. 256.

(*h*) Marks may be calculated to deceive, though in different register classes, p. 217; *Australian Wine Importers' Tm.*, 41 C. D. 278; 6 R. P. C. 311 (1889), Kay, J., and C. A. (wines and spirits); *Eno* v. *Dunn*, 10 R. P. C. 261 (1893), Kekewich, J. (an aperient drink and baking powder); *Turney & Sons' Tm.*, 11 R. P. C. 37 (1893), North, J. (beer and rum). In some instances the Courts have interfered to prevent a defendant using or imitating the trade-name of a well-known firm with the object of fraudulently suggesting that he has a connection of some sort with the firm, even where the defendant's trade is different from that of the firm, but the difference is not so great as to make the success of the fraudulent suggestion very improbable. *Eastman Co.* v. *John Griffiths Corpn.*, 15 R. P. C. 105 (photographic materials and cycles); *Dunlop Pneumatic Tyre Co.* v. *Dunlop Lubricant Co.*, 16 R. P. C. 12, both 1898, Romer, J. (cycle tyres, &c., and cycle lubricants); *Valentine Meat Juice Co.* v. *Valentine Extract Co., Ld.*, 17 R. P. C. 673, C. A., overruling 17 R. P. C. 1 (1900), Stirling, J. (meat extract for food and for medicinal purposes).

(*i*) *Edwards* v. *Dennis*, 30 C. D. 454 (1885), C. A., cited p. 97.

(*k*) *Jay* v. *Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.; *Hart* v. *Colley*, 44 C. D. 193: 7 R. P. C. 93 (1890), North, J.

that he could not sue to restrain an infringement in respect of cigars (*l*).

The infringement must be in respect of spurious goods.

Further, the use of the defendant's mark, which is relied on as an infringement, must be a use upon goods which are not the genuine goods—*i.e.*, those upon which the plaintiff's mark is properly used—for anyone may use the plaintiff's mark on the plaintiff's goods, since that cannot cause the deception which is the test of infringement (*m*). So the retailer of goods obtained from the plaintiff may lawfully place or renew (*n*) the labels upon them, and may have sufficient labels printed for the purpose (*o*). In the case last cited, the defendant failed to satisfy the jury, in an action at common law, that he had in fact printed the labels only for use on the genuine goods of the plaintiff; and the injunction, which had been granted in a suit in Chancery by Wood, V.-C., and dissolved on appeal by Cranworth, L. C., was accordingly restored (*p*). The rule just stated is well illustrated by *The Angostura Bitters Case*, where the injunction granted was so expressed as not to prevent the name being applied to an article identical with the plaintiff's, should any other person discover the secret of manufacture and make the goods (*q*).

Adulterations, and goods comprising authentic parts.

But goods of the plaintiff, adulterated by some other person (*r*), are not goods on which the mark may lawfully be placed; nor is the manufacture by the defendant of an article made up of several parts the less an infringement

(*l*) *Hargreaves* v. *Freeman*, (1891) 3 Ch. 39; 8 R. P. C. 237, Chitty, J.; and see *Beazley* v. *Soares*, 22 C. D. 660 (1882), Pearson, J. A person who does not use the mark at all cannot sue; last case, and *Delondre* v. *Shaw*, 2 Sim. 237 (1828), Shadwell, V.-C.

(*m*) Chap. II., p. 32.

(*n*) *Condy* v. *Taylor*, 56 L. T. 891 (1887), Kekewich, J.

(*o*) *Farina* v. *Silverlock*, 1 K. & J. 509; 24 L. J. Ch. 632; 6 De G. M. & G. 214; 26 L. J. Ch. 11 (1855).

(*p*) 4 K. & J. 650 (1850).

(*q*) *Siegert* v. *Findlater*, 7 C. D. 801 (1878), Fry, J. In the *Yorkshire Relish Case* (next chapter, p. 481) the defendant's sauce differed from the plaintiffs' by a "pinch of salt," but if the two had been indistinguishable the name would still (according to the evidence) have meant the former only.

(*r*) *Condy* v. *Taylor*, 56 L. T. 891 (1887), Kekewich, J.

because one genuine part of the plaintiff's manufacture, and bearing his mark, is included in it (*s*).

What connection with the spurious goods is sufficient.

It is not necessary that the spurious mark should be actually affixed to the goods, provided it is so used in connection with them as to be calculated to cause them to be taken for the plaintiff's goods (*t*). Use on the wrapper in which they are sold, or upon a slip placed in the package with them, or on a show-card to which the goods are attached (*u*), or in circulars or advertisements offering them for sale is sufficient (*t*). So printing the plaintiff's trade-mark labels, without showing that they were for use on genuine goods only (*v*), or using the plaintiff's marked or stamped bottles (*x*), casks (*y*), or boxes (*z*) for goods other than his genuine goods, is an infringement, unless the Court is satisfied that the use under the circumstances is not calculated to deceive (*a*).

But the use of a descriptive word registered as an old trade-mark, not in connection with the goods, but only in price lists referring to them, has been held to be no infringement (*b*).

In a recent case Vaughan Williams, J., said: "I am, for my own part, not at all sure that you can prove an infringement of a trade-mark without proving that the defendants have imitated the plaintiffs' trade-mark upon something capable of receiving the impression of the mark. Either the material itself, or the paper which is used, or the sacks, or bags, or boxes, or whatever it is that the material is put into, I should have thought must have been imitated

(*s*) *Richards* v. *Williamson*, 30 L. T. N. S. 746 (1874), Bacon, V.-C., a gun with stamped lock.

(*t*) *Jay* v. *Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.

(*u*) *Chameleon Patents, &c. Co.* v. *Marshalls*, 17 R. P. C. 527, (1900) Kekewich, J. (passing off).

(*v*) *Farina* v. *Silverlock*, note (*o*); *Guinness* v. *Ullmer*, 10 L. T. O. S. 127 (1847), Shadwell, V.-C.

(*x*) *Rose* v. *Henley*, 47 L. J. Ch. 577 (1877), Malins, V.-C.; *Rose* v. *Loftus*, *ibid.*

(*y*) *Hennessy* v. *Cooper*, Seb. Dig. p. 327 (1877), Malius, V.-C.

(*z*) *Barnett* v. *Leuchars*, 13 L. T. N. S. 405 (1865), Stuart, V.-C.

(*a*) As in *Welch* v. *Knott*, 4 K. & J. 747 (1857), Wood, V.-C.

(*b*) *Talbot* v. *Webley*, 3 R. P. C. 276 (1886), Bacon, V.-C. (*Baffle*, for safes); cf. "Singer system," in *Singer* v. *Loog*, 8 App. Ca. 15 (1882), and above, p. 38.

to constitute an infringement of a trade-mark" (*c*). The question actually decided in the case was, that the sale of goods by the descriptive name *Rugby Cement* was not an infringement of a trade-mark comprising those words; and the decision was undoubtedly correct; but it is submitted, with great deference, that, had the words been distinctive and an essential feature of the mark, it would have been an infringement to use them to effect the sale of any goods other than those of the plaintiffs. The distinction suggested by Jessel, M. R., and adopted by the Court of Appeal (*d*) in *The Singer Manufacturing Co.* v. *Wilson*, between cases where a name or device taken from a trade-mark is affixed to the goods, and cases where a name so taken is used in respect to them—for instance, in advertisements—to push their sale, was not approved by the House of Lords (*e*). The abstract question is, however, of little or no importance, since in the case put, the words would almost necessarily come by the legitimate user of the mark to denote the plaintiff's goods, and the use of them by the defendant, in any manner calculated to deceive, could be restrained in a "passing off" action. "It will be observed," Fry, J., said, in *The Linoleum Case* (*f*), "that the inquiry with regard to the use of the word *Linoleum* as a constituent element in the trade-mark, and the inquiry as to the use of the word *Linoleum* as a misrepresentation, are one and the same inquiry, and I must consider what the word *Linoleum* meant as used at the time when the defendants intended to attribute it to their manufacture."

The infringing mark may either (a) be an actual or substantial copy of the plaintiff's mark; (b) consist of or comprise its essential features; or (c) be a colourable imitation of it (*g*).

(*c*) *Rugby Portland Cement Co., Ld.* v. *Rugby and Newbold Portland Cement Co., Ld.*, 8 R. P. C. 241; affirmed on appeal, 9 R. P. C. 46 (1891).

(*d*) 2 C. D. 434 (1874).

(*e*) 3 App. Ca. 376; see Lord Cairns' judgment, cited Chap. II., p. 14.

(*f*) *Linoleum Manufacturing Co.* v. *Nairn*, 7 C. D. p. 836 (1878).

(*g*) It will be seen that (b) and (c) are not distinct cases, although they are separated for convenience in the text. The test of infringement is the same in each (p. 373). In case (b) the whole mark must be infringed, and in case (c) essential features are necessarily imitated or copied.

Where the plaintiff's mark has been copied.

(a) The first case presents no difficulties. By sect. 76, the registration of the plaintiff as proprietor of the trade-mark is *primâ facie* evidence, and, after five years (in the absence of an application to rectify), is conclusive evidence of his right to the exclusive use of the trade-mark (*h*). The registered proprietor can therefore make a case in an action for the mere using of his mark in connection with goods of the class over which his right extends, without showing that the use is calculated to deceive (*i*). And this is not, substantially, an alteration of the law as it stood before the Acts (*j*) if registration be taken as equivalent to public user, although proof of the probability of deception was usually, but not invariably (*k*), mentioned as an element of right of action; for if the defendant had taken a "material and substantial" portion of the plaintiff's mark, and, *à fortiori*, if he had taken the whole, the onus of showing that his conduct was not calculated to deceive was cast upon him (*l*), and it was practically, at any rate, impossible for him to support it. Moreover, unless he could give a reasonable explanation to show how he came to adopt a mark identical with that of the plaintiff, the Court would infer that he intended to deceive (*m*), and would not consider whether or not his attempt was likely to be successful (*n*).

False claim to the plaintiff's registered marks.

The infringement proved in *Paine & Co.* v. *Daniells & Sons' Breweries* (*o*) was effected in a very unusual way. The

(*h*) Above, p. 361.

(*i*) See the judgment of Cotton, L. J., in *Edwards* v. *Dennis*, 30 C. D. 454 (1885).

(*j*) Cf. with the judgment last referred to that of Hall, V.-C., in *Cope* v. *Evans*, 18 L. R. Eq. 138 (1874).

(*k*) For instance, see the judgment of Jessel, M. R., in *The Singer Manufacturing Co.* v. *Wilson*, 2 C. D. p. 422 (1875). "The right which a manufacturer has in his trade-mark is the exclusive right to use it for the purpose of indicating where, by whom, or at what manufactory, the article to which it is affixed was manufactured": *per* Lord Cranworth, in *The Leather Cloth Case*, 11 H. L. C. p. 533; 35 L. J. Ch. 53 (1865).

(*l*) *Ford* v. *Foster*, 7 Ch. 611 (1872), James, L. J.; *Orr-Ewing* v. *Johnston*, 13 C. D. 434 (1879), Fry, J., and C. A. See also Lord Herschell in *Reddaway* v. *Banham*, 13 R. P. C. at p. 228.

(*m*) See *The Orr-Ewing Case*, in the H. L., 7 App. Ca. 219; *Taylor* v. *Taylor*, 23 L. J. Ch. 255 (1854), Wood, V.-C.

(*n*) See *per* Lindley, L. J., in *Slazenger* v. *Feltham*, 6 R. P. C. p. 533 (1889). See, however, *Lever* v. *Bedingfield*, cited below, p. 372.

(*o*) (1892) 2 Ch. 567; 10 R. P. C. 71, 217, C. A.

plaintiffs' marks consisted of labels bearing a figure of John Bull, and the words *John Bull* and *John Bull Brand*. The defendants used a label bearing a different figure of John Bull, with the words *John Bull, Registered*. Their label, though entered as their copyright at Stationers' Hall, had been, in 1885, refused registration as a trade-mark, on the ground of the plaintiffs' opposition, but they had, notwithstanding the refusal, continued to use it in their business. Although the labels had been in use so long, no evidence of actual deception was tendered, for the trades of the plaintiffs and defendants had been carried on in different districts, and were only beginning to overlap at one point at the date of the trial. There was no other evidence than that furnished by the labels themselves, that the defendants' label was calculated to deceive; but the Court of Appeal regarded the false claim of registration in their label as amounting in effect to a representation that the plaintiffs' marks—the only John Bull marks which really were registered—were their own, and this was held to be an undoubted infringement (*p*).

Where an essential feature has been copied.

(b) The right of the registered proprietor exists in regard to the whole mark, not in regard to any particular part of it (*q*), and an infringement must be an infringement of the whole mark (*r*). But the adoption of a single characteristic and distinctive particular from the plaintiff's mark, and its use alone, or with other matter, may well be an infringement of the entire mark. At any rate, it throws upon the

(*p*) *Lawrie* v. *Baker*, 2 R. P. C. 213 (1885), Day, J., is a similar case. There the defendant described his goods as *patent cups*, the plaintiff having the only patent. Cf. *Pneumatic Stamp Co.* v. *Lindner*, 15 R. P. C. 525, cited below, p. 457.

(*q*) *Hudson's Tm.*, 32 C. D. 311; 3 R. P. C. 155 (1886), Cotton, L. J.; *Christiansen's Tm.*, 3 R. P. C. 54 (1886), C. A.

(*r*) "It is established by the history of the defendant's label and by comparing it with the plaintiff's label of 1894, that the central space and curved scroll on the plaintiff's label have been utilized, and to some extent copied, by the person employed by the defendant to prepare his label. If, notwithstanding this circumstance, the defendant's label as a whole is not a copy of the plaintiff's labels, and is not as a whole a colourable imitation of them, it cannot be truly said that the defendant has infringed the rights conferred upon the plaintiffs by the registration of their marks." *Per* Lindley, M. R., in *Lever* v. *Bedingfield*, 16 R. P. C. 3, at p. 10 (1899) (*Sunlight and Redmaid Soaps*); so *Rugby Cement Co.* v. *Rugby and Newbold Co.*, note (*t*).

defendant the onus of proving the contrary (*s*). But it is not an infringement to take non-essential particulars from a mark: for instance, to take merely descriptive or other common words (*t*).

Where there is a colourable imitation.

(c) A colourable imitation is the most common case, for, if the resemblance is intended, the defendant will have tried to introduce apparent differences sufficient to prevent the Court from interfering, while preserving a likeness which is near enough to enable him to profit by the reputation of the plaintiff's mark. So far as the Court succeeds in carrying into effect the principles which govern its interference, the two ends are inconsistent with each other.

Colourable Imitation.

The test of infringement.

In both the second and third cases the test of infringement is the question whether or not the defendant's mark is calculated to cause his goods to be taken by ordinary purchasers (*u*) for the goods of the plaintiff (*x*), and the Registration Acts have made no alteration of the law in this respect (*y*).

(*s*) *Ford* v. *Foster*, 7 Ch. 611 (1872), James, L. J.; *Johnston* v. *Orr-Ewing*, 13 C. D. 434 (1879), Fry, J., and C. A.

(*t*) *Linoleum Manufacturing Co.* v. *Nairn*, 7 C. D. 834 (1878), Fry, J. (*Linoleum*); *Watt* v. *O'Hanlon*, 4 R. P. C. 1 (1886), Porter, M. R. (*Old Innishowen*); *Humphries* v. *Taylor's Drug Co.*, 59 L. T. 820 (1888), Kekewich, J. (*Herbalin*); *Native Guano Co.* v. *Sewage Manure Co.*, 8 R. P. C. 125 (1888), C. A. and H. L. (*Native Guano*); *Rugby Cement Co.* v. *Rugby and Newbold Co., Ld.*, 8 R. P. C. 241; 9 R. P. C. 46 (1891), V. Williams, J., and C. A.; cf. Chap. X., p. 243; and *Barber* v. *Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L. J. See, further, next chapter, p. 476.

(*u*) See above, p. 363.

(*x*) *Hall* v. *Barrows*, 4 De G. J. & S. 150; 33 L. J. Ch. 204 (1863), Westbury, L. C.; *Leather Cloth Co., Ld.* v. *The American Cloth Co., Ld.*, 4 De G. J. & S. 137; 33 L. J. Ch. 199 (1863), Westbury, L. C.; and 11 H. L. C. 523; 35 L. J. Ch. 53. The suggestion in the Scotch case of *Crawford* v. *Bernard*, 11 R. P. C. 580 (1894), Lord Kyllachy, that colourable infringement can be judged of apart from probability of deception, is not in accordance with the authorities.

(*y*) *Mitchell* v. *Henry*, 15 C. D. 181 (1880), C. A.; *Singer Manufacturing Co.* v. *Loog*, 18 C. D. 395, C. A.; and 8 App. Ca. 15 (1870); *Edwards* v. *Dennis*, 30 C. D. 454 (1885), Cotton, L. J.; *Lever* v. *Redingfield*, note (*r*).

"It is not a question whether this (the use of the defendant's mark) necessarily is deceptive, but whether there is not a strong probability of its causing deception" (*z*). So that the imitation of the plaintiff's mark cannot be justified by showing either that the device or inscription on the imitated mark is ambiguous, and capable of being understood by different persons in different ways, or that a person who carefully and intelligently examined and studied it might not be misled (*a*).

Questions for the jury.

There can be no infringement, therefore, in cases where the plaintiff's mark is not actually copied, if there is no reasonable probability of deception (*b*). It was held by the Court of Common Pleas, as early as 1847, that the following questions were properly left to the jury by Williams, J., in *Rodgers* v. *Nowill* (*c*):—(1) Whether there was such a resemblance to the plaintiffs' marks, in the marks put on the knives made by the defendants, as was calculated to make an ordinary person believe that the marks were the marks of the plaintiffs, denoting that the knives were the knives of the plaintiffs? and (2) Did the defendants, with an intention to deceive, sell these knives representing them to be the manufacture of the plaintiffs? It will be shown immediately that if the plaintiffs' mark was their trade-mark, the second question has long been held to be immaterial, except so far as it dealt with the mere fact of the sale of the knives.

Actions for infringement and for passing off.

The same test, as will be shown in the next chapter, applies also to actions for "passing off." It is sometimes suggested that a less degree of resemblance between the plaintiff's and defendant's marks will suffice to support an action for

(*z*) *Per* Cotton, L.J., in *The Upper Assam Tea Co.* v. *Herbert & Co.*, 7 R. P. C. p. 186 (1889).

(*a*) *Per* Lord Selborne, in *The Singer Manufacturing Co.* v. *Loog*, 8 App. Ca. p. 18 (1882).

(*b*) *Cope* v. *Evans*, 18 L. R. Eq. 138 (1874), Hall, V.-C.; *Beddow & Sons* v. *Boyd*, 4 R. P. C. 310 (1887), Chatterton, V.-C.; see also *Woollam* v. *Radcliff*, 1 H. & M. 259 (1863), Wood, V.-C.; *Bradbury* v. *Beeton*, 39 L. J. Ch. 57 (1869), Malins, V.-C.; *Civil Service Supply Association* v. *Dean*, 13 C. D. 512 (1879), Malins, V.-C.; and *Borthwick* v. *The Evening Post*, 37 C. D. 449 (1888), Kay, J., and C. A., in all of which an injunction was refused.

(*c*) 5 C. B. 109; 17 L. J. C. P. 52.

"passing off" than is required to support an action for infringement, or, what is the same thing, proof of a lower degree of probability of deception. This distinction is, it is submitted, unnecessary and inconvenient. In the cases before the Acts, when the two classes of actions were not yet separated, there could have been no ground for it, and there is nothing in the Acts to require its introduction. The essential difference is plain enough. In an infringement action the plaintiff can rely only upon the imitation of his registered mark, while in an action for "passing off" he may rely on other things, or on additional things, which are proved to be connected with his trade or goods.

Actual deception need not be proved;

Proof of actual deception, if the mark is, in the opinion of the Court, calculated to deceive, or if the plaintiff's registered mark has been substantially copied (*d*), is unnecessary, although the absence of it, where the plaintiff's and defendant's marks have circulated side by side for a considerable time, may go far to negative the probability of deception, unless it is explained, for instance, by the practical impossibility of calling evidence from a distant country to show that purchasers there have been deceived (*e*). The plaintiff is not bound to wait to see whether his customers will, in fact, be deceived, for "the very life of a trade-mark depends upon the promptitude with which it is vindicated" (*f*).

nor yet an intention to deceive.

Nor where the defendant's mark has in fact deceived, or is, in the opinion of the Court, calculated to do so, is it necessary to show that the defendant intended to deceive. This was first decided by Lord Cottenham, in *Millington* v. *Fox* (*g*), as regards the relief by an injunction, and by Lord Westbury, in *Edelsten* v. *Edelsten* (*h*), as regards both injunction and account. It is now well-settled law (*i*).

(*d*) Above, p. 371; and see *Paine & Co.* v. *Daniells & Sons' Breweries*, cited *ante*, p. 371.

(*e*) Page 249.

(*f*) *Johnston* v. *Orr-Ewing*, per James, L.J., 13 C. D. p. 464; and Lord Blackburn, 7 App. Ca. p. 230 1880).

(*g*) 3 My. & Cr. 338 (1838).

(*h*) 1 De G. J. & S. 185; 10 L. T. N. S. 780 (1863).

(*i*) *Reddaway* v. *Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639; 9 R. P. C. 503, C. A.; *Johnston* v. *Orr-Ewing*, 7 App. Ca. 219 (1882); *Powell* v. *Birmingham Vinegar Co.*, (1896) 2 Ch. 54; 13 R. P. C. 235, in the C. A. As to damages at law, see the first-mentioned case.

The dicta of Lord Chelmsford in *The Glenfield Starch Case*, that where the trade-mark is not actually copied, fraud is a necessary element in the plaintiff's case—"that is, the party accused of piracy must be proved to have done the act complained of with the fraudulent design of passing off his own goods as those of the party exclusively entitled to the trade-mark" (*k*)—and of Jessel, M. R., and the Court of Appeal, in *The Singer Manufacturing Co.* v. *Wilson* (*l*), that, where the defendant has not actually put the plaintiff's trade-mark, or a colourable imitation of it, on his goods, or on the bottles or boxes containing them, but has otherwise acted so as to represent his goods as those of the plaintiff (*m*), a fraudulent intent must be proved, cannot now be taken to be law. In the former case, Lord Hatherley said it had been pointed out that a *mala fides* towards the first purchaser was not the ground of the Court's interference; for it is sufficient if such purchaser is furnished by the defendant with goods bearing a label, of which the necessary consequence is that he is enabled to deceive others by means of them (*n*). And in *The Singer Case*, Lord Cairns said: "I wish to state in the most distinct manner that, in my opinion, fraud is not necessary to be averred or proved in order to obtain protection for a trade-mark" (*o*); and in this Lord O'Hagan concurred (*p*). Lord Blackburn said: "I am not as yet prepared to assent either to the position that there is a right of property in a name, or, what seems to me nearly the same thing, to assent to its full extent to the proposition that it is not necessary" (in trade-name cases) "to prove fraud" (*q*). But the last-mentioned judge, in a subsequent case, stated that he thought it clear, at any rate, that if the defendant persevered in using a trade-mark calculated to

(*k*) *Wotherspoon* v. *Currie*, L. R. 5 H. L. p. 519 (1872).

(*l*) 2 C. D. 432 (1875).

(*m*) As already shown, these may be cases of infringement if the representation is effected by using a mark in connection with the defendant's goods (though not on them) which resembles the plaintiff's mark, or by using a distinctive name taken from the plaintiff's mark; above, p. 369.

(*n*) L. R. 5 H. L. p. 517.

(*o*) 3 App. Ca. p. 391, quoted and adopted in *Bodega Co., Ld.* v. *Owens*, 7 R. P. C. 31 (1889), Chatterton, V.-C.

(*p*) 3 App. Ca. 396.

(*q*) Page 400.

deceive after notice of the facts, that would be evidence to support a claim for damages for knowingly selling his goods as and for those of the plaintiff (*r*). "However honest or inadvertent the original mistake may have been, the continuation of the use of it after that was pointed out is of itself evidence of a fraudulent intention" (*s*).

And it has already been shown that the proprietor of a trade-mark may obtain an injunction against an innocent consignee of spuriously marked goods, and an order for the spurious marks to be expunged from the goods, without having given the defendant any notice before the commencement of the action (*t*).

On the other hand, the mere intention of the defendant to deceive, if the Court is clearly of opinion that the mark complained of is not calculated to deceive, cannot constitute an infringement (*u*).

What resemblance is calculated to deceive.

It follows that the question to be answered when an infringement without taking the actual mark is alleged, is the same question as arises when a mark tendered for registration is objected to, or, having been registered, is sought to be removed from the Register, on the ground that it has such resemblance to a trade-mark already on the Register as to be calculated to deceive, within the restriction of sect. 72 (2). The principles governing the comparison of the marks, and determining what amount of resemblance is calculated to deceive, are the same in both cases, although a higher standard of resemblance must be conformed to in an action for infringement than that set up in cases of the other class. These principles have been already discussed at length (*x*), and it will, therefore, be sufficient in this place to shortly summarise the conclusions deduced from an examination of the authorities.

(*r*) *Singer Manufacturing Co.* v. *Loog*, 8 App. Ca. 31 (1882); and *Cochrane* v. *McNish*, (1896) A. C. 225; 13 R. P. C. 100, Privy Council.

(*s*) Per James, L. J., in *Orr-Ewing* v. *Johnston*, 13 C. D. p. 454 (1880); see also *Paine & Co.* v. *Daniells & Sons' Breweries*, (1892) 2 Ch. 567; 10 R. P. C. 217, C. A., cited above, p. 371.

(*t*) *Ante*, p. 357; *Upmann* v. *Forester*, 24 C. D. 231 (1883), Chitty, J.; *American Tobacco Co.* v. *Guest*, (1892) 1 Ch. 630; 9 R. P. C. 218, Stirling, J.

(*u*) See next chapter, p. 492.

(*x*) Chap. X., pp. 224 *et seq.*

The probable purchasers are to be considered.

(1) The persons with regard to whom the test question—Is the spurious mark calculated to deceive them?—ought to be asked, are the persons who are probable purchasers, whether they buy, or are likely to buy, directly from the plaintiff or defendant, or from, or through, intermediate purchasers from either of them, and whether they are English or foreign, and not merely very careful or intelligent persons, but ordinary unwary purchasers (*y*). No rule has, or probably can be laid down, as to what amount of intelligence or knowledge of the trade in question ought to be attributed to them, since this must necessarily vary with the nature of the case (*z*).

The net impressions left by the marks are to be contrasted.

(2) No definite rule as to the amount of resemblance required can be formulated *à priori*, but the net impression produced and "the main idea left on the mind" by one mark must be compared with that left by the other, for marks may well be confused by purchasers, who see the defendant's mark when they have present in their memories only an indefinite recollection of the plaintiff's, in cases where the marks could not be mistaken for each other if they were seen side by side (*a*). So that the whole mark of the defendant may too nearly resemble that of the plaintiff, although all the essential particulars of the two are distinguishable (*b*); but special regard must, nevertheless, be paid to the essential features of the plaintiff's mark in considering whether the defendant has infringed it (*c*).

The marks are to be considered as seen in ordinary use.

(3) Further, the marks must be compared as they are seen in actual ordinary use (*d*) on the goods they are used for; remembering, however, that so far as the plaintiff's mark substantially differs from the mark on the Register, it is an unregistered mark (*e*).

(*y*) Page 224; and *Shrimpton* v. *Laight*, 18 Beav. 164 (1854), Romilly, M. R.

(*z*) See the "passing off" cases, *Payton* v. *Snelling*, 17 R. P. C. 48: and *Payton* v. *Titus Ward*, *ibid.* 58 (both 1899, C. A.), and above, pp. 225 and 226. The first-mentioned decision was affirmed in the H. of L., 17 R. P. C. 628.

(*a*) Page 227.

(*b*) Page 230.

(*c*) Pages 226 and 236; and cases in note (*z*); also *Hubbuck* v. *Brown*, 17 R. P. C. 148 and 638, (1900) Kekewich, J., and C. A.

(*d*) Page 234.

(*e*) Page 236.

(4) The circumstances of the trade (*f*) and market in which the marks are used must be considered also,—the language of the purchasers, for instance, and the number of analogous marks in use in connection with the same goods (*g*).

Regard is to be paid to all the circumstances surrounding the marks in use.

But, since colour is not admitted to consideration in estimating the distinctiveness of a mark tendered for registration (*h*), and cannot, on account of the practical difficulties, be registered as an essential element of a trade-mark, similarity of colour is not to be greatly relied upon in deciding a question of infringement (*i*), although it is an element to be considered.

Colour.

If the plaintiff's mark, or some feature of it, has led to the application of a particular name to his goods, it is an infringement for the defendant to use a mark which is calculated to cause the same name to be applied to his (*j*), unless the name is applied, not merely to the plaintiff's goods, but to all goods of the kind (*k*), for instance, because it is suggested by matter in the mark which is common to the trade (*l*); and the defendant's use of his mark is none the less an infringement of the plaintiff's rights, because the exclusive use of the name may give the plaintiff a practical monopoly in certain goods in a particular market (*m*).

And, in particular, to the adoption of a special name for goods bearing the plaintiff's mark.

Attention must be paid, of course, not only to the points of resemblance between the marks, but also to the points of difference. But it will not be sufficient for the defendant to show that the differences might prevent purchasers being deceived. If there is a case for him to answer, the Court must hold that they are "such as to prevent its being likely that they would be deceived" (*n*).

What importance is to be attached to differences between the marks.

(*f*) *Cochrane* v. *McNish*, (1896) A. C. 225; 13 R. P. C. 100, P. C. (*Club Soda*).

(*g*) Page 240.

(*h*) *Hanson's Tm.*, 37 C. D. 112; 5 R. P. C. 130 (1887), Kay, J., above, p. 194.

(*i*) *Nuthall* v. *Vining*, 28 W. R. 330 (1880), C. A. Registration confers the exclusive use of the mark in any colours: sect. 67. Colour is often of great importance in a case of "get up." See the next chapter.

(*j*) Page 240 *et seq.* This appears to have been treated rather as "passing off" than infringement by Romer, J., in *Hodgson* v. *Kynoch*, 15 R. P. C. 465, at p. 476 (1898).

(*k*) Page 243.

(*l*) Page 244. See note (*z*) above.

(*m*) Page 246. See *The Yorkshire Relish Case*, cited below, p. 481.

(*n*) Per Lord Blackburn, in *Johnston* v. *Orr-Ewing*, 7 App. Ca. p. 230

Instances of infringements by marks which prominently displayed the defendant's name.

In the following cases it was held that the use of words taken from the plaintiff's mark by the defendant was an infringement, notwithstanding that he always added his own name:—*Perry* v. *Truefitt*, 6 Beav. 66, PERRY'S MEDICATED MEXICAN BALM, TRUEFITT'S MEDICATED MEXICAN BALM; *Braham* v. *Bustard*, 1 H. & M. 447, BUSTARD & Co.'s EXCELSIOR WHITE SOFT SOAP; *Kinahan* v. *Bolton*, 15 Ir. Ch. 75, KINAHAN'S LL WHISKY, BOLTON'S LL WHISKY; *Ford* v. *Foster* (*o*), L. R. 7 Ch. 611, FORD'S EUREKA SHIRTS, FOSTER, PORTER & Co.'s IMPROVED EUREKA SHIRTS; *Eno* v. *Stephens*, Seb. Dig. p. 372; *Eno* v. *Dunn*, 10 R. P. C. 261, ENO'S FRUIT SALT, STEPHENS & Co.'s EFFERVESCING VINOUS FRUIT SALTS; DUNN'S FRUIT SALT AND CHLORATE OF POTASH LOZENGES. In *The Glenfield Starch Case* (*p*), *Wotherspoon* v. *Currie*, 5 L. R. H. L. 508, the defendant's own name appeared in bold letters upon the infringing labels, and this was also the case in *Johnston* v. *Orr-Ewing*, 13 C. D. 434, and 7 App. Ca. 219, but there the Indian customers of the plaintiff could not, it was assumed, read English (*q*). So, in *Rose* v. *Loftus*, 47 L. J. Ch. 576, the defendant washed the plaintiff's labels off the bottles, leaving only the moulded marks, and pasted his own labels upon the bottles in their place, but was, nevertheless, held to have committed an infringement. And in *Curtis and Harvey* v. *Pape*, 5 R. P. C. 146, an imitation of a diamond mark was held to be an infringement, although the defendant put a K in the middle of his diamond which did not appear in that of the plaintiffs.

Different get-up.

On similar grounds it is held to be no excuse for a clear infringement of a trade-mark that the infringing mark is used upon goods of which the get-up differs *in toto* from that of the plaintiff's goods (*r*).

(1882), quoted and followed by the Privy Council in *Somerville* v. *Schembri*, 12 App. Ca. p. 458; 4 R. P. C. 179 (1887). Cf. p. 375, note (*r*).

(*o*) Cited p. 37.

(*p*) Cited pp. 459 and 481. In *The Yorkshire Relish Case*, cited p. 49, the defendants did everything possible to distinguish their goods, but this proved to be insufficient while they used the (unregistered) trade-mark.

(*q*) *Henderson* v. *Jorss*, Seb. Dig. p. 110 (1861), Wood, V.-C., is a similar case.

(*r*) *Apollinaris Co.* v. *Herrfeldt*, 4 R. P. C. 478 (1887), Chitty, J., and C. A. (*Apollinis*). See note (*p*).

But the use of the defendant's name as part of the mark complained of is an element to be considered, and in some cases it has turned the scale in his favour. Thus, in *Beard* v. *Turner*, 13 L. T. N. S. 746, KIRBY'S NE PLUS ULTRA NEEDLES, on a label, was held not to be infringed by TURNER'S NE PLUS ULTRA NEEDLES on a label generally resembling the plaintiff's, the words NE PLUS ULTRA being common to the trade; and in *Blackwell* v. *Crabb*, 36 L. J. Ch. 504, BLACKWELL'S PICKLES on a label, not to be infringed by CRABB'S PICKLES on a label resembling the plaintiffs', the name of the manufacturer, under the circumstances of the case, being the thing which a customer would rely on most to establish the identity of the goods he wanted. In each of these cases the elements of all the labels were for the most part common to the trade (*s*).

Differences which may be removed by retailers are disregarded.

Where any such additions or precautions are relied on by the defendant to rebut an alleged infringement, it is necessary to inquire whether they may not be removed or obliterated by fraudulent retail dealers leaving the imitated marks to effect deception without any check. On this ground, in *Barlow* v. *Johnson* (*t*), the Court paid no regard to the tickets and labels attached by the defendant to the towels sold by him under the name, *Osman*, which he had taken from the plaintiff's trade-mark.

Decided cases do not assist in determining the question of fact.

Probability of deception is, of course, a question of fact, and, except so far as they lay down any general principle of comparison, the decided cases are of no assistance in the determination of new questions of fact raised upon other materials. "How can observations of judges upon other and quite different facts bear upon the present case, in which the only question is what is the result of the evidence?" Lord Watson asked, in *Johnston* v. *Orr-Ewing* (*u*), but the habit of referring to reported cases at the trial of such questions is inveterate, and it has been thought useful, therefore, to collect

(*s*) See also the "passing off" cases, *Jamieson* v. *Jamieson*, 15 R. P. C. 169, (1898) C. A.; *Payton* v. *Snelling*, 17 R. P. C. 48 and 628, (1900) C. A. and H. of L.; and *Payton* v. *Titus Ward*, *ibid.* 58 (1899), C. A., cited p. 232.

(*t*) 7 R. P. C. 395 (1890), Chitty, J., and C. A.

(*u*) 7 App. Ca. 219 (1882).

the cases just cited, and those cited at pp. 249 and 251, above.

Inconspicuous additions a badge of fraud.

The reported cases show that attempts are frequently made to prevent the interference of the Court by using along with the spurious or deceptive marks, words, descriptions, or other additions which, if carefully examined, would prevent the deception, and at the same time, by writing the additions in small letters, or otherwise causing them to be comparatively inconspicuous, to make the probability of careful examination as small as the infringer thinks he safely can. It is obvious that, so far from affording an answer to a charge of infringement, such colourable precautions are themselves a badge of fraud. The defendant is met at once with the questions, if the additions are necessary, why are they not made conspicuous? and, if they are superfluous, why are they used at all? (*x*) In the following cases the several additions noted in brackets were added in small letters to the plaintiff's name or trade-mark, or to an imitation of it: [Equal to] Day & Martin's, injunction granted, *Day* v. *Binning*, C. P. Cooper, 489; [Late of] Lundy, Foot & Co., dismissed pending verdict at law, *Foot* v. *Lea*, 13 Ir. Eq. 484; [From] Thresher & Glenny, injunction granted, *Glenny* v. *Smith*, 2 Dr. & Sm. 476; [From] Hookham & Pottage, injunction granted, *Hookham* v. *Pottage*, L. R. 8 Ch. 91; [Agent for] Mason & Brand's Essence of Beef, injunction granted, *Dence* v. *Mason*, W. N. (1877) 23; W. N. (1878) 42; C. B. [& Co.], the plaintiff's mark was C. B., the infringing goods were made by Connell Brothers & Co., injunction granted, *Bayer* v. *Baird* (*x*).

5. Defences.

The ordinary defences.

The defences commonly set up may be tabulated as follows, that:—

(1.) The plaintiff has no title to the trade-mark in question (*y*);

(*x*) *Bayer* v. *Baird*, 15 R. P. C. 615 (1896), Court Sess.; *Bayer* v. *Connell*, 16 R. P. C. 157 (1899), M.R. of Ireland.

(*y*) Pages 358 *et seq.* and 383. The

(2.) The defendant has an independent or a concurrent right to use the mark complained of;

(3.) The plaintiff has not complied with the provision of sect. 77 by obtaining the registration or refusal of the mark (*z*);

(4.) There is no infringement (*a*);

(5.) The plaintiff is debarred from suing the defendant for all or part of the relief he seeks by (a) an agreement or some personal estoppel (other than those next alluded to); (b) acquiescence or licence; (c) delay; or (d) because the trade-mark is deceptive, or his trade is fraudulent (*b*).

(1), (3), and (4) are traverses of parts of the plaintiff's case, but (1) may be something more.

Application to vary.

Attack on the plaintiff's title.

(1) If the plaintiff's mark has been registered for five years (*c*), whether in his name or in that of his predecessor in title (*d*), the registration is conclusive evidence of his right to the exclusive use of the mark, subject to the provisions of the Act—that is, subject to his possessing the goodwill of the business in the goods to which the trade-mark is attached (*e*). The defendant can adduce evidence to show (*f*), or he may show from the plaintiff's own evidence (*g*), that this condition is not complied with; but he cannot attack the plaintiff's title generally, for instance, by showing that the mark is not a trade-mark (*h*), or is not within the classes of registerable symbols enumerated in sect. 64, except on an application

question whether the mark concerned is a trade-mark at all, as to which see Chap. II., p. 23, seldom arises in practice, except on an application to expunge an entry from the Register.

(*z*) Chap. XII., p. 312.

(*a*) Page 363.

(*b*) Page 390.

(*c*) Sect. 76, *ante*, p. 361.

(*d*) Sect. 87.

(*e*) *Ante*, p. 343.

(*f*) *Edwards* v. *Dennis*, 30 C. D. 454 (1885), C. A.

(*g*) As in *Pinto* v. *Badman*, 8 R. P. C. 181 (1891), C. A.

(*h*) See Chap. II., p. 23.

under sect. 90 (*i*). The application cannot be made by counterclaim in the action (*k*).

If the plaintiff's mark has not been registered for five years, the defendant can (probably) attack his title without an application to vary the Register (*l*).

Application to expunge or limit the plaintiff's registration.

It follows that the defendant in an infringement action, unless satisfied that the plaintiff's title cannot safely be attacked, generally applies to expunge the mark of the latter from the Register, or to so limit it as to defeat the action, and, according to the usual practice, the application comes on for hearing with the trial of the action, or with the plaintiff's motion for an interlocutory injunction, if any. The Court will, in a proper case, adjourn the decision of the last-mentioned motion in order to enable the defendant to make his cross application to rectify or expunge (*m*).

Determination of the plaintiff's title.

In any case, it is submitted, and notwithstanding that there is no application to rectify, the defendant may show that the plaintiff's right has determined by abandonment or otherwise (*n*).

Concurrent Right.

Concurrent or independent right.

Where the Court has so decided, two or more persons may be registered as proprietors of the same mark for the same goods (*o*), and they will then have concurrent rights. But where more than three persons are independently entitled to use a mark for the same goods it is treated as common to the trade, so that if any of them has obtained registration, the entry ought to be expunged (*p*).

The defendant, therefore, if he have an independent right, can apply for registration himself, and in a proper case the Court will order a motion for an interlocutory injunction

(*i*) As to which see Chap. XI., p. 262.

(*k*) *Pinto* v. *Badman*, *supra*.

(*l*) See above, p. 361, note (*d*).

(*m*) Cf. *Edwards* v. *Elkan*, *infra*, note (*q*).

(*n*) See Chap. XIV., p. 338.

(*o*) Sects. 71 and 72. It must be a right to use the mark as a trade-mark; not, for instance, as a family crest, *Standish* v. *Whitwell*, 14 W. R. 512; *Beard* v. *Turner*, 13 L. T. N. S. 746, both (1866) Wood, V.-C.

(*p*) Chap. X., p. 214.

in an action against him to stand over until his application is disposed of (*q*); or, if he allege that the mark is common, he can apply to remove the plaintiff's mark from the Register.

Mouson v. *Boehm*.

In *Mouson* v. *Boehm* (*r*), where the plaintiffs had independently adopted, and in 1880 had registered, a mark closely resembling a mark which the defendant had previously acquired by user for the same goods, and which he had never abandoned, the plaintiffs brought their action to restrain the defendant from using the latter mark. The defendant applied to register the mark as his, and moved to have the entry of the plaintiffs' mark expunged from the Register. The application to register came before the Court on a summons to proceed, and was heard, together with the motion for an injunction, at the trial of the action. Chitty, J., allowed the defendant to be registered as a proprietor of the mark, but he refused to order the registration of the plaintiffs' mark to be expunged, and he dismissed the action.

Jackson v. *Napper*.

Jackson v. *Napper* (*s*) is a similar case. There the defendant, in 1876, applied through an agent to register a mark as his trade-mark, and he supposed that it was registered accordingly, but, in fact, the application was not proceeded with and was, as the Court held, abandoned. In the next year the plaintiffs registered a similar mark, and more than five years after their registration they brought the action to restrain the defendant from using his mark, and thereupon the defendant took out a summons for a direction to the Comptroller to proceed with the registration of his mark. Stirling, J., found that the defendant had acquired and used his mark as a trade-mark before the 13th of August, 1875, in respect of the goods in question, except one particular class (sheep-shears); and he held that, notwithstanding that the

(*q*) *Edwards* v. *Elkan*, 5 R. P. C. 70 (1887), Stirling, J.

(*r*) 26 C. D. 398 (1884), Chitty, J. A similar case of an old mark is cited by Mr. Sebastian, *Re United Vineyards, &c. Co.* (1889), Stirling, J.; and *Re Bryant and May*, 4 Times L. R. 675 (1888), Stirling, J., is another. In *Daniel and Arter* v. *Whitehouse*, (1898) 1 Ch. 685; 15 R. P. C. 134, Gorell Barnes, J. (*Brazilian Silver*), cited below, p. 484, the defendant lost by non-user a concurrent right to an (unregistered) trade name.

(*s*) 35 C. D. 162; 4 R. P. C. 45 (1886), Stirling, J.

five years' registration of the plaintiffs was conclusive evidence of their right to the "exclusive use" of their mark, he had jurisdiction to allow the defendant to be registered in respect of his own mark, upon the analogy of the rule that an entry on the Register may be rectified, under sect. 90 (*t*), after five years' registration. He accordingly directed the defendant to be registered as proprietor of his mark for the goods in question, other than the sheep-shears, and dismissed the action, except so far as regarded the last-mentioned goods, in respect of which he granted the injunction the plaintiffs sought.

Where the case made is one of colourable infringement by using part of the registered mark, or a word taken from the registered mark, the defendant may show that he has a concurrent right to the use of the part or word, as, for instance, by prior user of it (*u*).

The defendant should apply to register his own mark or to expunge the plaintiff's.

It will have been observed that in both *Mouson* v. *Boehm* and *Jackson* v. *Napper* there was before the Court an application to register the defendant's mark, and, upon the analogy of the decisions cited above (*x*), that, in the absence of an application to rectify, the registration of the plaintiff's mark is after five years conclusive proof of his right, it would seem that where the plaintiff's mark has been registered for the period named, the defendant, if he wishes to plead an independent right, must apply either to register his own name or to rectify the registration of that of the plaintiff.

Registration gives the defendant a right to use his mark *primâ facie* or conclusive.

It is assumed in the judgments delivered in the above-cited cases, and is besides clearly implied by the Act, that registration when properly made gives the defendant an equal title to use the mark with the plaintiff, but only, of course, according to the terms of the entry. It is just as much an infringement for the defendant to use a registered mark for

(*t*) Chap. XII., p. 309.

(*u*) *Edge* v. *Gallon*, 16 R. P. C. 509, and 17 R. P. C. 557 (1900), C. A. and H. of L. (*Dolly Blue*); *Meaby* v. *Triticine*, 15 R. P. C. 1 (1897), North, J., both "passing off" cases. In an infringement action, the defendant would probably argue alternatively that he had not infringed or that the plaintiff's mark was wrongly registered.

(*x*) Page 361.

goods (*y*), or in a market in respect of which it is not registered, and the plaintiff's mark is registered, as if the defendant's mark were not registered at all. If the plaintiff alleges that the use of the registered mark of the defendant for the goods in respect of which it is registered is an infringement of his mark, his proper course is to apply in the first place to remove the defendant's mark from the Register before commencing, or concurrently with (*z*), the action for infringement.

If the defendant's mark has been registered for five years, on the principle referred to above (*a*), the plaintiff cannot question the right *primâ facie* conferred by the registration except upon an application to vary or expunge the entry; but, as in the corresponding case of the plaintiff's registered mark, where the registration is less than five years old, it appears to be open to the plaintiff to prove by evidence in the action that it does not, in fact, confer any right to the use of the mark (*b*).

Registration at Stationers' Hall.

Registration for copyright purposes of a mark at Stationers' Hall confers no trade-mark rights, and constitutes no defence if the mark is an infringement of another person's trade-mark (*c*).

Is the introduction of the defendant's own mark into a new market an infringement?

If the plaintiff and defendant are severally entitled to, and are the registered proprietors of, two marks which are in ordinary markets distinct and unlikely to be confused, is it an infringement for the defendant to introduce his mark into a market where the plaintiff's is already known, if from the character of the customers there,—their ignorance of English, for instance,—its use is calculated to cause the defendant's goods to be taken for the goods of the plaintiff? It is

(*y*) *Upper Assam Tea Co.* v. *Herbert*, 7 R. P. C. 183 (1889), C. A.

(*z*) As in *Anglo-Swiss Condensed Milk Co.* v. *Metcalf*, 31 C. D. 454; 3 R. P. C. 28 (1886), Kay, J., where the Register was rectified by limiting the goods for which the defendant's mark was registered, and an injunction was granted in respect of other goods.

(*a*) Page 362.

(*b*) *Read* v. *Richardson*, 45 L. T. 54 (1881), C. A., cited, p. 407, interlocutory injunction granted; *Goodwin* v. *Venning*, 24 Sol. J. 690 (1880), Jessel, M. R.

(*c*) *Reinhardt* v. *Spalding*, 49 L. J. Ch. 57 (1879), Hall, V.-C. (*Family Salve*); *Paine* v. *Daniells & Sons' Breweries*, cited p. 372.

submitted that it is an infringement, for the case put falls within the principle that one trader must not do what is calculated to cause his goods to be taken for those of another, and the defendant's action is in this sense the cause of deception. The question was raised, but not determined, in *Johnston* v. *Orr-Ewing*, in the House of Lords, and the words of the order of Fry, J., having special reference to the Bombay trade were, with the assent of the respondents, directed to be omitted. Lord Selborne said, in his judgment in the case: "Your Lordships are not called upon to decide whether a ticket, which was a rightful and *bonâ fide* trade-mark of the trader using it, could be excluded by injunction from particular markets (though unimpeachable everywhere else) merely because in those markets it might be liable to be called by a name which the mark of another trader had already acquired there. . . . To that proposition I should not myself, as at present advised, be prepared to assent" (*d*).

Introduction into a new trade.

The introduction of the defendant's marks into a new trade in goods for which it is not, and the plaintiff's mark is registered, is undoubtedly an infringement (*e*).

Trade-mark rights on the dissolution of a partnership.

Where a partnership is dissolved without a sale of the goodwill, or any arrangement having been made for its disposal, or governing the use of the trade-marks of the firm, each of the late partners who carries on the business may use the trade-marks (*f*), for he is, as to a portion of the

(*d*) 7 App. Ca. p. 227 (1882). See also *Wilkinson* v. *Griffith*, 8 R. P. C. 370 (1891), Romer, J. An injunction, on the ground of "passing off," limited to Ireland was granted in *Barber* v. *Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L. J.

(*e*) Above, p. 387, note (*y*). In *Hodgson* v. *Kynoch*, 15 R. P. C. 465 (1898), Romer, J., the defendants were makers of ammunition. Their works were known as Lion Works, and they had lion trade-marks. Held, that they were not justified in using lion marks for soap.

(*f*) *Banks* v. *Gibson*, 34 Beav. 566 (1865), Romilly, M. R.; *Condy* v. *Mitchell*, 37 L. T. N.S. 268 and 766 (1877), Bacon, V.-C., and C. A.; *Benbow* v. *Low*, 44 L. T. N.S. 875 (1881), Bacon, V.-C. See Chap. XIII., p. 331. As to cases where the severance of business relations determines a joint trade-mark, see *Robinson* v. *Finlay*, 9 C. D. 487; and *Jones' Tm.*, 53 L. T. N.S. 1, cited pp. 53 and 54. As to trade-name on dissolution of partnership, see next chapter, p. 496.

goodwill, a successor of the firm (*g*); but if the goodwill is sold as part of the assets of the firm, the exclusive right to use the trade-marks may be sold with it, and in that case the late partners cannot lawfully use the trade-marks, even though they set up a similar business in competition with the purchaser (*h*).

But a late partner cannot grant to others who are in no way successors to the firm's business, or any part of it, a right or licence to use the trade-marks, even though he be registered as proprietor of the marks under sect. 87, or otherwise. The case of *Hanson* v. *Game, Harrison and Larner, Limited* (*i*), was decided on the construction of a consent order under which the partnership in question had been dissolved, and which provided that the late partners "and any partners they may take respectively" were to have the common use of the trade-marks; but it is submitted that the decision might have been put on the general ground that the defendants—a limited company, of which one late partner was a shareholder and director—could not use the marks without infringing the rights of the plaintiffs, the other late partner and his partners, because they were not possessed of the goodwill of any part of the old business.

Sale of trade-marks in bankruptcy.

So if the trustee in bankruptcy of a trader sells the goodwill and trade-marks of the latter's business, the trader has no right to continue to use the marks (*k*).

Honest use of the defendant's name is no infringement.

A trader who is honestly using his own name in his business will not be guilty of infringement because its similarity to a name appearing in another's trade-mark is calculated to lead to deception. Sect. 64 (3) (i), which relieves an applicant for registration from the necessity of

(*g*) The partners will not be entitled to re-register the marks in their separate names, or (*semble*), if there are more than two partners, to register themselves separately as assignees. The marks, by arrangement, could be assigned to a trustee for all; *Ehrmann's Tms.*, (1897) 2 Ch. 495; 14 R. P. C. 665, Stirling, J.

(*h*) See *Re David and Matthews*, (1899) 1 Ch. 378, Romer, J., cited below, p. 498, where all the authorities are reviewed.

(*i*) 9 R. P. C. 186 (1892), Stirling, J.

(*k*) *Hammond* v. *Brunker*, 9 R. P. C. 301 (1892), Chitty, J.; *Hudson* v. *Osborne*, 39 L. J. Ch. 79 (1869), James, V.-C.

disclaiming his own name or its foreign equivalent if it forms part of the mark tendered for registration, expressly provides that no entry of any such name upon the Register shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof. But to support this defence the business must be his own, for a fraudulent attempt to cover an infringement by employing or taking into partnership a man who happens to bear the name which is to be used to effect the fraud, still less by buying from him the right to use his name, will not avail to protect the offender (*l*).

(3.) The necessity for registration of the plaintiff's marks, having regard to sect. 77, has already been discussed (*m*).

(4.) And so has the question, What constitutes an infringement? (*n*).

Estoppel.

(a) With the exception of the several defences which are considered below, there is nothing peculiar to the law of trade-marks to determine what agreements, or what circumstances constituting a personal estoppel, will prevent a plaintiff from suing a particular defendant for infringement. It is to be remembered, however, that an infringement is primarily a fraud on the public, in respect of which the plaintiff is allowed to sue, because its natural effect is to cause damage to him (*o*). An agreement, therefore, not to prosecute future infringements would be an agreement to permit a fraud, and although, if established, it would undoubtedly prevent the Court from interfering in favour of any party to it (*o*), it could not be specifically enforced, and, unless the intention were clearly indicated, the Court would presume that a lawful

Agreement to condone infringements.

(*l*) See the next chapter, p. 511, where this matter is fully discussed in relation to trade-names.

(*m*) Above, p. 361; Chap. XII., p. 312.

(*n*) Above, p. 363.

(*o*) See *Grezier* v. *Autran*, 13 R. P. C. 1 (1896) (*Chartreuse*), where an agreement was set up, Chitty, J., said, "I need hardly state that the plaintiffs do not move in any sense on behalf of the public."

arrangement, for instance, a waiver of the remedy in respect of past infringements only, was intended (*p*).

Uncandid conduct.

As an instance of estoppel by conduct, the case of *Maxwell* v. *Hogg* (*q*) may be taken. There the defendants had received, and published for reward from the plaintiffs, advertisements of an intended new magazine, bearing the title of a magazine which they were themselves preparing to publish, without warning the plaintiffs of their own intention; and this uncandid conduct was held to be sufficient ground for dismissing the cross suit of the defendants for an injunction to prevent the plaintiffs using the name.

Failure to give warning.

And anything in the nature of a representation by the plaintiff to the defendant that his mark was not an infringement, or that it might be lawfully used, or of an encouragement to him to continue using it, would be an answer to a subsequent claim for damages for infringement, although a mere failure by the plaintiff as soon as he had knowledge of the infringement to warn the defendant, would be no bar (*r*).

The plaintiff is not barred because he uses his registered mark with additions.

It is sometimes urged, on behalf of the defendant, as an objection to the plaintiff's case, that the plaintiff in actual practice uses his mark in a form different from that for which he has obtained registration; but the variation of his registered mark by the plaintiff, provided it is not an infringement of any other person's mark, or a breach of any agreement binding upon him, is perfectly lawful, although so far as the mark actually used differs substantially from his registered mark, it is an unregistered mark, as has been already pointed out. If the registered mark is in substance not used at all, that would be an independent objection to the plaintiff's action (*s*). It is well settled that the use of a varied mark by the plaintiff does not in any way estop him from pro-

(*p*) *Oldham* v. *James*, 13 Ir. Ch. 393; 14 Ir. Ch. 81 (1862), Brady, C., and Blackburn, L. J.

(*q*) L. R. 2 Ch. 307 (1867), Turner and Cairns, JJ., cited p. 33.

(*r*) See *Proctor* v. *Bennis*, 36 C. D. 740 (1887), C. A., a patent case; and the notes to *Savage* v. *Foster*, 2 White & Tudor's Leading Cases, 6th ed., 680. The rule is "*qui potest et debet vetare jubet*"; *Osborn* v. *Lees*, 9 Mod. 96; *Willmott* v. *Barber*, 15 C. D. 96; 17 C. D. 772. As to *delay*, see p. 394.

(*s*) Above, p. 361.

ceeding against infringers. Thus, in *The Melachrino Case* (*t*), the plaintiffs had tried to register a label comprising three coats of arms, but the coats of arms had been rejected and the label registered without them. The plaintiffs, nevertheless, always used the labels with the arms in it, and the defendants, who had imitated the label, were enjoined from continuing the infringement. In a subsequent case (*u*), Chitty, J., said: "I adhere to what I said in *Melachrino's Case*, that the mere addition of something, as, in that case, a coat of arms, to the trade-marks, is not sufficient to disentitle a person who otherwise uses the whole of his trade-marks to sue for an injunction."

Similarly, it is no ground of estoppel that the plaintiff extends the use of his mark to goods in respect of which it is not registered (*x*).

Acquiescence.

(b) Acquiescence in the infringement on the part of the plaintiff is a complete defence (*y*), but it can only be inferred where he is shown to have had knowledge of it (*z*). And, assuming that it is shown that the plaintiff knows of the infringement, the Court will not readily infer that he has assented to what is likely to be so detrimental to his property. It has been held that, where it is pleaded in answer to a motion to commit the defendant for the breach of an injunction restraining him from infringing, it must amount to a licence "sufficient to create a new right in him" (*a*).

(*t*) *Melachrino & Co.* v. *The Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215 (1887), Chitty, J.; *Newman* v. *Pinto*, 4 R. P. C. 508; 57 L. T. 31 (1887), Kekewich, J., and C. A. In *Rowland* v. *Mitchell*, 13 R. P. C. 457; 14 R. P. C. 37 (1896), Romer, J., and C. A., the plaintiff omitted some of the added words and used other words. This was held to be immaterial.

(*u*) *Hammond* v. *Brunker*, 9 R. P. C. p. 307 (1892).

(*x*) *Jay* v. *Ludlow*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.

(*y*) Per Chitty, J., in *Monson & Co.* v. *Bochm*, 26 C. D. p. 406 (1884).

(*z*) *Weldon* v. *Dicks*, 10 C. D. 247 (1878), Malins, V.-C.; *Re Farina*, 27 W. R. 456 (1879), Hall, V.-C., and the last case. See, generally, *De Busche* v. *Alt*, 8 C. D. 286, C. A.; and *Willmot* v. *Barber*, 15 C. D. 96; 17 C. D. 772, Fry, J., and C. A.

(*a*) *Rodgers* v. *Nowill*, 3 De G. M. & G. 614; 22 L. J. Ch. 404 (1853), per Turner, L. J. As to what constitutes acquiescence, see *Proctor* v. *Bennis*, *ante*, p. 391; "delay," section (e); and *Hogg* v. *Scott*, L. R. 18 Eq. 444, Hall, V.-C.; *Weldon* v. *Dicks*, 10 C. D. 247, Malins, V.-C. (copyright); and *Smith* v. *Smith*, L. R. 20 Eq. 500, Jessel, M. R.

In *Rowland* v. *Mitchell* (*b*) Romer, J., said :—"I quite agree that merely threatening a person in cases of this kind, without taking proceedings, is not sufficient. If the plaintiff really does stand by and allow a man to carry on business in the manner complained of, to acquire a reputation, and to expend money, he cannot then, after a long lapse of time, turn round and say that the business ought to be stopped." On the other hand, Russell, L. C. J.(*c*), said in the same case: "It cannot be stated as a general proposition in respect of a person, irrespective of the character of the trade done, and the extent of that trade in respect of the position and impecuniosity of that person, that the moment it comes to the knowledge of a manufacturer that somebody has been trying to do a fraudulent thing on his part he is bound to take proceedings, or if he does not take proceedings, it is concluded against him that he means to acquiesce in the right of that other person to continue to do what he has been doing." The facts of each case must be examined to see whether there has been an acquiescence or not.

Licence.

A licence by the plaintiff to the defendant to use the mark would be proof of acquiescence in user falling within the terms of the licence, and would be a defence (*d*). Any registered proprietor can grant licences to use the mark, subject to any equities affecting it (*e*), unless, for instance, he has agreed with the plaintiff not to do so (*f*). But it is submitted that a licence by some registered proprietor, other than the plaintiff, would not be a defence unless the defendant were possessed of the goodwill of the business, or part of it, to which the trade-mark was attached (*g*).

(ancient lights). See also, generally, the article *Acquiescence* in the Encyclopædia of English Laws, 1897.

(*b*) 13 R. P. C. p. 464. It was held there had been no acquiescence or abandonment in this case, see below, note (*x*). See also on the defence of "standing by," per Byrne, J., in *Jamieson* v. *Jamieson*, 15 R. P. C. 169, at p. 179.

(*c*) 14 R. P. C. at p. 44. See also Kekewich, J., in *Ripley* v. *Bandy*, 14 R. P. C. at p. 596.

(*d*) *Kinahan* v. *Bolton*, 15 Ir. Ch. 75 (1863), Brady, C.

(*e*) Sect. 87.

(*f*) *Hanson* v. *Game, Harrison and Larner, Ld.*, 9 R. P. C. 186 (1892), Stirling, J.

(*g*) See Chap. XIII., p. 335, and sect. 70.

Delay does not bar the right of action;

(c) Mere delay, after knowledge of the infringement, to take proceedings, not sufficient to call the Statute of Limitation into operation, or where the infringement continues, is no bar to the action. Before the Judicature Acts it might have furnished an answer to an application for an injunction (*h*), at least until the plaintiff had established his rights by recovering damages in an action at law, unless the deception resulting from the use of the defendant's mark were still continuing (*i*). But both branches of the Court now enforce legal and equitable rights together, and consequently, wherever an injunction could have been obtained after an action for damages, it can now be obtained at once or concurrently with the judgment for damages. The rule is not peculiar to trade-mark cases, but is part of the general law (*j*). It was stated by Fry, J., in the following terms, in *Fullwood* v. *Fullwood* (2) (*k*): "In my opinion that delay" (from early in 1875, when the plaintiff first knew of the infringement, till November, 1876, when he commenced his action) "—and it is simply delay—is not sufficient to deprive the plaintiff of his rights. The right asserted by the plaintiff in this action is a legal right. He is, in effect, asserting that the defendants are liable to an action for deceit. It is clear that such an action is subject to the Statute of Limitations (*l*), and it is also clear that the injunction is sought merely in aid of the plaintiff's legal right. In such a case the injunction is, in my opinion, a matter of course, if the legal right be proved to exist. In saying that I do not shut my eyes to the possible existence in other cases of a purely equitable defence, such as acquiescence or acknowledgment (*m*), and the various other equitable defences which may be imagined. But lapse of time, unaccompanied by anything else (and to that I con-

(*h*) *Horenden* v. *Lloyd*, 18 W. R. 1132 (1870), Bacon, V.-C., fifteen months' delay: *Estcourt* v. *The Estcourt Hop Essence Co.*, 10 Ch. 276 (1875), Cairns, L. C. and L. JJ., seven months' delay.

(*i*) *Rodgers* v. *Rodgers*, 31 L. T. N. S. 285 (1874), L. JJ.

(*j*) See *The Three Towns Banking Co.* v. *Maddever*, 27 C. D. 533 (1884), C. A.

(*k*) 9 C. D. p. 178 (1878); and see *L. C. & D. Rail. Co.* v. *Bull*, 47 L. T. 413.

(*l*) But where the tort is continuing, the right of action is also continuing.

(*m*) *Quære* abandonment.

fine my observations), has, in my judgment, just as much effect, and no more, in barring a suit for an injunction as it has in barring an action for deceit. In my judgment, the same rule applies since the Judicature Act as formerly applied in the Court of Chancery when the legal right had to be determined in an action at law" (*n*).

but delay may modify the relief granted;

But delay may affect the nature of the relief granted. It may cause the Court to refuse the ordinary interlocutory injunction, either on terms of the defendant keeping an account, or absolutely (*o*), or to refuse to give damages, or to direct an account of profits in lieu of damages, or to restrict such account to profits made since the beginning of the action (*p*).

And in a case where the plaintiffs took no action on hearing that the defendant had received a small consignment of spuriously marked goods, preferring to wait until he received a larger consignment, Malins, V.-C., ordered the injunction to be directed to future receipts by the defendant only (*q*). Unless, however, this case can be supported on the ground of acquiescence, it is submitted that it is inconsistent with the rule established by the cases cited above.

In *Liebig's Extract of Meat Co.* v. *Chemists' Co-operative Soc'y* (*r*), the defendants had used the wrapper complained of since 1893. The plaintiffs discovered in 1894 that the defendants were using it, but they did not know to what extent. They commenced their action in May, 1896, and obtained full relief, *i.e.*, an injunction, an inquiry as to damages, and costs.

and may amount to abandonment.

But delay to pursue infringers, where the infringements are numerous and notorious, may amount to abandon-

(*n*) Cf. the judgment of Mellish, L. J., upon the defence of misrepresentation in *Ford* v. *Foster*, L. R. 7 Ch. p. 632.

(*o*) See below, "Interlocutory injunction," p. 410.

(*p*) See below, "Profits," p. 422. The American law is the same on both points. It is well stated in *McLean* v. *Fleming*, 96 U. S. Rep. 245, followed in *Menendez* v. *Holt*, 128 U. S. Rep. 514 (both Supreme Court), Cox, pp. 326, 407.

(*q*) *The Anglo-Swiss Condensed Milk Co.* v. *The Swiss Condensed Milk Co.*, (1871) W. N. 163.

(*r*) 13 R. P. C. 635, 736 (1896), Kekewich, J., and C. A. A trade-name and passing off case.

ment (*s*) of the trade-mark, and lead to its becoming *publici juris* (*t*).

Delay may be explained.

The delay may be of little importance if it appears that the plaintiff had been led to believe that the infringement had ceased (*u*), or if the infringement is of slight amount. Its bearing on the case must always depend upon the circumstances under which it occurs. Thus in *Rowland* v. *Mitchell* (*x*) the plaintiff knew of an infringement by a third party in 1892. The third party when threatened with proceedings refused to stop, but was not worth suing. The plaintiff lost sight of him, and thought that the infringement had stopped. The action was begun in October, 1895, and the plaintiff obtained an injunction, with an inquiry as to damages and costs.

It has a bearing on the weight of evidence.

And, as already pointed out, delay may have an important bearing on the weight of the evidence in the case, for if, in spite of long user by the defendant of the alleged infringing mark, no case of actual deception is proved, and the absence of evidence of such deception is not otherwise accounted for, it may be difficult for the Court to believe that the defendant's mark is calculated to deceive. It has been suggested that, where the infringement has lasted a number of years, it is necessary for the plaintiff to prove that some persons have actually been deceived (*y*), but this is not, it is submitted, a rule of law (*z*).

Moreover, lapse of time may prevent conduct which would

(*s*) Page 346.

(*t*) As in *Hyde & Co.'s Tm.*, 7 C. D. 724 (1878), Jessel, M. R. (*Bank of England Sealing Wax*); Chap. XIV., p. 339. See also *National Starch Manufacturing Co.* v. *Munns & Co.*, (1894) A. C. 275; 11 R. P. C. 281 (*Maizena*), there cited. In *Ripley* v. *Bandey*, 14 R. P. C. 591 (1897), Kekewich, J. (*Oval Blue*), the action was dismissed, because the plaintiff had known of the use by others of the get-up of which he complained beginning sixteen years before the action. This use was at first small, but ultimately became important. An appeal was compromised, 14 R. P. C. 944.

(*u*) *Daniel and Arter* v. *Whitehouse*, (1898) 1 Ch. 685; 15 R. P. C. 134, Gorell Barnes, J.

(*x*) 13 R. P. C. 457; 14 R. P. C. 37, Romer, J., and C. A., not reported on this point in L. R. The third party was a costermonger. See the passages quoted above, p. 393. Cf. *Ripley* v. *Bandey*, note (*t*).

(*y*) *Rodgers* v. *Rodgers*, 31 L. T. N.S. 287 (1874), per Mellish, L. J.; *Isaacson* v. *Thompson*, 41 L. J. Ch. 101 (1871), Bacon, V.-C.

(*z*) See "Proof of Actual Deception," p. 249.

at first be an infringement from being calculated to deceive. Thus, in *The Marquis of Londonderry* v. *Russel* (*a*), an action against the defendant, for sending coals to the London market as "Londonderry Wallsend Coal," was dismissed because the defendant had used the name for twenty-five years, and the plaintiff had long known of his use of it. Whatever might have been the result had the plaintiff applied in 1861 to restrain the defendant from selling his coals under the name, it was clear, as the Court of Appeal held, that at the time of their judgment the defendant's conduct could not be taken to amount to any representation that his coals came from the plaintiff's Londonderry collieries.

Deceptive trade-mark and fraudulent trade.

(d) The Court will not interfere to protect the use of a deceptive trade-mark, or to assist a trader who is using his mark for the purposes of a fraudulent trade. This principle was well established in the Court of Chancery, and, although no case seems to be reported upon the point, it would no doubt have been recognized also in the Courts of Common Law before the Judicature Acts, had any case occurred, for the maxim *ex turpi causa non oritur actio* is a rule of law (*b*).

"The plaintiff," Lord Westbury said, in *The Leather Cloth Case* (*c*), "desires to restrain the defendant from selling his own goods as the goods of another person; but if, by the use of the trade-mark in question, the plaintiff himself is representing and selling his goods as the goods of another, or if his trade-mark gives a false description of the article, he is violating the rule upon which he seeks relief against the defendant."

Deceptive trade-marks are outlawed.

The deceptive mark, in Sir Roundell Palmer's phrase,

(*a*) 2 Times L. R. 843; 3 Times L. R. 360 (1886), Bacon, V.-C., and C. A.

(*b*) See the judgment of Mellish, L. J., in *Ford* v. *Foster*, L. R. 7 Ch. p. 631 (1872), cited below. In a "get up" case, *Jamieson* v. *Jamieson*, 15 R. P. C. 169, V. Williams, L. J., said, *obiter*, that misrepresentation to the public would be no answer to an action for damages. The misrepresentation alleged was not comprised in the matter sought to be protected, and the Court, in fact, thought there was no misrepresentation. In *Wolff* v. *Nopitsch*, 18 R. P. C. 27 (1901), Lord Alverstone, L. C. J., said that he wished to reserve his opinion on the question whether there was any distinction between cases of trade-mark and of fraudulent passing off.

(*c*) 4 De G. J. & S. 137; 33 L. J. Ch. 199 (1863).

adopted by James, V.-C., in *The Leather Cloth Co.* v. *Lorsont* (*d*), is "outlawed."

Collateral misrepresentation.

The earliest of the cases commonly cited, in which the Court of Chancery refused to interfere, on the ground of the plaintiff's own deceptive conduct, until the plaintiff had established his right by action at law, is *Pidding* v. *How* (*e*), and the leading authority on the subject is the judgment of Mellish, L. J., in *Ford* v. *Foster* (*f*). There it was objected by the defendants that the plaintiff in certain invoices and advertisements had falsely described himself as a patentee; but as the false description was collateral and did not appear in the mark in question, and the plaintiff's trade was not shown to be fraudulent, the Court decided that the plaintiff's legal right of action in respect of the defendant's infringement was not barred, and that he was consequently entitled to an injunction, with an account from the filing of the bill, and costs. If the false representation had been in the trade-mark itself, the Lord Justice held, no Court of Equity, and, according to his opinion, no Court of law, would have entertained the plaintiff's action, and the same rule would apply if the trade were fraudulent; but, he said, "where the trade is, as in this case, a perfectly honest trade, and where the trade-mark is, as in this case, a perfectly honest trade-mark, I am clearly of opinion that there is no common law principle upon which it is possible to hold that the fact that the plaintiff has been guilty of some collateral fraud would be an answer to an action. It would be impossible to plead at law as a justification for the defendant's committing the fraud, that the plaintiff had committed a fraud on someone else." "It is true," he added, "that in this case the bills containing this false representation as to its being a patented article are proved to have been given to the defendants themselves; but there is not the slightest evidence,

Ford v. *Foster*.

The judgment of Mellish, L. J.

(*d*) L. R. 9 Eq. p. 352 (1869).

(*e*) 8 Sim. 477; 6 L. J. Ch. N.S. 345 (1837), Shadwell, V.-C. Lying advertisements as to the origin of tea (*Hourqua's Mixture*). The Vice-Chancellor said, "It is a clear rule, laid down by Courts of equity, not to extend their protection to persons whose case is not founded upon truth."

(*f*) L. R. 7 Ch. 611 (1872) (*Eureka Shirts*). For the American authorities, which are very numerous, see Mr. Cox's note to this case.

or the slightest reason for supposing, that the defendants were ever deceived by that representation, because they knew perfectly well that there was no patent for these shirts" (*g*).

Examples of collateral misrepresentations.

The following are some miscellaneous examples of cases where objections to the plaintiff's case on the ground of collateral misrepresentation failed: title of a magazine protected, although the magazine purported to be written by someone other than the author, *Hogg* v. *Kirby*, 8 Ves. 215; 7 R. R. 30; similar cases with regard to songs, *Chappell* v. *Sheard*, 2 K. & J. 117; *Chappell* v. *Davidson*, 2 K. & J. 123; 8 De G. M. & G. 1; "Holloway's pills and ointment" protected, although the plaintiff called himself Professor Holloway without warrant, and published exaggerated commendations of his pills, *Holloway* v. *Holloway*, 13 Beav. 209; an objection on the ground that the plaintiffs retained a brass plate on the door of their business premises, bearing their predecessor's name, overruled, *Hudson* v. *Osborne*, 39 L. J. Ch. 79.

Sect. 73 provides that it shall not be lawful to register as part of, or in combination with, a trade-mark, any words the use of which would by reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a Court of Justice (*h*).

Application to remove deceptive mark from the Register.

It follows that a trade-mark which contains false statements or misrepresentations ought not to be entered or retained upon the Register, and, in modern cases, if the defendant wishes to rely upon the defence now under consideration, and to allege that the plaintiff's trade-mark itself is deceptive, he commonly applies under sect. 90 to have it removed from the Register (*i*). This is a convenient method

(*g*) See note (*h*) above. The matter is well stated in an American case. "Courts of equity will not protect a trade-mark that deceives the public. We do not suppose, however, that that deception need be of such a character as to work positive injury to purchasers, nor, on the other hand, that every erroneous impression which the public or a portion of the public may receive will be sufficient to destroy the validity of a trade-mark. The question is whether . . . the representation is of such a character as to defeat the petitioner's claim to protection": *Meriden Britannia Co.* v. *Parker*, 12 Amer. Rep. 401, cited by Cox, p. 20.

(*h*) Chap. X., p. 253.

(*i*) *Wood* v. *Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A.; *Dexter's Tm.*, (1893) 2 Ch. 202; 10 R. P. C. 269, Wright, J. See Chap. X., p. 253.

of bringing the question to an issue, if the plaintiff is suing in respect of a registered mark, and it is the most advantageous course for the defendant; but there is no reason to suppose that the Court would be any more ready to interfere to protect a deceptive trade-mark because it was registered, or that it is not open to the defendant to give evidence in support of a plea of the defence in question without there being any application under sect. 90 before the Court (*j*).

(i.) Where the trade-mark itself contains misrepresentations—

The Leather Cloth Case.

In *The Leather Cloth Case* (*k*), the plaintiffs' case failed because, in the label in question, they had described their goods as "tanned leather cloth," "patented," and "J. R. and C. P. Crockett" as the manufacturers, adding an American address, whereas, in fact, much of the cloth for which the mark was used was not tanned, none of it was made under any patent, and the manufacturers were not J. R. and C. P. Crockett, but the plaintiffs themselves, who had no American address. It was urged on behalf of the plaintiffs that the misrepresentations, and in particular the representation that the goods were tanned, could not deceive any ordinary purchaser; but in answer to this Lord Westbury said: "I cannot receive it as a rule either of morality or equity that the plaintiffs are not responsible for a falsehood because it is so gross and palpable that no one is likely to be deceived by it. If there is a wilfully false statement, I will not stop to inquire whether it is too gross to mislead" (*l*).

It is immaterial that the misrepresentation does not deceive;

It is no answer to the objection that the trade, or any other given class of persons, know the actual facts and are not deceived (*m*); for, as in the case of the test of infringe-

or that the facts are known to the trade.

(*j*) As to this point, see *Hubbuck* v. *Brown*, 17 R. P. C. 638 (1900), C. A.

(*k*) 4 De G. J. & S. 137; 33 L. J. Ch. 199, Lord Westbury; and 11 H. L. C. 523; 35 L. J. Ch. 53; H. L. overruling 1 H. & M. 271; 32 L. J. Ch. 721, Wood, V.-C. (1863). See also *Newman* v. *Pinto*, 4 R. P. C. 508; 57 L. T. 31 (1887), C. A., mark representing German cigars as of Havana make, cited p. 410.

(*l*) 33 L. J. Ch. p. 203. So per Fry, L. J., in *Newman* v. *Pinto*, 4 R. P. C. p. 520 (1887).

(*m*) *Wood* v. *Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A.; cf. *Eno* v. *Dunn*, 10 R. P. C. 261 (1893).

ment, the question is—is the mark calculated to deceive any probable purchasers who buy from the plaintiff directly or indirectly through others to whom he sells?

False claim of patent right.

The employment of the word "patent" in a mark used for goods which are not manufactured under an existing patent right has given rise to much discussion (*n*); but the authorities do not seem to have established any more definite rule than that it is in each case a question whether or not the employment of the word makes a false and deceptive claim to a non-existent patent right for the goods (*o*). It is not necessarily deceptive to describe as "patent" goods made according to a process which once was patented, or even those made according to a process which is, or was when the epithet was first applied, different from the common process, though never protected by a patent, for ordinary usage and understanding have long sanctioned such descriptions, as the names patent leather, patent medicine, patent metal, patent yellow, and patent hoe, show (*p*).

Lord Kingsdown's judgment in *The Leather Cloth Case*.

The following passage from Lord Kingsdown's judgment, in *The Leather Cloth Case* (*q*), in reference to the subject under consideration, is very frequently cited in argument: "If a trade-mark represents an article as protected by a patent, when in fact it is not so protected, it seems to me that such a statement *prima facie* amounts to a misrepresentation of an important fact, which would disentitle the owner of the trade-mark to relief in a Court of Equity against anyone who pirated it. In *Flavel* v. *Harrison* (*r*), Wood, V.-C., intimated his opinion that this would be so when there never had been

(*n*) Its use may amount to a criminal offence; sect. 105, and Merchandise Marks Act, 1887, s. 3 (1) (c); Book II., Chap. I., p. 579.

(*o*) The authorities cannot easily be reconciled under one rule: per Kekewich, J., *Hubbuck* v. *Brown*, (1899) W. N. 251; 17 R. P. C. p. 166.

(*p*) See per Wood, V.-C., in *Edelsten* v. *Vick*, 11 Hare, 78 (1853); *Morgan* v. *McAdam*, 36 L. J. Ch. 228 (1866) (*Patent Plumbago Crucibles*); and *Gridley* v. *Swinborne*, 5 Times L. R. 71; 52 J. P. 791 (1888), Coleridge, L. C. J., and Grantham, J., cited p. 580 (*Swinborne's Patent Refined Isinglass*). "The illustrious race whose drops and pills, have *patent powers* to vanquish human ills"—Crabbe, quoted in Ogilvie's Dictionary.

(*q*) 11 H. L. C. 523; 35 L. J. Ch. p. 64 (1865).

(*r*) 10 Hare, 467; 22 L. J. Ch. 866 (1853).

any patent at all. But in the subsequent case of *Edelsten* v. *Vick* (*s*), he seems to doubt whether the rule would be the same if there had originally been a patent, and the statement in the trade-mark being true when first introduced, had been continued after it had ceased to be true. I confess that I should have had great difficulty in assenting to that distinction. If the word 'patent' be not so used as to indicate the existing protection of a patent, but merely as part of the designation of an article known in the market by that term (and this I collect to have been the main ground of his Honour's decision), then I quite agree with his view. In such case nobody is meant to be deceived, or is deceived. A patent may have expired fifty years ago, and yet the name of patent may have become attached to the article, and be used in the trade as designating it. But if the trade-mark represents the article as protected by patent, when in fact it is not so protected, I cannot think that it can make any difference whether the protection has never existed or has ceased to exist."

Expired patent.

And in a later case, Jessel, M. R., said: "No doubt a man may use the word 'patent' so as to deceive no one. It may be so used as to mean that which was a patent but is not so now. In other words, you may state in so many words, or by implication, that the article is manufactured in accordance with a patent that has expired. But if you suggest that it is protected by an existing patent, you cannot obtain the protection of that representation as a trade-mark. Protection only extends to the time allowed by statute for the patent, and if the Court were afterwards to protect the use of the word as a trade-mark, it would, in fact, be extending the time for protection given by the statute. It is, therefore, impossible to allow a man who has once had the protection of a patent to obtain a further protection by using the name of his patent as a trade-mark. But further, no man can claim a trade-mark in a falsehood. It is a falsehood to represent that the patent is still existing" (*t*).

In *The Club Soda Case* the plaintiff's mark consisted of a

(*s*) 11 Hare, 78 (1853).
(*t*) *Cheavin* v. *Walker*, 5 C. D. p. 862 (1877), C. A.

label bearing the words "Club Soda," and also "Manufactured in Ireland by H.M. Royal Letters Patent." This was explained to mean "manufactured by the aid of patented machinery." The offending words were also used in advertisements, but the goods were never called "patent club soda water." The Privy Council held that, having regard to the nature of the goods, no one could be deceived, and they gave judgment for the plaintiff (*u*).

Where "patent" is not deceptive.

From the principles stated in these judgments, and from the decided cases, it follows that the use of the word "patent" in a trade-mark for unpatented goods is not to be taken to be misleading where either it is shown that the market name of the goods comprises the word (*x*), or where the goods are made according to an expired patent, and the word is so used as to be understood to refer to this (*y*), or wherein from the nature of the cases it is unlikely to mislead (*u*).

The following is a summary of the reported cases on the subject (*z*) :—

Summary of cases where "patent" used.

Action barred.

First, where the plaintiff's action was barred: FLAVEL'S PATENT KITCHENER, no patent, *Flavel* v. *Harrison*, 10 Ha. 467; 22 L. J. Ch. 866; PATENTED JAN. 24, '56, patent void, *Leather Cloth Co., Ld.* v. *American Leather Cloth Co., Ld.*, p. 400; *Leather Cloth Co., Ld.* v. *Lorsont*, L. R. 9 Eq. 345; PATENT PLUMBAGO CRUCIBLES, no patent, *Morgan* v. *McAdam*, p. 401; ROYAL LETTERS PATENT, no patent, but duty paid in respect of a patent medicine, *Lamplough* v. *Balmer*, W. N. (1867) 293 (*a*); MANUFACTURER AND PATENTEE, no patent, *Nixey* v. *Roffey*, W. N. (1870) 227; G. CHEAVIN'S IMPROVED

(*u*) *Cochrane* v. *Macnish*, (1890) A. C. 225; 13 R. P. C. 100.

(*x*) *Marshall* v. *Ross*, L. R. 8 Eq. 651 (*Patent Thread*); cf. *Leather Cloth Co.* v. *Lorsont*, L. R. 9 Eq. 345, both (1869), James, V.-C.

(*y*) *Ransome* v. *Graham*, 51 L. J. Ch. 897 (1882), Bacon, V.-C. In *Morgan* v. *McAdam*, 36 L. J. Ch. 228 (1866), Wood, V.-C., suggested that in these cases the date of the patent should be given.

(*z*) *The pages given refer to this book.* See also *Adams' Tm.*, 9 R. P. C. 171; 66 L. T. N.S. 610 (1892), where Kekewich, J., refused to allow "patent" to be struck out of an old mark for furniture polish.

(*a*) "Patent medicines" are excepted from the prohibition upon the sale of poisons in the Pharmacy Act, 1868. The exception relates to medicines manufactured under letters patent only: *Pharmaceutical Society* v. *Piper*, (1893) 1 Q. B. 686; *Stone* v. *Ormson*, (1894) 2 Q. B. 720.

PATENT GOLD MEDAL SELF-CLEANING RAPID WATER FILTER, expired patent, *Chevrin* v. *Walker*, p. 402. In *Hubbuck* v. *Brown*, 17 R. P. C. 638, where the mark included the words HUBBUCK'S PATENT LONDON in circular form with the words WHITE ZINC within the circle, the mark being an old one registered for paints, it was shown that the plaintiffs had never had any patent for White Zinc Paint, and that although they had had a patent, long since expired, relating to the manufacture of oxide of zinc, they had ceased to confine their mark to paint made with oxide of zinc manufactured under the patent. Rigby, L. J., said that, if necessary, he should have held that the plaintiffs were disentitled to sue (*z*).

Action not barred.

Secondly, where the plaintiff's action was not barred: SYKES' PATENT, patent invalid, no plea having reference to the misrepresentation, *Sykes* v. *Sykes*, 3 B. & C. 541 (*a*); TAYLOR'S PATENT SOLID-HEADED PINS, expired patent, labels printed from the old blocks in use while the patent existed, *Edelsten* v. *Vick*, 11 Hare, 78; PATENT THREAD, no patent, evidence that patent was understood in the market to denote the character of the goods, *Marshall* v. *Ross*, L. R. 8 Eq. 651; CLUB SODA, MANUFACTURED IN IRELAND BY H.M. ROYAL LETTERS PATENT, *Cochrane* v. *Macnish*, above, p. 403. The case of *Ransome* v. *Graham*, 51 L. J. Ch. 897, must probably be explained as one of collateral misrepresentation, if it can be supported at all. There the trade-mark consisted of letters and numbers stamped upon the working parts of the plaintiff's ploughs, and "patent" was stamped also, although the only patent which had ever existed related to the plough-shares merely, and had expired in 1817. The plaintiff's advertisements and catalogues stated that the patent had expired, but this could hardly be an answer to the objection, as the notice would not, or might not, reach all the persons who saw the stamp.

"Trade-mark."

It is a misrepresentation which disentitles a label or other

(*z*) See also the *Triticumina Case*, *Meaby & Co.* v. *Triticine*, 15 R. P. C. 1 (1898), where North, J., held that that word was the name of a patented article, and expressed the opinion, without deciding the point, that as the plaintiffs had represented the article as patented, they would be in no better position if the representation were untrue.

(*a*) See *Hubbuck* v. *Brown*, cited above.

trade-mark to protection or to registration, to indorse upon it anything which is calculated to mislead the public as to what is the mark of which the proprietor claims the exclusive use. The matter was first brought forward in *The Apollinaris Case* (*b*), where some of the labels in question had the word *trade-mark* printed immediately under the red triangle or disc, which was their most prominent feature, although other parts of the labels, and, in particular, the words *Apollinaris* and *Friedrichshall*, were claimed as essential features of the trade-marks. The application before the Court was to remove the marks from the Register on several grounds; and Fry, L. J., who delivered the judgment of the Court of Appeal, dealt with the present objection in the following passage (*c*) :— *The Apollinaris Case.*

"One (objection) was, that the mark was calculated to mislead, inasmuch as the whole label is registered as a trade-mark, and yet contains the assertion that the red disc, which is the most conspicuous part of the whole label, is 'trade-mark'—not saying 'a trade-mark,' not saying part of 'the trade-mark'—but an assertion pointing to the conclusion that it, and it alone, is 'the trade-mark,' and therefore that the label, as a whole, is not the trade-mark. Such would have been the impression produced (I am speaking for myself) on my own mind, had I approached the reading of the label unbiassed by what I have learned while sitting in this seat, and such, we think, is the true result of this case. An owner of a registered trade-mark may put it on a registered label, but not so as to mislead a reader of that label, and induce him to believe the only thing registered is the distinctive mark." It is true, the learned Lord Justice added, that the objection might, apparently, have been taken in *Hudson's Case*, where the mark there in question was upheld by the Court of Appeal (*d*), but it was, in fact, neither discussed in argument nor considered by the Court.

This judgment caused a number of applications, under sect. 92, for leave to remove "trade-mark" from registered

(*b*) (1891) 2 Ch. 186; 8 R. P. C. 137, C. A.

(*c*) (1891) 2 Ch. p. 233.

(*d*) 32 C. D. 311; 3 R. P. C. 155 (1886).

marks to be made to the Court. The results of these are stated in Chapter X. (*e*).

It is to be observed that Fry, L. J., does not say that the use of the words "trade-mark" within a label is necessarily misleading; it may be, but it is a question of fact whether it is or not.

Hammond v. *Brunker*.

In *Hammond* v. *Brunker* (*f*), the registered label of the plaintiffs comprised a number of devices, and among them a small blank shield in the middle of the upper half. In use, the plaintiffs printed within the blank shield a hand and forearm holding a dart, and having the words "trade-mark" beneath it. Chitty, J., in rejecting an objection founded upon this, said (*g*): "It is a question of *fact* in every case where a man puts the term 'trade-mark' on his device, or some part of it, whether he does or does not so place the words as to indicate to the public that he is claiming a particular part of the trade-mark only. In *The Apollinaris Case*, the Lord Justice's observations were addressed to a label which had been registered, and had the term *Friedrichshall* above a disc, with a quantity of printed matter; the disc was coloured red, and underneath the disc were the words 'trade-mark.' Without expressing a final opinion on the matter (*h*), the Lord Justice thought that there were grounds for saying, on that label, that the trade-mark referred to the disc, and if I may say so myself, with great respect, it seems to me that there were grounds. But, as I say, this is a question of fact, and I am satisfied that these words 'trade-mark' in the middle of this label do not indicate to the public that the shield only is the trade-mark. In *The Apollinaris Case* there was no other device except the disc, which was coloured red, in use (*i*). That being so, I think that these two grounds of objection to the plaintiff's suing, namely, the addition of the arrow and the forearm, and the addition of

(*e*) Page 250

(*f*) 9 R. P. C. 301 (1892). Chitty, J., came to a similar conclusion of fact in *Benedictus* v. *Sullivan*, 12 R. P. C. 25 (1894), cited below, where the registered trade-mark was the words "La Flor de Margaretta," see at p. 32.

(*g*) Page 307.

(*h*) This is hardly borne out by the report of the judgment of Fry, L. J.

(*i*) But there were the important words *Apollinaris* and *Friedrichshall*.

the words 'trade-mark,' do not disentitle the plaintiff to ask for an injunction with regard to his trade-mark."

In a later case (*k*), Wright, J., held the objection to be fatal to one of the respondents' marks, a label, and ordered it to be removed from the Register. There the main portion of the label was occupied by a picture of the head of a negro, inclosed by a circular band containing the words *W. D. & H. O. Wills, Bristol.* Underneath this picture was printed in very large letters the word *Star*. At the side of the label, on the right, was a representation of an eight-pointed star; and in immediate proximity to the star the words "trade-mark" occurred.

False assertion of registration.

It is a penal offence to describe a trade-mark as registered when it is not (*l*). Such a misrepresentation is, it seems, sufficient to deprive the proprietor of the mark of his right to protection against infringers, or against persons who pass off their goods as his under cover of the mark (*m*). In *The Melachrino Case* (*n*), however, Chitty, J., held that the use of the word "registered" with a mark in which blanks appearing on the registered form were filled up by coats of arms in use, was not a bar to the plaintiff's case; and it has been held by the Court of Appeal that the use of the words "special registered trade-mark," before registration had been obtained, was not a sufficient objection to prevent the Court granting an interlocutory injunction (*o*). And the Court of Appeal has allowed a mark to be registered which had been used with the words "registered shape." In this case both the mark (a dome-topped cylinder) and the words had been impressed on the blocks of blacklead, which were the goods in question,

(*k*) *Dexter's Tm. and Wills' Tm.*, (1893) 2 Ch. 262; 10 R. P. C. 269. See also *Day and Riley* v. *Whittaker*, 17 R. P. C. 817 (1900), Buckley, J., as to the mark No. 70,347.

(*l*) Act of 1883, s. 105, below, p. 639; Merchandise Marks Act, s. 3 (1) (e); see Book II., Chap. I., p. 570.

(*m*) In *Sen Sen Co.* v. *Britten*, (1899) 1 Ch. 692; 16 R. P. C. 137, Stirling, J., said, "Of course, if the plaintiffs are brought within the terms of that section they must be denied relief."

(*n*) 4 R. P. C. 215 (1887).

(*o*) *Read* v. *Richardson*, 45 L. T. 54 (1881), C. A. In *Lewis* v. *Goodbody*, 67 L. T. 194 (1892), Kekewich, J., refused an interlocutory injunction in a passing off case, because the plaintiffs had represented that their mark was a registered trade-mark. See note (*r*).

although the registration of the shape as a design had expired in 1864; but the case was not argued on behalf of the respondents (*p*).

In *Benedictus* v. *Sullivan* (*q*) the plaintiff had printed at the bottom of one of the labels used upon his cigar boxes "Rogd. by H. B. 6458." The label comprised a number of devices and also the words *La Flor de Margaretta*. The words alone had been registered in the trade-mark registry, and they were so registered under Number 6458. It was, however, held upon a consideration of the whole box and its other labels that there was no representation that anything besides the words of the label was registered.

The description of an unregistered trade-mark as a "trade-mark" is no offence within sect. 105, and if the mark is, in fact, as it may be, a trade-mark acquired by user, such description is not by itself a misrepresentation (*r*). But the use of the words "Trade Mark—Registered," or "Registered," is a representation of registration in this country, and, in the absence of words qualifying that meaning, the use of either expression referring to an unregistered mark is an offence under the section (*s*).

Other misleading statements.

It was further suggested, in *The Apollinaris Case*, and the Court of Appeal were inclined to hold, that the indorsement upon one of the labels used for natural mineral waters, and claimed as a trade-mark, "imitations of this water will be prosecuted," meant all imitations, whether fraudulent or not, of the water, and was addressed, therefore, to artificial waters

(*p*) *James' Tm.*, 33 C. D. 392; 3 R. P. C. 340 (1886).

(*q*) 12 R. P. C. 25 (1895), Chitty, J. The label is printed in the report. The label was, in fact, registered at Stationers' Hall, but not under No. 6458.

(*r*) *Sin Sen Co.* v. *Britten*, note (*m*). The mark there was registered in the United States. An interlocutory injunction was granted. Stirling, J., held that the use of the words "trade-mark" was not a pretence of registration. Kekewich, J., who was reported in *Lewis* v. *Goodbody* (note (*o*)), as having decided the contrary, has adopted this ruling: *Hubbuck* v. *Brown*, 17 R. P. C. 148; (1899) W. N. 250.

(*s*) *Wright, Crossley & Co.* v. *Dobbin*, 15 R. P. C. 21 (Q. B. D. Ireland); *MacSymons Stores, Ld.* v. *Shuttleworth*, 15 R. P. C. 748 (Day and Channell, JJ.), both 1898. See also *Winser & Co., Ld.* v. *Armstrong*, 16 R. P. C. 167, as to use of "registered" after expiration of protection of design.

which might lawfully be made and sold as imitations of the natural water, and that, if it bore this meaning, it was calculated to deceive (*t*).

And by the practice of the registry the words "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To counterfeit this is forgery," will not be registered under the Acts, and accordingly should not appear upon the representations of trade-marks forming part of an application (*u*).

The operation of a deceptive misstatement as to the origin of the goods in destroying the distinctive character of the mark, has been referred to in an earlier chapter (*v*). In *The Eton Cigarette Case* (*x*), it was held that an English tobacconist, who put a Russian name, as that of the maker, upon his goods could not protect the mark which they also bore as his trade-mark against infringements.

Fraudulent trade.

(ii) Where the plaintiff uses the trade-mark in aid of a fraudulent trade, the rule which bars his action is so clear that it will be sufficient to summarise the few cases reported on the subject.

Summary of cases.

A plea that the plaintiff made a practice of selling by short weight failed because it was not supported by the evidence, *The Guinea Coal Case*, *Lee* v. *Haley*, L. R. 5 Ch. 155. A Pianoforte Tutor, described as "600th edition, specially revised by Hemy," although the musician referred to had not revised the work for ten years, was held not to be misleading, evidence being given that in the trade an issue of 250 was called an edition, *Metzler* v. *Wood*, 8 C. D. 606. A trade in German cigars sold in boxes bearing a label with the words LA PUREZA (an old Havana brand), HABANA, RAMON ROMEDO, and additional labels with other words and a sham address in Spanish was held to be fraudulent, the whole get-up being described by Bowen, L. J., as "an elaborate concatenation of pictorial lies" intended to pass off the cigars as

Havana cigars.

(*t*) (1891) 2 Ch. p. 226.

(*u*) Instructions 29, Appendix, p. 728.

(*v*) Chap. VIII., p. 186.

(*x*) *Wood* v. *Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A.; *Wolff* v. *Nopitsch*, 17 R. P. C. 321 (1900), Cozens-Hardy, J. (*Spanish Graphite*); on appeal this point was not specially dealt with, 18 R. P. C. 27.

made in Havana, although evidence was given that the name *Havana* in the cigar trade indicates the shape of the cigars only, *Newman* v. *Pinto*, 4 R. P. C. 508; 57 L. T. 31 (*y*); but the sale of English cigars under a label bearing the word HABANA, in boxes marked BRITISH MANUFACTURE, was held not to be fraudulent in the absence of evidence that the plaintiffs represented that their cigars were made in Havana, *Hargreaves* v. *Freeman*, (1891) 3 Ch. 39; 8 R. P. C. 237 (*z*). The application of the name CALIFORNIAN SYRUP OF FIGS to an aperient drug in which fig syrup was used as a flavouring only was held not to be a misrepresentation: *Californian Fig Syrup Co.* v. *Taylor's Drug Co.* (*a*).

Misrepresentation abandoned before, or commencing after action brought.

A misrepresentation which has been corrected and abandoned before the action is no bar (*b*). The same rule is said to apply to one adopted after the commencement of the action. So Fry, J., stated in *Siegert* v. *Findlater* (*c*), for, he said, applying the test laid down by Mellish, L. J., in *Ford* v. *Foster* (*d*), its adoption could not, before Sir John Rolt's Act, have warranted the Court of Chancery in restraining the action had it been commenced in a common law Court. The learned Judge held, however, that in the case before him there was in fact no fraudulent misrepresentation which ought, in any case to debar the plaintiffs. It is submitted, with great deference, that on principle it can make no difference, supposing the plaintiff is seeking the aid of the Court for a fraudulent trade, or for a trade conducted by fraudulent means, that the frauds commenced after the action was begun. The objection is not that the plaintiff's case is incomplete, or that the defendant has any answer as of right to oppose to it, but that the plaintiff and his business are,

(*y*) Cf. *Fuente's Tms.*, (1891) 2 Ch. 166; 8 R. P. C. 214: and *Dexter's Application*, (1893) 2 Ch. 262; 10 R. P. C. 269.

(*z*) Cf. *Benedictus* v. *Sullivan*, above, p. 408, where a Spanish look about the box, and the words "Fabrica de Tabaccos do la Vuelta Abago," was held not to be a representation of foreign manufacture in the face of the words "Regalia Britannica," "Londini"; and *Robinson and Barnsdale, Ld.'s Case*, Times, April 2nd, 1901, cited p. 576.

(*a*) 14 R. P. C. 341 (1897), Kekewich, J., reversed on appeal on another point; 14 R. P. C. 564.

(*b*) *Benedictus* v. *Sullivan*, note (*z*). See also the American case, *Siegert* v. *Abbott* (2) (1891), Cox, p. 486.

(*c*) 7 C. D. 801 (1878) (*Angostura Bitters*).

(*d*) L. R. 7 Ch. 611, cited p. 398.

when the Court takes cognizance of the matter, unworthy of its protection or assistance.

It may here be noticed that in a recent firm-name case the defendants set up that the use of the name by the plaintiffs, a limited company, had been in contravention of sect. 41 of the Companies Act, 1862, but Farwell, J., held that this was no defence (*e*). Alleged illegality of plaintiffs' user.

6. The Relief granted.

If the plaintiff succeeds in an action for infringement, he may obtain an order for—(i.) an injunction restraining further infringements of his rights; (ii.) the delivery up for destruction, or for the erasure of the marks, of any goods already marked with the spurious mark and in the possession or under the control of the defendant; (iii.) and damages in respect of the past infringement, or, in lieu of damages, an account of the profits made by the defendant by the sale of the spuriously marked goods, or for some one or more of these.

(i.) Injunction.

This was the characteristic remedy by which the Court of Chancery protected trade-marks, either after the plaintiff had recovered damages for past infringements at law, or where it had been appealed to in the first instance and no action had been brought. It is generally the most beneficial relief for the plaintiff, because it summarily stops the particular infringement which the defendant has practised, and makes it highly dangerous for him to commence any other, and it is operative against impecunious infringers who might care little for repeated judgments for damages against them. The Merchandise Marks Act of 1862 (*f*) empowered a court of law, in any action for fraudulent infringement, to grant an injunction to the successful plaintiff; and, since the

(*e*) *Pearks, Gunston & Tee, Ld.* v. *Thompson, Talmey & Co.*, 18 R. P. C. 185 (1901) (*Talmey & Co.*). On appeal the case was settled. Cf. Lord Robertson's judgment in *Royal Baking Powder Co.* v. *Wright, Crossley & Co.*, 18 R. P. C. at p. 103.

(*f*) 25 & 26 Vict. c. 88, s. 21, now repealed; see Chap. I., p. 17.

Judicature Acts, both divisions of the High Court have the same power as that formerly exercised by the Court of Chancery.

Further infringement must be threatened or be likely to occur.

The grant of an injunction in trade-mark cases is governed by the general rules governing it where other rights are concerned. There must be some threat or probability that the infringement will be commenced, continued, or repeated, or the Court will not interfere (*g*); but if an actual infringement is shown to have occurred that is usually sufficient, and the plaintiff is not bound to wait until it has been frequently repeated, or until warning has been given and been disregarded (*h*), for "the life of a trade-mark depends upon the promptitude with which it is vindicated" (*i*). So an injunction has been granted where the defendant had altered the device and discontinued the use of the labels complained of, and offered to undertake not to use any more of them (*j*), although, in some instances, the undertaking of an innocent infringer has been accepted by the Court (*k*). Nor is it necessary that any actual infringement should have occurred if it is proved that the defendant contemplates committing or has threatened to commit one (*l*), and it is sufficient evidence of this that he is in possession of a considerable quantity of spuriously marked goods (*m*), even though it is only as a forwarding agent (*n*).

Proof of fraud not necessary.

It has already been shown that the fact that the infringement was not fraudulent (*o*), or even that it was made in

(*g*) The Court will presume that a trader will use his mark so as not to be deceptive, if it is capable of being used without the probability of being deceptive, unless some reason to the contrary is shown: *Kutnow's Tm.*, 10 R. P. C. 401 (1893), cited p. 258.

(*h*) See *Upmann* v. *Forester*, 24 C. D. 231 (1883), Chitty, J., see above, p. 357.

(*i*) *Johnston* v. *Orr-Ewing*, 7 App. Ca. 219.

(*j*) By Malins, V.-C., in *Guinness* v. *Heap*, Seb. Dig. p. 377 (1878); cf. *Tonge* v. *Ward*, 21 L. T. N.S. 480 (1869), Romilly, M. R.

(*k*) *Rose* v. *Loftus*, 47 L. J. Ch. 576 (1878), Malins, V.-C.

(*l*) See *The Emperor of Austria* v. *Day and Kossuth*, 3 De G. F. & J. 217; 30 L. J. Ch. 690 (1861), Campbell, C. and L. JJ.

(*m*) See above, note (*h*).

(*n*) *Upmann* v. *Elkan*, L. R. 12 Eq. 140; L. R. 7 Ch. 130 (1871), Romilly, M. R., and Hatherley, C.

(*o*) *Millington* v. *Fox*, 3 My. & Cr. 338 (1838), Cottenham, C.

ignorance of the plaintiff's right (*p*), is no defence to the claim for an injunction.

Form of injunction (*s*).

The injunction is sometimes directed generally to restrain the infringement of the plaintiff's trade-marks to which his title is established in the case (*q*), but it is usually expressed with more particularity, to restrain the use by the defendant of such trade-marks, or of marks only colourably differing from them, in connection with goods of the kind for which they are registered, by selling or otherwise disposing of the goods marked with such marks. Sometimes the particular colourable infringement of which the defendant has been proved to have been guilty, is expressly referred to in the order, a general restraint being added. And, in some cases, the form of injunction which seems more appropriate to the unspecialized action for "passing off" is made use of also, the defendants being restrained from "in any other way passing off their goods as those of the plaintiff" (*r*). To avoid a discussion upon a motion to commit for an alleged breach of the injunction, it is obviously advantageous for the plaintiff to combine in the order a particular reference to the form of the infringement which has actually been committed or threatened, with general words, as wide as are obtainable, directed to prevent a colourable evasion of the decree (*s*).

As it is not an infringement to use the plaintiff's mark upon his own goods, that is, goods which possess the attribute connoted by the mark (*t*), the injunction is commonly expressed so as to prevent this being a breach of its terms (*u*).

And in cases where the infringement has been effected by

(*p*) *Moet* v. *Couston*, 33 Beav. 578 (1864), Romilly, M. R.; *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185 (1863), Westbury, C.

(*q*) *The Bodega Co., Ld.* v. *Riviere*, 6 R. P. C. 243 (1888), Chatterton, V.-C.; *Montgomery* v. *Thompson*, (1891) A. C. p. 218; 8 R. P. C. 361.

(*r*) *Slazenger and Sons* v. *Feltham & Co.*, 6 R. P. C. 531 (1889), C. A.

(*s*) See the forms of injunction collected in the Appendix, p. 748, and in Seton, 5th ed., Vol. I., 534.

(*t*) Chap. II., p. 32. And see *Condy* v. *Taylor*, 56 L. T. 891 (1887), Kekewich, J.

(*u*) Cf. the "passing off" cases; *Siegert* v. *Findlater*, 7 C. D. 801; and *Braham* v. *Beachim*, 7 C. D. 848, both (1878), Fry, J.

the employment of a word, to the exclusive use of which the plaintiff has no title, the injunction should, it seems, be directed to restrain the defendant from using the word without clearly distinguishing his goods from those of the plaintiff, not to forbid his using it altogether (*x*).

Injunction directed to future consignments of goods only.

In a case where the plaintiffs refrained from taking proceedings on learning that the defendants had received a small quantity of the infringing goods, but waited until they had got a larger consignment, Malins, V.-C., ordered the injunction to be directed to stop the sale of future consignments only (*y*). It is submitted, however, with great deference, that the calculated conduct of the plaintiffs was not a sufficient reason for allowing the goods already received to be sold under the deceptive labels, although it might have been an answer to a claim for damages for past infringements.

Injunction refused because of acquiescence.

It has certainly been held that acquiescence, not sufficient to bar the plaintiff's right, may, in some classes of actions, cause the Court to refuse relief by injunction, and to grant the plaintiff damages only (*z*), but the case last referred to did not involve any continuing fraud or deception (*a*).

Injunction limited to a particular market.

The injunction may also be limited with reference to the use of the mark in a particular country or market (*b*), for

(*x*) *Seixo* v. *Provezende*, L. R. 1 Ch. (1865), Wood, V.-C., and Cranworth, L. C.; *Johnston* v. *Orr-Ewing*, 13 C. D. 434; 7 App. Ca. 219 (1880), Fry, J., C. A. and H. L.; and see *Montgomery* v. *Thompson*, (1891) App. Ca. 217; 8 R. P. C. 361; and *Reddaway* v. *Banham*, (1896) A. C. 199; 13 R. P. C. 218; and also the special proviso to the injunction in *Bewlay* v. *Hughes*, 15 R. P. C. 290 (1898), North, J.

(*y*) *The Anglo-Swiss Condensed Milk Co.* v. *The Swiss Condens.' Milk Co.*, W. N. (1871), 163.

(*z*) *Sayers* v. *Collyer*, 28 C. D. 103, per Fry, L. J. A restrictive covenant in regard to buildings case. And below, p. 426.

(*a*) The action for infringement may wholly fail, because the defendant has used the plaintiff's mark so long that there is no longer any deception, as in *The Marquis of Londonderry* v. *Russel*, 2 Times L. R. 843; 3 Times L. R. 360 (1886), Bacon, V.-C., and C. A. Above, p. 397.

(*b*) *Carver* v. *Bowker*, Seb. Dig. p. 350 (1877), Little, V.-C.; *Barber* v. *Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L. J.; see *Société, &c. de l'Étoile's Tm.*, 10 R. P. C. 436; (1894) 1 Ch. 61, Stirling, J., and above, pp. 222 and 366.

instance, if it is calculated to deceive there only (*c*), or in a particular manner, as by sending goods marked with it to English ports for shipment to the colonies (*d*).

Interlocutory application for an interim injunction.

The plaintiff in an infringement or "passing off" action usually moves, as soon as the action is commenced, for an interim injunction to restrain the defendant, until the hearing of the action or further order, from continuing or committing the infringement or deceptive conduct of which he complains, either getting leave to serve notice of motion with the writ (*e*), or serving it after the defendant has appeared. In a plain case the motion is, in the first instance, often made *ex parte* for an injunction until the day for which the notice of motion is given; and in a case where the defendant is committing a deliberate fraud, it is important, if possible, to obtain an *ex parte* order before giving him a notice which may lead to the disposal of any spurious goods which he is about to put upon the market.

Balance of convenience.

Where the plaintiff's title is disputed, or the fact of infringement is doubtful, or misrepresentation amounting to a bar to the action, or some other defence is plausibly alleged upon the interlocutory motion, the Court, in granting or refusing the interim injunction, is guided principally by the balance of convenience, that is, by the relative amounts of damage which seem likely to result if the injunction is granted and the plaintiff ultimately fails, or if it is refused and he ultimately succeeds. Thus, in *Read* v. *Richardson* (*f*), on the defendants undertaking to keep an account, Jessel, M. R., refused an interlocutory injunction; but the Court of Appeal granted it because, while the defendants had only recently commenced to use their mark, and their trade was admittedly not dependent on

(*c*) See *Wilkinson* v. *Griffith*, 8 R. P. C. 370 (1891), Romer, J., and above, p. 366. Cf. *Cowie* v. *Herbert*, 14 R. P. C. 436 (1897), Court of Sess.

(*d*) *Rodgers* v. *Rottgen*, 5 Times L. R. 678 (1889), Kay, J.

(*e*) O. 52, r. 9.

(*f*) 45 L. T. 54 (1881) (*Dog's Head Beer*). In *Evans* v. *Smith*, 3 Times L. R. 390 (1887), Kay, J., refused an interlocutory injunction because it was a serious question whether the plaintiff's registered trade-mark *Montserrat* was a "special and distinctive word." But *quære* whether sufficient weight was given to sect. 76 in this case; see above, p. 361, note (*d*).

it, the plaintiffs had a large trade in connection with which they used the label alleged to be infringed, and their rights would have been irremediably and incalculably injured unless the injunction were granted, if their case should be established at the trial. In this action the defendants' mark had been registered as well as the plaintiffs', and the defendants asserted that the plaintiffs' action was barred because the plaintiffs had, before registration, printed the words "specially registered trade-mark" upon their labels (*g*).

As appears by the cases just cited, it is not necessary for the plaintiff, upon the interlocutory application, to give conclusive evidence as to his title to the mark It is sufficient if he makes it appear probable that he will succeed at the hearing, at least in order to bring the question of balance of convenience before the Court, and where there is reason to doubt the good faith of the defendant, the Court is more easily induced to interfere (*h*).

Interim injunction refused on account of delay.

The interim injunction will not be granted if the plaintiff has delayed interfering until the defendant has built up a large trade in which he has notoriously used the mark (*i*), or if the plaintiff has delayed for a considerable time after he knew of the matters complained of, unless the delay is explained (*k*). But a slight use of the defendant's mark, chiefly upon sales to a few purchasers for their private use, will not prevent the Court from interfering in a case where the plaintiff's trade is considerable (*l*).

(*g*) As to this plea, see above, p. 407. Jessel, M. R., had refused the injunction on the ground of no apparent infringement. See also *Parker and Smith* v. *Satchwell*, 17 R. P. C. 713 (1900), where the Court of Appeal in a passing off case granted an interlocutory injunction, which had been refused by Cozens-Hardy, J., on the ground of no probability of deception. In *Alaska Packers' Association* v. *Crooks*, 16 R. P. C. 503, an interlocutory injunction granted on the balance of convenience by Kekewich, J., was discharged on special (arranged) terms. The plaintiffs failed at the trial, 18 R. P. C. 129 (1901).

(*h*) *Radde* v. *Norman*, L. R. 14 Eq. 348 (1872), Wickens, V.-C.

(*i*) Above, pp. 392 and 395.

(*k*) *North British Rubber Co.* v. *Gormully Co.*, 12 R. P. C. 17, (1894) Chitty, J., a patent case.

(*l*) *Apollinaris Co.* v. *Herrfeldt*, 4 R. P. C. 478; 4 T. L. R. 9 (1887), Chitty, J., and C. A. *Apollinis*, used in Germany from 1876, and in England from 1881. *Derby Photographic Dry Plate Co., Ld.* v. *Pollard*, 2 Times L. R. 276 (1886), Bacon, V.-C.;

If the plaintiff intends to ask for an interim injunction he ought to apply for it as soon as possible after commencing proceedings (*m*).

Application adjourned to the trial.

And if no actual infringement is in progress, and no harm is likely to be done, and the motion is seriously contested, it is usually referred to the trial.

Interim injunction limited as closely as possible;

The interim injunction being intended only to preserve the plaintiff's rights from serious detriment until the hearing is, at any rate in cases which appear to be doubtful or honestly disputed, limited as closely as possible to what is sufficient to attain that end (*n*). It is only granted upon the plaintiff undertaking to be responsible in damages for the loss (if any) occasioned by it to the defendant, should it turn out at the hearing that it ought not to have been granted (*o*).

only granted on undertaking as to damages.

A common form of interlocutory injunction is to restrain a wharfinger or consignee from passing into the market goods alleged to bear spurious marks until the trial or further order (*p*).

Since registration is *primâ facie* evidence of title, and, in the absence of an application to rectify, conclusive evidence after five years, if the plaintiff's mark is registered, but it is desired to dispute his title to it, the defendant's proper course is to apply to expunge the mark under sect. 90 (*q*). This is the course usually adopted, and a large proportion of the seriously contested trade-mark cases commence with cross motions for an interim injunction, and to expunge or vary the plaintiff's registered mark.

Cross motions for injunction and to expunge.

In a case where the defendant claimed a right to the mark

Isaacson v. *Thompson*, 41 L. J. Ch. 101 (1871), Bacon, V.-C.

(*m*) *Knowles* v. *Bennett*, 12 R. P. C. 137, (1894) Robinson, V.-C., a designs case.

(*n*) See *Apollinaris Co.* v. *Herrfeldt*, 4 R. P. C. 478; 4 T. L. R. 9 (1887), Chitty, J., and C. A.; and *Alaska Packers' Association* v. *Crooks*, *supra*, note (*g*).

(*o*) As to the calculation of the damages covered by the undertaking, see *Mansell* v. *The British Linen Co. Bank*, (1892) 3 Ch. 159. Under special circumstances the defendant may be left to move specially to enforce the undertaking: *J. & J. Cash, Ld.* v. *Cash*, 18 R. P. C. 213 (1901), Kekewich, J.

(*p*) *Rivero* v. *Norris* (1868), Seb. Dig. p. 178; Seton, 5th ed., p. 536, Giffard, V.-C.; *Del Valle* v. *Mayer* (1870), Seb. Dig. p. 195; Seton, *ibid.*, James, V.-C.

(*q*) *Apollinaris Co.* v. *Herrfeldt*, 4 R. P. C. 478; 4 T. L. R. 9 (1887), Chitty, J., and C. A.; *Read* v. *Richardson*, 45 L. T. 54, cited p. 415; and see above, p. 361.

in question, and had applied to register it himself, an interlocutory motion for an injunction by the plaintiff was ordered to stand over pending the result of the application (*s*).

Undertaking to keep an account.

And sometimes, where there is a substantial case to be tried, the application for an interim injunction is ordered to stand over to the hearing upon the defendant undertaking to keep an account of his sales under the mark objected to (*t*).

Enforcement of the injunction.

Breaches of the injunction are contempts of Court, which may be punished by the committal or attachment (*u*) of the guilty person, or by ordering him to pay a fine or costs. "Committal was the proper remedy for doing a prohibited act, and attachment the proper remedy for neglecting to do some act ordered to be done," but there is now no substantial difference between the two (*x*). The course usually adopted is to move to commit, the notice of motion being personally served upon the respondent, or if this is impracticable, leave for substituted service being obtained (*y*).

The order granting the injunction should be forthwith drawn up and served upon the defendant, but no formal service or notice of it is necessary to enable the Court to enforce it. It is sufficient to subject him to the risk of committal if he infringes it that the defendant or other respondent is shown to have been in fact aware of the order for the injunction having been granted or made (*z*), although, as a general rule, a person intending to ask the Court to enforce an order by committal or attachment should proceed strictly (*zz*).

Unintentional breach of the injunction.

The principal question upon an application to commit for

(*s*) *Edwards* v. *Elkan*, 5 R. P. C. 70 (1887), Stirling, J.

(*t*) *Mitchell* v. *Henry*, 15 C. D. 181 (1880), C. A.; *Apollinaris Co.* v. *Snook*, 7 R. P. C. 474 (1890), North, J.

(*u*) O. 42, r. 7, or in the case of a corporation, by sequestration of its property or attachment of its officers, O. 42, r. 31.

(*x*) *Callow* v. *Young*, 56 L. T. 147; *Harvey* v. *Harvey*, 26 C. D. p. 654; *Evans* v. *Noton*, (1893) 1 Ch. 252. The proper remedy for the breach of an *undertaking* is committal: *D.* v. *A. & Co.*, 1900, W. N. 30.

(*y*) See the notes to O. 44, r. 1, in the Annual Practice.

(*z*) *Marcovitch* v. *Bramble, Wilkins & Co.*, Seb. Dig. p. 363 (1878), Malins, V.-C. Annual Practice note to O. 42, r. 7; and see *United Telephone Co.* v. *Dale*, 25 C. D. 778.

(*zz*) *Incandescent Gas Light Co.* v. *Riemer*, 17 R. P. C. 378 (1900), C. A.

breach of an injunction restraining the infringement of a trade-mark is, generally: Does the new mark of the defendant constitute an infringement or not? And it may be assumed that if the Court is satisfied that the defendant has honestly tried to select a mark which is not objectionable, having regard to its order, it will be unwilling to send him to prison because he has failed in his endeavour. But the Court has jurisdiction to commit for disobedience to an order which is not shown to have been wilful (*a*). If the defendant is in the wrong, even though by mistake or misfortune, he is usually ordered to pay the costs of the motion (*b*). A mere servant of the defendant should not be joined as respondent to a motion to commit (*b*).

Choice of a new mark by the defendant.

It may be safely assumed also that in the case suggested above the Court will be careful not to compel an honest trader to alter his mark more than is necessary to protect the plaintiff's rights. But the following passage from Lord Romilly's judgment, in *Bass* v. *Dawber* (*c*), goes, perhaps, too far, for the plaintiff is entitled to have the full extent of his right secured to him, without reference to the loss which it occasions to the defendant. "If a person has *bonâ fide* taken a label or trade-mark which does resemble the label of another person, and this is not done with the intention to deceive, the Court will not require him to change it completely, because the change of a trade-mark is a serious thing. . . . It is like beginning a new firm."

In a case where the plaintiff refused to take any notice of a label which the defendant suggested and proposed to adopt in lieu of the label against the use of which the injunction was granted, Langdale, M. R., himself undertook to determine whether the distinction between the labels was sufficient (*d*).

Delay in application to commit.

If the plaintiff delays taking steps to enforce the injunc-

(*a*) *Hewitt* v. *Mansell*, 29 Sol. J. 66.

(*b*) *Daniel and Arter* v. *Whitehouse*, 16 R. P. C. 71 (1899), North, J.

(*c*) 19 L. T. N.S. 626 (1869), Seb. Dig. p. 186.

(*d*) *Croft* v. *Day*, 28 Leg. Obs. 378; Seb. Dig. p. 39 (1844), on a motion to commit. The French Courts, apparently, will order affirmatively what the defendant is to do: see *Grezier* v. *Autran*, 13 R. P. C. at p. 10; see also *Rodgers* v. *Nowill*, note (*e*).

tion for a considerable time after he knows of the fresh infringement, the delay may cause the Court to refuse to commit; but if the infringement is continuing, it has been said that "there must—in order to deprive the party who has obtained the injunction of the right to move for committal upon the breach of it—be a case made out almost amounting to such a licence to the party enjoined, to do the act enjoined against, as would enable him to maintain a bill against others for doing the act. The party enjoined must, I think, show such acquiescence as would be sufficient to create a new right in him" (*e*). In the case just quoted, the injunction was granted in 1847, the new infringement began in 1848, and was continued until the motion to commit in 1853. The Lords Justices, however, were not satisfied that the plaintiffs were aware of it. Stuart, V.-C., refused the motion on the ground of the delay, but the Lords Justices directed that the defendant should be committed unless, within a week, he suggested, and undertook to use for the future, a mark which the Court should consider satisfactory, and they ordered that he should pay the costs of the motion.

In *Cartier* v. *May* (*f*), where the plaintiff delayed moving for fifteen months after the defendant had commenced a new infringement not expressly covered by the injunction, Wood, V.-C., refused to commit the defendant, but ordered him to pay the costs of the application, and enlarged the injunction so as to make it extend to the new fraud.

(ii.) Delivery up of the marked articles.

Erasure of the spurious marks.

The Court not only forbids further infringement by its injunction, but, where the defendant is proved to have spuriously marked articles in his possession or under his control, it also orders the erasure of the marks (*g*), or the

(*e*) Per Turner, L. J., in *Rodgers* v. *Nowill*, 3 D. G. M. & G. 614; 22 L. J. Ch. 404 (1853).

(*f*) Seb. Dig. p. 111 (1861).

(*g*) *Dent* v. *Turpin*, 2 J. & H. 139; 30 L. J. Ch. 495 (1861), Wood, V.-C.; *Upmann* v. *Elkan*, L. R. 12 Eq. 140; 7 Ch. 130, Romilly, M. R., and Hatherley, L. C., note (*l*) below.

delivery up of the marked articles for that purpose, or, if erasure is impracticable, for destruction (*h*). Thus, in *Slazenger* v. *Feltham* (*i*), where the word *Demotic*, an infringement of the plaintiffs' mark *Demon*, was stamped upon the defendants' tennis racquets, the order of Kekewich, J., for the destruction of the racquets, was varied by the Court of Appeal, upon it being pointed out that the spurious mark could be planed off; and it was ordered that the defendants should make an affidavit verifying the number of the racquets, and that they should either deliver up the racquets to the plaintiffs, to be destroyed, or satisfactorily erase from them the name *Demotic*, in the presence of the plaintiffs or their agent.

Interests of innocent persons in the marked goods unaffected.

Lien for costs.

The lien of a wharfinger for his charges in regard to goods deposited with him, including the costs he is put to by being made a defendant in a trade-mark action, is not destroyed if the goods turn out to be spuriously marked (*k*); and although, in some earlier cases (*l*), the plaintiff was adjudged to have a lien upon the goods, subject to that of any wharfinger or mortgagee who had an earlier charge, and who was innocent in regard to the infringement, the Court of Appeal, in the case last cited (*k*), expressed considerable doubt whether such a lien could be supported. Of course, neither the wharfingers nor any other persons interested in the goods would be allowed to sell or dispose of the goods until the spurious marks were removed.

(*h*) *Farina* v. *Silverlock*, 4 K. & J. 650 (1858), Wood, V.-C. The repealed Merchandise Marks Act of 1862, s. 21, empowered the Court to direct any chattel to which any trade-mark had been fraudulently applied, or which had been exposed for sale with a forged or counterfeited trade-mark applied to it, to be destroyed or otherwise disposed of. The Act of 1887 empowers it to forfeit every chattel by means of, or in relation to which, an offence under the Act has been committed, to Her Majesty, and it contains a power for the Court to order the destruction of the forfeited articles; sect. 2 (3), (4); Book II., Chap. I., pp. 611, 619.

(*i*) 6 R. P. C. 531; 5 T. L. R. 365 (1889), Kekewich, J., and C. A.

(*k*) *Moet* v. *Pickering*, 6 C. D. 770: 8 C. D. 372 (1877), C. A. reversing Fry, J.

(*l*) *Ponsardin* v. *Peto*, 33 Beav. 642; 33 L. J. Ch. 371 (1863), Romilly, M. R.; *Upmann* v. *Elkan*, L. R. 12 Eq. 140; L. R. 7 Ch. 130 (1871), Romilly, M. R., and Hatherley, C.

The duty of the bailee of infringing goods.

A wharfinger, transport agent, or other bailee who finds that goods committed to his charge are spuriously marked, therefore, is justified in refusing to deliver them up until the objectionable marks have been erased (*m*). And, further, he is entitled to an indemnity from the bailor against the damages and costs incurred by him by reason of his dealing with the goods at the latter's request (*n*). His proper course, on being informed by the owner of the trade-mark infringed, or his agents, that goods in his possession are spuriously marked, is to give all necessary information to enable them to stop the infringement, to undertake that the goods shall not be removed or dealt with until the spurious marks have been obliterated, and to give the persons injured all requisite facilities for that purpose (*o*). If he takes this course, the costs of any proceedings subsequently taken against him by the plaintiff will be ordered to be paid to him (*p*); but he must pay the costs of proceedings previously taken, even though in an action commenced without notice to him (*q*), unless the value of the infringing goods in his possession is trifling (*r*).

(iii.) Damages or Profits.

Nominal damages.

It was long ago decided at common law, that the mere proof of an infringement entitles the plaintiff to nominal damages (*s*), and that, consequently, no allegation of special

(*m*) *Hunt* v. *Maniere*, 34 Beav. 157; 34 L. J. Ch. 142 (1864), Romilly, M. R., and L. JJ. Action by indorsee of dock warrants against wharfingers restrained. In *Knowles* v. *Bennett*, 12 R. P. C. 137 (1894), Robinson, V.-C., shipowners were restrained from parting with the goods except to the plaintiffs.

(*n*) *Dixon* v. *Fawcus*, 3 E. & E. 537; 30 L. J. Q. B. 137 (1861).

(*o*) *Upmann* v. *Elkan*, L. R. 12 Eq. 140; L. R. 7 Ch. 130 (1871), Romilly, M. R., and Hatherley, C.

(*p*) Last case, and *Moet* v. *Pickering*, 6 C. D. 770; 8 C. D. 372 (1877), Fry, J., and C. A.

(*q*) See last cases, and *Upmann* v. *Forester*, 24 C. D. 231 (1883), Chitty, J.

(*r*) *American Tobacco Co.* v. *Guest*, (1892) 1 Ch. 630; 9 R. P. C. 218, Stirling, J.

(*s*) *Blofeld* v. *Payne*, 4 B. & Ad. 410; 2 L. J. K. B. N.S. 68 (1833). In *Daniel* v. *Whitehouse*, 15 R. P. C. 134 (1898) Gorell Barnes, J., 40*s*. damages were given.

damage is a necessary part of his case (*t*). And the natural consequence of an infringement, even though it be made in complete ignorance of the plaintiff's rights, is that the infringer must pay at least nominal damages, and the costs of action, so that, if he acted under the direction of a third person, he may reasonably compound with the proprietor of the trade-mark on these terms, and claim an indemnity from his employer (*u*).

Indemnity to agent or purchaser.

But, if the plaintiff claims substantial damages, the onus of showing what loss he has actually sustained by reason of the defendant's conduct, lies upon him; and it will not be presumed, in the absence of evidence, that the amount of goods sold by the defendant under the infringing trade-mark would, but for the defendant's unlawful use of the plaintiff's mark, have been sold by the plaintiff (*x*). The proper form of an order for an inquiry as to damages occasioned by the infringement of a trade-mark is, therefore, what damage (if any) has the plaintiff sustained (*y*).

Onus of showing substantial damage lies on the plaintiff.

In general, the only injury which is done by an infringe-

(*t*) *Rodgers* v. *Nowill*, 5 C. B. 109; 17 L. J. C. P. 52 (1847). See also *Reddaway* v. *Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639; 9 R. P. C. 503.

(*u*) *Dixon* v. *Fawcus*, 3 E. & E. 537; 30 L. J. Q. B. 137 (1861). As to implied warranty by the use of a trade-mark, see below, Chap. XVII., p. 521.

(*x*) *Leather Cloth Co.* v. *Hirschfield*, L. R. 1 Eq. 299 (1865), Wood, V.-C.; *Magnolia Metal Co.* v. *Atlas Metal Co.*, 14 R. P. C. 389 (1896), Collins, J., and C. A. (a passing-off case). If there is a demand which remains unsatisfied after the infringing goods have been sold, it may be inferred that genuine goods would have been sold in place of all the latter: *Alexander* v. *Henry*, 12 R. P. C. 360, (1895) Kekewich, J. In the United States there appears to be a question whether any recognized rule of law exists on the point or not. Mr. Cox says (p. 198): "There is a conflict between the cases as to the proper measure of damage for the infringement of a trade-mark. It has been held in many instances that the profits of the defendant is the true measure, and in others that it is the profits which would have been realized by the plaintiff had he sold the quantity of goods shown to have been sold by the defendant. Perhaps the most authoritative decision on the subject is *Faber* v. *Hovey* (Codd. Dig. 79, 249 (1875)), decided by the General Term of the Supreme Court of New York, and affirmed on appeal by a divided Court, in which the latter rule was applied, although the mark involved was of a strictly technical nature." As is stated in the text, the plaintiff in England has usually the option of taking the defendant's profits in lieu of damages.

(*y*) *Davenport* v. *Rylands*, L. R. 1 Eq. p. 308, per Wood, V.-C.

ment is that the defendant's goods are sold instead of those of the plaintiff, and the sale of the latter is, in some degree, diminished in consequence. But it may, under exceptional circumstances, appear that further damage has been done, for instance, where the spurious goods are so inferior to the genuine as to injure the trade reputation of the plaintiff (*z*), or where the stress of the competition compels the plaintiff to lower his prices in order to avoid being driven from the market, and the reduction does not, as it may, bring him a sufficient increase of business to make up for the loss of profit on each article sold (*a*).

The case of *Alexander* v. *Henry* (*a*) is an example of such exceptional circumstances as are referred to above. There the plaintiffs had had complete command of the Mexican market for their thread until it was taken from them by the fraudulent imitations of their marks in respect of which the damages were awarded. The result of the imitations was (1) to enable the defendants to make sales which would otherwise have been made by the plaintiffs; (2) to compel the plaintiffs to reduce their prices; and (3) to so injure the plaintiffs' reputation that the defendants were able to sell goods, without disguise (*b*), in competition with them. The action was not defended, and the assessment of damages was referred to an Official Referee who awarded 772*l.* under head (1), and 2,295*l.* under head (2) against one set of defendants (the Henrys), and a lump sum of 5,000*l.* (apparently) under head (3) against the other set of defendants (the Wallers). On an appeal to Kekewich, J., this award was supported.

If the infringement is a continuing one, the damages ought to be assessed down to the time of the assessment (*c*).

Damages or profits.

The plaintiff may, in general, make his choice of either an account and payment to him of the profits which the defen-

(*z*) *Sykes* v. *Sykes*, 3 B. & Cr. 541; 3 L. J. K. B. o.s. 46 (1824).

(*a*) See the patent cases: *American Wire Co.* v. *Thomson*, 44 C. D. 274; 7 R. P. C. 152 (1890), C. A.; and *United Horseshoe Co.* v. *Stewart*, 13 App. Ca. 401; 5 R. P. C. 260 (1888), both discussed in *Alexander* v. *Henry*, 12 R. P. C. 360 (1895), Kekewich, J., and *British Motor Syndicate* v. *Taylor*, 17 R. P. C. 180, 723 (1900).

(*b*) This appears to be the meaning of paragraph 3 of the referee's report.

(*c*) O. 36, r. 58.

dant has gained by his wrongful conduct, or an inquiry as to, and payment of, the damages occasioned to the plaintiff by reason of it, that is, unless the case is tried before a jury and damages are assessed by the jury at once, or assessed by the judge sitting alone, acting as a jury. But if the Court is satisfied that the defendant's goods have not, to any substantial extent, been passed off as those of the plaintiff, although infringing or deceptive marks have been used upon them, the plaintiff ought not, it is submitted, to be given any option. To allow him to take the profits made by the defendant's trade in goods which were in fact sold without deception would be unjust (*d*).

Account of profits and damages are alternative.

The account and inquiry are alternative remedies (*e*), for though in some of the earlier cases they were both allowed, they are now considered to be inconsistent. "If you take an account of profits, you condone the infringement," Lord Westbury said, in a patent case (*f*), and the same rule applies in trade-mark cases also.

Account or inquiry only granted if substantial damage is shown.

But neither an account nor an inquiry as to damages will be granted if the evidence of sales under the objectionable mark is not sufficient to make it worth while (*g*), or if it appears that the defendant has only used his mark for a short time (*h*). For instance, no account or damages was allowed or given in a case where the only infringement proved was by the defendant, at the request of a customer, filling with lime-juice of his own make, a bottle embossed with the plaintiff's mark, removing the plaintiff's label, and replacing it by his own (*i*).

They only go back for six years;

Damages can only be recovered, and the profits to be included in the account can only be reckoned, in respect of

(*d*) *Hodgson* v. *Kynoch*, 15 R. P. C. 465 (1898), Romer, J.; but cf. *Saxlehner* v. *Apollinaris Co.*, cited below, p. 427.

(*e*) Per Cotton, L. J., in *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887).

(*f*) *Neilson* v. *Betts*, L. R. 5 H. L. 1 (1871); followed in *De Vitre* v. *Betts*, L. R. 6 H. L. 319 (1872).

(*g*) *Sanitas Co., Ld.* v. *Condy*, 4 R. P. C. 530 (1887), Kekewich, J.; neither was granted in *Magnolia Co.* v. *Atlas Co.*, 14 R. P. C. 389 (1896), Collins, J., and C. A., although the plaintiffs obtained an injunction.

(*h*) *McAndrew* v. *Bassett*, 10 Jur. N.S. 495 (1864), Westbury, C.

(*i*) *Rose* v. *Loftus*, 47 L. J. Ch. 576 (1878), Malins, V.-C.

infringements occurring within six years from the issue of the writ (*k*), subject to the exception in the case of concealed fraud, which is part of the general law.

and, as against innocent purchasers or bailees, only to notice of infringement.

It has been shown that it is no answer to the claim for an injunction that the infringement was effected innocently, in ignorance of the existence of trade-mark rights; but damages or an account of profits are only calculated as against an innocent dealer in, or purchaser of, the spuriously marked goods, in respect of sales, dealings, or other infringements, if any, of which he is guilty after becoming aware of the plaintiff's rights (*l*).

The case of a manufacturer who copies a mark he finds on goods which he knows are not his own is different. He may not know whose mark it is, and may possibly be in doubt whether it is a trade-mark or not, but he knows that he has no right to the mark, and the damages or account are therefore calculated as against him from the first infringement, within six years of the writ (*m*).

Refused because of delay or acquiescence.

The Court has refused, in some cases, to order an account of profits where the plaintiff has neglected to take proceedings after becoming aware of the infringement (*n*); and it may be assumed that it certainly would not assist the plaintiff to recover profits which he had deliberately allowed the defendant to earn in the expectation of obtaining them from him (*o*). But delay in order to obtain evidence necessary to establish his case would not bar the plaintiff of his ordinary remedy (*p*), nor, it is submitted, would any reasonable delay in the hope of avoiding litigation after a definite warning to the defendant.

(*k*) Per Mellish, L. J., in *Ford* v. *Foster*, L. R. 7 Ch. p. 633 (1872).

(*l*) *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185; 10 L. T. N.S. 780 (1863), Westbury, L. C.; *Moet* v. *Couston*, 33 Beav. 578; 10 L. T. N.S. 395 (1864), Romilly, M. R.; *Elkan* v. *Slack*, 24 Sol. J. 290 (1880), Jessel, M. R.

(*m*) *Moet* v. *Couston*, *supra*; *Cartier* v. *Carlile*, 31 Beav. 292; 8 Jur. N.S. 183 (1862), Romilly, M. R.

(*n*) *Harrison* v. *Taylor*, 11 Jur. N.S. 408; 12 L. T. N.S. 339; *Beard* v. *Turner*, 13 L. T. N.S. 746, both (1865) Wood, V.-C.

(*o*) Ct. *Anglo-Swiss Condensed Milk Co.* v. *Swiss Condensed Milk Co.* (1871), W. N. 163, Malins, V.-C., cited above, p. 414; *Beard* v. *Turner*, *supra*.

(*p*) See *Cave* v. *Myers* (1868), Seb. Dig. p. 181, Giffard, V.-C.; and *Lee* v. *Haley*, 21 L. T. N.S. 546; L. R. 5 Ch. 155 (1869), Malins, V.-C., and Giffard, L. J.

In a case where there had been some delay, and some amount of misrepresentation in his business, on the plaintiff's part, and the defendant's proper trade was larger than that of the plaintiff's, the account was limited to profits earned since the commencement of the suit, and Mellish, L. J., said that it was a case where a jury would have given forty shillings damages only (*q*). Limited because of misrepresentation.

The ordinary form of the order for an account directs an account of the profits made by the defendant in selling or otherwise disposing of the goods bearing the spurious mark or marks to be taken by the master or the official referee, and orders payment of the amount found to be made by the defendant to the plaintiff within a time fixed from the date of the certificate or report (*r*). Form of order for account.

In the case last cited, it was objected that the account should be limited to sales made to persons who bought the goods as and for the goods of the plaintiff, by reason of the use of the infringing mark upon them. The Court overruled this objection (*s*). They said that the mischief done by the spurious marking of the goods is not merely that it is calculated to deceive immediate purchasers from the infringers, but that it puts "a weapon calculated to be fraudulently used by the middlemen" (*t*) into their hands, by which they may, intentionally or not, deceive the ultimate purchasers. In a subsequent case Kekewich, J., made an order in the same form notwithstanding that he did not believe that there had been a single sale of the defendant's goods as those of the plaintiff, and notwithstanding that the goods had been fairly competing (*u*), but it may be doubted whether in the view which the learned judge took of the facts any account of profits should have been ordered at all (*x*).

The costs of the inquiry as to damages or the account of profits, should generally be reserved until the result of the Costs of inquiry or account.

(*q*) *Ford* v. *Foster*, L. R. 7 Ch. p. 633 (1872), L. JJ.

(*r*) *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A.; Appendix, p. 752.

(*s*) See also *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185; 10 L. T. N.S. 780 (1863), Westbury, L. C.

(*t*) Per Cotton, L. J., in *Lever* v. *Goodwin*.

(*u*) *Saxlehner* v. *Apollinaris Co.*, (1897) 1 Ch. 893; 14 R. P. C. 645.

(*x*) See p. 425, note (*g*).

inquiry or account is known (*y*), at any rate, unless it is clear that it will be of substantial value to the plaintiff; for if no damages or profits are found to have been incurred or made (*z*), or if the proceedings subsequent to the judgment are oppressively conducted by the plaintiff, he ought to pay the costs. But where the defendant had filed a false affidavit greatly understating the number of goods sold, although the account showed that he had made no profit, Chitty, J., said it was a case for investigation, and allowed the plaintiff the costs (*a*).

Account where plaintiff not sole owner.

The plaintiff is entitled to the ordinary inquiry as to damages, or account of profits made by the defendant by the use of the infringing mark, although the plaintiff is not the sole owner of the mark. If he elects to have an account of profits, however, he can only claim payment of such proportionate share of the profits as may be found to be appropriable to his interest in the mark (*b*), and the defendant is, it seems, entitled to have all the co-owners of the mark made parties, before the account is taken, in order that they may be bound by it, and that it may be taken once for all (*c*).

(*y*) Per Fry, J., in *Stark* v. *Midland Rail. Co.*, 16 C. D. 81 (1880), a case of nuisance.

(*z*) *Tonge* v. *Ward*, 21 L. T. N.S. 480 (1869), Romilly, M. R.

(*a*) *Dicks* v. *Jackson*, 31st March, 1884, cited Sebastian, 3rd ed. p. 255, 4th ed. p. 231.

(*b*) In *Dent* v. *Turpin*, 2 J. & H. 139 (1861), Wood, V.-C., which is substantially the only authority on the matter, both of the two owners of the mark had filed bills asking, in each case, for payment of so much of the profits made by the defendant as the plaintiff was entitled to. The Vice-Chancellor said the fact that both owners were suing avoided the difficulty in regard to the account. In *Southorn* v. *Reynolds*, 12 L. T. N.S. 75 (1865), the same Vice-Chancellor followed his previous decision, but the order as to payment (if any) is not reported. In the latter case, contrary to the modern rule, the inquiry and the account were both ordered.

(*c*) See the patent cases, *Bergmann* v. *Macmillan*, 17 C. D. 423 (1881), Fry, J.; and *Van Gelder* v. *Sowerby Society*, 44 C. D. 374; 7 R. P. C. 208 (1890), C. A., see per Cotton, L. J., 44 C. D. p. 392. The defendant cannot, as appears from the last case, object to judgment on the ground of want of parties, but can apply to have the owners who are not plaintiffs added (as plaintiffs or defendants) for the purposes of the account after judgment. See O. 16, r. 11, in the Annual Practice.

7. Costs.

Costs in the discretion of the judge.

Subject to sect. 77a of the Act, which is referred to below, the costs of and incident to an action for the infringement of a trade-mark, as the costs in any other action, are in the discretion of the Court or judge, and the Court or judge has full power to determine by whom and to what extent such costs shall be paid (*d*). Provided that where the action is tried with a jury, the costs follow the event, unless the judge by whom it is tried, or the Court, for good cause, otherwise orders (*e*).

Unsuccessful party usually ordered to pay costs.

The Court or judge in general follows the ordinary rule that the unsuccessful party shall pay the costs of the litigation, such costs being taxed upon the usual scale between party and party; but the discretion conferred by the Act and Rule just cited is constantly exercised in trade-mark cases, where the nature of the case, or the conduct of the parties, or of one of them, makes it just that the ordinary practice should be departed from.

Infringer must offer complete redress before action,

An unsuccessful defendant must usually pay costs, although he has only defended a mark which he honestly adopted without being aware of its too great resemblance to the plaintiff's mark (*f*), and though he has acted without fraud and in ignorance of the plaintiff's rights (*g*), and the action has been commenced against him without notice (*h*). But by offering the plaintiff all that he is entitled to,—that is, in the case of the innocent holder of spuriously marked goods, an undertaking (*i*) not to part with them until the

(*d*) Supreme Court of Judicature Act, 1890, s. (5).

(*e*) O. 65, r. 1.

(*f*) *Blair* v. *Stock*, 52 L. T. 123 (1884), Kay, J.; cf. the registration cases, *Hyde & Co.'s Tm.*, 7 C. D. 724; *Kuhn & Co.'s Tm.*, 53 L. J. Ch. 238 n., both (1878) Jessel, M. R.

(*g*) *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185; 10 L. T. N.S. 780 (1863), Westbury, L. C.; *Tonge* v. *Ward*, 21 L. T. N.S. 480 (1869), Romilly, M. R.

(*h*) *Field* v. *Lewis*, Seb. Dig. p. 167 (1867), Wood, V.-C.; *Upmann* v. *Forester*, 24 C. D. 231, (1883), Chitty, J.

(*i*) The plaintiff is not bound to accept an undertaking in the case of an infringer with notice, or where there is reasonable risk that it will be necessary to take steps to enforce it. In such a case the defendant must pay the costs of the plaintiff obtaining an injunction by consent

spurious marks have been removed (*k*), and all requisite information to enable the plaintiff to stop the infringement (*l*) and the payment of the taxed costs (*m*) (if any) already incurred by him in the action, if an action has been commenced,—the defendant may escape liability for subsequent costs (*mm*). If the plaintiff, after such an offer has been made, commences or continues proceedings against the defendant making it, he will be ordered to pay him his costs subsequently incurred (*n*). In a case where, as it turned out, the plaintiff was entitled to an injunction only, and his right to this was admitted on the second day of the trial, he was given costs up to that time, and was ordered to pay the subsequent costs (*o*).

and will then get subsequent costs.

If the plaintiff moves for an interlocutory injunction after being offered all that he can obtain on such a motion, unless there is ground to believe that the offer will not be carried out, the motion should be refused with costs (*p*).

in chambers: *Slazenger* v. *Pigott*, 12 R. P. C. 439 (1895), North, J. Cf. the patent case, *Jenkins* v. *Hope*, (1896) 1 Ch. 278; 13 R. P. C. 57, North, J.

(*k*) An innocent consignee or bailee may become liable for damages if he sends the spurious goods out of the country, or otherwise puts them beyond the control of the Court. *Upmann* v. *Elkan*, *infra*; and cf. the patent case *British Motor Syndicate, Ld.* v. *Taylor*, (1901) 1 Ch. 122; 17 R. P. C. 723, C. A.

(*l*) Above, p. 422. The plaintiff is not entitled to the publication of an apology: *Hudson* v. *Bennett*, 14 L. T. N.S. 698 (1866), Stuart, V.-C.; *Hudson* v. *Chatteris Co.*, *infra*; or to receive a list of the defendant's customers, if not entitled to an enquiry or account: *Hipkins* v. *Plant*, p. 433, below, note (*b*).

(*m*) *Burgess* v. *Hills*, 26 Beav. 244; 28 L. J. Ch. 356 (1858), Romilly, M. R.; *McAndrew* v. *Bassett*, 33 L. J. Ch. 561; 4 De G. J. & S. 380 (1864), Wood, V.-C., and Westbury, C.; *Fennessy* v. *Day and Martin*, 55 L. T. 161 (1886), Bacon, V.-C.

(*mm*) But the defendant must not ask for a term which he is not legally entitled to, as, for instance, that the plaintiff should not advertise the undertaking, *Hipkins* v. *Plant*, below, note (*b*).

(*n*) *Millington* v. *Fox*, 3 My. & Cr. 338 (1838), Cottenham, C.; *Moet* v. *Couston*, 33 Beav. 578 (1864), Romilly, M. R.: *Upmann* v. *Elkan*, L. R. 12 Eq. 140; 7 Ch. 130 (1871), Romilly, M. R., and Hatherley, C.; *Moet* v. *Pickering*, 6 C. D. 770; 8 C. D. 372 (1877), Fry, J., and C. A.

(*o*) *Magnolia Metal Co.* v. *Atlas Metal Co.*, 14 R. P. C. 389, at p. 400 (1896), Collins, J. A passing-off case.

(*p*) *Snuggs* v. *Seyd & Kelly's Credit Index Co.*, (1894) W. N. 95, Chitty, J. In *Hudson* v. *Chatteris Co.*, 15 R. P. C. 433 (1898), Stirling, J., a patent case, where the defendant had paid sufficient money into Court to cover

In *Moet* v. *Pickering* (*q*), where wharfingers with whom the spuriously marked goods had been warehoused in the ordinary course of trade, and who were entitled to a lien for their charges, were added as defendants, and the plaintiffs proceeded to trial against them, the Court of Appeal, reversing Fry, J., ordered that their costs of action should be paid by the plaintiffs. The wharfingers had pleaded that they had no knowledge of the infringement, and that they submitted to act as the Court should direct, upon payment of their charges and costs; but the Court of Appeal regarded this as meaning only that they claimed nothing adversely to the plaintiffs or the infringer. The case does not conflict with the rules stated above, for the plaintiffs had claimed to override the wharfinger's lien by a lien of their own for costs, and this was held to be wrong; and besides, it was clearly unnecessary to have added the wharfingers as defendants or to have proceeded to trial against them, since not only had they made no threat to part with the goods, but after notice of the injunction obtained against the infringer it would have been a contempt of Court for them to do so.

Stay of proceedings.

Where the plaintiff has obtained, or is offered, all that he is entitled to, the Court will stay further proceedings in the action, at the defendant's instance (*r*).

Trivial cases.

And in a trivial case, where an action had been commenced without notice against the innocent purchaser of an inconsiderable quantity of spuriously marked goods, and he at once submitted to do as the Court directed, Stirling, J., refused to give any costs (*s*).

damages and an injunction was refused at the trial, costs subsequent to the acceptance of the money were given to the plaintiff. See also note (*i*), above.

(*q*) A similar order was made in *Upmann* v. *Elkan*, note (*n*).

(*r*) *Rudd* v. *Rowe*, L. R. 10 Eq. 610 (1870), James, V.-C.; *Curtis and Harvey* v. *Pape*, 5 R. P. C. 146 (1888), North, J. (*Diamond Gunpowder*).

(*s*) *American Tobacco Co.* v. *Guest*, (1892) 1 Ch. 630; 9 R. P. C. 218; cf. *Rose* v. *Loftus*, 47 L. J. Ch. 576 (1878), Malins, V.-C. Cf. *Leahy* v. *Glover*, 10 R. P. C. 141 (1893), H. of L., and *Rutter* v. *Smith*, 18 R. P. C. 49 (1901), Kekewich, J., where only a single act of passing off by a servant, since discharged, was proved, and costs were given against the plaintiffs.

It is no reason for not giving costs that the defendant is an infant (*t*).

Costs refused because plaintiff claimed too much.

Costs have been refused to a successful plaintiff because he claimed, besides the injunction to which he was entitled, an account to which he was not, against an innocent purchaser of the spuriously marked goods (*u*); and in a similar case, where the plaintiffs set up claims to a copyright in a music tutor, as well as an exclusive right to its title, and failed as to the copyright, they were allowed only half their taxed costs of action (*x*). On similar grounds, plaintiffs have been ordered to pay (*y*), or have been deprived of (*z*), the costs occasioned by allegations which they have failed to prove, although they have succeeded and obtained the general costs of their actions. But where the plaintiff, in an action for infringing his trade-mark and also for "passing off," failed as regards the infringement in respect of some of the goods for which he used, but had not registered, the trade-mark, and succeeded as to the rest of the action, and the defendant was held to have been guilty of deliberate infringement in breach of an undertaking previously given by him, Kekewich, J., refused to deprive the plaintiff of any part of his costs (*a*).

The usual rule is to apportion the costs, each party getting costs of the substantial issues upon which he has succeeded, the plaintiff getting the costs of the action except so far as these are increased by the issues upon which costs are given

(*t*) *Chubb* v. *Griffiths*, 35 Beav. 127 (1865), Romilly, M. R.

(*u*) *Moet* v. *Couston*, 33 Beav. 578; 10 L. T. N.S. 395 (1864), Romilly, M. R. In *Hipkins* v. *Plant*, note (*b*), the defendants were given the costs of the action so far as it asked for damages or an account.

(*x*) *Metzler* v. *Wood*, 8 C. D. 606 (1877), Malins, V.-C., and C. A.

(*y*) *Pierce* v. *Franks*, 15 L. J. Ch. 122 (1846), Knight-Bruce, V.-C.

(*z*) *Standish* v. *Whitwell*, 14 W. R. 512 (1866), Wood, V.-C., an affidavit charging fraud. So *Saxlehner* v. *Apollinaris Co.*, below, note (*b*), Kekewich, J., where a charge of fraud failed in part.

(*a*) *Jay* v. *Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888). So *Rowland* v. *Mitchell*, 13 R. P. C. 457 (1896), Romer, J. In *Hodgson* v. *Kynoch*, 15 R. P. C. 465 (1898), Romer, J., there was no fraud, and the claim as to infringement had not substantially increased the costs, consequently no order as to them was made.

against him (*b*), unless there is one main issue upon which he has failed (*c*).

In a recent case, where an action for infringement and two motions by the defendants, one to expunge the plaintiff's registration, and the other for an order to the Comptroller to register a mark propounded by the defendants, were tried together, and the action and the second motion failed, but the *first motion succeeded, and both parties made unfounded* allegations of fraud, North, J., refused to give any costs to either, principally on the ground that it was absolutely impossible for any taxing master to do justice between the parties by distinguishing the costs of one part of the case from another (*d*).

Successful defendant deprived of costs.

A successful defendant is much more often deprived of his costs than a successful plaintiff, for the plaintiff may fail in his action notwithstanding that the evidence makes it clear that the defendant has acted, or intended to act, dishonestly, and in such a case, although the Court decline to assist the plaintiff, it generally refuses to give costs to the defendant.

Where, for example, the plaintiff failed because of misrepresentations contained in his trade-mark (*e*), but the defendant had closely imitated the mark, the action was dismissed without costs; and the same course was followed where there was no sufficient proof that the defendant's mark was calculated to deceive, having regard to the long delay of the plaintiff to take proceedings, and the absence of evidence of actual deception (*f*); and in cases where the action was dismissed, but the Court thought that the defendant's conduct had been uncandid and unfair (*g*); and North, J., dismissed

(*b*) *Saxlehner* v. *Apollinaris Co.*, (1897) 1 Ch. 893; 14 R. P. C. 645; *Lever* v. *Bedingfield*, 15 R. P. C. 453 (1898), both Kekewich, J.; *Hipkins* v. *Plant*, 15 R. P. C. 294 (1898), Byrne, J.

(*c*) *Pneumatic Stamp Co.* v. *Lindner*, 15 R. P. C. 525 (1898), Byrne, J.

(*d*) *Baker* v. *Racson*, 45 C. D. 519; 8 R. P. C. 89 (1890); *Jackson* v. *Napper*, 35 C. D. 162; 4 R. P. C. 45 (1886), Stirling, J.

(*e*) *The Leather Cloth Co., Ld.* v. *The American Leather Cloth Co., Ld.*, 4 De G. J. & S. 137; 33 L. J. Ch. 199; 11 H. L. C. 523; 35 L. J. Ch. 53 (1863), Westbury, L. C., and H. L. The House of Lords held that there was no infringement.

(*f*) *Rodgers* v. *Rodgers*, 31 L. T. N.S. 285 (1874), L. JJ.

(*g*) *Estcourt* v. *The Estcourt Hop Essence Co.*, 31 L. T. N.S. 567; L. R. 10 Ch. 276 (1874), Malins, V.-C.,

an action without costs because he thought that the defendants had kept back information (*h*).

So, too, no costs were given where it was proved that the defendant had represented the goods he sold as being those of the plaintiff, although the proof of the plaintiff's title failed (*i*)

In *The Patent Plumbago Case* (*j*), however, where the plaintiffs failed on the ground of misrepresentation, but the imitation of their trade-name was clearly made out, the action was dismissed with costs, the plaintiffs having continued to misdescribe their goods as "patent" after a summons taken out at their instance had been dismissed by the magistrate because of such misdescription.

Defendant *in pari delicto*.

So, in cases in which the plaintiff fails because he is carrying on a fraudulent trade, and the defendant stands *in pari delicto*, the practice is to dismiss the action without costs (*k*).

Unfounded charges of fraud.

And a successful defendant has also been deprived of costs because he has made an unfounded charge of fraud (*l*).

Costs of appeal.

In a trade-name case, where the plaintiffs' action was dismissed by the Court of Appeal on the ground that they were not satisfied that the name adopted by the defendants would cause any deception likely to occasion damage to the plaintiffs, costs, both of the appeal and in the Court below, were refused because the Lords Justices believed that the defendants had chosen the name in dispute with

Cairns, C., and L. JJ.; *Maxwell* v. *Hogg*, 15 L. T. N.S. 204; L. R. 2 Ch. 310 (1866), Stuart, V.-C., and L. JJ.

(*h*) *Meaby & Co., Ld.* v. *Triticine, Ld.*, 15 R. P. C. 1 (1898).

(*i*) *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518 (1866), Wood, V.-C.; and see *Browne* v. *Freeman* (1), 12 W. R. 305 (1864), Wood, V.-C., where the defendant misdescribed his goods as *The Original Chlorodyne*.

(*j*) *Morgan* v. *McAdam*, 36 L. J. Ch. 228 (1866), Wood, V.-C.

(*k*) *Newman* v. *Pinto*, 4 R. P. C. 504; 59 L. T. 31 (1887), C. A.; *Thorneloe* v. *Hill*, 11 R. P. C. 61 (1894), Romer, J.; cf. *Baschet* v. *London Standard Co.*, (1900) 1 Ch. 73, Kekewich, J., a copyright case.

(*l*) *Humphries* v. *The Taylor Drug Co.*, 59 L. T. 820 (1888), Kekewich, J.; *Hargreaves* v. *Freeman*, (1891) 3 Ch. 39; 8 R. P. C. 237, Chitty, J. As to unfounded charges of fraud by the plaintiff, see p. 432, note (*z*).

the hope of obtaining some illicit advantage from the plaintiff's reputation (*m*).

But, in general, the reasons for depriving the defendant of costs do not apply to the costs of an unsuccessful appeal brought by the plaintiff against the dismissal of his action. Thus, the appeal to the House of Lords in *The Leather Cloth Case* (*n*), and the appeal to the Court of Appeal in *Newman* v. *Pinto* (*o*), were both dismissed with costs. In the former case the plaintiff obtained judgment in the first instance, and when this was reversed on appeal by Lord Westbury no costs were given (*p*).

Interest on costs repaid.

A party who succeeds on appeal and recovers the costs paid under the judgment below is not entitled to interest (*q*).

Higher scale.

The Court or judge may order the costs adjudged to be paid to be taxed upon the higher scale, if special grounds arising out of the nature and importance, or the difficulty or urgency, of the case, appear to exist (*r*). Such an order was made by North, J., in *The Great Tower Street Tea Co.* v. *Smith* (*s*), where the hearing occupied a long time, and the facts were complicated, and a great number of witnesses were called. But some special reason for the order must be shown, for, although the application is almost always made in heavy trade-mark or patent actions, it is not granted as of course (*t*); and it is not granted as a punishment (*u*), or merely because a case of gross fraud is made out (*t*). The order ought only to be made in cases of very unusual difficulty requiring skill,

(*m*) *Borthwick* v. *The Evening Post*, 37 C. D. 449 (1888), C. A.

(*n*) 11 H. L. C. 523; 35 L. J. Ch. 53.

(*o*) See note (*k*), *ante*, p. 434.

(*p*) 4 De G. J. & S. 137; 33 L. J. Ch. 199. This course was taken also in *Borthwick* v. *The Evening Post*, *supra*.

(*q*) *Edge* v. *Gallon*, 16 R. P. C. 509, at p. 520, (1899) C. A.

(*r*) O. 65, r. 9. See the note in the Annual Practice.

(*s*) 6 R. P. C. 165 (1889).

(*t*) *Sanitas Co., Ld.* v. *Condy*, 4 R. P. C. 530 (1887), Kekewich, J. In *Rodgers* v. *Rottgen*, 5 Times L. R. 678 (1889), Kay, J., said he gave costs on the higher scale very charily. In *Leonhardt* v. *Kalle*, 12 R. P. C. 103, at p. 120 (1895), Romer, J., said he had never done it except by consent. Collins, J., gave such costs in *Reddaway* v. *Banham*, 12 R. P. C. 86, and his judgment was restored by the H. of L., (1896) A. C. at p. 222.

(*u*) *Hudson* v. *Osgerby*, 32 W. R. 566; 50 L. T. 323 (1884), Pearson, J.; and see *Pooley's Trustee* v. *Whetham*, 33 C. D. p. 120; and *Paine* v. *Chisholm*, (1891) 1 Q. B. 531, and the cases there cited.

antiquarian research and things of that kind (*u*). That scientific witnesses are necessarily called has been held to be a special reason (*x*). An appeal lies on the question whether there are "special grounds" or not (*y*).

Costs as between solicitor and client.

It is provided by **sect. 77** (a) (*z*) that—

"In an action for the infringement of a registered trade-mark the Court or a judge may certify that the right to the exclusive use of the trade-mark came in question, and if the Court or a judge so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses, as between solicitor and client, unless the Court or judge trying the action certifies that he ought not to have the same."

This section corresponds to the provision of sect. 31 of the Act with regard to actions for the infringement of a patent (*a*).

Certificate that title to trade-mark came in question.

A certificate cannot be granted unless the right to the exclusive use of the trade-mark has, in fact, come in question, and, therefore, it was refused in a case where the defendant's counsel admitted that, upon the failure of the defendant's application to remove the plaintiff's mark from the Register, he had no defence to the action (*b*). But notwithstanding that the section says "in an action," it can under some circumstances be granted upon a motion for rectification where the mark has been registered for five years, since the mark can then only be attacked by proceedings under sect. 90. Thus where, under an order of the Court, a motion for recti-

(*u*) *Gadd* v. *Mayor of Manchester*, 9 R. P. C. 516, at p. 535, Lindley, L. J. See also *Dunlop Co.* v. *Wapshare Co.*, 17 R. P. C. 433 (1900), Buckley, J., and *Chamberlain and Hookham* v. *Mayor of Bradford*, 17 R. P. C. 493 (1900), Farwell, J., where the order was made.

(*x*) *Ellington* v. *Clark*, 5 R. P. C. 328; 58 L. T. 818 (1888), C. A.; *The Robin*, (1892) P. 95, Joune, J.; *Dunlop Co.* v. *Wapshare Co.*, *supra*.

(*y*) *Paine* v. *Chisholm*, (1891) 1 Q. B. 531, C. A.

(*z*) Act of 1888, sect. 18.

(*a*) See Edmunds on Patents, pp. 329 *et seq.* and 487, 2nd ed. p. 620.

(*b*) *Benjamin Edgington, Ld.* v. *John Edgington & Co.*, 6 R. P. C. 513; 61 L. T. 323 (1889), Kay, J.

fication and an action for infringement were heard together and on the same evidence, it was held that there was jurisdiction to grant a certificate, and the grant was made (*c*).

In a case where the Court of Appeal refused an application by the defendant to expunge the plaintiffs' marks, partly on the ground that the defendant was a deliberate infringer, they declined to give the plaintiffs a certificate under the section (*d*).

The order granting a certificate is not appealable (*e*).

Costs of motion to rectify in aid of defence.

Similar considerations govern the grant or refusal of costs in respect of the application to rectify the Register by expunging or varying the registration of the plaintiff's mark, which is an ordinary incident of the defence in an action for infringement. The usual practice is to give the applicant costs, if he succeeds (*f*); but if the application is made by the defendant for the purposes of the action, and it is doubtful whether he is not acting fraudulently, the costs may be reserved till the trial (*g*), or may be refused (*h*).

8. Appeal.

Appeal advanced.

In a case where the defendant desired to appeal against an interim injunction which the plaintiff had obtained, the Court, on his application, and on the ground that the continuance of the injunction would do irreparable damage to his business, advanced the case to the head of the list (*i*).

Stay of order.

An application to stay a new trial ordered to take place by the Court of Appeal, pending an appeal against the order to the House of Lords, was refused in *Edge* v. *Johnson* (*k*).

(*c*) *Field & Co.* v. *Wagel Syndicate*, (1900) 1 Ch. 651; 17 R. P. C. 266, Buckley, J.

(*d*) *Paine & Co.* v. *Daniells and Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 217, cited p. 371.

(*e*) *Haslam & Co.* v. *Hall*, 5 R. P. C. 144 (1888), C. A.

(*f*) *Richards* v. *Butcher*, (1891) 2 Ch. 522; 8 R. P. C. 37, Kay, J.

(*g*) *Gimaelis' Tm.*, 6 R. P. C. 167; 58 L. J. Ch. 782 (1889), North, J.

(*h*) *Perry-Davis' Tm.*, 5 R. P. C. 333; 58 L. T. 695 (1888), Kay, J.; *Bradley's Tm.*, 9 R. P. C. 205 (1892), Chitty, J. See further Chap. XI., p. 293.

(*i*) *Lazenby* v. *White*, L. R. 6 Ch. 89 (1870), James, L. J.

(*k*) 9 R. P. C. 134 (1892).

Barred by delay.

In *Burgess* v. *Burgess* (*l*), delay for five months in appealing against an order for an interim injunction, where the plaintiff was appellant, seeking to have the scope of the order enlarged, was held to be a bar to the appeal.

Appeal in case of fraud.

Where the judge of first instance has found, or has refused to find fraud, it is difficult, and usually impossible, for the Court of Appeal to reverse his finding. In a recent case, however, a finding of fraud was reversed, the Court being able to act without relying on the evidence of the defendant, which the judge below had not believed (*m*).

Non-suit.

If an appeal is brought, and the defendant succeeds, judgment is entered in his favour, not a non-suit (*n*); but the Court of Appeal, in dismissing the plaintiff's action, may reserve to him liberty to sue again in respect of any part of his claim. This course was adopted in an action where the plaintiff sought to raise a new case of "passing off," not set up by the pleadings, at the trial, and was not allowed to proceed with it (*o*).

9. Practice.

Pleadings.

There are no rules as to pleadings which are peculiar to actions for the infringement of trade-marks (*p*); all that is necessary, therefore, is that the statement of claim, defence,

(*l*) 3 De G. M. & G. 896; 22 L. J. Ch. 675 (1853), L. JJ. So also in *Re Palmer's Application*, 22 C. D. 88 (1882), C. A., where the Court had decided against a preliminary objection. The time for appealing against an interlocutory order is now fourteen days. R. S. C., O. 58, r. 15.

(*m*) *Jamieson & Co.* v. *Jamieson*, 15 R. P. C. 169 (1897). In *Valentine Meat Juice Co.* v. *Valentine Extract Co., Ld.*, the Court of Appeal found fraud, where Stirling, J., had failed to do so, 17 R. P. C. 1 and 673; 83 L. T. 259 (1900).

(*n*) *Pinto* v. *Badman*, 8 R. P. C. 181 (1891), C. A. No plaintiff can, under the modern practice, claim to be non-suited: *Fox* v. *Star Newspaper Co.*, (1900) A. C. 19.

(*o*) *Native Guano Co.* v. *Sewage Manure Co.*, 8 R. P. C. 125 (1888), C. A. and H. L.

(*p*) Sect. 9 of the Merchandise Marks Act, 1887, provides that in any pleading, proceeding, or document in which any trade-mark or forged trade-mark is intended to be mentioned, it shall be sufficient, without further description and without any copy or facsimile, to state that trade-mark or forged trade-mark to be a trade-mark or forged trade-mark. Appendix, p. 810.

and reply, if any, in any such action, shall respectively contain statements, in a summary form, of the material facts upon which the party pleading relies for his claim or defence (*q*), giving particulars of the frauds, if fraud is alleged (*r*). What are material facts, having regard to the circumstances of the case, may be gathered from the statement of substantive law, given in the earlier part of the present chapter.

Forms in the Rules of the Supreme Court.

The forms provided by the appendices to the Supreme Court Rules are set out below. They, when applicable, and when they are not applicable forms of a like character, and as near as may be to them, are to be used for all pleadings; and, where they are applicable and sufficient, any longer forms are to be deemed prolix, and the costs occasioned by such prolixity are to be disallowed, or to be borne by the party so using the same, as the case may be (*s*).

INDORSEMENT ON THE WRIT.

The plaintiff's claim is for damages for wrongfully using (or imitating) the plaintiff's trade-mark.

STATEMENT OF CLAIM.

(1.) The defendant has infringed the plaintiff's trade-mark.

(2.) The trade-mark is (*describe it*). (*If the plaintiff is not the original proprietor of the trade-mark, show shortly how his title is derived.*)

(3.) The following acts are complained of, viz.:—
(*Set them out.*)

The plaintiff claims an injunction to restrain the defendant, his servants and agents, from infringing the plaintiff's said trade-mark, and in particular from (*stating any particular injunction sought*).

The plaintiff also claims an account or damages (*t*).

(*q*) O. 19, r. 4.

(*r*) O. 19, r. 6.

(*s*) O. 19, r. 5.

(*t*) Rules of the Supreme Court, Appendix C., sect. 6, Form 8.

DEFENCE.

(1.) The trade-mark is not the plaintiff's.
(2.) The alleged trade-mark is not a trade-mark.
(3.) The defendant did not infringe.

It will be observed that the form of statement of claim here given does not comprise an allegation that the plaintiff's trade-mark has been registered, or that sect. 77 of the Act has been otherwise complied with; but such an allegation is certainly proper, and, it is submitted, necessary.

Some more elaborate and detailed forms are given in the Appendix (*u*).

Particulars.

The ordinary rule (*x*) that the parties must state the facts upon which they rely and which they plead in their pleadings, or in particulars separately delivered, with sufficient particularity to prevent their opponents being taken by surprise at the trial, applies to trade-mark cases.

So if the plaintiff alleges that actual deception has occurred, he will be ordered to give particulars of the persons deceived (*y*). And if the defendant pleads that the plaintiff's trade-mark is invalid, he must give particulars of the invalidity alleged (*z*).

If a motion to expunge the plaintiff's mark is made by way of reply to the usual interlocutory application on behalf of the plaintiff for an interim injunction, and both the motion and application stand over to the trial, unless there are affidavits sufficiently showing what the defendant's case is upon his motion to expunge, he is frequently directed to deliver particulars of it.

Discovery.

The ordinary rules (*a*) governing discovery also apply to trade-mark actions (*b*).

(*u*) Pages 743 *et seq.*

(*x*) See the notes to O. 19, rr. 6 and 7 in the Annual Practice.

(*y*) *Humphries* v. *Taylor Drug Co.*, 39 C. D. 693; 5 R. P. C. 687 (1888), Kekewich, J.; *Whitstable Oyster Fishery Co.* v. *Hayling Fisheries, Ld.*, 17 R. P. C. 461 (1900).

(*z*) *Rowland* v. *Mitchell*, 13 R. P. C. 457 (1896), Romer, J.

(*a*) O. 31. The Merchandise Marks Act, 1887, provides that nothing in that Act shall entitle any person to refuse to make a complete discovery, or to answer any question or interrogatory in any action: sect. 19. Appendix, p. 814.

(*b*) *Orr* v. *Diaper*, 4 C. D. 92 (1876), Hall, V.-C., demurrer to an action for discovery against

Orders for discovery in trade-mark cases modified to prevent abuse.

But a process which enables a rival trader to extract from his opponent information concerning his customers, his trade, and his mode of doing business, is extremely likely to be abused, and in cases where a large trade-mark business is affected, even the ordinary order for discovery of documents upon oath may be very oppressive (*c*). The Court, therefore, will, upon a proper case being shown, modify the common orders so that they shall occasion no more inconvenience to the party to whom they are directed than is necessary to ascertain the rights of his opponent.

Thus, in *Carver* v. *Pinto Leite* (*d*), it was held that the defendants, in a suit for infringement, who had been ordered to file an affidavit of documents and to produce the documents in the ordinary way, ought not to be ordered to disclose the names of customers, or of persons to or from whom letters referring to the matters in issue were sent or received, inasmuch as such discovery might be used in a manner prejudicial to the defendants in their trade, and was not likely to assist the plaintiffs in making out their case at the hearing.

And in a later case, where the defence was that the plaintiff was carrying on a fraudulent trade by selling as foreign cigars goods made in England, the plaintiff, who admitted the fact that his goods were in fact made in England, was allowed to refuse to say who was the manufacturer because, under the circumstances, the question was irrelevant (*e*).

Disclosure of sales.

Discovery in regard to the sales effected by the defendant under the disputed mark is not, in general, where the infringement is denied, material, until the fact that the mark is an infringement of the plaintiff's rights has been

shippers, brought in aid of an intended action against the consignors, dismissed.

(*c*) *Wills' Tms.*, (1892) 3 Ch. 201; 10 R. P. C. 269, C. A.

(*d*) L. R. 7 Ch. 90 (1871), C. A. See also *Benbow* v. *Low*, 16 C. D. 93 (1880), C. A.; and *The Attorney-General* v. *The North Metropolitan Tramways Co.*, (1892) 3 Ch. 70, North, J. Full discovery was ordered in *Howe* v. *McKernan*, 30 Beav. 547 (1862), Romilly, M. R., where the defendant was charged with advertising himself as the plaintiff's agent after the agency was determined.

(*e*) *Benedictus* v. *Sullivan, Powell & Co.*, 12 R. P. C. 25 (1895), Chitty, J. If the question had been relevant, the plaintiff must have answered it.

Discovery in aid of inquiry or account.

decided (*f*); but where the giving of an account would occasion little trouble to the defendant, and may enable the plaintiff to get final judgment at the trial, without further inquiry, the judge, in his discretion, may order it to be given (*f*). In a case where the questions of fact had been ordered to be tried by a jury, such discovery was refused, before the trial, on the ground that the plaintiff had not elected whether to claim damages or an account of profits if he succeeded (*g*). After an account of profits or an inquiry as to damages has been directed, discovery of the names and addresses of the persons to whom the marked goods were sold, or, if this cannot be had, of persons to whom goods—as to which the accounting party cannot swear that they were *not* marked with the objectionable mark—were sold, may be ordered (*h*).

Inspection, &c.

The Court or a judge has wide powers, under Ord. 50, r. 3, to make any order for the detention, preservation, or inspection (*i*) of any property or thing, being the subject of litigation, and to authorize any persons to enter upon or into any land or building in the possession of any party to the litigation, and, for all or any of the purposes aforesaid, to

(*f*) *Benbow* v. *Low*, 16 C. D. 93 (1880), C. A. See also O. 31, r. 20, and the note in the Annual Practice thereon. And for the decisions in patent cases, see Edmunds on Patents, p. 308, 2nd ed. p. 420, and *De la Rue* v. *Dickinson*, 3 K. & J. 388 (1857).

(*g*) *Fennessy* v. *Clark*, 37 C. D. 184 (1887), Kay, J., and C. A.

(*h*) *The Leather Cloth Co., Ld.* v. *Hirschfeld*, 1 H. & M. 295 (1863), Wood, V.-C.; *Powell* v. *Birmingham Brewery Co.*, 14 R. P. C. 1 (1897), Stirling, J., and C. A.; *Saccharin Corporation* v. *Chemicals and Drugs Co.*, (1900) 2 Ch. 556; 17 R. P. C. 612, C. A.

(*i*) Sect. 21 of the repealed Merchandise Marks Act of 1862 gave jurisdiction to order inspection. As to the powers of justices to issue *search warrants* for goods by means of or in relation to which an offence has been committed under the Merchandise Marks Act, 1887, see sect. 12 of that Act, p. 618. A person charged with an offence under the Act may find it necessary to show 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"; sect. 2 (2), and sect. 6 See Book II., pp. 598, 604, and 608.

authorize any samples to be taken, or any observation to be made, or experiment to be tried, which may be necessary or expedient for the purpose of obtaining full information or evidence.

Under this power the Court could, for instance, authorize the plaintiff to inspect goods upon which he showed reasonable grounds for suspecting that a mark infringing his mark had been placed (*k*).

The application is made in the Chancery Division by motion or summons; in the Queen's Bench Division by summons (*l*).

Documents referred to in the pleadings, &c.

Production and inspection of copies of the trade-marks, or of other documents which are referred to in any of the pleadings or affidavits of any of the parties in a case, may be obtained by giving notice in writing to such party to produce them, unless some cause or excuse for not complying with the notice is shown, which the Court or judge deems sufficient (*m*).

Evidence.

The Comptroller's certificate, and sealed copies of the Register.

The registration of the plaintiff's mark, or the refusal to register it, is proved by the production of a certificate under the hand of the Comptroller, and the actual terms of the registration, and proof of the mark itself as it is registered, are shown and given by the production of an extract or copy from the Register certified by the Comptroller and sealed with the seal of the Patent Office (*n*).

The request for the certificate should be made to the Comptroller in writing, stating for what purpose it is required, in the form given in the schedule to the Rules (*o*). It may be

(*k*) Such inspection is frequently authorized in patent cases. See Edmunds on Patents, p. 307, 2nd ed. p. 413; and *Neilson* v. *Betts*, L. R. 5 H. L. p. 11, per Lord Westbury.

(*l*) See the Annual Practice notes to O. 50, rr. 3 and 6.

(*m*) O. 31, r. 15. *Smith* v. *Harris*, 48 L. T. 869 (1883), Chitty, J. The learned judge refused to order barrels branded with the mark to be produced. See also *Wills' Tms.*, above, p. 441.

(*n*) Sect. 88, Rule 52, Chap. III., p. 61.

(*o*) Rule 60, Form S., p. 712.

sent by post (*p*). The fee for a certificate for use in legal proceedings is one pound.

By **sect. 89**—

Copies of the Register.

"Printed or written copies or extracts, purporting to be certified by the Comptroller, and sealed with the seal of the Patent Office, of or from (patents, specifications, disclaimers, and other documents in the Patent Office, and of or from) Registers and other books kept there shall be admitted in evidence in all Courts in her Majesty's dominions, and in all proceedings, without further proof or production of the originals."

And by **sect. 96**—

Comptroller's certificates.

"A certificate purporting to be under the hand of the Comptroller of any entry, matter, or thing which he is authorized by this Act, or any general rules made thereunder, to make or do, shall be *primâ facie* evidence of the entry having been made and of the contents thereof, and of the matter or thing having been done or left undone."

This section corresponds to sect. 8 of the Act of 1875.

The registered mark is, in practice, usually shown by the production of a copy of the advertisement in the Trade-Marks Journal, leading to its registration, and this is generally accepted as sufficient.

Proof of title of registered proprietor;

Where the mark is registered, and the plaintiff is the registered proprietor, proof of the registration, and of the identity (if any question as to this is raised) of the registered proprietor with the plaintiff is *primâ facie* evidence of the plaintiff's right to the exclusive use of the mark, and, after five years from the date of the application for registration, is conclusive evidence of his right, until the registration is annulled upon an application under sect. 90 (*q*).

of title by assignment, &c.;

If the plaintiff claims, by devolution or assignment, through the registered proprietor, he must prove the devolution or assignment by giving the proper evidence of the facts which effect it, and must prove in the same way that the

(*p*) Sect. 98.

(*q*) Sects. 75 and 76. See above, p. 361.

goodwill of the business concerned has also devolved upon or been assigned to him (*r*).

of infringement;

The infringement must be proved by showing that the defendant, his servants, or agents, have dealt in, or threaten, or are about to deal in goods of the kind to which the plaintiff's trade-mark rights extend, in such a manner as to infringe his trade-mark (*s*).

of probability of deception.

The nature of the evidence which should be adduced to satisfy the Court that the defendant's mark has such a resemblance to the plaintiff's as to be calculated to deceive, has already been discussed (*t*). It has been shown that the Court, in general, attaches little weight to the mere statements of opinion by persons who are called as witnesses, or, as Fry, L. J., put it, in *Turton* v. *Turton* (*u*), as "compurgators," to say that they think there is no probability of deception.

The Registrar's books are not evidence that a mark is *publici juris*.

In *Orr-Ewing* v. *Johnston* (*x*), Fry, J., held, that the books kept by the Registrar of trade-marks were not evidence, in an action for infringement, to show that marks like the plaintiff's mark were in common use and had been refused registration, and that the plaintiff's mark was consequently *publici juris*. The books were only evidence, the learned judge held, that other persons had made claims. Certified copies of entries actually made on the Register are, however, evidence of such entries, and if they show that three or more marks other than, but similar to, the plaintiff's have been registered for the same goods, that would, it is submitted, be evidence that the mark is a common mark (*y*).

(*r*) Sect. 70, Chap. XIII., p. 324. As to registration of the assignment, see p. 317.

(*s*) *Ante*, p. 363.

(*t*) Above, p. 373, and Chap. X., p. 224. In many of the reports in the R. P. C. the nature of the evidence is very fully indicated; see, for instance, *Liebig's Co.* v. *Chemists' Society*, 13 R. P. C. 635, and the *Valentine* and *Payton* cases cited in the next chapter.

(*u*) 42 C. D. 149 (1889). See also *Cope* v. *Evans*, L. R. 18 Eq. 138 (1874), Hall, V.-C.; and per Jessel, M. R., in *Thorn* v. *Worthing Skating Rink Co.*, 6 C. D. 415, n.

(*x*) 13 C. D. at p. 442 (1879).

(*y*) See the "Three Marks Rule," Chap. X., p. 214.

CHAPTER XVI.

THE ACTION FOR "PASSING OFF."

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Foundation of the action.

IT is an actionable wrong for the defendant to represent, for trading purposes, that his goods are those or that his business is that of the plaintiff, and it makes no difference whether the representation is effected by direct statements, or by using some of the badges by which the goods of the plaintiff are known to be his, or any badges colourably resembling these, in connection with goods of the same kind, not being the goods of the plaintiff, in such manner as to be calculated to cause the goods to be taken by ordinary purchasers for the goods of the plaintiff. But, except in a very extreme case (*a*), this rule has never been applied so as to prevent the defendant honestly trading under his own name (*a*), or under the names

(*a*) The very recent case of *Cash* v. *Cash*, cited below, p. 508. Can the use be said to be honest, after it is shown that the result is to lead to the belief that the defendant's goods are the plaintiff's. See p. 377.

of the members of his firm, or honestly describing his goods, and their place of origin, manner of manufacture, and other characteristics, in the ordinary terms current in his trade.

The question whether the use of particular words or badges is calculated to pass off the defendant's goods as those of the plaintiff, or is merely honestly descriptive, is often one of difficulty, but it is, in substance, a question of fact.

"The principle of law may be very plainly stated, that nobody has any right to represent his goods as the goods of somebody else. How far the use of particular words, signs, or pictures, does or does not come up to the proposition enunciated in each particular case must always be a question of evidence, and the more simple the phraseology, the more like it is to a mere description of the article sold, the greater becomes the difficulty of proof; but if the proof establishes the fact, the legal consequence appears to follow" (*aa*).

Comparison with the action for the infringement of a trade-mark.

The action to restrain the defendant from passing off his goods as the goods of the plaintiff, is obviously the generalized form of the action to restrain the infringement of a trade-mark (*b*); and the old principles from which the latter action grew up are still recognized and put into force by the Courts (*c*). The action for infringement has been specialized, and the proof of the plaintiff's case in it greatly facilitated and simplified by the registration of trade-marks and the provisions of the Acts; but the plaintiff's trade-mark,

(*aa*) Per Halsbury, L. C., in *Reddaway* v. *Banham*, (1896) A. C. at p. 204; 13 R. P. C. at p. 224. See generally on the subject of this Chapter the summaries of the law by Kay and Lindley, L. JJ., in *Powell* v. *Birmingham Vinegar Brewery Co.*, (1896) 2 Ch. 54; 13 R. P. C. 235; and Lord Davey in *Cellular Clothing Co.* v. *Maxton*, (1899) A. C. at p. 343; 16 R. P. C. at p. 408, the first of which is printed in a note at the end of this Chapter. See also an article entitled "Unfair Competition," by Mr. O. R. Mitchell, in the *Harvard Law Review* for January, 1897. Leading American authorities are the *Amoskeag Co.* v. *Spear*, 2 Sandf. S.C. 599 (1849); and *Lawrence Co.* v. *Tennessee Co.*, 138 U. S. 537 (1891).

(*b*) See Chap. I., pp. 1 and 13, and Chap. XV., p. 354.

(*c*) See Chapters I. and II., and the judgments of the C. A. in *Powell* v. *Birmingham Brewery Co.*, (1896) 2 Ch. 54; 13 R. P. C. 235; *Lee* v. *Haley*, L. R. 5 Ch. 155 (1869), Malins, V.-C., and Giffard, L. J.; *Somerville* v. *Schembri*, 12 App. Ca. 453; 4 R. P. C. 179 (1887), P. C.; *Montgomery* v. *Thompson*, 41 C. D. 35; (1891) A. C. 217; 8 R. P. C. 361 (*Stone Ales*).

although the most important, is only one of the badges by which his trade or his goods are, or may be, identified with him; and it is equally a wrong, according to the principles laid down in the judgments quoted in the Introduction, and in the cases last cited, to imitate or copy any of the others (*d*),—his trade-name or the get-up of his goods. for instance,—so as to damage his trade by passing off other goods as his, or by leading his customers to suppose that there is a connection between such other goods and his business, which does not in fact exist (*e*).

In a trade-mark action the plaintiff must prove his title to the mark he claims, that it is registered as his mark or as the mark of his predecessor in business (or that sect. 77 has been otherwise complied with), and that the defendant has infringed the mark (*f*). And proof of the registration is, at least *primâ facie*, proof of title also. Further, if the mark has been actually or substantially copied, that constitutes an infringement, although it is not shown that the copy is calculated to deceive (*g*). In a passing off action the plaintiff's case is very similar to this, but registration forms no part of it, and the plaintiff must prove by direct evidence that the conduct of the defendant is calculated to pass off the defendant's goods as his; and to do so, he must show either that the defendant has actually represented that his goods or business are those of the plaintiff, or,—and this is the common case,—that he has used certain symbols or badges in connection with his goods or business, which are reputed in the market to import that the goods or business in connection with which they are used are the plaintiff's goods or business. A plaintiff may, therefore, fail to make out a case of infringement of trade-mark rights because he cannot prove his title

Where trade-mark action fails, passing off action may succeed on the same evidence.

(*d*) "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" (*i.e.*, that his goods are those of the plaintiff) "but in different words and without using the name of the rival tradesman at all." Per Halsbury, L. C., in *Birmingham Brewery Co.* v. *Powell*, (1897) A. C. at p. 711; 14 R. P. C. at p. 728.

(*e*) See *Borthwick* v. *The Evening Post*, 37 C. D. 449 (1888), Kay, J., and C. A., cited below, p. 475.

(*f*) See the last Chapter.

(*g*) See p. 371.

to the trade-mark, or its registration, or that its registration extends to the goods (*h*), or to all of the goods (*i*), in question, or because the registration is ordered to be annulled (*k*), and may yet show that by imitating the mark claimed as a trade-mark, or otherwise, the defendant has done what is calculated to pass off his goods as those of the plaintiff. It follows that a case of "passing off" is generally added as a second string to an action for infringement, and is frequently successful where the trade-mark action proper breaks down (*l*).

The two actions are frequently combined.

Sect. 77 affords no bar to a passing off action.

The Acts, and in particular the definition sections and the sections barring, in certain events, proceedings to prevent or to recover damages for the infringement of unregistered trade-marks (*m*), seem to have been undoubtedly intended to limit and define the classes of symbols which could be appropriated as trade-marks, to restrict the latitude which existed before 1875 (*n*) with regard to the choice of trade-marks, and to make registration a condition precedent to all litigation in respect of subsequently acquired trade-marks corresponding to the trade-mark cases before the Acts. This intention was not, however, sufficiently clearly expressed, and the Acts have, in consequence, been construed so as practically to leave a plaintiff in possession of all the rights which he would have had if they had not been passed, while greatly facilitating the protection of such trade-marks as may be and are properly registered (*o*).

(*h*) *Hart* v. *Colley*, 44 C. D. 193; 7 R. P. C. 93 (1890), North, J.

(*i*) *Jay* v. *Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.

(*k*) *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A.; *Montgomery* v. *Thompson*, 41 C. D. 35; 6 R. P. C. 404; (1891) A. C. 217; 8 R. P. C. 361, C. A. and H. L.; *Powell* v. *Birmingham Co.*, (1896) 2 Ch. 54; 13 R. P. C. 235; (1897) A. C. 710; 14 R. P. C. 720.

(*l*) See the cases cited in the last three notes. *Barber* v. *Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L. J.; and the judgment of Lindley, L. J., in *Reddaway & Co.* v. *Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639; 9 R. P. C. 503, C. A. (*Camel Hair Belting*). See also *Compania Général de Tobacos* v. *Rehder*, 5 R. P. C. 61 (1887), Kay, J., and *Curtis and Harvey* v. *Pape*, 5 R. P. C. 146 (1887), North, J., where the trade-mark questions were left undecided.

(*m*) Act of 1875, sect. 1; Act of 1883, sect. 77; see Chap. XII., pp. 312 *et seq.*

(*n*) See the judgment of Cotton, L. J., in *Van Duzer's Tm.*, 34 C. D. p. 634; 4 R. P. C. 31 (1887); and above, p. 315.

(*o*) See *Sen Sen Co.* v. *Britten*, (1899) 1 Ch. at p. 694; 16 R. P. C. at p. 140, Stirling, J.

As the cases cited above show, it is no bar to an action for passing off that the trade-name, get-up, or any other of the badges identified with the plaintiff's business, which are alleged to have been copied or imitated by the defendant, might have been, but are not, registered under the Acts as trade-marks (*p*), even though the evidence is wholly addressed to what may be a mark capable of registration (*q*). Such unregistered marks are frequently referred to as "common law trade-marks" (*q*).

Common law trade-marks.

But a plaintiff who has raised no issue upon his pleadings except in regard to the infringement of his trade-mark, has been refused leave to amend his claim at the trial, so as to start a fresh case of "passing off" in order to save his action (*r*). In the case first cited in the note, however, leave was reserved to the plaintiffs to bring a fresh action to restrain the defendants from passing off their goods as the plaintiffs'. If a charge of fraud is to be made at the trial, it is essential that it should be put forward clearly and prominently on the pleadings (*s*).

New case of passing off or of fraud raised at the trial.

Passing off cases are usually cases of deliberate and intentional misrepresentation, and they have been treated in many reported judgments even in recent cases, in which the attention of the Court was not directed to the point, as though fraud were a necessary element of the right of action; but it is well settled that this is not the case (*t*). In an action

Proof of fraudulent

(*p*) See above, Chap. XII., p. 317, and *Great Tower Street Tea Co.* v. *Langford & Co.*, 5 R. P. C. 66 (1887), Stirling, J.

(*q*) *Reddaway & Co.* v. *Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639; 9 R. P. C. 503, Lindley, L. J.; *Barber* v. *Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L. J.

(*r*) *Native Guano Co.* v. *Sewage Manure Co.*, 4 R. P. C. 478; 8 R. P. C. 125 (1887), Kay, J., C. A. and H. L. Leave was granted, the defendants not objecting, in *Jay* v. *Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.; and also in *Barber* v. *Manico*, *supra*, where the defendants raised the objection.

(*s*) *Leahy, Kelly and Leahy* v. *Glover*, 10 R. P. C. 141 (1893), H. L.

(*t*) *Singer Manufacturing Co.* v. *Wilson*, 3 App. Ca. 376 (1877), Cairns, L. C., cited above, p. 14; *Johnston* v. *Orr-Ewing*, 7 App. Ca. 219 (1882); *Singer Manufacturing Co.* v. *Loog*, 8 App. Ca. 15 (1882); *Reddaway* v. *Bentham*, (1892) 2 Q. B. 639; 9 R. P. C. 503, C. A.; *Saxlehner* v. *Apollinaris Co.*, (1897) 1 Ch. 893; 14 R. P. C. 645, Kekewich, J.; and see the judgments of Cotton, L. J., in *Borthwick* v. *The Evening Post*, 37 C. D.

intention is not essential.

to restrain passing off, proof that the defendant intended to deceive, if his conduct is shown to be calculated to pass off his goods as those of the plaintiff, or to cause them to be so passed off, is no more necessary than in an action for infringement (*u*). And if it were necessary, it would be sufficient evidence of fraud to show that the defendant continued, or sought to continue, to use the deceptive badges or descriptions, after the danger of mistake arising from their use had been brought to his notice (*x*). For it has never been held that innocent inception is a defence (*y*).

"Property" in trade-names and get-up.

It is obvious, therefore, that a trader has much the same right in respect of his trade-name, the get-up of his goods, and all the other distinctive badges and descriptions by which goods are known to be his, as he has in respect of his trade-marks, although the latter right is called a right of property, and the former is commonly, but not invariably (*z*), denied that title (*a*). There are, however, important practical

449 (1888); and *Turton* v. *Turton*, 42 C. D. 128 (1889), cited below, p. 508; and Halsbury, L. C., in *Cellular Clothing Co.* v. *Maxton*, (1899) A. C. at p. 334; 16 R. P. C. at p. 404; *Chivers & Sons* v. *Chivers & Co., Ld.*, 17 R. P. C. 420 (1900), Farwell, J., is the latest authority.

(*u*) Chap. XV., p. 375. This rule was too well settled to be disturbed by the judgments in *Derry* v. *Peek*, 14 App. Ca. 337 (1889), although it originally rested upon the extension of the action of deceit to cases where there was no intentional deception, which was reprobated in that case. Although in some judgments actions for passing off have been referred to as actions for deceit, *e.g.*, as by Vaughan Williams, L. J., in *Jamieson* v. *Jamieson*, 15 R. P. C. at p. 191, they are not actions for deceit in the ordinary sense, *i.e.*, actions brought to recover damages for a fraudulent misrepresentation made *to the plaintiff*. See also note (*x*).

(*x*) See p. 375, above; and *Chivers* v. *Chivers*, note (*t*).

(*y*) *Paine & Co.* v. *Daniells and Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 217, C. A.

(*z*) *Clement* v. *Maddick*, 1 Giff. 98 (1859) Stuart, V.-C.; *Borthwick* v. *The Evening Post*, 37 C. D. 449 (1887), Kay, J., property in the name of a newspaper. Cf. p. 460, note (*p*) below.

(*a*) See per Lord Blackburn, in *Singer Manufacturing Co.* v. *Wilson*, 3 App. Ca. p. 400. In *Reddaway* v. *Banham*, (1896) A. C. at p. 209, 13 R. P. C. 228, Lord Herschell said that he doubted whether it was accurate to speak of there being property in such a trade-mark (*i.e.*, a common law trade-mark), though no doubt some of the rights which are incident to property might attach to it, especially if it was such as to be capable of no conceivable legitimate use except by the proprietor. In *Jamieson & Co.* v.

differences between the two rights. A trade-mark being deliberately assumed or invented as a distinctive mark to identify the goods of its proprietor because of its supposed fitness for the purpose, could hardly be adopted by any other trader in the same market for similar goods without its use by him being calculated to deceive. But the other badges and descriptions referred to, although by use they may become more or less identified with the trader who used them first, or most extensively, may have been adopted merely for purposes of convenience or of ornament, and may have been suggested by the circumstances of the trade in question, or of the trader himself; and the same considerations or circumstances may suggest the use of the same badges and descriptions to others also (*b*), and their use of them will not necessarily be calculated to deceive. The cases in which a defendant can plead an independent right to the use of badges or descriptions which are not trade-marks,—for instance, to the use of the same trade-name as the plaintiff,—are much more important than the rare cases in which he can claim a right to use the trade-mark of the plaintiff or a trade-mark closely resembling it (*c*).

Inferiority of the spurious goods need not be shown.

It is immaterial to the existence of the plaintiff's right of action that the goods passed off as his are as good as or better than his own (*d*); but it would seem that if they are not inferior no case of damage by injury to the plaintiff's trade reputation could be made out.

Rules and practice of infringement action apply, in general, to passing off action.

It will be seen from the definition placed at the beginning of the chapter, and the comparison of the two actions in the preceding pages, that the rules and principles relating to the action of infringement which are collected in the last chapter,

Jamieson, 15 R. P. C. at p. 191, Vaughan Williams, L. J., said it was wrong to assume that a trader acquired some sort of property in his trade-name or its use, and that the action is one of deceit.

(*b*) Or to customers of other traders, as for instance in the *Dolly Blue Case*, *Edge* v. *Gallon*, 17 R. P. C. 557 (1901) H. of L.

(*c*) See per Cotton, L. J., in *Turton* v. *Turton*, 42 C. D. p. 142, and Chap. XV., p. 384; and the last note.

(*d*) *Blofield* v. *Payne*, 4 B. & Ad. 410; 2 L. J. K. B. N.S. 68 (1833); *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185 (1863), Westbury, L. C.; per Lord Blackburn, in *Singer Manufacturing Co.* v. *Loog*, 4 App. Ca. p. 29. See last chapter, pp. 363 and 364.

in general apply also to the action for "passing off," substituting proof of repute for evidence of title and registration. The defences available, the relief granted, and the practice and procedure in both actions are substantially the same.

1. Direct Misrepresentation as to Business or Goods.

Where there is a direct misrepresentation by the defendant that the goods he sells are the goods of the plaintiff, the case presents no difficulty.

No case if the defendant believed that his representation was true.

Thus, in *Ainsworth* v. *Walmsley* (*d*), it was shown that the defendant had sold certain spools of thread wound and marked like the plaintiff's thread, with a representation that it was of the plaintiff's make. The defendant asserted that he had himself bought it on a like representation, which he believed, and that he had disclosed the source through which he himself obtained the goods, and his assertion was not disproved. The Vice-Chancellor accordingly dismissed the suit, for if the defendant in fact believed that the thread was the plaintiff's thread, he had committed no act of which the plaintiff could complain. Had he known it was not, there would have been a clear case for an injunction. "The use (by one manufacturer) of the name of another manufacturer," the Vice-Chancellor said, "whether *scienter* or not, is an interference with his business which this Court will interpose to prevent, on the ground that the defendant is endeavouring to pass off the goods of his own, or somebody else's, manufacture, as the manufacture of the plaintiff." But, he added, "taking the case most strongly against the defendant, it merely amounts to this, that Walmsley stated to the purchaser, 'I sell you thread which I have bought of Wreford, but which I know to be Ainsworth's.'"

"Similar to."

But no action lies for passing off the defendant's goods as "similar to" those of the plaintiff (*e*), or with a representa-

(*d*) L. R. 1 Eq. 518 (1866), Wood, V.-C. Upon the facts proved the plaintiff would probably succeed at the present day. The Vice-Chancellor treated the representation as practically equivalent to a warranty to the purchaser and no more.

(*e*) *Magnolia Metal Co.* v. *Tandem Smelting Syndicate*, 15 R. P. C. 701; 17 R. P. C. 477 (1900) C. A. and H. of L.

tion that they are better than his (*f*), even though the statements complained of are untrue and injurious to the plaintiff (*g*).

Representation that the defendant's business is that of the plaintiff.

Cases in which the defendant directly represents that his business is the plaintiff's business, or a branch of it, are equally clear as soon as the false representation is made out.

False pretence of a business connection.

A partner or servant who has left a well-known firm and set up a similar business of his own, is entitled to advertise his former connection (*h*), unless restrained from doing so by contract with his late partners or employers (*i*); but he must take care to do it so as not to suggest that the connection is still existing between them and him (*k*), or that they have ceased to carry on business and he is their successor (*l*).

And the same rule holds good of a trader who (*m*), or whose trustee in bankruptcy (*n*), has sold the goodwill of his business.

False representation of succession to business.

Thus, where the son of the plaintiff quitted his father's employment, and described himself as "late of 107, Strand" (*k*), an injunction was granted to restrain him from continuing to do so. So, in *Scott* v. *Scott* (*o*), a doorplate, bearing the words "Scott and Nixon, late Robert and Walter Scott," was held to be a representation that Walter Scott had retired,

"Late."

(*f*) *White* v. *Mellin*, (1895) A. C. 154.

(*g*) *Hubbuck* v. *Wilkinson*, (1899) 1 Q. B. 86, C. A., and see cases last cited.

(*h*) *Clark* v. *Leach*, 32 Beav. 14; 1 De G. J. & S. 409; 32 L. J. Ch. 290 (1862), Romilly, M. R., and Westbury, L. C.

(*i*) Asin *Wolmershausen* v. *O'Connor*, 36 L. T. N.S. 921 (1877); and *Selby* v. *The Anchor Tube Co.*, W. N. (1877) 191, both Bacon, V.-C., where the style and goodwill passed, under the articles, to one partner on a dissolution. A servant must not use information acquired in his employment to enable him to solicit his master's customers to deal with him after he has left the employment: *Robb* v. *Green*, (1895) 2 Q. B. 1, 315, Hawkins, J., and C. A. As to sales of goodwill, see below, p. 496.

(*k*) *Burgess* v. *Burgess*, 3 De G. M. & G. 896; 22 L. J. Ch. 675 (1853), Kindersley, V.-C., and L. JJ.; and see p. 382.

(*l*) See the cases next cited, and *Labouchere* v. *Dawson*, L. R. 13 Eq. 322 (1872), Romilly, M. R.

(*m*) *Churton* v. *Douglas*, Johns. 174; 28 L. J. Ch. 841 (1859), Wood, V.-C.; *Fullwood* v. *Fullwood*, W. N. (1873) 93 and 185, Malins, V.-C., and L. JJ. See this further discussed below, p. 497.

(*n*) *Hudson* v. *Osborne*, 39 L. J. Ch. 79 (1869), James, V.-C. See further, as to this, below, p. 499.

(*o*) 16 L. T. N.S. 143 (1866), Wood, V.-C.

and that Scott and Nixon were carrying on the business of his old firm.

And in a case where no such connection as those above referred to had ever existed between the defendants and the plaintiffs, but the defendants, having obtained a lease of clay mines formerly leased to the plaintiffs, described themselves in advertisements, referring not only to the mines, but to certain works also, where they carried on a trade similar to that of the plaintiffs, as *E. and J. Pearson* (*late Harpers and Moore*), the description was held to be a representation calculated to lead the public to believe that the plaintiffs, Harpers and Moore, had retired from business (*p*). So where the plaintiff and defendant were carrying on business as rival dentists in the same street, and, on the expiration of his tenancy, the plaintiff was compelled to remove, and the defendant put up a board describing himself as the "old established dentist," this was held to be a representation that the plaintiff had removed to the defendant's place of business. An interim injunction would have been granted had the defendant not undertaken to put his name very conspicuously upon the board (*q*).

Description of new comer as "the old established."

Another description of false representation of a business connection which sometimes comes before the Courts, is where the defendant has pretended to be agent for the sale of the plaintiff's goods (*r*).

Pretence of agency.

The fraud is commonly effected by issuing misleading circulars or advertisements (*s*), or by placing the deceptive

Deceptive circulars.

(*p*) *Harpers* v. *Pearson*, 3 L. T. N.S. 547 (1860), cited p. 359; *Stevens* v. *Paine*, 18 L. T. N.S. 600 (1868), Giffard, V.-C., and cf. *Townsend* v. *Jarman*, 17 R. P. C. at 657 (1900), Farwell, J.

(*q*) *Mallam* v. *Davis*, 3 Times L. R. 221 (1887), Stirling, J.

(*r*) *Howe* v. *McKernan*, 30 Beav. 547 (1862), Romilly, M. R. (discovery ordered); *Wheeler and Wilson Co.* v. *Shakespear*, 39 L. J. Ch. 36 (1869), James, V.-C. (injunction granted).

(*s*) As in *Purser* v. *Brain*, 17 L. J. Ch. 141 (1848), Shadwell, V.-C.; *Burrows* v. *Foster*, 32 Beav. 18 (1862), L. JJ.; *Graveley* v. *Winchester*, Seton, 5th ed. 591; Seb. Dig. p. 162 (1867), Wood, V.-C. (circulars ordered to be given up); *Stevens* v. *Paine*, 18 L. T. N.S. 600 (1868), Giffard, V.-C.; *Selby* v. *Anchor Tube Co.*, W. N. (1877) 191, Bacon V.-C. (defendants restrained from soliciting or executing orders obtained by the misrepresentations); *Mogford* v. *Courtenay*, 45 L. T. N.S. 303;

name or title on the facia over the defendant's shop (*t*), and by opening and replying to letters addressed to, or intended for, the plaintiff, and executing the orders contained in them (*u*); or some one or more of these devices.

Names over shops. Executing orders intended for the plaintiff.

As further examples of misrepresentation, not included in the classes considered below, may be mentioned claims to medals, prizes, &c. which, in fact, have been gained by the plaintiff (*x*), or to patents under which he, and not the defendant, is working (*y*). Such claims may enable a rival to pass his goods or business off as those of the person who is really entitled to the medals, prizes, or patents. Where they are not calculated to produce such a result no case can be made (*z*).

Claim to the prizes, medals or patents of another.

In the old case of *Clark* v. *Freeman* (*a*), Lord Langdale, M. R., refused to restrain the defendant from selling a quack medicine as "Sir J. Clarke's Consumption Pills," at the instance of the Sir J. Clark referred to, who was an eminent physician, on the ground that the plaintiff carried on no

Unauthorized use of the name of a non-trader.

Vernon v. *Hallam*, 34 C. D. 748 (1886), Stirling, J.; and see *Townsend* v. *Jarman*, note (*p*).

(*t*) *Foot* v. *Lea*, 13 Ir. Eq. 484 (1850), Smith, M. R.; *Burgess* v. *Burgess*, 3 De G. M. & G. 896; 22 L. J. 675 (1853), Kindersley, V.-C., and L. JJ.; *Scott* v. *Scott*, 16 L. T. N.S. 143 (1866), Wood, V.-C. (door plate); *Hookham* v. *Pottage*, L. R. 8 Ch. 91 (1872), Malins, V.-C., and L. JJ. As to the purchase of a building with the vendor's name built into it, see *Jarman* v. *Townsend*, note (*p*).

(*u*) *Schicle* v. *Brackell*, 11 W. R. 796 (1863); Seton, 5th ed. 584, Stuart, V.-C.; *Edgington* v. *Edgington*, 10 L. T. N.S. 299 (1864), Wood, V.-C. (a single instance proved, injunction refused); *Witt* v. *Concoran*, 2 C. D. 69 (1873), Bacon, V.-C.; *Townsend* v. *Jarman*, note (*p*).

(*x*) *National Starch Co.* v. *Munn's Patent Maizena Co.*, (1894) A. C. at p. 281, P. C.; 11 R. P. C. 294; *Franks* v. *Weaver*, 10 Beav. 297; 8 L. T. O.S. 510 (1847), Lord Langdale; see note (*z*), and below, p. 494.

(*y*) *Lawrie* v. *Baker*, 2 R. P. C. 213 (1885), Day, J.; *Pneumatic Rubber Stamp Co.* v. *Lindner*, 15 R. P. C. 525 (1898): see also *Paine & Co.* v. *Daniells & Sons' Breweries*, cited *ante*, p. 371.

(*z*) *Tallerman* v. *Dowsing Radiant Heat Co.*, (1900) 1 Ch. 1, Stirling, J. A medicine vendor published as his own testimonials sent to another. There was no probability of deception. Interlocutory injunction refused. An appeal in this case was compromised. See also *Batty* v. *Hill*, 1 H. & M. 264; 8 L. T. N.S. 791. As to medals and certificates at the Exhibitions of 1851 and 1862, see 26 & 27 Vict. c. 119, below, p. 817. Cf. also *Ajello* v. *Worsley*, (1898) 1 Ch. 274.

(*a*) 11 Beav. 112; 17 L. J. Ch. 142 (1848).

business in pill-making, and that the wrong done to him was a libel only, which the Court of Chancery had no jurisdiction to restrain (*b*). It has always been considered (*c*) that a narrow view was taken of the facts of this case, as the sale of pills under a well-known doctor's name is eminently calculated to suggest that the pills are prepared according to his directions, and to injure his practice if they do not meet with a favourable reception by purchasers who are, or who might become, his patients; but, in a similar recent case, Kay, J., refused to treat the older authority as no longer law, at least, upon an interlocutory application (*d*).

2. Imitations of Trade-Name, Get-up, &c.

The name or get-up must be known as that of the plaintiff or his predecessors whose business he has.

Actions based upon direct misrepresentation are comparatively rare. The plaintiff's case more commonly is that the defendant has copied or imitated the trade-name, or the get-up, or some other badge or description by which the plaintiff's business and goods are known to be his. Where the charge is one of indirect misrepresentation of this sort, the onus is cast upon the plaintiff, in the first place, to show that the things copied or imitated are reputed in the market to denote a connection between himself or his predecessors in business, and the business or goods in, upon, or in reference to which they are used. And this is precisely the proof which the plaintiff had to adduce in trade-mark actions before the Acts. So far as regards marks applied or attached to the goods themselves, it has been considered, and the authorities relevant to it have been collected in a previous chapter (*e*).

(*b*) As to this, see *Bonnard* v. *Perryman*, (1891) 2 Ch. 269; *Collard* v. *Marshall*, (1892) 1 Ch. 571; and *Monson* v. *Tussaud*, 10 Times L. R. 227 (1894).

(*c*) Lord Selborne said the case had seldom been cited except to be disapproved: *Re Rivière's Tm.*, 26 C. D. 48 (1884). See also *Maxwell* v. *Hogg*, L. R. 2 Ch. 307 (1867), Lord Cairns; *Springhead Spinning Co.* v. *Riley*, L. R. 6 Eq. 551 (1868), Malins, V.-C. Cf. the case of the name of a private house, below, p. 474. As to authors' names, see p. 487, below.

(*d*) *Williams* v. *Hodge*, 4 Times L. R. 175 (1887). Kekewich, J., did so in *Lee* v. *Gibbings*, 67 L. T. 263 (1892). But see *Dockrell* v. *Dougall*, 80 L. T. 556 (1899), C. A.

(*e*) Definition of a trade-mark, Chapter II., p. 23; *Lawson* v. *The Bank of London*, 18 C. B. 84; 25 L. J. C. P. 188 (1856).

The plaintiff himself may be unknown.

It is not, however, necessary to show that the customers who knew the goods of the plaintiff's firm by a particular name or get-up knew anything whatever about the plaintiff. It is immaterial that they did not even know his name (*f*); for it is sufficient to prove that purchasers of his goods recognized, by the use of the marks in question in connection with them, that they were goods of a particular class, and to show that such class is, in fact, constituted by his goods.

Thus, in the much contested *Yorkshire Relish Case* (*g*), the plaintiff's sauce was made according to a secret recipe, and was always bought and sold by the name alone. The defendants made a sauce described as a "wonderful match" of the plaintiff's, and their contention was that the public knew and cared nothing about the actual manufacturer, but wanted only the sauce known as *Yorkshire Relish*. The contention failed. Lord Herschell said of it in the House of Lords: "I think that the fallacy of the appellant's argument rests on this: that it is assumed that one trader cannot be passing off his goods as the manufacture of another unless it be shown that the persons purchasing the goods know of the manufacturer by name, and have in their mind when they purchase the goods that they are made by a particular individual. It seems to me that one man may quite well pass off his goods as the goods of another if he passes them off to people who will accept them as the manufacture of another, though they do not know that other by name at all. In the present case it seems to me that *Yorkshire Relish* meant the manufacture of a particular person" (*h*).

Evidence of repute.

Where the existence of such repute is not shown, the action cannot succeed (*i*). Thus, in a case where the plaintiff claimed only as the mortgagee of a business and its trade-name, and had never used, and did not intend to use, the trade-name (*k*), and in a case in which the plaintiffs were

(*f*) *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A. (*Sunlight Self-washer Soap*); see next case.

(*g*) *Powell* v. *The Birmingham Brewery Co.*, (1896) 2 Ch. 54; 12 R. P. C. 496 (1897) A. C. 710; 14 R. P. C. 720, and p. 35, above.

(*h*) (1897) A. C. at p. 715.

(*i*) *Goodfellow* v. *Prince*, 35 C. D. 9 (1887), C. A.

(*k*) *Beazley* v. *Soares*, 22 C. D. 660 (1882), Pearson, J.; cf. *Clark* v. *Freeman*, *ante*, p. 457.

carrying on no business in England (*l*), the actions were dismissed. But no length of time during which the use of the badges in question by the plaintiff or his predecessors must have extended can be laid down (*m*), although it seems safe to assume that an actual and practical knowledge of the connection between them and him by a number, apparently considerable, of probable dealers in, or purchasers of, the goods must be shown, and, accordingly, that a name, get-up, or other badge just adopted and brought into use, would not now be protected, as a newly adopted trade-mark would have been before the Registration Acts (*n*), and would be now, if registered, under sect. 76.

It has been held that three days' use of the name of a new weekly newspaper, of which fifteen copies had been sold (before the defendant's publication began), was not sufficient to give the owners any right to stop other persons using the same name for a rival paper (*o*).

The reputed connection must be a connection of the trade or the goods, in or upon which the name, get-up, or other badges are used, with the plaintiff himself, or else with his predecessors as owners of the business in which he is at the time of action, using, or intending to use them. And trade-names may be assigned and may devolve in connection with the goodwill of the business (*p*). The rules in regard to

Assignment and devolu-

(*l*) *Robineau* v. *Charbonnel*, W. N. (1876) 160, Malins, V.-C. The plaintiffs were confectioners (*quære* dressmakers) in Paris, having no agency in England. Held, no probability of injury.

(*m*) This was stated to be a question for a jury in the old case of *Purser* v. *Brain*, 17 L. J. Ch. 141 (1848), Shadwell, V.-C. (*The London Manure Co.*).

(*n*) *Maxwell* v. *Hogg*, L. R. 2 Ch. 307 (1867), L. JJ.; *Hall* v. *Barrows*, 32 L. J. Ch. 548 (1863), Romilly, M. R.; *McAndrew* v. *Bassett*, 33 L. J. Ch. 561 (1864), Wood, V.-C., *ante*, p. 33.

(*o*) *Licensed Victuallers' Newspaper Co.* v. *Bingham*, 38 C. D. 139 (1888); North, J., and C. A.; Cotton, L. J., said that the larger sale of the plaintiff's paper subsequently to the adoption of the defendant's name was immaterial; cf. *Maxwell* v. *Hogg*, *supra*, and p. 33, above.

(*p*) "I think it is settled by a series of cases, of which *Hall* v. *Barrows* (note (*n*)) is, I think, the leading one, that both trade-marks and trade-names are, in a certain sense, property, and that the right to use them passes with the goodwill of the business to the successors of the firm which originally established them, even though the name of that firm be changed, so that they are no

assignment already discussed in relation to trade-marks (*q*) apply, therefore, to trade-names and similar matters, for if the things which the defendant has copied or imitated denote a connection, not with the plaintiff, but with someone else, he can have no claim to sue in respect of the deception which, as he alleges, the defendant's use of them is calculated to occasion. Thus, in *Pinto* v. *Badman*, the jury at the trial found upon the same facts that the defendant had infringed the plaintiff's trade-mark, and had passed off his goods as those of the plaintiff. On the appeal it appeared that the label and brand copied by the defendant had, not long before the commencement of the action, been assigned, without the business with which they were connected, by certain third parties to the plaintiff. Upon this ground the Court of Appeal set aside the verdict and entered judgment for the defendants, notwithstanding the finding as to "passing off" (*r*). And neither a licence to use, nor an absolute assignment of a trade-name without the goodwill of the business to which it was attached, entitles the licensee or assignee to sue to restrain the use of the name by another trader (*s*).

Application of trade-name, &c.

The question of repute is, however, rarely considered separately, for, as a right of property in respect of the exclusive use of marks or badges other than registered trade-marks (and, to some extent, the trade-name of the plaintiff) is not recognized, it is generally more convenient to deal directly with the more general question: Is the defendant's conduct calculated to pass off his goods as those of the plaintiff? (*t*).

The question as to repute is not generally considered separately.

The imitation by the defendant of any of the badges by which the plaintiff's goods are known to be his, falls within

longer strictly correct"; per Lord Blackburn, in *Singer Manufacturing Co.* v. *Loog*, 8 App. Ca. p. 33 (1882). See above, p. 452, n. (*x*).

(*q*) Chap. XIII. p. 324.

(*r*) 8 R. P. C. 181 (1891). The case, so far as regards passing off, was not expressly referred to in the judgments, but the principles stated were as applicable to that as to the case for infringement.

(*s*) *Thorneloe* v. *Hill*, W. N. (1894) 15; 11 R. P. C. 61, Romer, J. (*John Forrest*). It follows that the mere right to use a name cannot be sold; see below, p. 471.

(*t*) See *Jamieson & Co.* v. *Jamieson*, 15 R. P. C. 169 (1898), in the C. A.

the scope of the action to restrain passing off. The most important of these badges are the trade-name of the plaintiff and the trade-name and the get-up of his goods.

A. The Plaintiff's Trade- or Firm-name.

A man's own name, or the name under which he trades, may be an ordinary trade-mark, if used as such, that is, applied or attached to the goods in which he deals (*u*). If it is "printed, impressed, or woven in some particular and distinctive manner," or in the form of "a written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade-mark," it may be entered upon the Register (*x*). But although it is not so used or registered, and it therefore does not become a trade-mark, its use by the defendant for trading purposes in connection with goods which are not the plaintiff's is obviously calculated to mislead, unless it happens to be the name of the defendant also, or a name under which he is entitled to trade (*y*).

Principle on which a trade-name is protected.

The ground upon which the Court acts in protecting a trade-name was stated by James, L. J., in *Levy* v. *Walker* (*z*) in the following passage: "It should never be forgotten that in these cases the sole right to restrain anybody from using any name he likes in the course of any business he chooses to carry on is a right in the nature of a trade-mark, that is to say, a man has a right to say, 'You must not use a name, whether fictitious or real—you must not use a description, whether true or not, which is to represent, or calculated to represent, to the world that your business is my business, and so, by a fraudulent (*a*) misstatement, deprive me of the profits of the business which would otherwise come to me.' An individual plaintiff can only proceed on the ground that, having established a business reputation under a particular name, he

(*u*) See Chap. II., p. 23.

(*x*) Sect. 64, Chap. VIII., pp. 124 and 129.

(*y*) See per Wood, V.-C., *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518 (1866), and p. 500, below.

(*z*) 10 C. D. p. 447 (1879).

(*a*) See above, pp. 14 and 451.

has a right to restrain anyone else from injuring his business by using that name" (*b*).

It may belong to others beside the plaintiff.

The name taken or copied by the defendant need not be that under which the plaintiff alone, and no other person, is properly trading. Thus, in *Dent* v. *Turpin* (*c*), Wood, V.-C., held that each of two firms carrying on business separately as watchmakers under the name *Dent* might sue a third person, who had set up a similar business under the same name, for an injunction, delivery up of the marked articles, and an account of profits (*d*). But if the name in question is properly used by more than one person the difficulty of showing that its use by the defendant has caused his goods to be taken for those of the plaintiff may be greatly increased (*e*).

It need not be the plaintiff's family name.

And as stated by James, V.-C., in the judgment quoted above, the name need not be the personal name of the plaintiff (*f*). It need not even be that of a predecessor in business, for a trader may lawfully adopt and trade under any name which is unappropriated for businesses of the same kind, and when the name has become his by repute he is as

(*b*) Cf. Lord Chelmsford's statement in *Du Boulay* v. *Du Boulay*, L. R. 2 P. C. p. 441 (1869): "The right to the exclusive use of a name in connection with a trade or business is familar to our law; and any person using that name after a relative right of this description has been acquired by another is considered to have been guilty of a fraud, or, at least, of an invasion of another's right, and renders himself liable to an action, or he may be restrained from the use of the name by injunction"; and *Clark* v. *Freeman*, cited *ante*, p. 457; see also the judgments of James, L. J., and Jessel, M. R., quoted above, pp. 1 and 13.

(*c*) 2 J. & H. 139; 30 L. J. Ch. 495 (1861); *Southorn* v. *Reynolds*, 12 L. T. N.S. 75 (1865), Wood, V.-C. See also per Lord Watson during the argument in *Powell* v. *The Birmingham Brewery Co.*, 14 R. P. C. at p. 726. The action in *Jamieson & Co.* v. *Jamieson*, 15 R. P. C. 169 (1898), failed because the defendant had not used anything identified with the plaintiffs (p. 182), not because there were other Jamiesons in the trade at Aberdeen.

(*d*) As to the relief granted in such a case, see the last chapter, p. 428.

(*e*) See the last case. Vaughan Williams, L. J., said (at p. 193): "The moment it is admitted that the goods of more traders than one are denoted by the same name you have gone a long way towards disposing of the assertion that the particular name is understood in the trade to denote the goods of the plaintiff." See also *Whitstable Oyster Co.* v. *Hayling Fisheries, Ld.*, 17 R. P. C. 461 (1900), Buckley, J.

(*f*) Cf. "Defences," below, p. 511.

well entitled to protection for it as if it were his own (*g*). A modern case before North, J., is an illustration of this rule. There the plaintiffs made and sold a sauce which, by his permission, they called by the name of one of their servants, "Holbrook's Worcester Sauce." The servant left them and joined the defendants, who thereupon advertised that they had acquired the right to make "Holbrook's Worcester Sauce." It was shown that the sauce sold by the plaintiffs was well known as theirs by the name, and the learned judge held that they had a right to the name in question, and that Holbrook could not sell it to the defendants (*h*). In this case the sauce was identified by the name with the plaintiffs, and not with Holbrook; an opposite result would have been reached if the name had been understood to indicate that the latter person was the actual maker of the goods, and that they were his goods of which plaintiffs happened to be vendors (*i*). Thus, in *Franke* v. *Chappell* (*k*), although the plaintiff had organized series of concerts known as "Richter Concerts" for many years, when Herr Richter made arrangements to conduct the rival concerts of the defendants, it was held that the defendants might rightly advertise their series under the name, since it was understood to mean, not concerts got up by the plaintiff, but anybody's concerts conducted by Richter.

The trade-name of a company.

Sect. 20 of the Companies Act, 1862.

In the case of a company registered under the Companies Act, 1862, it is enacted that (*l*)—

> "No company shall be registered under a name identical with that by which a subsisting company is already registered, or so nearly resembling the same as to be calculated to deceive, except in a case where such subsisting company is in the course of being

(*g*) In *Isaacson* v. *Thompson*, 41 L. J. Ch. 101 (1871), Bacon, V.-C., for instance, the plaintiff traded as *Mme. Elise*.

(*h*) *Birmingham Vinegar Brewery Co.* v. *Liverpool Vinegar Co.*, W. N. (1888) 139, an interlocutory injunction was granted; cf. *Dence* v. *Mason*, W. N. (1877) 23; (1878) 42, Malins, V.-C. (*Brand's Essence of Beef*).

(*i*) As to joint trade-marks, see p. 358, above.

(*k*) 57 L. T. N.S. 141 (1887), Chitty, J.

(*l*) 25 & 26 Vict. c. 89, s. 20.

dissolved (*m*), and testifies its consent in such manner as the registrar requires."

And the section further makes provision for a change of the name of any company which, through inadvertence or otherwise, is registered under a name which falls within the prohibition.

As Mr. Justice Buckley points out in his note to the section (*n*), it is to be observed (1) that it only applies to the case of taking the name of a subsisting company already registered, and not to a case like *Hendriks* v. *Montagu* (*o*), where a new company proposes to register in the name of, or in a name closely resembling, the name of an old-established company, which is not registered, or of a firm or individual trader (*p*); (2) that so soon as the new company is registered, the section has ceased to be applicable, so that the old registered company cannot found upon the section any claim for an injunction to restrain the newly registered company from trading under the name; (3) that the Act forbids registration in the same or a similar name, irrespective of the fact whether the business to be carried on under the name is the same or not.

The section is supplementary to the common law.

But the provision of the section is merely in supplement of the ordinary rule upon which the Court acts in protecting trade-names, and that rule is in no way limited by the registration of the name objected to as the name of the defendant company (*q*). An injunction will therefore be granted to restrain the defendant from carrying on the same trade as that of the plaintiff under a name so nearly resembling his as to be calculated to deceive, whether it has been registered as the name of the defendant company or not, and, in the latter event, to restrain the defendants also from applying

(*m*) For example, upon a reconstruction.

(*n*) Buckley on the Companies Acts, 7th ed. p. 27; see also Palmer's Company Precedents, 7th ed., Pt. I., pp. 265—267.

(*o*) 17 C. D. 638 (1881), Jessel, M. R., and C. A.

(*p*) *Hoby* v. *Grosvenor Library Co., Ltd.*, 28 W. R. 386.

(*q*) *Merchant Banking Co. of London* v. *Merchants Joint Stock Bank*, 9 C. D. 560 (1878), Jessel, M. R.; *Manchester Brewery Co., Ld.* v. *North Cheshire and Manchester Brewery Co., Ld.*, (1898) 1 Ch. 539; (1899) A. C. 83.

Hendriks v. *Montagu*.

for registration of the name. In *Hendriks* v. *Montagu* (*r*), the leading case on the point, the plaintiff, on behalf of the *Universal Life Assurance Society*, sued certain persons who were the promoters of an intended new company, to be called the *Universe Life Assurance Association*, and an injunction in the following form was granted:—

The injunction granted.

"To restrain the defendants from applying to the registrar of joint stock companies in England, for registration under the Companies Acts, of any company to be incorporated under the name of the *Universe Life Assurance Association*, or any other name likely to mislead or deceive the public into the belief that the company, being incorporated as aforesaid, is the same as the *Universal Life Assurance Society*, from issuing or publishing advertisements, circulars, or prospectuses representing that a company is to be incorporated pursuant to the Companies Act, 1862, under the name of the *Universe Life Assurance Association, Limited*, or any such other name as aforesaid; and from carrying on or commencing any business under the name of the *Universe Life Assurance Association, Limited*, or any such other name as aforesaid."

The Master of the Rolls had refused the first branch of the injunction (as to the application to register), on the ground that no case could be made for granting it except under the section, and that the section did not apply, because the plaintiffs were not a registered company, and he had refused the second and third branches (as to advertising and carrying on business), on the ground that it was not shown that the defendants would carry on the same business as the plaintiffs, or that, if they did, the resemblance of the names must necessarily lead to the unfair appropriation by them of part of the plaintiffs' business; but the Court of Appeal overruled all these objections. The Lords Justices held that the defendants were shown to have threatened and intended to carry on the same business, and that it was morally certain that, if they did so under the name they had adopted, persons who had heard of the *Universal* would be misled into going to the

(*r*) 17 C. D. 638 (1881), Jessel, M. R., and C. A.

Universe. And this, the Court said, according to the rules of equity, was sufficient, without reference to the Act, to entitle the plaintiffs to the injunction they claimed.

The ground of the interference of the Court is, that the use of the defendant company's name, or its intended name, is calculated to deceive, and so to divert business from the plaintiff to the defendant, or to occasion a confusion between the two businesses. If this is not made out there is no case (*s*).

No monopoly allowed in names merely descriptive.

And the mere employment of a term which is descriptive of the business of both the parties, will not of itself be accepted as sufficient to make out the plaintiff's case (*t*). If it were it would give the first user a monopoly in the term. "If a company which does colonial business cannot call itself colonial, it is obvious that, under a species of assertion that the word colonial is symbolical, the plaintiffs might prevent every other person using it as descriptive of his trade" (*u*).

Cases of company trade-names.

In *The Guardian Fire and Life Assurance Co.* v. *The Guardian and General Insurance Co.* (*x*), the plaintiff company were a very old-established institution, and were commonly known as *The Guardian* or *The Guardian Assurance Co.*, and the defendant company had been lately formed by the reconstruction of the *Guardian Horse and Vehicle Insurance Association*. They had assumed powers to carry on general insurance business, and their offices were near those of the plaintiffs, in Lombard Street. It was shown that there were two other companies doing some insurance business in other parts of London, under names comprising the word *guardian*; but notwithstanding this, Jessel, M. R., held, that the defendants' new name was calculated and intended to deceive, and

(*s*) See the cases collected below.

(*t*) Cf. the rule against descriptive trade-marks, Chap. II., p. 36; Chap. VIII., p. 140; and as to infringement in similar cases, Chap. X., pp. 243, 244, and below, p. 476.

(*u*) *Per* Lord Romilly, in *The Colonial Fire Assurance Co.* v. *The Home and Colonial Assurance Co.*, *Ltd.*, 33 Beav. 548; 33 L. J. Ch. 741 (1864); see also *India and China Tea Co.* v. *Teide*, W. N. (1871) 241, Jessel, M. R.; and *The Australian Mortgage, Land, and Finance Co.* v. *The Australian and New Zealand Mortgage Co.*, W. N. (1880) 6, C. A., cited p. 470.

(*x*) 50 L. J. Ch. 253 (1880), Jessel, M. R.

he would have granted an injunction had they not undertaken to call themselves the "Guardian Horse, Vehicle, and General Insurance Company."

Taking an existing name as a whole.

A new company will not be allowed to take the whole name of a subsisting company even though that name is of a descriptive character (*y*). Thus, where the Manchester Brewery Co., Ld., had a brewery and a large business at Manchester, a new company which had acquired a brewery at Macclesfield with a business extending to Manchester, as well as other towns, attached to it, was restrained by the Court of Appeal from trading as the "North Cheshire and Manchester Brewery Co., Ld." The decision was affirmed by the House of Lords on the ground that the use of the name would amount to a representation that the new company was an amalgamation comprising the business of the complainants (*y*).

Name suggesting an amalgamation.

Name comprising plaintiffs' trade-name.

In the *Eastman Co.* v. the *John Griffiths Corporation, Ld.*, and the *Kodak Cycle Co., Ld.*, the first-named defendants had promoted the Kodak Co., to which they gave a name comprising as its distinctive element the trade-name of the plaintiffs' goods, *Kodak*. Both defendants were restrained from carrying on business under the name Kodak Cycle Co., Ld., or under any name comprising the word *Kodak* (*z*).

Assignments of trade-name to or by a limited company.

A limited company often becomes by purchase of a business entitled to a trade-name which is different from its registered name, and, provided that sect. 41 of the Companies Act is not violated, there seems to be no objection to its continuing the use of such a name in connection with its business (*a*), and it could, whether it had so used the name or not, if it had not abandoned it, prevent a person so using it as to represent that he was carrying on the business formerly carried on under the name; and, moreover, the company could sell the name with, of course, the goodwill (*b*).

(*y*) *Manchester Brewery Co., Ld.* v. *North Cheshire, &c. Co., Ld.*, (1898) 1 Ch. 539; (1899) A. C. 83.

(*z*) 15 R. P. C. 105 (1898), Romer, J. See the order below, p. 759.

(*a*) It would not, perhaps, be proper to use the name *qua* trade-name alone, but such a use as Jones & Co., incorporated in Smith & Robinson, Ld., would seem to be unobjectionable.

(*b*) *Townsend* v. *Jarman*, 17 R. P. C. 649 (1900), Farwell, J. As to the effect of contraventions of the section

Although a limited company could not, it is presumed, sell to a purchaser of its goodwill the whole of its registered name, yet a third person would not be permitted after the dissolution of a company to adopt its name except the word "limited," so as to lead to the belief that his business was that formerly carried on by the company (*c*).

Injunctions granted.

Injunctions were granted in *Hoby* v. *The Grosvenor Library Co., Ld.* (*d*), where the plaintiff's library was called the "Grosvenor Library," and in *The Accident Insurance Co., Ld.* v. *The Accident, Disease, and General Insurance Co., Ld.* (*e*), where the plaintiff company was popularly known as *The Accident Company* or *The Accident;* also in the cases specially mentioned above.

Injunctions refused.

In the following cases injunctions were refused: *London and Provincial Law Assurance Society* v. *London and Provincial Joint Stock Life Assurance Co.* (*f*), although there was evidence that the former company was usually called the *London and Provincial Insurance Co.; London Assurance* v. *London and Westminster Assurance Corporation* (*g*); *Colonial Life Assurance Co.* v. *Home and Colonial Assurance Co., Ld.* (*h*); *London and County Banking Co.* v. *Capital and Counties Bank* (cited in the next case); *Merchant Banking Co. of London* v. *Merchants Joint Stock Bank* (*i*); *The Army*

above referred to, see *Pearks, Gunston & Tee, Ld.*, v. *Thompson, Talmey & Co.*, 18 R. P. C. 185 (1901), Farwell, J., on appeal the case was settled.

(*c*) *Montreal Lithographing Company* v. *Sabiston* (1899), A. C. 610, J. C., really supports this proposition, although the actual decision, which turned on the special facts of the case (see *Townsend* v. *Jarman*, 17 R. P. C. 649), was there in favour of the defendant, it being held that the mere use of the name was not, under the circumstances, calculated to deceive.

(*d*) 28 W. R. 386.

(*e*) 54 L. J. Ch. 104 (1884), Pearson, J.; see also *Wolmershausen* v. *G. S. Wolmershausen & Co., Ld.*, W. N. (1892) 87, Chitty, J.; *Saunders* v. *The Sun Life Assurance Co. of Canada*, (1894) 1 Ch. 537; 10 Times L. R. 183, Stirling, J.; and *Premier Cycle Co., Ld.* v. *Premier Tube Co., Ld.*, 12 T. L. R. 481 (1896), Chitty, J., interlocutory injunction granted against the use of *Premier* as part of the title of the defendant company, whose works had before the formation of the company for six years been known as "Premier Mills."

(*f*) 17 L. J. Ch. 37 (1848), Shadwell, V.-C.

(*g*) 32 L. J. Ch. 664 (1863), Stuart, V.-C.

(*h*) 33 Beav. 548; 33 L. J. Ch. 741 (1864), Romilly, M. R.

(*i*) 9 C. D. 560 (1878), Jessel, M. R.

and Navy Co-operative Society, Ld. v. *The Junior Army and Navy Stores, Ld.* (*g*); *Australian Mortgage Land and Finance Co.* v. *Australian and New Zealand Mortgage Co.* (*h*). In *Bamstead* v. *The General Reversionary Co., Ld.*, an interlocutory injunction was refused, because, although the defendant company had adopted a name resembling that of the company of which the plaintiff was secretary, the General Reversionary and Investment Co., yet there was no probability of deception because the former was a small Liverpool concern, and the latter a very large London one (*i*).

The company may continue an established name.

A limited company formed to take over a business may adopt and use a name embodying a name under which the business has already been lawfully and properly carried on (*k*). This was fully recognized by Stirling, J., in the case of *Tussaud* v. *Tussaud* (*l*), where, however, the condition did not obtain. In that case an unsuccessful attempt was made by the defendant to shelter himself under the general exception to the principle stated at the head of this chapter, that anyone may honestly trade under his own name, which is discussed more fully below (*m*). The plaintiffs, Madame Tussaud and Sons, Limited, were the owners of a waxwork exhibition originally founded by a Madame Tussaud, and subsequently carried on by the father and uncles of the defendant. Their business was often referred to as *Madame Tussaud's*, and not infrequently as *Tussaud's* only. The defendant, who was a wax modeller by trade, was promoting a company to be called

(*g*) Seb. Dig. p. 393 (1879), Jessel, M. R.

(*h*) W. N. (1880) 6, C. A., James, L. J., said: "The difficulty in these cases was, that while the business name of another could not be appropriated, a man could not, on the other hand, give himself any monopoly in a name which, as in this case, merely described the nature of the business or the locality of its operations"; see above, p. 467.

(*i*) 4 Times L. R. 621 (1888), Stirling, J.

(*k*) In *S. Chivers & Sons* v. *S. Chivers & Co., Ld.*, 17 R. P. C. 420 (1900), Farwell, J., said, at p. 426: "To my mind, no element of suspicion of fraud attaches to a man who has established a business under his own name if he turns that business into a limited company, and applies to that limited company his own name with the word "limited," because the reason for doing so is obvious, that he desires to retain the goodwill which he has gained for that name."

(*l*) 44 C. D. 678 (1890), Stirling, J.; *Rendle* v. *Rendle & Co.*, 63 L. T. 94 (1890), Kay, J., is a somewhat similar case.

(*m*) Page 500.

Louis Tussaud, Ld., to open and carry on a waxwork exhibition under that name in Shaftesbury Avenue, the plaintiffs' exhibition being situated in the Marylebone Road. He was to be engaged as manager of the exhibition and modeller of the exhibited figures. He had never carried on, and did not possess the goodwill of, any business in any such exhibition.

The judgment of Stirling, J.

It follows, said the learned judge, "from the decisions in *Burgess* v. *Burgess* (*n*) and *Turton* v. *Turton* (*o*), 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 *Louis Tussaud & 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 present to say that that company might not be registered under the same name as had previously been used in connection with the business" (*p*).

Right to use a name not attached to any goodwill cannot be sold.

But the defendant could not, it was held, sell the right to use his name in connection with a business which he had never carried on, and in which he had no interest whatever, or in which he stood simply in the position of a paid servant (*q*). And the proper inference to be drawn from the facts of the case *primâ facie* was, the learned judge concluded, that the object of the defendant in promoting the proposed

(*n*) 3 D. M. & G. 896; 22 L. J. Ch. 675 (1853), Knight-Bruce and Turner, L. JJ., cited p. 501.

(*o*) 42 C. D. 128 (1889), C. A., reversing North, J., cited p. 508.

(*p*) 44 C. D. p. 687.

(*q*) Cf. *The Birmingham Vinegar Brewery Co.* v. *The Liverpool Vinegar Co.*, *supra*, p. 464; and *Warner* v. *Warner*, 5 Times L. R. 327, 359 (1889), Stirling, J., and C. A., (*Warner's Cure*); and see below, p. 511.

company was to induce the world to believe that the business intended to be carried on was that of the plaintiff company or a branch of it, notwithstanding that the prospectus issued by the defendant plainly stated on the face of it that the new exhibition had no connection with the plaintiff company. An interim injunction in the terms of that in *Hendriks* v. *Montagu* (*r*), set out above, was accordingly granted.

In three cases which subsequently came before the Courts attempts appear to have been made to carry through the series of operations indicated in the judgment just cited, but in each instance the defence which might have been founded upon them was displaced by evidence of deliberate fraud.

Brinsmead & Co. v. T. E. Brinsmead, Ld.

In *The Brinsmead Case* (*s*), the plaintiffs were the well-known firm of pianoforte makers. T. E. Brinsmead and his sons, who were relatives of the partners, and had been in their employment, started a small independent business as "T. Brinsmead & Sons." They were restrained from trading under the name Brinsmead without using their full names, and they then promoted the defendant company under the name of "Thomas Edward Brinsmead & Sons, Ld.," with the fraudulent intention of getting some of the plaintiffs' business. By the use of this name they induced the public to subscribe for shares in the belief that the company possessed the plaintiffs' business. The defendants were restrained from using the name Brinsmead in connection with pianos without an express statement that they had no connection with the plaintiffs' firm.

No connection.

Pinet et Cie. v. Maison Pinet, Ld.

In *Pinet's Case* (*t*), a man who had carried on business in special boots for lame persons as "Maison Pinet," assigned his business to a company called "Maison Pinet, Ld." The French firm of Pinet et Cie. complained of this, but the defendants contended that they intended only to trade in the special boots, and on that ground Kekewich, J., refused an interlocutory injunction. The Court of Appeal did not

(*r*) *Ante*, p. 466.

(*s*) *John Brinsmead & Co.* v. *Thomas Edward Brinsmead & Sons, Ld.*, 12 Times L. R. 631; 13 *ibid.* 3 (1896), North, J., and C. A. The facts appear in *Re T. E. Brinsmead & Sons, Ld.*, (1897) 1 Ch. 45, 406.

(*t*) *Pinet et Cie.* v. *Maison Pinet, Ld.*, 14 R. P. C. 933 (1897), C. A.

believe the defendants' story, and granted the injunction restraining them from carrying on their business in boots under the name Pinet without clearly distinguishing their boots from those of the plaintiffs. Subsequently it was discovered that the vendor to the defendant company had assumed the name Pinet for the purpose of defrauding the plaintiffs, and an injunction was then granted forbidding the use of the name by the defendants, and forbidding the liquidator of the company selling the right to use the name in connection with boots (*u*).

And in *Valentine's Case* (*v*) the Court of Appeal came to the conclusion that there had been an attempt to get the benefit of the plaintiffs' reputation, and in addition to relief in respect of passing off, they restrained the defendant company from carrying on the business of manufacturers of extract of meat under any name of which *Valentine* formed part.

Name of business, house, or factory.

A trader has the same rights in respect of the name of the house, shop (*x*), or factory (*y*), where he carries on his trade or business, as he has in respect of his trade-name. He can, therefore, support an action for passing off, and obtain an injunction by showing that the name of the house, &c., has a reputed connection with his trade or business or goods, and that the defendant, without having any independent right to

(*u*) *Pinet et Cie.* v. *Maison Louis Pinet, Ld.*, 15 R. P. C. 65 (1898), North, J.

(*v*) *Valentine Meat Juice Co.* v. *Valentine Extract Co., Ld.*, 17 R. P. C. 673, 83 L. T. 259 (1900), C. A. The facts will be found more fully set out below, p. 506.

(*x*) *Hudson* v. *Osborne*, 39 L. J. Ch. 79 (1869), James, V.-C. (*Osborne House*); *Boulnois* v. *Peake*, 13 C. D. 512, n. (1868), Giffard, V.-C. (*The Carriage Bazaar*); *Bodega Co.* v. *Owens*, 6 R. P. C. 236; 7 *ib.* 31; 23 L. R. Ir. 371 (1889), Chatterton, V.-C. (*Bodega Wine Shop*). A number of American decisions are cited by Mr. Sebastian, 3rd ed., p. 294, 4th ed., p. 270. In *Charleston* v. *Campbell*, 4 Sess. Cas. 4th ser. 149 (1876), an injunction to restrain the use of the "Royal Station Hotel," at the instance of the proprietor of the "Station Hotel," was refused, because the title was merely descriptive.

(*y*) *Braham* v. *Beachim*, 7 C. D. 848 (1878), Fry, J. (*Radstock Colliery*); *Montgomery* v. *Thompson*, 41 C. D. 35; (1891) A. C. 217; 8 R. P. C. 361, Chitty, J., C. A., and H. L. (*Stone Brewery*).

do so (*z*), is using for business purposes a name which is calculated to cause his trade, business, or goods to be taken for, or to be confounded with, the plaintiff's (*a*). There is no right to the exclusive use of the name of a mere private house (*b*), and no cause of action arises where, although the defendant has adopted, for business purposes, an address likely to be confused with that of the plaintiff, yet the businesses of the parties are so different that no damage can result to the plaintiff's trade (*c*).

If the name in question is taken from a building where a firm carries on business, it may be that on the removal of the firm the name still attaches to the building and may properly be used by the next tenant. The question appears to be one of fact (*d*).

(*z*) In *Mason* v. *Queen*, 23 Scot. L. R. 641 (1886), the Lord Ordinary held that the goodwill and trade-name of an hotel could not be transferred so as to entitle the transferee to stop a new occupier of the building from using the old name. The "Waverley Hotel," Glasgow, was taken by a railway company under compulsory powers in May, 1884, compensation being paid for loss of business. The proprietor, who had other "Waverley Hotels" in London and Edinburgh, transferred the goodwill and the right to use the name to the plaintiff, who thereupon changed the name of her own house to "Waverley," and put up a notice of removal upon the old building. In January, 1885, the railway company let the old building to the defendant, who opened it as the "Old Waverley." Held: (1) the plaintiff had no exclusive right to the name, and (2) (but *quære* on the special facts) there was no case of passing off. See also *Nicholson* v. *Buchanan*, Sol. Jo., vol. 44, p. 408 (1900), where a firm who were the owners of a business and distillery, sometimes known as "the Black Swan Distillery," which had had a figure of a black swan outside, and who also had a black swan for a trade-mark, sold first the premises to the defendants, and subsequently the goodwill and trade-mark to the plaintiffs. The vendors had been known chiefly for gin, whereas the defendants carried on business on the premises in Scotch whisky, no distilling being done there. On the evidence it was held that there was no probability of deception, and the action in which the plaintiffs complained of the use of the words "Black Swan" and the device was dismissed. As to the assignment of marks having a local connotation, see above, p. 328.

(*a*) See note (*x*) above.

(*b*) *Day* v. *Brownrigg*, 10 C. D. 294 (1878), C. A.

(*c*) *Street* v. *Union Bank of Spain and England*, 30 C. D. 156 (1885), Pearson, J.; the plaintiffs were advertising agents (telegraphic cypher).

(*d*) See *Mason* v. *Queen*, *Nicholson* v. *Buchanan*, *supra*, note (*z*), and *Charleston* v. *Campbell*, *supra*, note (*x*); *Booth* v. *Jarrett*, 52 How. Pr. 169 (1876), New York ("Booth's Theatre"); and Sebastian, 4th ed., p. 272.

B. The Trade-name of the Plaintiff's Goods.

A name which is applied or attached to a trader's goods when they are offered for sale, so as to distinguish them from similar goods, and to identify them with him, or with his successors as the owners of a particular business, as being made, worked upon, imported, selected, certified, or sold by him or them, is a trade-mark (*e*). And if it is within any of the classes enumerated in sect. 64, it may be registered as a trade-mark. But whether or not the name is applied or attached to the goods, so as to conform to the definition just stated, or registered as a trade-mark, if it is in fact known in the market as the distinctive name of the goods of a particular trader, no one else may use it for dealings in other goods of the same class as those in connection with which it has acquired its distinctive signification.

The acquisition of a trade-name by the use of it in connection with the sale of, or with dealings in, goods has already been considered, and the authorities bearing on the subject have been collected in the chapter on the definition of a trade-mark. It will be sufficient, therefore, to summarize shortly the results deduced from the reported cases.

Right restricted to particular goods or business.

The qualified right in the trade-name,—a right to prevent a defendant from passing off his goods as those of the plaintiff by the use of it,—exists only with regard to goods of the kind for which the plaintiff uses it, and to which the connection with his business suggested by the use of the name extends (*f*). So, where the proprietors of *The Morning Post* sought to restrain the publishers of a new evening newspaper from calling their paper *The Evening Post*, the Court of Appeal, holding, as an inference of fact, that there was no probability of the defendant's paper being taken for the plaintiff's, or being taken to have any connection with it so as to cause damage to the plaintiffs, dismissed the action (*g*). But if the name, although not actually used by

The Evening Post Case.

(*e*) Chap. II., p. 24.

(*f*) Page 31; and cf. the rule in respect of the infringement of trade-marks, Chap. XV., p. 366.

(*g*) *Borthwick* v. *The Evening Post*, 37 C. D. 449 (1888), C. A., overruling Kay, J.; but see *Re The Australian Wine Importers, Ld.*, 41 C. D. 278;

the plaintiff for the particular kind of goods to which the defendant has applied it, is so identified with the plaintiff that the defendant's use of it will induce the belief that his goods are those of the plaintiff, or that his business is an extension of (*h*), or an amalgamation with (*i*), or is otherwise connected with the plaintiff's business, and will thereby cause substantial damage to the plaintiff, an injunction may be granted (*h*), and possibly a prospective interference with the natural and probable extension of the plaintiff's business would be sufficient (*k*) ground to entitle the plaintiff to relief.

The name may be used on the right goods.

Anyone may use the name in connection with goods which are in fact the goods of the plaintiff (*l*).

It must be distinctive of the plaintiff's goods;

It is the essence of the plaintiff's case that the use of the name should be understood in the market to imply that the goods sold or dealt in under it are his goods (*m*).

In *The Two D. Case* (*n*), Herschell, L. C., said, the foundation of a passing off case "is that the party alleging it should prove, in the first instance, that any name which he claims as his trade-name has been so extensively used in

6 R. P. C. 311 (1889), Kay, J., and C. A., where a mark for wine was refused registration, as too closely resembling a mark for spirits, and the Court left open the question whether its use would amount to infringement or passing off; and other cases, cited above, p. 217. Injunctions were granted in *Walter* v. *Emmott*, 54 L. J. Ch. 1059 (1885), C. A. (*The Morning Mail*), and *Reed* v. *O'Meara*, 21 L. R. Ir. 216, V.-C. (*The Grocer*).

(*h*) *Eastman, &c. Materials Co.* v. *John Griffiths' Corp., Ld.*, 15 R. P. C. 105 (1898), Romer, J. The plaintiff company dealt in photographic materials, and sold *Bicycle Kodak* cameras. *Kodak* was their trade-name. The defendants were restrained from selling *Kodak Cycles*. Romer, J., said it would lead to confusion and to deception, and would be injurious to the plaintiff company. See further as to this case, above, pp. 218, 256, n., and 468.

(*i*) See *Manchester Brewery Co.* v. *North Cheshire, &c. Co.*, above, p. 468.

(*k*) See the cases last cited, and per Lord Watson in *Eno* v. *Dunn*, 15 App. Ca. at p. 258. In an American case, *Celluloid Co.* v. *Reed*, 47 Fed. Rep. 712; Cox, p. 509, the judge said the prospect that the complainant will in future want to manufacture starch, is too shadowy to base an injunction upon. But the suggested extension was there improbable in fact.

(*l*) Pages 22 and 368; and *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518 (1866), Wood, V.-C., cited p. 454.

(*m*) Page 34.

(*n*) *Leahy, Kelly and Leahy* v. *Glover*, 10 R. P. C. p. 155 (1893), H. L.

connection with his manufacture or with the goods which he sells, that his goods have come to be known in the market by that name; that anyone using that name would intend to refer to his goods; and that anyone to whom the name was used would understand that his goods were referred to."

not the mere name of the goods.

Hence the critical question of fact in cases under this head is often whether a word or term is the distinctive name of the plaintiff's goods, or is the name of anybody's goods of the kind (*o*), like *Liebig's Extract* (*p*), *Chlorodyne* (*q*), *Linoleum* (*r*), *Wellington Boots*, *Gladstone Bag*, *Hansom Cab*, and *Vaseline* (*s*), or a mere description of the goods, denoting only their pattern (*t*), mode of manufacture (*u*), or sale (*v*), ingredients (*x*), or place of origin (*y*), or the use for which they are intended.

Descriptive names may have a secondary distinctive meaning.

Words and terms which *primâ facie* are merely descriptive in the sense just explained may, however, acquire by

(*o*) See pp. 36 and 243 *et seq.*

(*p*) *Liebig's Extract of Meat Co., Ld.* v. *Hanbury*, 17 L. T. N.S. 298 (1867), Wood, V.-C.; *Liebig Co.* v. *Anderson*, 55 L. T. 206 (1887), Chitty, J.; and cf. *Same* v. *Chemists' Co-operative Society, Ld.*, 13 R. P. C. 736.

(*q*) *Browne* v. *Freeman*, (1) 12 W. R. 305 (1864), Wood, V.-C.; (2) W. N. (1873) 178, L. JJ.

(*r*) *Linoleum Manufacturing Co.* v. *Nairn*, 7 C. D. 834 (1878), Fry, J.

(*s*) *Chesebrough Co.'s Tms.*, 18 R. P. C. 191 (1901), Buckley, J.

(*t*) *Ford* v. *Foster*, L. R. 7 Ch. 616 (1872), L. JJ. (*Eureka Shirts*); *Hirst* v. *Denham*, L. R. 14 Eq. 542 (1872), Bacon, V.-C.; *Harrison, McGregor & Co.'s Tm.*, 42 C. D. 691; 7 R. P. C. 25 (1889), Kekewich, J. (*Albion Mowers*); *Winser* v. *Armstrong*, 16 R. P. C. 167 (1899), Byrne, J. (*Winser Interceptors*); and see *Talbot* v. *Webley*, 3 R. P. C. 276 (1886), Bacon, V.-C. (*Baffle Safes*).

(*u*) *Singer Manufacturing Co.* v. *Wilson*, 2 C. D. 434; 3 App. Ca. 376 (1875); *Id.* v. *Loog*, 18 C. D. 395; 8 App. Ca. 15 (1877); *Id.* v. *Spence & Co.*, 10 R. P. C. 297 (1893), Romer, J. (*Singer System, Singer Sewing Machines*), cited *ante*, p. 38.

(*v*) *Symington* v. *Footman*, 56 L. T. 696 (1885), Kay, J. (*Guaranteed Corset*).

(*x*) *Massam* v. *Thorley's Cattle Food Co.*, 14 C. D. 748 (1880), C. A.

(*y*) *McAndrew* v. *Bassett*, 4 De G. J. & S. 380; 33 L. J. Ch. 561 (*Anatolia Liquorice*); *Seixo* v. *Provezende*, L. R. 1 Ch. 192 (*Seixo Wine*); *Wotherspoon* v. *Currie*, 5 L. R. H. L. 508 (*Glenfield Starch*), all cited pp. 47 to 50; see also *The Reading Biscuit Case, Huntley & Palmer* v. *The Reading Biscuit Co., Ld.*, 10 R. P. C. 277 (1893), Chitty, J.; and *The Rugby Portland Cement Case, Rugby Portland Cement Co., Ld.* v. *The Rugby and Newbold Portland Cement Co.*, 8 R. P. C. 241; 9 R. P. C. 46 (1891), V. Williams, J., and C. A., and *Bewlay* v. *Hughes*, 15 R. P. C. 290 (1898), North, J. (*Dindigul Cigars*).

use and reputation a secondary distinctive meaning (*z*), so that, although no longer treated as trade-marks proper, even where they are used as such, and not admitted, unless as old marks, to registration under the Acts, they may be practically monopolized for use in connection with certain classes of goods by a particular trader, since their employment by anyone else would be calculated to deceive (*a*). "I take it to be clear from the evidence," Lord Westbury said, in *The Glenfield Starch Case* (*b*), "that long antecedently to the operations of the respondent, the word *Glenfield* had acquired a secondary signification or meaning in connection with a particular manufacture—in short, it had become the trade denomination of the starch made by the appellants. It was wholly taken out of its ordinary meaning, and in connection with starch had acquired that peculiar secondary signification to which I have referred. The word *Glenfield*, therefore, as a denomination of starch, had become the property of the appellants."

And in the *Camel Hair Belting Case* (*c*) Lord Herschell said: "The name of a person, or words forming part of the common stock of language, may become so far associated with the goods of a particular maker that it is capable of proof that the use of them by themselves without explanation or qualification by another manufacturer would deceive a purchaser into the belief that he was getting the goods of A. when he was really getting the goods of B. In a case of this description the mere proof by the plaintiff that the defendant was using a name, word, or device which he had adopted to distinguish his goods would not entitle him to any relief. He could only obtain it by proving further that the defendant was using it under such circumstances or in such manner as to put off his goods as the goods of the plaintiff" (*d*).

(*z*) Chap. II., p. 36.

(*a*) See the cases cited in the last three notes, and *Montgomery* v. *Thompson*, 41 C. D. 35; (1891) A. C. 217; 8 R. P. C. 361 (*Stone Ales*).

(*b*) See above, note (*y*), p. 477.

(*c*) *Reddaway* v. *Banham*, (1896) A. C. 199, at p. 210; 13 R. P. C. at p. 228.

(*d*) Cf. the decisions on the expression "fancy word not in common use" in the Act of 1883, above,

Descriptive meaning must be lost.

It follows that where a word, which is not a "fancy word" (*d*), but is *primâ facie* descriptive, is claimed as his trade-name by the plaintiff, he must show that its original or apparent meaning has been wholly lost, or does not exist, "amongst those who are purchasers of the goods" in question (*e*) within a definite area. Such area must (probably) extend to at least the whole of England and Wales (*f*). If the word still continues to be used and understood with its original descriptive meaning by any considerable section of such persons, it cannot be monopolised (*g*). And the more appropriate the words claimed are as a description of the goods or of some characteristic of the goods, the greater is the burden of proof required from the plaintiff (*h*).

The question for the jury.

The question of fact which has to be answered in the cases under consideration has, accordingly, a negative as well as an affirmative part (*i*).

p. 158. The current use of the term "fancy word" is as an antithesis to "descriptive," or *primâ facie* descriptive word. See the judgments in the *Cellular Cloth Case* cited below. *Yorkshire Relish* was referred to as a "fancy word," although it could not have been registered under the Act: see (1896) 2 Ch. p. 92, 13 R. P. C.

(*e*) This was Lord Herschell's phrase in *Reddaway* v. *Banham*, (1896) A. C. at p. 208; 13 R. P. C. at p. 227.

(*f*) *S. Chivers & Sons* v. *S. Chivers & Co., Ld.*, 17 R. P. C. 420 (1900), Farwell, J. The learned judge expressed the rule by saying that the secondary meaning must be "locally universal." He did not think that the area need necessarily comprise Scotland in order to establish a case in the English Courts.

(*g*) *Parsons* v. *Gillespie*, (1898) A. C. 239; 15 R. P. C. 57, P. C. (*Flaked Oatmeal*); *Cellular Clothing Co., Ld.* v. *Maxton*, (1899) A. C. 326; 16 R. P. C. 397, H. L. See also the judgments in the Court of Session in the last case, 15 R. P. C. 581.

(*h*) "The *Camel Hair Belting Case* may be an example of what, under ordinary circumstances, it would be very difficult to establish." Per Halsbury, L. C., in the *Cellular Clothing Case*, (1899) A. C. at p. 336; 16 R. P. C. at p. 405.

(*i*) In his direction to the jury in *A. W. Gamage, Ld.* v. *H. E. Randall, Ld.*, 16 R. P. C. 185 (1899), at p. 196, Russell, L. C. J., said: "The first point is, have Gamages made out to your satisfaction that *Shorland* means a buckle and strap shoe sold by Gamage & Co. *exclusively*, so that the person who sold the shoe under the name of *Shorland* would be passing off as Gamages' what was not Gamages', but his own, and so that a person buying it would believe that he was getting Gamages' and not the shoe of the man who sold it to him." This was approved by the C. A. In *Reddaway* v. *Banham*,

The possibility of proving that a word which is *primâ facie* descriptive is in reality a trade-name is not an exception to the well-settled rule that no case of passing-off can be made out merely by showing that the defendant has adopted and used a descriptive or other "open" word previously used by the plaintiff (*k*). Any trader is entitled to affix a true description to his goods in ordinary language; but if words are used which have lost their ordinary descriptive meaning and have acquired a new meaning which is not descriptive, they no longer constitute a true description (*l*).

(1895) 1 Q. B. 280; (1896) A. C. 199; 12 R. P. C. 83; 13 R. P. C. 218, the questions put to the jury were:—1. Does *Camel Hair Belting* mean belting made by the plaintiffs as distinguished from belting made by other manufacturers? (*Answer*, Yes.) 2. Or does it mean belting of a particular kind without reference to any particular maker? (*Answer*, No.) 3. Do the defendants so describe their belting (*i.e.*, by using the term) as to be likely to mislead purchasers, and to lead them to buy the defendants' belting as and for the belting of the plaintiffs? (*Answer*, Yes.) 4. Did the defendants endeavour to pass off their goods as and for the goods of the plaintiffs, so as to be likely to deceive purchasers? (*Answer*, Yes.) Upon these findings, Collins, J., gave judgment for the plaintiffs; the Court of Appeal reversed the judgment on the ground that the term was descriptive; but the House of Lords restored it. It appears from all the judgments that the fourth question was superfluous.

(*k*) *Kelly* v. *Byles*, 13 C. D. 682 (1880), Bacon, V.-C., and C. A. (*Post Office Directory*); *Schove* v. *Schmincke*, 33 C. D. 546 (1886), Chitty, J. (*Castle Album*); *Great Tower Tea Co.* v. *Smith*, 6 R. P. C. 165; 5 T. L. R. 232 (1889), North, J. (*Tower Tea*); *Burland* v. *Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J. (*Washerine*); *Rugby Portland Cement Co., Ld.* v. *Rugby and Newbold Portland Cement Co. Ld.*, 8 R. P. C. 241; 9 R. P. C. 46 (1891), Vaughan Williams, J., and C. A. (*Rugby Portland Cement*); *The Colonial Fire Assurance Co.* v. *The Home and Colonial Assurance Co., Ld.*, above, p. 469; *Magnolia Metal Co.* v. *Atlas Metal Co.*, 14 R. P. C. 389, Collins, J., and C. A. (1897) (*Magnolia Metal*); *Parsons* v. *Gillespie* and *Cellular Clothing Co., Ld.* v. *Maxton*, above, p. 479, note (*g*).

(*l*) In *Reddaway* v. *Banham*, (1896) A. C. at p. 212; 13 R. P. C. at p. 229, Lord Herschell said: "I rather demur, however, to the statement of James, L. J., that the defendant in *Wotherspoon* v. *Currie* (above, p. 49) was not telling a lie in calling his starch *Glenfield Starch*, as I do to the view that the defendants in this case were telling the simple truth when they sold their belting as camel-hair belting. I think the fallacy lies in overlooking the fact that a word may acquire in a trade a secondary meaning differing from its primary one, and that if it is used to persons in the trade who will understand it in its secondary sense, it will be none the less a falsehood that in its primary sense it

Evidence.

It will be useful to contrast the evidence in some of the recent cases in which the plaintiffs succeeded with that in others in which they failed. In *Reddaway* v. *Banham* (*m*), although it was admitted that the yarn of which the belting was made consisted for the most part of camel hair (*n*), it was shown that the name camel-hair belting had never been current as a description in the trade, a number of other names being used, and there was evidence that the defendant had adopted the name in order to deceive purchasers, and that he was likely to succeed in deceiving them by its use. In *Powell* v. *The Birmingham Vinegar Brewery Co.* (*o*), numerous wholesale and retail grocers, export agents, travellers, sauce-makers and purchasers, and scientific witnesses were called, and the effect of their evidence, stated shortly, was that if a purchaser asked for Yorkshire Relish he would expect to get the plaintiffs' sauce. There was also evidence of actual deception (*p*). In this case, as there was no other maker of the sauce but the plaintiffs themselves, the defendants' (*q*) sauce being a clever imitation, but not the same thing, it was inevitable that the name should indicate the plaintiffs' goods. This circumstance might have gone some way to displace the plaintiffs' evidence, as in the case next cited, if the defendants had been prepared to sell the goods which, according to their own contention, were described by the name.

On the other hand, in *Parsons* v. *Gillespie* (*qq*), a number of

may be true." Lord Macnaghten said (at p. 219; 13 R. P. C. at p. 233): "At Banham's works, where it cannot mean Reddaway's belting, it may be construed to mean belting made of camel's hair; abroad, to the German manufacturer, to the Bombay mill-owner, to the up-country native, it must mean Reddaway's; it can mean nothing else. I venture to think that a statement which is literally true, but which is intended to convey a false impression, has something of a faulty ring about it; it is not sterling coin; it has no right to the genuine stamp and impress of truth."

(*m*) Above, p. 478. See the findings of the jury, p. 479, note (*i*).

(*n*) Cf. the earlier case, *Reddaway* v. *Bentham Hemp Co.* (1892), 2 Q. B. 639; 9 R. P. C. 503, C. A., where there was no such admission.

(*o*) (1894) 3 Ch. 449; 11 R. P. C. 563, interlocutory injunction; (1896) 2 Ch. 54; (1897) A. C. 710; 13 R. P. C. 235; 14 R. P. C. 710, Stirling, J., C. A. and H. L.

(*p*) (1896) 2 Ch. p. 57.

(*q*) Above, p. 459.

(*qq*) See (1898) A. C. p. 254; 15 R. P. C., p. 62.

Secondary meaning not acquired while no competition.

grocers proved that when asked by their customers for "Flaked Oatmeal" they supplied the plaintiff's goods; but there was no evidence of actual deception or confusion, and the value of the evidence first mentioned was discounted by the fact that it wholly or chiefly referred to a period when there were no other goods of the kind in question in the market besides the plaintiff's goods. In *The Cellular Clothing Co., Ld.*, v. *Maxton* (*r*), the plaintiffs' evidence consisted of (a) their own advertisements, in which they used the word "cellular" to describe their cloth, but did not suggest that its use distinguished their cloth from cloth of a similar description made by others; (b) statements of witnesses who said that they understood "cellular goods" to mean the goods of the plaintiffs, but who did not say that they knew of any other manufacturers making similar classes of goods; and (c) consent orders for injunctions obtained against other persons who had used the name. In both of these cases the plaintiffs failed.

In *A. W. Gamage, Ld.*, v. *H. E. Randall, Ld.* (*s*), where the plaintiffs were retail shopkeepers, a mass of evidence was called on both sides. The plaintiffs relied principally on the evidence of purchasers, of retail dealers, and of writers in trade newspapers; the defendants principally on that of wholesale dealers. It was admitted that there were in the market shoes of the same pattern as the shoes in question made by other makers, but it was proved that the plaintiffs invariably used, besides their alleged trade-name, a stamp bearing the name of the company. Some of the plaintiffs' witnesses admitted that if they saw the name without the stamp they would not think the goods were the plaintiffs'. The jury found for the defendants, being possibly influenced by the admission just mentioned, and the Court of Appeal refused to disturb their verdict (*t*).

(*r*) See (1899) A. C. at p. 345; 16 R. P. C. at p. 410.

(*s*) 16 R. P. C. 185 (1899), Russell, L.C.J., and C. A. (*The Shorland Cycling Shoe*). See above, p. 479, n. (*i*).

(*t*) Further illustrations will be found under the heading, "Right to use a man's own name," below, p. 500.

Name of introducer or patentee.

The name of the inventor or first introducer of goods which are new to the market, or the name which he gives to those he manufactures or sells, is very readily adopted as the name of goods by whomsoever they are made; and in the case of goods made under a patent, the Court is careful not to extend the patentee's monopoly by forbidding other manufacturers, after the patent has expired, to sell goods lawfully made by them according to its specification under the only name by which they are known (*u*).

In *James* v. *James* (*x*), Romilly, M. R., said that anyone who was possessed of the secret of an invention might make the goods according to it, and might sell them under the name of the inventor after his death, but might not sell them in his lifetime, so as to suggest that they were made by him. But the distinction here suggested was questioned by James, L. J. (*y*), in a later case, for the death of the inventor would not necessarily prevent the use of his name being calculated to pass off the goods of others as goods manufactured in the business lately carried on by him, if his successors were continuing the business; and, on the other hand, during his lifetime, if there was no monopoly in the manufacture, anyone might state that the goods were made according to his system. It is material also to remember that the name of the first maker or inventor is often understood to imply the good quality of work or materials which has brought the new goods into favour rather than the mode of manufacture or the nature of the ingredients employed (*z*). Where this is the case the use of the name by traders who have no connection with him must almost always be calculated to deceive.

Names may become *publici juris*;

On the other hand, names which once carried a distinctive reference to a particular trader may, in consequence of successful piracies, or of their use by the trader himself for goods which are the goods of others, or are put forward as such (*a*),

(*u*) See Chap. II., p. 43.

(*x*) L. R. 13 Eq. 421 (1872) (*Lieutenant James' Horse Blister*).

(*y*) *Massam* v. *Thorley's Cattle Food Co.*, 14 C. D. p. 754 (1880).

(*z*) See the last case; and cf. the use of "original," above, p. 47.

(*a*) *Wood* v. *Butler*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A. (*Eton Cigarettes*). See also *Wolff* v. *Nopitsch*, 17 R. P. C. 321 (1900), Cozens-Hardy, J.; 18 R. P. C. 27 (1901), C. A.

or for other reasons, lose it and fall into common use and become *publici juris* (*b*), in the same way as trade-marks may be lost or abandoned.

or become associated with another trader.

Further, as the question is, What is the meaning of the name for the time being? it is possible for a word which has at one time been the trade-name of one trader to become so identified with the goods of a rival trader as afterwards to become the trade-name of the latter (*c*), who may thereby acquire an exclusive right to its use (*c*), or, if its association with the original owner has continued, a right concurrent with his right (*d*).

Disclaimed word.

A word, or other particular, forming part of a registered label or other trade-mark, and which the plaintiff has disclaimed as a condition of registration, is, it would appear, necessarily open, and the plaintiff cannot be heard to allege that it by itself forms a distinctive mark (*e*). The same rule does

Expunged trade-mark.

not hold good of a word or particular which has been expunged from the Register, even though it was expunged without the plaintiff's assent, for the removal of the mark does not prevent the plaintiff from showing that the mark is, nevertheless, distinctive of his goods (*f*). It has already been shown that a trade-mark which has never been registered, or which has been removed from the Register, may be the basis of a passing off case (*g*).

(*b*) Chap. II., p. 37; and Chap. XIV., p. 338.

(*c*) *Daniel & Arter* v. *Whitehouse*, (1898) 1 Ch. 685; 15 R. P. C. 134, Gorell Barnes, J. (*Brazilian Silver*); cf. next case.

(*d*) *Edge & Sons, Ld.* v. *Gallon & Son*, 16 R. P. C. 509 (1899), C. A. (*Dolly Blue*).

(*e*) *Rosenthal* v. *Reynolds*, (1892) 2 Ch. 301; 9 R. P. C. 189, North, J. (*W. R. Corsets*), interim injunction refused, *ante*, pp. 209 and 244. This was not followed by the Scotch Court in *Bayer* v. *Baird*, 15 R. P. C. 615 (1898) (*C. B. Corsets*). Might not the plaintiff show, at any rate, that the word has acquired a distinctive meaning after the registration?

(*f*) See the *Yorkshire Relish* (above, pp. 459 and 481) and *Stone Ale* (above, p. 318) cases.

(*g*) Above, p. 450; Chap. XII., p. 317. In *Paine & Co.* v. *Daniells & Sons' Breweries Co., Ld.*, (1893) 2 Ch. 567; 10 R. P. C. 217 (*John Bull Beer*), the C. A. assumed that the plaintiffs must fail if their trade-mark were expunged from the Register, although the action was brought, not only in respect of infringement, but also in respect of passing off. But the case was a peculiar one, for the only matter which led the Court to think the defendants' conduct was calculated to pass off their goods as those of the plaintiffs, was the use by the

Use of common word by defendant may be an element in a *get-up* case.

But an open word, that is to say, a non-distinctive word, or open words, may be an important element in the plaintiff's labels, and the use of the same word or words by the defendant in the same manner, especially if coupled with the use of other details of "get-up" which are similar to those which the plaintiff uses, may be strong evidence to support a passing off case based upon imitation of get-up (*h*).

This was pointed out by Wood, V.-C., in *Woollam* v. *Ratcliff* (*i*), where, in commenting upon *The Omnibus Case* (*k*), he said: "The words *Conveyance Company*, the green omnibus, &c., were held sufficient together to entitle the plaintiffs to an injunction. The defendant might have had those words painted on a yellow omnibus without objection, and so of the other resemblances; the wrong lay in their accumulation, not in any one of them alone."

Geographical names.

In the case of trade-names which are *primâ facie* geographically descriptive, a special order has sometimes been made in order to avoid any interference with the honest and proper use of them by persons other than the owner of the trade-name. Thus, in *Braham* v. *Beachim* (*l*), the plaintiff, being owner of all the collieries in Radstock, except a very small one, traded as the "Radstock Coal Co.," and the defendants began to sell coal under the same name, and also as "The Radstock Colliery Proprietors." An injunction was granted, "to restrain the defendants, unless and until they shall acquire a colliery or coal mine within the parish of Radstock, from trading under, or using, the name or style of 'The Radstock Colliery Proprietors,' or any other name or style signifying that the defendants or either of them are proprietors of any colliery or collieries at Radstock." Subsequently the defendants

defendants of a label, bearing the words *Registered* and *John Bull*, whereas, in fact, the only *registered* John Bull mark was that of the plaintiffs.

(*h*) As in *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A. (*Sunlight Self-Washer*, and *Goodwin's Self-Washing Soap*); and see the report of Lord Herschell's Committee on disclaimed additions, Chap. IX., p. 198.

(*i*) 1 H. & M. 259 (1863).

(*k*) *Knott* v. *Morgan*, 2 Keen, 213 (1836), Lord Langdale, M. R., and Cottenham, L. C.

(*l*) 7 C. D. 848 (1878), Fry, J.

acquired a colliery, but not in Radstock, and began to trade as "The Radstock Coal and Waggon Co., Colliery Proprietors, Radstock, Somerset," and a motion to commit for breach of the injunction was refused on the ground that the terms used by them did no more than imply that they were proprietors of collieries, and that their place of business was at Radstock, and this was true (*l*). So, in *The Whitstable Oyster Case* (*m*), where it was held that the name "Whitstable Native Oysters" meant the plaintiffs' oysters, and could not be fairly used of French oysters relaid and brought to maturity at Whitstable; the learned judge said, the plaintiffs' right in respect of the name was subject to the inconvenience that the name might honestly be used by anyone to describe real Whitstable natives, whether the plaintiffs' oysters or not (*n*).

It may be doubted whether the decision in *The Radstock Colliery Case*, and the dicta just referred to, are consistent with the judgments delivered in the House of Lords, in *The Stone Ales Case* (*o*), where, although the right of the appellant to state that his beer was brewed at Stone was recognized, it was held to be subject to an obligation not to do so in any manner calculated to cause the appellant's beer to be passed off as that of the respondents, which was commonly known as *Stone Ale*, and the learned lords were clearly of opinion that the obligation would prevent the appellant from using the last-mentioned term at all. And if, as required by the rule laid down in the recent authorities, the plaintiff proves that an apparently descriptive word which he claims to appropriate has wholly lost its descriptive meaning, it is difficult to

(*l*) Seb. Dig. p. 633 (1878), Buckley, J., it was decided that "Whitstable," as applied to oysters, was descriptive of the place where the oysters reach maturity.

(*m*) *Free Fishers of Whitstable* v. *Elliot*, 4 Times L. R. 273; W. N. (1888) 27, Stirling, J., interlocutory injunction to restrain the use of *native*: no order as to *Whitstable*. In the later case of *The Whitstable Oyster Fisheries Co.* v. *The Hayling Fisheries, Ld.*, 17 R. P. C. 461 (1900), Fry, J.

(*n*) Cf. also *Burlay* v. *Hughes*, above, p. 50, note (*q*).

(*o*) *Montgomery* v. *Thompson*, (1891) A. C. 217; 8 R. P. C. 361. See also the *Yorkshire Relish Case*, above, p. 159.

imagine how the defendant can be truthfully using the word with that meaning (*p*).

An author can restrain the publication under his name of books which are not written by him, on the same principles as a trader can obtain an injunction to protect his trade-name or that of his goods (*q*). And, further, it has been held that the writer of a work can maintain an action against the owner of the copyright for the damage occasioned to his reputation by the publication of a new edition of the book, purporting to be prepared by him, but in fact not so prepared (*r*). But in the case of a serial publication, the purchaser of the goodwill of the business of conducting it,—sometimes, but erroneously, called the copyright in the publication,—is at liberty to publish subsequent numbers under the old name after determining his business relations with the author or editor of earlier numbers, and notwithstanding that the name is that of the first editor or author (*s*). Author's name.

The author's right to prevent the work of another being passed off as his is, of course, quite distinct from the copyright which he may have in his own work. Upon the principle already stated (*t*), the right here under consideration will not enable him to stop the republication under his name of his own, non-copyright, work (*u*).

Titles of books, newspapers, or other publications, are also protected on the same principles, that is, as trade-names, and no cause of action arises, therefore, unless it is shown that the title is known to indicate the plaintiff's book or paper, so Title of book.

(*p*) Above, p. 480.

(*q*) *Lord Byron* v. *Johnson*, 2 Mer. 29 (1816), Eldon, L. C.; cf. *Barnard* v. *Pillow*, W. N. (1868) 94, Romilly, M.R. (music); and *Martin* v. *Wright*, 6 Sim. 297 (1833), Shadwell, V.-C., copy of work of diorama painter.

(*r*) *Archbold* v. *Sweet*, 1 M. & R. 162; 5 C. & P. 219 (1832), Lord Tenterden, C. J. In *Lee* v. *Gibbings*, 67 L. T. 263 (1892), Kekewich, J., said the question was one of libel. He refused an interim injunction. See Chap. XVIII.

(*s*) *Ward* v. *Beeton*, L. R. 19 Eq. 207 (1874), Malins, V.-C. (*Beeton's Christmas Annual*); cf. *Condy* v. *Mitchell*, 37 L. T. N.S. 766 (1877), C. A. (*Condy's Fluid*). A late editor would be restrained from advertising that a serial is discontinued; *Bradbury* v. *Dickens*, 27 Beav. 53; 28 L. J. Ch. 667 (1859), Romilly, M. R. (*Household Words*).

(*t*) Above, and pp. 447, 475.

(*u*) *Clemens* v. *Belford*, 14 Fed. Rep. 728 (1883), Amer. (*Mark Twain*).

that its use by the defendant would be calculated to lead to deception (*v*). There is no copyright in such titles (*w*).

C. Imitation of Get-up.

The general appearance of a trader's goods as they are presented to purchasers is often the most important of the signs by which the goods are recognised as his, and an imitation of it frequently affords the readiest means by which a fraudulent rival, and fraudulent retail dealers in collusion with him, can pass off his goods as the goods of the other. The cases falling under this head are almost necessarily cases of deliberate fraud, for such similarity of "get-up" as is calculated to deceive is, as a rule, the result of a resemblance, more or less close, in a number of corresponding details, and this can hardly happen by accident or coincidence. In effect, if the get-up of the defendant's goods appears, on first inspection, to closely resemble that of the plaintiff's, and it is shown that it has recently been adopted by him, the only explanation, consistent with honest conduct, that can ordinarily be given is, that the leading features of the get-up are common to the trade in question. A familiar example of such common features is the square tin box covered with yellow paper, bearing red and black letters, of the mustard trade (*x*).

Get-up common to the trade.

What is compendiously called the "get-up" of goods,—the dress in which they are presented to the buyer (*y*),—

(*v*) *Schove* v. *Schmincke*, 33 C. D. 546 (1886), Chitty, J. (*Castle Album*); *Borthwick* v. *The Evening Post*, 37 C. D. 449 (1888), Kay, J., and C. A.; and cases in the next note. A list of those cases is collected in Cox's Trade-marks, 2nd ed. p. 5.

(*w*) *Dicks* v. *Yates*, 18 C. D. 76 (1880), Bacon, V.-C., and C. A. (*Splendid Misery*); *Licensed Victuallers' Newspaper Co.* v. *Bingham*, 38 C. D. 139 (1888), North, J., and C. A. (*Licensed Victuallers' Mirror*).

(*x*) See *Farrow's Tm.*, 7 R. P. C. 260; 63 L. T. 233 (1890), Stirling, J. Other examples will be found in *Jamieson & Co.* v. *Jamieson*, 15 R. P. C. 169, (1898) C. A., overruling Byrne, J.; *Puckham & Co.* v. *Sturgess & Co.*, 15 R. P. C. 669 (1898), North, J., and C. A.; *Payton & Co.* v. *Snelling, Lampard & Co.*, 17 R. P. C. 48 and 628, C. A. and H. of L., enamelled tins for French coffee, reversing Byrne, J., 16 R. P. C. 283.

(*y*) In *Knott* v. *Morgan*, 2 Keen, 213 (1836), Langdale, M. R., and Cottenham, L. C., the fraud consisted in the imitation of the painting of the plaintiff's [illegible] cases, the mul-

comprises, in particular, the size and shape of the packages (*z*), where the goods have no definite outline, or none which is shown to the buyer, the material, colour, and decoration of their wrappers, and the lettering and arrangement of their labels (*a*). Thus, in *Lever* v. *Goodwin* (*b*), the plaintiffs sold their soap in packets wrapped up in a peculiar parchment paper, with *Sunlight Self-washer* printed in spaced type upon the wrapper; the defendants began to use similar packets and paper, with the words *Goodwin's Self-washing Soap* printed upon it in similar type. It was treated as an obvious case of fraud (*c*).

No monopoly in the constituent elements.

"Looking at the two tablets," Cotton, L. J., said, "one cannot but see that there is a strong general resemblance between them, and especially in the eyes of people who cannot read. But (the defendants') contention was this: there is no trade-mark in *Self-washer* or *Self-washing* (*d*); there is no monopoly in this parchment paper; there is no monopoly in the spaced printing; then why should we be restrained, in carrying on business, from using those things as to which the plaintiffs cannot claim any monopoly? That is an obvious fallacy. There may be no monopoly at all in the individual things, but if they are so combined by the defendants as to pass off the defendants' goods as the plaintiffs' then the defen-

forms of their servants and the use of their descriptive [illegible]—the London Conveyance Co. The facts in the *London General Omnibus Co.* v. *Felton*, 12 T. L. R. 213, Chitty, J., and *London Road Car Co.* v. *Era Omnibus Assn.*, (1898) *Times*, June 23; (1899) *Times*, April 28, were similar.

(*z*) In *Ripley* v. *Bandey*, 14 R. P. C. 591, Kekewich, J., the blue was done up in oval packets, and thence called *Oval Blue*. In *Jones* v. *Hallworth*, 14 R. P. C. 225 (1897), Kekewich, J., the colours, patterns, shape, and sizes of the plaintiff's *Selvyt* dusters were imitated.

(*a*) A curiously shaped stick on which the plaintiffs' carpets were rolled has been protected in America: *Lowell Manufacturing Co.* v. *Larned*, Cox, 2nd ed., p. 241.

(*b*) 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A. Cf. *Lever* v. *Bedingfield*, 16 R. P. C. 3 (1899), C. A.

(*c*) Imitations of the descriptive and commendatory inscriptions, and of the directions for use printed on the covers of patent medicines and proprietary articles are very common: *Franks* v. *Weaver*, 10 Beav. 297 (1847), Langdale, M. R.; and *Massam* v. *Thorley's Cattle Food Co.*, 14 C. D. 748 (1880), C. A., are instances. As to prizes, medals, and testimonials, see above, p. 457, and below, p. 491, note (*i*).

(*d*) It had been struck off the Register on the defendants' application.

dants have brought themselves within the old common law doctrine in respect of which equity will give to the aggrieved party an injunction to restrain the defendants from passing off their goods as those of the plaintiffs" (*e*).

Get-up common to the trade,

No case can be made merely by showing an imitation of the parts of the get-up of goods which are common to the trade (*f*). And even where a trader introduces a new feature

or newly introduced.

into the get-up of his goods he does not thereby acquire any proprietary interest in it, so as to be able to prevent its use by competitors without proving that it has become so identified with his goods that its use by others is calculated to deceive (*g*).

Imitation of part of get-up.

It is not, however, necessary that every part of the get-up should be imitated, for, though no exclusive right to the use of any single feature of it which is not a registered trade-mark is recognized, yet a part of the get-up, a picture, for instance, which is used on the label or wrapper, may be shown to be so identified with the plaintiff's goods that its use for similar goods is calculated to pass them off as his. The picture, in effect, may become,—as the trade-name of the plaintiff's goods may,—a "common law trade-mark" (*h*).

Thus, in *Jay* v. *Ludler* (*i*), the plaintiff used the device of a lady and a bear, in his trade as a furrier, by attaching it to the wrappers and boxes in which he sent out his goods, but he had registered it only as a trade-mark for sealskin mantles and coats. The defendant began to issue a circular, bearing

(*e*) *Blofield* v. *Payne*, 4 B. & Ad. 410; 2 L. J. K. B. N.S. 68 (1833), imitation of envelope; *Great Tower Street Tea Co.* v. *Langford & Co.*, 5 R. P. C. 66 (1887), Stirling, J., of packets; *Hammond* v. *Brunker*, 9 R. P. C. 301 (1892), Chitty, J., of label; *Stephens* v. *Peel*, 16 L. T. N.S. 145 (1867), Wood, V.-C., of bottle, and Steel-pens for *Stephens*.

(*f*) Page 488, n. (*x*).

(*g*) In *Payton* v. *Snelling, Lampard & Co.* (above, p. 488, n. (*x*)), the plaintiffs had been the first to put up coffee in tins enamelled in bright colours. The practice was soon followed, and it was held that the plaintiffs had no monopoly in such tins. See also the remarks of Kekewich, J., in *Hubbuck* v. *Brown*, 17 R. P. C. at p. 154 (1900), and in *Alaska Packers' Association* v. *Crooks*, 18 R. P. C. 129 (1901), as to the fashion of the market.

(*h*) Above, p. 451.

(*i*) 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.; see also *Hart* v. *Colley*, 44 C. D. 193; 7 R. P. C. 93 (1890), North, J.; and *Great Tower Street Tea C.* v. *Langford & Co.*, 5 R. P. C. 66 (1887), Stirling, J.; and see p. 485, above.

a similar mark, in connection with his trade, which was also that of a furrier. Two injunctions were granted, one, restricted to the mantles and coats, to restrain infringement of the trade-mark, the other, not so restricted, to restrain the defendant from using the device so as to deceive the public.

And, on the other hand, the imitation of a number of things, each of which is in itself not distinctive of the plaintiff's goods, may make a strong case on account of the cumulative effect of the detailed resemblances (*k*).

Only things which are put prominently forward so as to be likely to catch the eye of a purchaser and remain in his memory need generally be considered. Thus, the printing on the back or sides of a box may usually be disregarded in considering whether the get-up of goods is likely to deceive (*l*).

3. Use in Connection with the Defendant's Goods.

Name, &c. need not be attached to the goods.

The spurious badges must be used in connection with goods which are not the plaintiff's, but they need not be stamped or printed upon them or their envelopes. The fraudulent trade-names, for instance, in most of the cases where injunctions have been granted, were used as descriptions of the defendants for general purposes, and in their advertisements and circulars (*m*), or were placed over their shop doors (*n*). In *Jay* v. *Ladler* (*o*), the deceptive representation was effected by sending to the defendant's customers a circular inclosing a print of a design resembling the plaintiff's distinctive design. The action extends to every kind of representation

(*k*) See the judgment, in *Lever* v. *Goodwin*, quoted above, and compare it with those in *Lever* v. *Bedingfield*, 16 R. P. C. 3 (1899), C. A. See also per Wood, V.-C., in *Woollam* v. *Radcliff*, 1 H. & M. 259, cited *ante*, p. 485. at p. 462 (a box of tablets of soap).

(*l*) "I attribute very little importance indeed in a case of this kind to the sides and back." Per Kekewich, J., in *Lever* v. *Bedingfield*, 15 R. P. C.

(*m*) See the injunctions in *Hendriks* v. *Montagu*, 17 C. D. 638; *Massam* v. *Thorley*, 14 C. D. 748; and *Saxlehner* v. *Apollinaris Co.*, (1897) 1 Ch. 893; 14 R. P. C. 645; Appendix, pp. 750, 751, 758.

(*n*) *Burgess* v. *Burgess*, 3 De G. M. & G. 896; 22 L. J. Ch. 675.

(*o*) 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.

which is calculated to pass off the defendant's goods as the plaintiff's.

4. Probability of Deception.

Where deception is intended.

The Court must be satisfied that the defendant's conduct is calculated to pass off other goods as those of the plaintiff, or, at least, to produce such confusion in the minds of probable customers or purchasers as would be likely to lead to the other goods being bought and sold for his (*p*). This is the foundation of the action.

If it is shown to have been intended to deceive in this way, the Court will not generally push the inquiry further (*q*).

But the intention is only evidence of the actual deception or probability of deception which may be inferred from it. And if the Court does not believe that there is any probability of deception, the action must fail (*r*). "The law does not take notice of a fraudulent intention in a man's mind if he does nothing to carry out the fraud" (*s*).

Badges of fraud: unexplained similarities; colourable differences;

The existence of unexpected and unexplained similarities (*t*) between the goods of the defendant and those of the plaintiff, or of similarities which have been modified by colourable differences (*u*) or by differences and distinctions so arranged as to escape notice (*x*); the use by the

(*p*) *Hendriks* v. *Montagu*, 17 C. D. 638 (1881); see per James, V.-C., p. 646.

(*q*) "Why should we be astute to say that (the defendant) cannot succeed in doing what he is straining every nerve to do?" Lindley, L. J., asked, in *Slazenger* v. *Feltham*, 6 R. P. C. p. 538 (1889). Cf. per Lord Macclesfield, in *Mitchell* v. *Reynolds*, 1 Smith L. C., 10th ed., p. 391. "He only can suffer by his knavery, and surely Courts of Justice are not concerned lest a man should pay too dear for being a knave."

(*r*) *Lever* v. *Bedingfield*, 16 R. P. C. 3 (1898), C. A., overruling 15 R. P. C. 453, Kekewich, J.

(*s*) Per Lord Esher, M. R., in *Reddaway* v. *Banham*, 12 R. P. C. at p. 89. "If intent to deceive be once established, it is a short step, though it is a step, and not an inevitable one, to the conclusion that the intention has been fulfilled, and that the goods are calculated to deceive," per Kekewich, J., in *Saxlehner* v. *Apollinaris Co.*, 14 R. P. C. at p. 654.

(*t*) *Taylor* v. *Taylor*, 2 Eq. Rep. 290; 23 L. L. J. Ch. 255 (1854), Wood, V.-C.

(*u*) *Slazenger & Sons* v. *Feltham & Co.*, 6 R. P. C. 531 (1889), C. A. (*Demon, Demotic*). Obvious differences between the goods themselves are very material to the question: *Coleman* v. *Brown*, 16 R. P. C. 619, (1899) North, J., and C. A. on an interlocutory application (*Wincarnis, Vincalis*).

(*x*) *E.g.*, "*late of*," &c., in small letters, Chap. XV., p. 382,

defendant of descriptions, which, as applied to himself or his own trade, are inaccurate, and by reason of their inaccuracy approach more nearly to the proper description of the plaintiff (*y*), and the gradual approximation of the defendants' names, get-up, or description to those of the plaintiff (*z*), are all obvious badges of fraudulent intention frequently recurring in the cases which come before the Court (*a*).

gradual approximation.

Instances of actual deception need not be proved if the Court is otherwise satisfied of the probability of deception (*b*); and on the other hand, they are not necessarily conclusive where they have occurred, in cases, for example, where their number is comparatively insignificant (*c*). And, of course, proof of deception is not sufficient to enable the plaintiff to succeed if the defendant has done nothing but what he was entitled to do, as where he has only used marks common to the trade (*d*).

Proof of actual deception.

The question what resemblance is calculated to deceive, and the modes of comparison adopted, have been sufficiently considered in the preceding chapters (*e*).

Proof of probability of deception.

(*y*) *Holloway* v. *Holloway*, 13 Beav. 209 (1850), Langdale, M. R.

(*z*) *Boulnois* v. *Peake*, 13 C. D. 513, n. (1868), Giffard, V.-C., *Carriage Repository* changed to *New Carriage Bazaar*; *Apollinaris Co.* v. *Herrfeldt*, 4 R. P. C. 478 (1887), C. A. (*Apollinis*); *Sanitas Co., Ld.* v. *Condy*, 4 R. P. C. 195, 530; 56 L. T. 621 (1886), Kay, J. (*Condi-Sanitas*). "When a manufacturer's goods are a drug on the market so long as they bear his own name or proclaim their true origin, and yet are saleable at once if marked with nothing but some common English words, and when that manufacturer holds himself out as ready and willing so to mark his goods, and does so mark them at the 'instigation,' as he says, of a purchaser, a Lancashire jury may perhaps be trusted to solve the riddle." Per Lord Macnaghten in the *Camel Hair Belting Case*, 13 R. P. C. at p. 233.

(*a*) See further, p. 382.

(*b*) See the last chapter, p. 375.

(*c*) *Civil Service Supply Association* v. *Dean*, 13 C. D. 512 (1879), Malins, V.-C.; *Borthwick* v. *The Evening Post*, 37 C. D. 449 (1888), C. A.; *Leahy, Kelly & Leahy* v. *Glover*, 10 R. P. C. 141 (1893), H. L.; *Rutter* v. *Smith*, 18 R. P. C. 49 (1901), Kekewich, J.

(*d*) See below, *Defences*. In *Jamieson* v. *Jamieson*, above, p. 488, n. (*x*), the C. A. dismissed the action, although Byrne, J., had found both actual deception and intention to deceive.

(*e*) Chap. XV., p. 373; Chap. X., p. 224; see also *Goodfellow* v. *Prince*, 35 C. D. 9 (1887), C. A. (plaintiff and defendant both mere importers); *Bodega Co.* v. *Owens*, 6 R. P. C. 236; 7 R. P. C. 31; 23 L. R. Ir. 371

5. Proof of Damage.

Proof of damage is not in every case essential to enable the plaintiff to maintain his action, for if he shows that the defendant is acting so as to pass off goods as those of the plaintiff which are not the plaintiff's, it will generally be assumed that the plaintiff is thereby prevented from selling as many of the goods as he otherwise would. But if this assumption is negatived by the circumstances of the case, proof of actual or probable damage is necessary(*f*). For the assumption of a name (*g*), or an address (*h*), similar to the name or address of the plaintiff, without malicious intent, although it may cause annoyance and inconvenience to him, —for instance, by delaying his letters,—is not actionable, unless it is shown to be calculated to injure him in his trade. And no action lies at the suit of any private individual for deception practised upon the public, unless it incidentally causes, or is calculated to cause, damage to him as an individual; if this is not the case, the wrongdoer can only be punished through the criminal law, or in a civil action on information brought in the name of the Attorney-General (*i*).

Probability or proof of damage is essential.

The questions how far the inconvenience caused to a trader

(1889), Chatterton, V.-C. (defendant called his wine-shop in Belfast *Bodega*; plaintiff had no Bodega shop in Ireland outside Dublin); and the cases in the last note.

(*f*) So that a non-trader has no action, *ante*, p. 366; *Delondre* v. *Shaw*, 2 Sim. 237 (1828), Shadwell, V.-C.; *Levy* v. *Walker*, 10 C. D. 436 (1879). See also cases in last note.

(*g*) *Borthwick* v. *The Evening Post*, above, p. 475, n. (*g*); *Du Boulay* v. *Du Boulay*, L. R. 2 P. C. 430.

(*h*) *Day* v. *Brownrigg*, 10 C. D. 294 (1878), C. A.; *Street* v. *Bank of Spain and England*, 30 C. D. 156 (1885), Pearson, J., adoption by the defendants (bankers) of the same cypher telegraphic address as that of the plaintiff.

(*i*) Per Cotton, L. J., in *The Native Guano Co.* v. *The Sewage Manure Co.*, 8 R. P. C. p. 128 (1891); see also *Clark* v. *Freeman* and *Williams* v. *Hodge*, cited above, pp. 457, 458; *Batty* v. *Hill*, 1 H. & M. 264 (1863), Wood, V.-C., false pretence of award of gold medal. In the *Maizena Case* (above, p. 481), the Privy Council thought that the defendants had made an objectionable reference to a medal really gained by the plaintiffs, but that it was a mere advertising trick. The defendants gave an undertaking to discontinue the reference, and the action was dismissed: (1894) A. C. 275; R. P. C. 281.

by the use of his trade-name, or the trade-name of his goods, in a business which is not in competition with his own, and how far the interference with a possible extension of his existing business entitle him to sue, have already been considered (*j*).

6. Defences.

The defences, other than a simple denial of the acts alleged, which are commonly set up, may be tabulated as follows: that—

(1.) The name, or other badge, which the plaintiff charges the defendant with having imitated, carries no distinctive reference to the plaintiff's goods.

(2.) The defendant has an independent or a concurrent right to use it (*k*).

(3.) The name or other badge which the defendant is using, is not such, or is not so used, as to be calculated to pass off other goods for those of the plaintiff (*l*).

(4.) The plaintiff is debarred from suing the defendant for all or part of the relief he seeks by (a) an agreement, or some personal estoppel (*m*) (other than those next alluded to); (b) acquiescence (*n*); (c) delay (*o*); or (d) deceptive use of the name or badges he relies on, or because his trade is fraudulent (*p*).

Denial of repute.

(1.) This is a traverse of part of the plaintiff's case. It may take the form of an allegation that the name or other badge is merely descriptive (*q*). If so, the defence falls under the second head also.

Concurrent right.

(2.) This defence is discussed below. The most important case is the right of any man, apart from restriction by contract, to trade honestly under his own name (*r*). That right

(*j*) Above, p. 476, and note (*h*).

(*k*) See, as to the right to use a man's own name, p. 500; and as to the right to honestly describe the place of origin, &c. of his goods, p. 485; and further, the last chapter, "Infringement," pp. 384 *et seq.*

(*l*) Above, p. 492; and Chap. XV., p. 373.

(*m*) Page 390.

(*n*) Page 392.

(*o*) Page 394.

(*p*) Page 409.

(*q*) Above, pp. 477 *et seq.*

(*r*) The right is not absolute; see below, p. 500.

is, of course, an answer only to a case which rests wholly upon an alleged imitation or adoption of the trade-name which the plaintiff is using.

Denial of deception.

(3.) This defence also is a mere traverse. It has been considered already (*r*).

Estoppel.

(4.) The defences collected under the fourth head are precisely analogous to those discussed in the last chapter; they depend on the same considerations and are governed by the same rules (*s*).

Concurrent Right.

The defendant may have as good a title to use the name or other things in question as the plaintiff has to use the name or things with which it or they are, as he alleges, likely to be confused. For instance, on the dissolution of a partnership, in the absence of special agreement, and unless the firm name is sold or assigned with the goodwill, as it may be (*t*), each partner has an equal right to use it, if he continues to carry on a similar business to that of the late firm (*u*), provided that he does not by so doing expose his former partners to any risk of liability (*x*). Whether there will be any such risk is a matter to be determined under the circumstances of the particular case (*x*).

Partners after dissolution.

Purchaser of goodwill.

It is convenient to note here, in passing, that the purchaser of the goodwill of a business, or a partner succeeding to it under agreement upon dissolution of partnership, has a right to use the trade-name and trade-marks under which it was conducted (*y*). And this even though it comprise the

(*r*) Note (*l*), above.

(*s*) See *Read* v. *Richardson*, 45 L. T. N.S. 54 (1881), C. A. (*Dog's Head Beer*).

(*t*) *Hall* v. *Barrows*, 4 De G. J. & S. 150; 33 L. J. Ch. 204 (1863), Westbury, L. C.; and see Lindley on Partnership, 6th ed., pp. 445 and 449; and *In re David and Matthews*, below, p. 498.

(*u*) *Burchell* v. *Wilde*, (1900) 1 Ch. 551, Byrne, J., and C. A. (*Burchell & Co.*); *Banks* v. *Gibson*, 34 Beav. 566; 34 L. J. Ch. 591 (1865), Romilly, M. R.; *Levy* v. *Walker*, and *Chappell* v. *Griffiths*, *infra*; and see further on this subject, Sebastian, 3rd ed., p. 289; 4th ed., p. 299.

(*x*) *Burchell* v. *Wilde*, *supra*; and see next paragraph.

(*y*) *Levy* v. *Walker*, 10 C. D. 436 (1879), C. A.; *Currie* v. *Currie*, 15 R. P. C. 339, (1897) Court of Sess. (*Prince Charlie*).

personal name of a late partner (*z*), or of any other late owner of the goodwill, but not so as to cast any risk of liability upon the late partner or owner (*a*) by using his personal name in such manner as to represent that he is still a member of the firm, or carrying on the business (*b*).

Trader may use his own name after the sale of his business, where no contrary agreement.

But where the goodwill of a business is sold, or is taken over on the dissolution of a partnership by agreement, without any restrictive condition being imposed upon the late owner or the retiring partner which restrains him from exercising his ordinary right, he is at liberty to start in the same trade again at once under his own name, so long as he uses it honestly, even though it be the same as, or be similar to, the name under which the old business was, and continues to be, carried on (*c*).

(*z*) *Condy* v. *Mitchell*, 37 L. T. N.S. 268, 766 (1877), Bacon, V.-C., and C. A. (*Condy's Fluid Co.*); *Chappell* v. *Griffith*, 53 L. T. N.S. 459 (1885), Kay, J.

(*a*) *Chatteris* v. *Isaacson*, 57 L. T. N.S. 177 (1887), Kekewich, J. The vendor of the business of "Mme. Elise" agreed that the purchaser should have the exclusive right to use the name "Mme. Elise & Co." Mme. Elise was his wife's name. Held, the purchaser must use the addition "& Co." In *Burchell* v. *Wilde*, (1900) 1 Ch. 551, it was held that, upon the division of a solicitor's business between the partners on dissolution, the partner whose name was Burchell would run no risk by reason of the use by the other of the old name, *Burchell & Co.* Notice of the change had been given to all the clients. The defendant, in fact, undertook to carry on business under a different name, viz., *Burchell, Wilde & Co.* In *Townsend* v. *Jarman* (1900), 2 Ch. 698; 17 R. P. C. 649, Farwell, J., the plaintiff bought the business of Jarman & Co., Ld., seedsmen, from a company to whom he and the defendant had, on the dissolution of their partnership, transferred it. He carried on business as *Jarman & Co.*, and it was held that the defendant could not complain of this. The defendant had sold business premises on which his name, *E. J. Jarman*, was cut to the company, who had transferred them to the plaintiff. It was held that the defendant could not compel the plaintiff to remove the name. See also *Routh* v. *Webster*, 10 Beav. 561 (1847); and *Prudential Assurance Co.* v. *Knott*, L. R. 10 Ch. 142 (1875); also *Rosher* v. *Young*, Sol. Jo., Vol. 45, p. 344.

(*b*) *Dickson* v. *McMaster & Co.*, 18 Ir. Jur. 202 (1866), Brady, C.; *Scott* v. *Rowland*, 26 L. T. N.S. 391 (1872), Wickens, V.-C.; *Gray* v. *Smith*, 43 C. D. 208 (1889), C. A.; *Thynne* v. *Shove*, 45 C. D. 577 (1890), Stirling, J. There can be no risk where the late partner is dead, *Webster* v. *Webster*, 3 Swan. 490 (1791), Thurlow, L. C.; see Lindley on Partnership, 6th ed., p. 448.

(*c*) *Churton* v. *Douglas*, Johnson, 174; 28 L. J. Ch. 841 (1859), Wood, V.-C.; see page 499; *Johnson* v. *Helleley*, 34 Beav. 63; 34

Vendor must not solicit his old customers.

In such a case the vendor or retiring partner could not trade under the old name if it differed from his own personal name (*c*). And he would not be allowed to solicit his old customers in the business which he has sold, because to do so would be to derogate from his grant (*d*).

In *Re David and Matthews* (*e*), there was a provision in a deed of partnership between two partners, that on the death of either a general account should be taken for the purpose of determining the value of the share of the deceased partner which was to be paid by the survivor, who, under other provisions, took over the assets of the firm. A question arose whether the goodwill should be included in the account or not, and, if it were, upon what basis it should be valued. Romer, J., after reviewing all the authorities on the subject, decided that the goodwill must be included as part of the assets, and must be valued as on a sale upon the footing that, if it were sold, the surviving partner would be at liberty to carry on a rival business, but not to solicit any person who was a customer of the firm before the death of the partner, or to carry on business under the firm-name, which was made up of the names of both partners.

Questions between the purchaser of a business and its former owners, or some of them, respecting the use of the firm name seldom arise except upon a dissolution of partnership, or after the sale of the goodwill of a debtor's business by his trustee in bankruptcy; for no careful purchaser would agree to buy the goodwill of a business without stipulating for the exclusive use of the trade-name, and probably stipulating also that the vendor should not carry on a new competitive business.

L. J. Ch. 32, 179; 2 De G. J. & S. 446 (1864), Romilly, M. R., and L. JJ.; *Labouchere* v. *Dawson*, L. R. 13 Eq. 322 (1872), Romilly, M. R.

(*c*) See previous note.

(*d*) So finally decided in *Trego* v. *Hunt*, (1896) A. C. 7, overruling *Pearson* v. *Pearson*, 27 C. D. 145, on this point. See also *Gillingham* v. *Beddow*, (1900) 2 Ch. 242. The order made by the H. L. in the former case restrained the defendant from applying privately by letter, personally, or by a traveller, to any person who was, prior to the dissolution, a customer of the old firm, asking such customer to deal with him (the defendant) or not to deal with the plaintiffs.

(*e*) (1899) 1 Ch. 378.

Sale in bankruptcy.

A trustee in bankruptcy has no power to contract on behalf of the bankrupt, and the bankrupt is not a grantor so as to be bound by the rule applied in *Trego* v. *Hunt*. The sale of the goodwill of his business in the bankruptcy, accordingly, throws no obligation upon the bankrupt trader other than the obligation of the general law, not to represent that the business is still carried on by him (*f*).

The vendor must not represent that his business is the old business, or its successor.

It is clear that the late owner or partner must do nothing, other than make an honest use of his own name, which is calculated to suggest that he is carrying on the old business (*g*).

"It has been settled," James, V.-C., said, in *Hudson* v. *Osborne* (*h*), "that there is no implied covenant of any kind in the sale by an individual himself of the goodwill of his business; but it seems to be settled that a trader, whose business, and the goodwill of whose business, have been sold by himself, or by any person deriving title under him, has no right to represent himself as carrying on that identical business; he has no right to use the trade-marks which were the marks of that business, or, by the use of the name, or of a title of the firm, to represent himself as being the continuer of that identical business which has been sold."

And, in *Churton* v. *Douglas* (*i*), a partner, who, after he had sold his share in the business of "John Douglas & Co." to his co-partners, continued to trade as "Churton, Bankart, and Hirst, late John Douglas & Co.," was restrained from trading as "John Douglas & Co.," or representing that his new business was a continuation of the old business.

The question whether a late partner, or other late owner of a business which has passed into the hands of the plaintiff,

(*f*) *Walker* v. *Mottram*, 19 C. D. 355 (1881), C. A., and last note. In *Trego* v. *Hunt*, above, note (*d*), Lord Macnaghten said: "There is all the difference in the world between the case of a man who sells what belongs to himself and receives the consideration, and a man whose property is sold without his consent by his trustee in bankruptcy, and who comes under no obligation, express or implied, to the purchaser from the trustee."

(*g*) As to the use of the word "late," see above, pp. 382, 455.

(*h*) 39 L. J. Ch. 79 (1869). This was, of course, before the decision in *Trego* v. *Hunt*.

(*i*) Note (*c*); *Witt* v. *Corcoran*, 2 C. D. 69 (1873), Bacon, V.-C., is a similar case; *Benbow* v. *Low*, 44 L. T. 875; 29 W. R. 837 (1881), Bacon, V.-C.

is representing that he is still carrying it on, or that his present business is its successor, or is only fairly working and advertising the latter business as his own, is often one of great nicety (*l*). The case of *Mogford* v. *Courtenay* (*l*) is an illustration of this. There the partnership between the parties having expired by effluxion of time, and the goodwill passing under the partnership articles to the plaintiff, but without any restrictive covenant binding the defendant not to use the firm-name or any similar name, the defendant was restrained from issuing a circular to the old customers stating the fact of dissolution, and that he had joined a new firm, and asking the customers for a "continuance" of their custom. This was held to be a suggestion that he was about to carry on, not merely a similar business, as he lawfully might, but the identical business which had passed to the plaintiff. It appears by the more recent authorities (*m*) that he ought to have been restrained from privately soliciting the old customers to deal with him in any terms whatsoever.

The right to Trade under one's own Name.

The former rule.

It was formerly supposed to be a rule of law, existing by way of exception to the general rule stated at the beginning of this chapter, that any man might—so long as he acted honestly—trade under his own name, or under the names of himself and his partners, even though the similarity of such name or names to the name under which another person had previously been carrying on business, or to the trade-name of that other's goods, might occasionally lead to confusion or lead to the business or goods of the new-comer being mistaken for the business or goods of the earlier trader (*n*).

(*l*) 45 L. T. N.S. 303 (1881), Fry, J. The decision that the defendant might not solicit the old customers has since been approved by the House of Lords, above, p. 498.

(*m*) *In re David and Matthews*, above, p. 498.

(*n*) See the 5th and 6th rules stated by Kay, L. J., in the *Yorkshire Relish Case*, printed in a note to this chapter (p. 518), and the judgment of Lindley, L. J., in the same case: (1896) 2 Ch. at p. 70; 13 R. P. C. at p. 270; the judgments of the C. A. in *Turton* v. *Turton*, 42 C. D. 128 (1889), and *Warner* v. *Warner*, 5

Thus, Knight-Bruce, L. J., said, in a suit between father and son (*o*), "all the Queen's subjects have a right to sell (their goods) in their own names, and not the less that they bear the same name as their father"; "but" he added, "if any circumstances of fraud had accompanied, and were continuing to accompany, the case, it would stand very differently."

Present state of authorities.

According to the more recent authorities, however, it appears to be now settled that no such rule of law exists (*p*), and that there is no difference in principle between the case of a man's own name and the case of any other apparently descriptive word (*q*). The result is that in the rare and highly exceptional cases where it can be proved that a personal name has become so identified by use in a wide-spread and well-known business with a particular trader as to be necessarily deceptive when used without qualification by anyone else in the same trade, another trader may be restrained from using it "without distinguishing, &c.," although it is his own name.

In the *Anchovy Sauce Case* cited above (*r*), Turner, L. J., T. L. R. 327, 359; and the first edition of this book, p. 420. In *Reddaway* v. *Banham* (below, p. 502), however, Lord Macnaghten said he was at a loss to know why *Turton* v. *Turton* was ever reported, and that the plaintiff's case was extravagant and absurd: (1896) A. C. at p. 220; 13 R. P. C. at p. 234.

(*o*) *Burgess* v. *Burgess*, 3 De G. M. & G. 896; 22 L. J. Ch. 675 (1853); see below, note (*r*).

(*p*) That is the case unless the matter should be reconsidered in the House of Lords. As will be shown, the case of *J. & J. Cash, Ld.* v. *Cash*, 18 R. P. C. 213 (1901), Kekewich, J., referred to below, p. 508, is the only actual decision on the point. It is said, as stated in the text, that the same rules are to apply to a personal name and any other *primâ facie* descriptive word. One such rule is that the word must have wholly lost its ordinary descriptive meaning for the trade purposes under consideration (see above, p. 479). How can this be the case while it remains the name and the only proper description of a person who is lawfully engaged in the trade?

(*q*) *The Valentine Meat Juice Co.* v. *The Valentine Extract Co., Ld.*, 17 R. P. C. 673; 83 L. T. 259 (1900), C. A. As to the conditions under which a descriptive word can be monopolized, see above, pp. 477 to 486.

(*r*) *Burgess* v. *Burgess*, 3 D. M. & G. 896; 22 L. J. Ch. 675 (1853), Kindersley, V.-C., and Knight-Bruce and Turner, L. JJ., on an interlocutory application. The defendant, who had recently left the employment of his father, the

said that "it is a mere question of evidence in each case whether there is a false representation or not," and in the *Camel-hair Belting Case* (*s*), in which the matter was placed upon its modern footing by the opinions of the learned Law Lords, this statement was adopted and approved. The Lord Chancellor said (*t*) that no principle of law was laid down in the earlier cases which would have prevented an injunction, although the defendant's name was Burgess and although the article was described by a descriptive name, but that, in the view of the Lords Justices, the descriptive name there in question, *Burgess' Essence of Anchovies*, had not, as a matter of fact, acquired the technical signification of being only made by Burgess the father.

Lord Herschell said (*u*): "the name of a person or words forming part of the common stock of language, may become so far associated with the goods of a particular maker that it is capable of proof that the use of them by themselves without explanation or qualification by another manufacturer would deceive a purchaser into the belief that he was getting the goods of A. when he was really getting the goods of B. In a case of this description the mere proof by the plaintiff that the defendant was using a name, word or device, which he had adopted to distinguish his goods, would not entitle him to any relief. He could only obtain it by proving further that the defendant was using it under such circumstances or in such manner as to put off his goods as the goods of the plaintiff."

These passages, and the passage from the judgment of Vaughan Williams, L. J., in *Jamieson* v. *Jamieson*, quoted below (*x*), were cited by Lord Alverstone, M. R., in the *Valentine Meat Extract Case* (*y*), as establishing that the supposed exception to the general rule in the case of a man's own name does not exist.

plaintiff, and set up a rival business in King William Street, was restrained from describing his business as "late of 107, Strand," his father's address; but the Court refused to restrain him from trading under his own name or describing his goods as "Burgess' Essence of Anchovies."

(*s*) *Reddaway* v. *Banham*, cited above, pp. 477 and 481.

(*t*) (1896) A. C. at p. 204; 13 R. P. C. at p. 225.

(*u*) (1896) A. C. at p. 210; 13 R. P. C. at p. 228.

(*x*) p. 505.

(*y*) Above, p. 501, and below, p. 505.

It follows that it is no more essential, in theory, to prove a fraudulent intent in a passing-off case which depends upon the use by the defendant of his own name than in any other case (*z*).

While, however, the possibility of such a monopoly of a personal name being established as to prevent the honest use of his own name, without qualification, by the defendant is recognised, the degree of proof exacted is very high, and only one case has been reported in which this has been done (*a*). There are, no doubt, many instances in which the deliberately fraudulent attempt of a defendant to make use of his own name, or, more commonly, an assumed name, in order to pass off his goods as another's, has been restrained (*b*), or where a company constituted for the purpose of competing with an established business under a name chosen because of its resemblance to the firm-name of such business has been compelled to take steps to prevent deception or to change its name.

In *Jamieson & Co.* v. *Jamieson* (*c*), the plaintiff failed *Jamieson & Co. v. Jamieson.*

(*z*) *S. Chivers & Sons* v. *S. Chivers & Co., Ld.*, 17 R. P. C. 420 (1900), Farwell, J. The learned judge said that in order to make out that a personal name has acquired a secondary meaning, its use in the secondary sense must be shown to have become universal, and that, if this were so, the defendant must necessarily have known that his use of it for his own goods was deceptive and dishonest.

(*a*) *J. J. Cash, Ld.* v. *Cash*, cited below, p. 508, and see App., p. 760. In *Dewar, Ld.* v. *Dewar*, 17 R. P. C. 341 (1900), Ct. of Sess. at p. 358, Lord Kyllachy said: "I do not myself know of any case in which the use by a man of his own name has been successfully challenged except in circumstances which plainly involved fraud on the part of the user." In *Cellular Clothing Co.* v. *Maxton*, cited above at p. 482, Lord Shand ((1899) A. C. at p. 341; 16 R. P. C., at p. 407) said the same thing of descriptive names in general. The *Valentine Case* was similar to the *Tussaud* and *Pinet Cases*, cited below, where a company was formed with a deceptive name for the purposes of competition.

(*b*) *Holloway* v. *Holloway*, 13 Beav. 209 (1850), Langdale, M. R., was a case of fraudulent imitation of "get-up." The M. R. said: "The defendant's name being Holloway, he has a right to constitute himself a vendor of Holloway's pills and ointment. I do not intend to say anything to abridge any such right."

(*c*) 15 R. P. C. 169, (1897) C. A., overruling Byrne, J. It should be noted that there were other Jamiesons engaged in the trade at Aberdeen besides the parties. It was a "get-up" case, but, in the view of the C. A., the only resemblance between

because the Court of Appeal decided that the defendant was not bound to use extra precautions to avoid confusion between his goods and those of other persons in the trade, if such confusion arose solely from the similarity of his own name with theirs (*d*), and from the use of features common to the trade (*e*). But the Court, as will be seen from the quotations following, carefully distinguished from the case before them the case where the name of a particular trader has come to denote his goods in the market.

Lindley, L. J., after referring to the *Holloway Pill Case* (*f*), said, "When we are asked to restrain a man from carrying on business in his own name, we must take very great care what we are about. The principle applicable to the case, I take it, is this: the Court ought not to restrain a man from carrying on business in his own name simply because there are other people who are doing the same and who will be injured by what he is doing. It would be intolerable if the Court were to interfere, and to prevent people from carrying on business in their own names in rivalry to others of the same name. There must be something far more than that, viz. (there must be), that the person who is carrying on business in his own name is doing it in such a way as to pass off his goods as the goods of somebody else" (*g*). "It is said, because yours may be mistaken for ours you are bound to take extra precautions to prevent yours being mistaken for ours. I am not aware of

Mere similarity of firm-name does not impose duty to take precautions.

the boxes of the plaintiff and defendant was due to the name and to features common to the trade.

(*d*) In *J. H. Brooks & Co., Ld.* v. *Norfolk Cycle Co. and John Brookes*, 16 R. P. C. 523, the plaintiffs were makers of the well-known "Brooks" saddle. The defendant Brookes was a saddle maker who had newly entered the trade, but his father had sold saddles under his own name, and had been restrained at the instance of the plaintiffs from doing so. Stirling, J., said that knowing the facts and the probability of confusion, it was the defendant's duty to mark his goods so as to avoid all possibility of mistake between them and those of the plaintiffs. Instead of doing this he had imitated the plaintiff's manner of marking. An injunction restraining him from marking saddles "J. Brookes" *without distinguishing, &c.* was granted. *Jamieson & Co.* v. *Jamieson* does not appear to have been cited, but the case was obviously one of fraud, and possibly also one in which the name had become a trade-name of the goods.

(*e*) Above, p. 232.

(*f*) Page 503, note (*b*).

(*g*) 15 R. P. C. at p. 181.

any case that goes so far as that." "In all cases in which a person has been restrained from carrying on business in his own name he has done something more than use his name: he has copied something from somebody else in the trade, or he has gone out of his way to make his things look like those of a rival in the trade" (*h*).

Vaughan Williams, L. J., said: "I do not understand that there is any case, or ever has been any case, in which it has been laid down that a man who happens to bear a particular name is debarred from entering into any trade which he chooses to enter into merely because there is somebody else of the same name who has acquired a great reputation in the manufacture of the particular goods dealt with in the trade." Then, after referring to such well-known trade-names as *Bass' Beer* (*i*), *Colman's Mustard*, and *Pears' Soap*, the Lord Justice continued: "A plaintiff never can complain of the user by the defendant of either the plaintiff's personal name, or of any other name that he chooses to use for the purpose of denoting his goods, unless he first establishes that in the market his goods have come to be known by that name. The right and duty of the Court always is to restrain a man from using a name that has come to be recognized as the name of a particular trader's goods for his, the defendant's, goods so as to suggest that the defendant's goods are the plaintiff's goods, and to pass them off as such" (*k*).

The question has since come before the English Courts on three occasions (*l*).

The *Valentine Case.*

In *The Valentine Meat Juice Co.* v. *The Valentine Extract Co. Ld.* (*m*), the plaintiffs in the Court of Appeal obtained an

(*h*) At p. 183.

(*i*) See below, p. 513.

(*k*) At pp. 192, 193. This passage was cited with approval by Lord Alverstone, M. R., in *Valentine Meat Juice Co.* v. *Valentine Extract Co., Ld.*, 17 R. P. C., at p. 690 (1900), as an exposition of the law on the point.

(*l*) It has also come before the Court of Session in Scotland in *Dewar, Ld.* v. *Dewar*, above, p. 503, note (*a*).

(*m*) 17 R. P. C. 1, Stirling, J.; 17 R. P. C. 673. 83 L. T. 259 (1901) C. A. Stirling, J., refused the injunction partly because of the difference between the trades, but also on the ground that the defendant, C. K. Valentine, was entitled to promote a company to work his invention under his name, unless fraud were shown, and the learned judge did not find fraud.

injunction (*mm*) to restrain the defendant company from carrying on business as manufacturers or vendors of extract of meat, and from selling any extract of meat, under a name of which *Valentine* formed part, and also an injunction to restrain the defendant, C. K. Valentine, from carrying on business, in such goods, under his name without distinguishing such business from that of the plaintiffs. The plaintiffs' business, although chiefly American, was well known in England, and their goods, a medicinal fluid extract of meat, were always described by a name comprising *Valentine*, and sometimes as *Valentine* simply. The defendant, C. K. Valentine, who had obtained a patent for putting up quite a different extract of meat, which was solid and was intended to be used as a food, promoted the defendant company as a purchaser of his invention, and became its managing director. He never had any business, although he purported to sell to the company "the goodwill of the business which is now being created by the vendor." There was evidence of actual deception, and the Court of Appeal came to the conclusion that C. K. Valentine adopted the name in dispute for his company for the purpose of getting the benefit of the plaintiffs' reputation (*n*). The decision might therefore have been put upon the ground of fraud, and might have been arrived at without going beyond the earlier cases (*o*) cited below. The decision was, however, placed on the broad ground that the supposed distinction in law between personal names and other descriptive words does not exist (*p*).

Chivers v. *Chivers.*

The second case, *Chivers & Sons* v. *Chivers & Co. Ld.* (*q*), is an example of the difficulties which may occur where the extension of a large business brings it into competition with one which is already established in a particular locality. In that case the plaintiffs carried on the business of jam and jelly

(*mm*) Appendix, p. 760.

(*n*) Per Lord Alverstone, M. R.

(*o*) *E.g.*, *Tussaud's Case* and *Pinet's Case* below, p. 511, and above, pp. 470, 472.

(*p*) The defendants were also restrained from using the word *Valtine* which they had registered as a trademark. It was subsequently removed from the Register, *Valentine's Tm.*, 18 R. P. C. 175 (1901), Farwell, J.

(*q*) 17 R. P. C. 420 (1900), Farwell, J.

makers at Histon, Cambridgeshire, and by very extensive advertising (*r*) for some years before the action they had developed a large trade in a particular class of their goods known as "table jellies," especially in the Eastern and Midland counties of England. It was not shown that they had any large or extensive trade in Wales. The goods in question were always described by the plaintiffs on the boxes in which all such goods were sold as *Chivers' Table Jellies*. The defendant company had been formed in the year 1895 by a firm of S. Chivers & Co., in which the senior partner, who became the principal managing director of the company, was Samuel Chivers. The firm, and after its incorporation the company, had carried on a substantial business at Cardiff and in South Wales as jam makers, and were locally well known. In the year 1898 the company commenced to make table jellies, the manufacture of which was, as the learned judge found, a by-product of the jam trade. Their boxes were quite different in appearance (*s*) from those of the plaintiffs, but they placed upon them their name, S. Chivers & Co. Ld., and it was this of which complaint was made. They did not themselves use the phrase *Chivers' Table Jellies*, but a number of witnesses, most of whom had never heard of the defendant company, were called to prove that in different parts of the country that phrase or *Chivers' Jellies* was understood to mean the plaintiffs' goods, and that by the use of the defendant company's name their goods might and probably would be passed off as those of the plaintiffs. No case of fraud or of actual deception was made out. It was held that, as the plaintiffs had not established that the secondary meaning of the name *Chivers* for which they contended was universal in Wales as well as in England, or that its original meaning had been lost, they could not succeed. The learned judge said that if they could do so they could also prevent the use of the defendant's name for their old-established jam trade.

(*r*) The learned judge said (at p. 431), "Advertising distinguished from trade is nothing."

(*s*) They at first adopted a box which, in some particulars, closely resembled that of the plaintiffs. It had directions copied from the latter. In a previous action they had consented to an injunction in respect of this box.

Cash v. *Cash*.

The most recent case on the subject is that of *J. and J. Cash, Ld.* v. *Cash* (*r*). The plaintiffs and their predecessors in business had been for some years carrying on business under the name of Cash, in Coventry, and it was established that "Cash's Frillings," and "Cash's Woven Names," and "Cash's Initials" meant the plaintiffs' goods. The defendant, whose proper name was Joseph Cash, commenced to carry on business, also at Coventry, in goods which included frillings, woven names, and initials. He did not claim the right to describe these as "Cash's Frillings," &c., but to trade in such goods under the name of *Joseph Cash & Company* or *Joseph Cash*. Kekewich, J., said: "Is it possible for Joseph Cash to have a shop in Coventry, and there to sell frillings without those frillings being sold and known as 'Cash's Frillings'? It seems to me, speaking as a jury, and simply applying such knowledge of the world as I can to the subject, that it is impossible that that can be done." An injunction was granted restraining the defendant from carrying on the business of manufacturer or seller of the three kinds of article under the name of Cash, or any other name so as to mislead (*s*). This case, therefore, as an actual decision, goes further than any other case on the point.

Earlier cases

As the earlier cases on the subject are useful as illustrations of circumstances under which the Court has restrained or limited, or refused to restrain or limit, the use by a defendant of his own name, although they cannot now be relied on as laying down a general principle, the summary of them contained in the former edition of this book has been retained.

Turton v. *Turton*.

The subject had been previously discussed by the Court of Appeal in *Turton* v. *Turton* (*t*). In that case the plaintiffs, Thomas Turton and Sons, Limited, were carrying on a widely known and extensive business acquired by the company in 1886, but established many years previously, under the name

(*r*) 18 R. P. C. 213 (1901), Kekewich, J. The case, on application for an interlocutory injunction, is reported 82 L. T. 655 (1900).

(*s*) The order is printed at length in the Appendix, p. 760.

(*t*) 42 C. D. 128 (1889), C. A., reversing North, J. In *Reddaway* v. *Banham*, Lord Macnaghten said he was at a loss to know why this case was ever reported. The plaintiff's case was extravagant and absurd: (1896) A. C. at p. 220.

of *Thomas Turton and Sons*, in Sheffield, and one of the trade-marks of the company bore that name upon it. The defendants, John Turton and his two sons, were carrying on a business of a similar description in the same town. Their business had also been established for many years, although not for so long as that of the plaintiffs. For ten years before June, 1888, its style had been *John Turton & Co.*, but John Turton then took his sons into partnership, and changed the style to *John Turton and Sons*, the name the plaintiffs complained of. There was evidence that the plaintiff company were often referred to as *Turton and Sons*, and *Thomas*, or *T. Turton and Sons*, and there were conflicting affidavits by persons engaged in the trade as to whether the distinction between the trade-names was sufficient to prevent mistakes being made. It was also shown that letters intended for the plaintiffs had, in some instances, been delivered to the defendants, but, apart from the adoption of the addition *and Sons*, in place of *and Co.*, there was no evidence that the defendants' conduct was intended or calculated to pass off their goods as those of the plaintiffs.

Mr. Justice North, at the trial, granted an injunction in the terms of that in *Hendriks* v. *Montagu* (*u*); but the Court of Appeal reversed this order, and dismissed the action.

In the view of the facts taken by the Court of Appeal, the defendant, John Turton, was not shown to have done anything to give to the name objected to any other meaning than that he was carrying on business in partnership with his sons; he had not done anything with the intent or for the purpose of making the use of his simple name look as if his name were the name of the plaintiffs. "In some cases," Lord Esher said, "besides using the names, parties have, to use what, I think, is a happy phrase of my brother Cotton's, 'garnished that use'—that is, they have done things besides using the name, in order that the use of that name might look as if it were being used by the old firm. There is nothing of that kind here." Lord Esher's judgment.

Notwithstanding the possibility of mistakes between the

(*u*) *Ante*, p. 466.

two firms being made by careless people, therefore, the Court held that the defendants were justified in adopting the name complained of, and in continuing its use after the possibility of mistake had been brought to their knowledge, and the action was accordingly dismissed. One may venture to regret that the Court did not adopt the slight extension of the principles appealed to which would have been necessary to forbid the defendants from choosing out of several alternative styles, all equally accurate as descriptions, and equally convenient according to business usage, the only one which was calculated to lead to mistake. If *Turton & Co.* did not suit the defendants, they might have been satisfied with *Turton*, *Turton and Turton*, or *Turton* preceded by the initials of the partners.

A man may describe his firm in the ordinary mercantile way; not necessarily by any "fancy name."

The foundation of the judgments of all the Lords Justices was that the statement comprised in the defendant's name was nothing other than a statement of the actual fact that their business was the business of Joseph Turton and his sons, expressed in the "ordinary mercantile way" (*x*), and made "truly, honestly, and in the usual manner in which such statements are made in the course of business" (*y*). The case is, therefore, readily distinguishable from cases where a "fancy name" which is not descriptive of actual facts in ordinary language is appropriated (*z*), such as, for instance, the name—the "Universal Life Assurance Association"—in *Hendriks* v. *Montagu* (*z*). There is no justification for the adoption and use of any such name if it is calculated to deceive.

Massam v. *Thorley*.

Massam v. *J. W. Thorley's Cattle Food Co., Ld.* (*a*), closely resembled the case of *Tussaud* v. *Tussaud* already referred to (*b*). There the plaintiffs, as executors of one Joseph Thorley, were carrying on a well-known business in a special food for cattle established by their testator. The defendant company had engaged as their manager J. W. Thorley, who was a brother of Joseph Thorley, and having been in his

(*x*) Cotton, L. J., p. 142.
(*y*) Fry, L. J., p. 147.
(*z*) *Ante*, p. 466; and see the latter part of the judgment of Cotton, L. J., 42 C. D. 145.
(*a*) 14 C. D. 748 (1880), C. A. reversing Malins, V.-C.
(*b*) *Ante*, p. 471.

employment some ten years previously, had become possessed of the recipe according to which the cattle food was made by the plaintiff's testator. J. W. Thorley was also the holder of a one-shilling share in the company. The defendants endeavoured to defend their use of the name which they had adopted on the ground of their relations with J. W. Thorley, but unsuccessfully, and the Court of Appeal were further of opinion that the defendants had imitated the get-up of the plaintiff's goods, and had intentionally acted so as to induce buyers to take their goods for them.

The injunction granted left the defendants at liberty to use their name, and to use the word *Thorley* in connection with their goods (if they could) in any way not calculated to mislead the public (*c*).

The injunction in this case might, in the view which the Lords Justices took of the facts, have been granted on the fraudulent intention of the defendants alone, for, as appears from the judgments quoted above, it is only the honest use of a man's own name which is ever a defence (*d*).

Name must be the defendant's own name;

And the justification only extends, in any case where it applies, to the use of a man's own name, or that of his predecessor who founded his business and established it under the name which the defendant is using (*e*); not to the use of that of his servant (*f*), or of an alleged partner who has really no interest in his business, and has been brought into it only in aid of an attempt to cover the employment of a deceptive name (*g*). Still less to the use of the name of a stranger (*h*),

not a bought name,

(*c*) See the form of injunction, 14 C. D. 762; and Appendix, p. 750.

(*d*) See also *Warner* v. *Warner*, 5 Times L. R. 327, 359; *Huntley & Palmer* v. *The Reading Biscuit Co.*, 10 R. P. C. 277 (1893), Chitty, J.; and *Clayton* v. *Day*, where one Day joined one Martin in a fraudulent attempt to carry on business as "Day and Martin," in unfair competition with the well-known firm, 26 Sol. J. 43 (1881), Chitty, J.

(*e*) See *Pinet* v. *Maison Pinet, Ld.*, *ante*, p. 472; *Turton* v. *Turton*, *ante*, p. 508; *Barber* v. *Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L. J.

(*f*) *Southorn* v. *Reynolds*, 12 L. T. N.S. 75 (1865), Wood, V.-C. (*Southorn's Broseley Pipes*); *Birmingham Vinegar Brewery Co.* v. *Liverpool Vinegar Co.*, W. N. (1888) 139, North, J., cited p. 464; *Tussaud* v. *Tussaud*, *ante*, p. 470.

(*g*) See *Croft* v. *Day*, *infra*; *Schweitzer* v. *Atkins*, 37 L. J. Ch. 847 (1868); *Dence* v. *Mason*, W. N. (1877) 23, (1878) 42 (*Brand's Essence of Beef*), both Malins V.-C.

(*h*) *Isaacson* v. *Thompson*, 41 L. J.

even though it is alleged that he has authorized the defendant to use it (*i*).

or a name altered to resemble the plaintiff's;

Such practices are badges of fraud rather than grounds of defence. So, where the defendant has altered his name in such a way as to make it more nearly resemble the plaintiff's, the inference is almost inevitable that fraud is intended (*k*), and whether it is or not, the rule in question only applies to the use of the defendant's name in its ordinary form.

but may be the defendant's name of repute.

But it is submitted that the name need not be that which the defendant received from his parents. A name which he has adopted and used until it has come to be his name by repute is as much his name as that by which his parents were known (*l*). Of course, a new name adopted at the time of, or shortly before, the alleged deceptive user of it would generally be taken to have been adopted for fraudulent purposes, even if it could be shown by the date of the trial to have become the defendant's name by repute.

Addition of "limited" to a firm-name.

The name of a company formed by the addition of "limited" to the firm-name of a business which the company takes over stands in the same position as the firm-name itself (*m*).

It must be used *simpliciter*, not garnished to look like the plaintiff's.

In most of the reported cases in which a defendant has been restrained from passing off his goods as those of the plaintiff under cover of a similar name, the defendant has added the "circumstances of fraud," to which Knight-Bruce,

Ch. 101 (1871), Bacon, V.-C. (*Madame Elise*), defendant used his daughter's name, *E. Louise*; interim injunction refused on account of delay. *Parks, Gunston & Tee, Ld.* v. *Thompson, Talmey & Co., Ld.*, 18 R. P. C. 185 (1901), Farwell, J.

(*i*) *Croft* v. *Day*, 7 Beav. 84 (1843), Langdale, M. R. (*Day and Martin*); *Shrimpton* v. *Laight*, 18 Beav. 164 (1854), Romilly, M. R.; *Melachrino & Co.* v. *The Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215 (1887), Chitty, J. See also *Tussaud* v. *Tussaud* and *Rendle* v. *Rendle & Co.*, above, p. 470, note (*l*), and the *Talmey* case, note (*h*).

(*k*) *Taylor* v. *Taylor*, 23 L. J. Ch. 255 (1854), Wood, V.-C.; *James* v. *James*, L. R. 13 Eq. 421 (1872), Romilly, M. R. (*Robert Joseph James* called himself *Robert James*); and see *Slazenger* v. *Feltham*, 6 R. P. C. 531 (1889), C. A.

(*l*) See per James, L. J., and Bramwell, L. J., in *Massam* v. *Thorley, &c.*, 14 C. D. 757, 760. It has already been shown that a name of repute is protected as a trade-name: above, p. 463.

(*m*) *Chivers* v. *Chivers*, above, p. 506. See also *Townsend* v. *Jarman*, above, p. 497, note (*a*).

L. J., referred, in *Burgess* v. *Burgess* (*n*), or, in the phrase of Cotton, L. J., in *Turton* v. *Turton* (*o*), has "garnished the use of his name" by imitating the get-up of the plaintiff's goods (*p*), or his labels and show-cards (*q*), or has issued circulars or advertisements (*r*) calculated to foster the error which the resemblance of his name and that of the plaintiff's was calculated to produce.

Thus, in *Moët* v. *Clyboune* (*s*), the defendant claimed to be entitled to use the names *Meadows* and *Clyboune*, and, by virtue of such right, to brand upon the corks of his champagne bottles the letters *M. & C.* in a circle on the bottom, and the word *England* at the side, in obvious imitation of the plaintiff's practice. And in *Holt* v. *Smith* (*t*), the defendant bought the business of H. Newman and changed its name to Newman & Co., in imitation of the plaintiff's trade-name.

Proximity may be a badge of fraud.

The proximity of the place where the defendant sets up his business to that where a well-known firm is already trading may be evidence to show that, although trading under his own name, the defendant is seeking to take fraudulent advantage of its similarity to the plaintiff's name. The case of somebody finding a man named *Bass* and setting up a brewery at Burton as Bass & Co. (*u*), and the case of a man starting business as a banker in the Strand under the name of Coutts (*x*), have been cited as instances

(*n*) *Ante*, p. 501; *e.g.*, by adding & *Co.*; *Graveley* v. *Winchester*, Seb. Dig. p. 162 (1867), Giffard, V.-C.; *Churton* v. *Douglas*, Johnson, 174; 28 L. J. Ch. 841 (1859), Wood, V.-C.; *Witt* v. *Concoran*, 2 C. D. 69 (1873), Bacon, V.-C.

(*o*) *Ante*, p. 509.

(*p*) *Holloway* v. *Holloway*, 13 Beav. 209 (1850), Langdale, M. R., above, p. 503, note (*b*); *Taylor* v. *Taylor*, note (*k*); *Schweitzer* v. *Atkins*, note (*q*); *Fullwood* v. *Fullwood* (1), W. N. (1873), 93, 185, Malins, V.-C., and L. JJ.; *J. H. Brooks & Co., Ld.* v. *Norfolk Cycle Co. and John Brookes*, 16 R. P. C. 523, Stirling, J., above, p. 504, note (*d*).

(*q*) *Croft* v. *Day*; *Melachrino* v. *The Melachrino Egyptian Cigarette Co.*, note (*i*).

(*r*) *Massam* v. *J. W. Thorley's Cattle Food Co.*, *supra*, p. 510.

(*s*) Seb. Dig. p. 316 (1877), Jessel, M. R. (*Moët and Chandon*).

(*t*) 4 Times L. R. 329 (1888), Kay, J. Action stayed on the defendant undertaking to use *H.* and drop *Co.*; defendant to pay costs.

(*u*) James, L. J., in *Massam* v. *Thorley, &c.*, 14 C. D. p. 757; see above, p. 505.

(*x*) Chitty, J., in *Melachrino* v. *The Melachrino, &c. Co.*, 4 R. P. C. p. 221.

in which it is scarcely conceivable that the use of the name could be honest (*y*). In *Turton* v. *Turton* (*z*), the defendants were trading in the same town, Sheffield, as the plaintiff, but their presence there was reasonably accounted for, because their business had been established in the town long before the circumstances which led them to adopt the name complained of arose.

7. The Relief granted.

The relief granted to the plaintiff, if he succeeds in a passing off action, corresponds to that granted in the action for infringement of a registered trade-mark to which the first-mentioned action is so closely allied. It comprises, therefore—(i.) an injunction (*a*); (ii.) an order for the delivery up for destruction, or for the erasure of the names or other badges, of any goods already marked with the deceptive names or badges, and in the possession or under the control of the defendant (*b*); and (iii.) damages in respect of the past interferences with the plaintiff's rights (*c*); or (iv.) an account of the profits made by the defendant by the sale of goods under the deceptive names or badges (*d*), or some one or more of these.

Injunction.

The general principles governing the grant of an injunction have been sufficiently considered in the last chapter.

Form of the injunction.

The form of the injunction granted varies considerably, according to the nature of the deceptive representation which the defendant is shown to have made use of, or threatened to make use of.

Where he has imitated or adopted the plaintiff's trade-

(*y*) *Lee* v. *Haley* is another illustration. There the plaintiff's late manager set up in business as the "Pall Mall Guinea Coal Co.," in the Strand, and afterwards removed to 46, Pall Mall. The plaintiffs traded, at 22, Pall Mall, as "The Guinea Coal Co." An injunction was granted; 21 L. T. N.S. 546; 22 *ib.* 251; L. R. 5 Ch. 155, Malins, V.-C., and Giffard, L. J.

(*z*) Page 508.

(*a*) Last chapter, p. 411. See below, and the orders collected in the Appendix, pp. 748 *et seq.*

(*b*) Page 420.

(*c*) Page 422.

(*d*) Page 422.

name, the order may be an absolute injunction that he shall not carry on business under that name (*e*).

Injunction in *Massam* v. *Thorley*.

A very full form of order was adopted in *Massam* v. *Thorley's Cattle Food Co.* (*f*). It restrained the defendant company and their servants from selling, or procuring to be sold, and from in any manner representing any goods manufactured by them as the goods of the late Joseph Thorley or the plaintiffs, his successors; from in any manner representing, or doing anything which should lead to the belief that the defendant company were carrying on the business of the late Joseph Thorley; from affixing to their goods, or otherwise employing, any labels, wrappers, or marks used by him or the plaintiffs, or so contrived as to represent, or lead to the belief, that the goods manufactured or sold by the defendant company were his goods or those of the plaintiffs; and from using or circulating any circulars or advertisements, used or circulated by him or the plaintiffs, or which should in any manner represent or lead to the belief that the defendant company had been or were carrying on the business of the late Joseph Thorley, or were his successors.

Only deceptive use of open word, &c. restrained.

But a device or name, which is not a trade-mark or the trade-name of the plaintiff, may always be used by the defendant in any way which is not calculated to deceive, if such way can be found; and the injunction in passing off cases is usually drawn so as to preserve this right, the order not to use a particular device or word being qualified by the addition "so as to represent, or lead to the belief," that the defendant's goods are the plaintiff's (*g*).

Thus, in *Massam* v. *Thorley's Cattle Food Co.*, the Lords Justices refused to prohibit the defendants from using the word Thorley in connection with cattle food altogether (*h*). And in *Slazenger* v. *Feltham*, the Court of Appeal modified the order of Kekewich, J., forbidding the defendants to stamp

(*e*) As in *Hendriks* v. *Montagu*, 17 C. D. 638, set out above, p. 466.

(*f*) 14 C. D. p. 762, set out in the Appendix, p. 750.

(*g*) *Slazenger & Sons* v. *Feltham & Co.*, 6 R. P. C. 531 (1889); *Jay* v. *Ladler*, 40 C. D. p. 656; 6 R. P. C. 136 (1888), Kekewich, J.; *Magnolia Metal Co.* v. *Atlas Metal Co.*, 14 R. P. C. 389 (1897), Collins, J., and C. A.

(*h*) 14 C. D. 763.

Demotic on their lawn-tennis bats, by adding the words "so as to represent that (they) are manufactured by the plaintiffs, or in any other way from passing off their lawn-tennis bats as the goods of the plaintiffs."

Where what is complained of is the deceptive use of an open word, which has come to be associated with the plaintiff's trade or goods, the form of injunction is now generally directed to prevent the defendant from using it "without clearly distinguishing his goods from the plaintiffs." This was the form adopted in the infringement cases *Seixo* v. *Provezende* (*i*), and *Johnston* v. *Orr-Ewing* (*k*), and in the *Yorkshire Relish* (*l*), and *The Stone Ales* cases. In the last-mentioned case several of the Lords of Appeal referred to it as the proper form to adopt unless the plaintiff had a claim to the exclusive use of the word, name, or other mark in question (*m*).

"Without distinguishing, &c."

The Stone Ales Case.

In the last-mentioned case, however, the injunction to restrain the defendant (*inter alia*) from selling beer not of the plaintiff's manufacture, under the term *Stone Ales* or *Stone Ale*, or in any way so as to induce the belief that such ale was of the plaintiff's manufacture, was, under the circumstances, maintained, the Lords of Appeal holding that the *Seixo* v. *Provezende* form of injunction would be more stringent, as it would, in effect, prevent the defendant using the term *Stone Ale* at all (*n*).

Temporary or contingent prohibition.

And the defendant has, in some instances, been restrained from using a word or words which could not be used by him at all, except deceptively, so long as this should continue to be the case; for instance, from calling his bitters *Angostura*

(*i*) L. R. 1 Ch. 194 (1865), Wood, V.-C., and Cranworth, L. C.

(*k*) 13 C. D. 434; 7 App. Ca. 219, Fry, J., C. A., and H. L.

(*l*) Above, p. 459. *Bewlay & Co., Ld.* v. *Hughes*, 15 R. P. C. 290 (1898), North, J. (*Dindigul Cigars*); and *Grezier and Doyle* v. *Autran*, 13 R. P. C. 1 (1895), Chitty, J., and C. A. (*Chartreuse*), are other recent examples. See also Lord Macnaghten's judgment in *Reddaway* v. *Banham*, (1896) A. C. at p. 221; 13 R. P. C. at p. 234.

(*m*) Lord Watson and Lord Macnaghten: *Montgomery* v. *Thompson*, (1891) A. C. 217; 8 R. P. C. 361; see also *Thompson* v. *Bent's Brewery Co., Ld.*, 8 R. P. C. 479 (1891), Chitty, J. In *The Magnolia Case* (note (*g*)), Collins, J., granted an injunction in this form, and the plaintiffs unsuccessfully appealed, asking for an absolute prohibition.

(*n*) See above, p. 485; and *Braham* v. *Beachim*, there cited.

Bitters until he should find out how to make the real *Angostura Bitters* (*o*); or from using the name *Radstock Colliery Proprietors* until he should be able to sell coal from Radstock (*p*).

The *Pinet* cases (*q*) illustrate the different cases to which the absolute and the limited forms of injunction are respectively applicable. In the first case it was supposed that the assignor to the defendant company had traded under his own name, "Pinet," and a limited injunction was granted. Subsequently it was discovered that this was not his own name, but a name adopted for the purpose of the fraud, and thereupon an absolute injunction was decreed.

No rule as to what distinction is sufficient.

No general rule can be laid down as to what additions to the objectionable matter will be sufficient to effect the requisite distinction (*r*). It must depend upon the circumstances of each case. Where the order is in respect of a word which has, in fact, become the trade-name of the plaintiff's goods, the most careful differentiation of the get-up of the goods (*s*), and the greatest possible prominence of the defendant's own name (*t*) upon his labels may not be enough. In such cases the limitation of the order is more likely to mislead the defendant than to protect him in his assumed right to use the word.

Limited to particular market.

The injunction may be limited with reference to the use of the mark in a particular country or market (*u*).

(*o*) *Siegert* v. *Findlater*, 7 C. D. 801 (1878), Fry, J.

(*p*) See note (*n*), *ante*, p. 516.

(*q*) *Pinet* v. *Maison Pinet, Ld.* 14 R. P. C. 933 (1897), C. A.; *Same* v. *Maison Louis Pinet, Ld.*, 15 R. P. C. 65, North, J.

(*r*) "No Court has ever said how the distinction is to be made": per Stirling, J., in *Powell* v. *Birmingham Vinegar Co.*, (1896) 2 Ch. at p. 64. But see the last chapter, p. 419. In France the Court sometimes settles what may be used: see *Grezier and Doyle* v. *Autran*, 13 R. P. C. 1.

(*s*) In the last case the bottles and labels of the defendants' *Yorkshire Relish* were totally different from those of the plaintiffs. They are shown in 13 R. P. C. pp. 237, 238, and 240.

(*t*) In *Daniel and Arter* v. *Whitehouse*, 16 R. P. C. 71 (1898), North, J., *F. Whitehouse's Brazilian Silver* was held to be an infringement of an order not to use *Brazilian Silver* without distinguishing, &c.

(*u*) *Carver* v. *Bowker*, Seb. Dig. p. 350 (1877), Little, V.-C., a trade-mark case before the Acts; *Barber* v. *Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L. J.; the action succeeded only as to passing off; the injunction was limited to Ireland. In *Société, &c. de l'Etoile's Tm.*, (1894) 1 Ch. 61; 10 R. P. C. 436, a regis-

Interim injunctions.

Interim injunctions are granted in passing off actions on the same terms and according to the same principles as in infringement actions (*u*).

8. Costs, Appeals, and Practice.

And the rules and principles in regard to costs (*x*), appeals (*y*), and practice (*z*), are also the same in both actions, except in so far as they depend upon registration and the Registration Acts, which do not extend to or affect passing off actions.

NOTE.

Rule.

In *Powell* v. *Birmingham Vinegar Brewery Co.*, (1896) 2 Ch. at p. 79; 13 R. P. C. at p. 256, Kay, L. J., said: "The law relating to this subject may be stated in a few propositions: (1) It is unlawful for a trader to pass off his goods as the goods of another. (2) Even if this is done innocently it will be restrained (*Millington* v. *Fox*, 3 My. & Cr. 338). (3) *A fortiori* if done designedly, for that is a fraud. (4) Although the first purchaser is not deceived, if the article is so delivered to him as to be calculated to deceive a purchaser from him, that is illegal (*Sykes* v. *Sykes*, 3 B. & C. 541). (5) One apparent exception is that where a man has been describing his goods by his own name, another man having the same name cannot be prevented from using it, though this may have the effect of deceiving purchasers (*Burgess* v. *Burgess*, 3 De G. M. & G. 896; *Turton* v. *Turton*, 42 Ch. D. 128). (6) But this exception does not go far. A man may so use his own name as to infringe the rule of law. "It is a question of evidence in each case whether there is false representation or not" (per Turner, L. J., *Burgess* v. *Burgess*, 3 De G. M. & G. 905). So he may be restrained if he associates another man with him, so that under their joint names he may pass off goods as the goods of another person (*Croft* v. *Day*, 7 Beav. 84; *Clayton* v. *Day*, 26 Sol. Jour. 43; *Melachrino* v. *The Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215).

First exception.

Second exception.

(7) Another apparent exception is where a man trading under a patent had a monopoly for fourteen years, and has given the article a descriptive name, he cannot, when the patent has expired, prevent another from selling it under that name (*Young* v. *Macrae*, 9 Jur. N.S. 322; *Linoleum Co.* v. *Nairn*, L. R. 7 Ch. D. 834). (8) I am not sure that this would be so if the name so used were the name of the patentee, or even a purely fanciful name not

tered trade-mark case, Stirling, J., said that he did not think limiting the registration would give the applicants, under the circumstances of the case, complete relief. See above, pp. 222 and 414.

(*u*) Chap. XV., p. 415.

(*x*) Page 429.

(*y*) Page 437.

(*z*) Page 438; forms of pleadings, p. 743.

descriptive. (9) Certainly where there has not been a patent, and an article has been made and sold under a fanciful name not descriptive, so that the article as made by one person has acquired reputation under that name, another trader will not be permitted to use the name for a similar article made by him (*Braham* v. *Bustard*, 1 K. & M. 417; *Cochrane* v. *MacNish*, 13 R. P. C. 100). (10) In this last proposition there is again a limitation. If the first maker has slept upon his rights or allowed the name to be used by others until it has become *publici juris*, this Court will not interfere."

Third exception.

CHAPTER XVII.

WARRANTY OF TRADE-MARKS AND TRADE DESCRIPTIONS (*a*).

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It is provided by sect. 17 of the Merchandise Marks Act, 1887, that:—

> "On the sale or in the contract for the sale of any goods to which a trade-mark (*b*), or mark, or trade description (*c*) has been applied (*d*), the vendor shall be deemed to warrant that the mark is a genuine (*e*) trade-mark and not forged (*f*) or falsely applied (*g*), or that the trade description is not a false trade description (*h*) within the meaning of this Act, unless the contrary is expressed in some writing signed by or on behalf of the vendor and delivered at the time of the sale or contract to and accepted by the vendee."

This section corresponds to sect. 19 of the Merchandise Marks Act, 1862, but the older section applied only to trade-marks which were applied to goods sold, and the implied warranty was that the trade-marks were "genuine and true, and not forged or counterfeit, and not wrongfully used."

(*a*) The references in this Chapter are to the Merchandise Marks Act, 1887, which is set out and commented on in Book II.

(*b*) "Trade-mark," sect. 3 (1), see next page.

(*c*) "Trade description," sect. 3 (1), p. 570.

(*d*) "Applied," sect. 3 (2), and sect. 5 (1), p. 567.

(*e*) "Genuine," cf. sect. 2 (2) (a), p. 608.

(*f*) "Forged," sect. 4, p. 563.

(*g*) "Falsely applied," sect. 5 (3), p. 569.

(*h*) "False trade description," sect. 3 (1), pp. 570, 584.

Trade-mark.

Trade-mark (*i*) here means registered trade-mark or trade-mark protected by law in any British possession or foreign state to which sect. 103 of the Patents, &c. Act, 1883, is applicable (*k*). The section, however, imports a warranty of the genuineness of unregistered English trade-marks, at any rate when the application of them to the goods is reasonably calculated to lead persons to believe that the goods are the manufacture or merchandise of the proprietor of the trade-mark, and also of any trade-mark, whether registered or not, which the mark applied to the goods purports to be, for in such cases the mark is a false trade description applied to the goods (*l*). "Mark," where it first occurs in the section, can hardly include an unregistered trade-mark, for the warranty implied is that the mark is a genuine trade-mark, that is, a genuine registered trade-mark, and that it does not purport to be. "Mark," where it occurs the second time, should be trade-mark or mark.

The several terms occurring in the section have the meanings given to them respectively by the sections of the Merchandise Marks Act, 1887, which are referred to in the notes (*m*). The general effect of the implied warranty is that the trade-marks, or marks purporting to be trade-marks, applied to the goods, are used with the assent of the proprietor of the trade-marks which they purport to be, and that the statements made or implied by the trade descriptions are true.

Statement in writing to the contrary.

The saving at the end of the section is, it will be observed, very carefully expressed. The statement required to prevent the implication of a warranty must be in writing, signed, delivered at the time of sale, and accepted by the vendee (*n*).

(*i*) "Trade-mark," sect. 3 (1), p. 560.

(*k*) See Chap. XX., p. 545, and the list in the Appendix, p. 762.

(*l*) Sect. 3 (2), p. 588.

(*m*) See Book II., Chap. I., p. 554.

(*n*) The Food and Drugs Act, 1875 (38 & 39 Vict. c. 63), s. 25, enables the vendor to set up as a defence that he purchased the adulterated goods under a written warranty and resold them unaltered. See *Laidlaw* v. *Wilson*, (1894) 1 Q. B. 74; and *Robertson* v. *Harris*, (1900) 2 Q. B. 117. Sect. 9 makes any alteration in the article without disclosure to the purchaser an offence. A notice exhibited in the shop may be such a disclosure: *Spiers & Pond* v. *Bennett*, (1896) 2

What "accepted by the vendee" means is not clear. It would probably be construed to import at least that the vendee understood that he was to get no warranty, and that he completed the purchase on that footing.

Implied warranty at common law.

Apart from the statutory warranties implied by the Merchandise Marks Act, it is held, at common law (*o*), that when a purchaser orders goods from a firm who are manufacturers only of such goods, and not dealers in them, then, unless it is shown that in the particular trade, or as regards the particular goods, there is a custom for the manufacturer to supply the goods of other makers, the purchaser must be assumed to have contracted with the particular manufacturers in reliance on the general excellence of the work of their firm, and he is entitled (in the absence of any express stipulation to the contrary) to have goods of the manufacturer's own make delivered in performance of the contract (*p*).

Warranty where goods are described by a trade-mark.

It is a question of fact, or, if there is a written contract, of construction, whether a manufacturer or vendor has agreed to deliver goods, which are referred to by a trade-mark in the contract, stamped with the mark, and being, therefore, goods of the kind properly denoted by it, or whether he has agreed only to deliver goods of the same quality as those which are denoted by the mark. Thus, in *Hopkins* v. *Hitchcock* (*q*), where the contract was for iron described as "S. and H. (crown) bars," and the vendors were Hopkins & Co., the successors of Snowden and Hopkins, iron marked "H. & Co." with a crown was delivered, and the jury found that the mark

Q. B. 65. Knowledge of the adulteration on the purchaser's part is not a defence: *Heywood* v. *Whitehead*, 76 L. T. 781 (1897). Under sect. 17 of the Merchandise Marks Act, such questions can hardly arise. The statement in writing must, if the construction in the text is adopted, be a term of the contract. Disclosure that, for example, a trade-mark is not genuine without the statement would not prevent a warranty being implied. Under the Food and Drugs Act proof of scienter is necessary to a conviction for giving a false warranty, *Derbyshire* v. *Houliston* (1897), 1 Q. B. 772.

(*o*) Warranties of the genuineness of marks are implied, in respect of *anchors and chain cables*, by 37 & 38 Vict. c. 51, s. 4, and in respect of *hops*, by 29 & 30 Vict. c. 37, s. 8.

(*p*) Per Cotton, L. J., in *Johnson* v. *Raylton*, 7 Q. B. D. 438 (1881), Cotton and Brett, L. JJ., Bramwell, L. J., dissenting; *Starey* v. *Chilworth Gunpowder Co.*, 24 Q. B. D. 90 (1889), Div. Court.

(*q*) 14 C. B. N.S. 65; 32 L. J. C. P. 154 (1863).

was not a material part of the bargain. Judgment was given for the vendors in an action for the price of the iron, and the Court of Queen's Bench upheld the judgment, on the ground that the contract was for iron of a particular quality, not for iron bearing a particular mark.

Pictures ascribed to particular artists.

A somewhat similar question has arisen upon sales of pictures under the names of the supposed painters of them, and in such cases the matter to be decided is whether the use of the artist's name amounts to a warranty by the vendor that the picture in question is his, or merely to an expression of the vendor's opinion.

In a case where pictures had been sold as "Views in Venice, Canaletto," and they were not by Canaletto (*r*), the question was left to the jury; but where the supposed artist was an old master, Lord Kenyon, at *Nisi Prius*, held that it was impossible to make the case one of warranty. The pictures, he said, were the work of artists of some centuries back, and there being no way of tracing the picture itself, it could only be matter of opinion whether the picture in question was the work of the artist whose name it bore or not; the catalogue only expressed the opinion of the vendor, but left the determination to the buyer's own judgment (*s*).

Remedy for breach of the warranty.

The remedy for breach of warranty, whether implied under the section set out above, or at common law (*t*), or imported by express agreement in any contract in regard to goods sold or agreed to be sold, is an action for damages, reduction of the agreed price, or rescission of the contract. The rules determining the nature and extent of the remedy are now contained in the Sale of Goods Act, 1893 (*u*), from which the following sections are quoted:—

> "**53.**—(1.) Where there is a breach of warranty by the seller, or where the buyer elects, or is compelled, to treat any breach of a condition on the part of the seller as a breach of warranty, the buyer is not by

(*r*) *Power* v. *Barham*, 7 C. & P. 356; 4 Ad. & E. 472; 5 L. J. K. B. N.S. 88 (1835) (Canaletto died in 1768). The jury found there was a warranty.

(*s*) *Jendwine* v. *Slade*, 2 Esp. N. P. C. 572 (1797) (Teniers and Claude Lorraine, who died in 1694 and in 1682 respectively).

(*t*) See Benjamin on Sale, Book IV., Part II., Chap. I.

(*u*) 56 & 57 Vict. c. 71.

reason only of such breach of warranty entitled to reject the goods; but he may—

"(a.) Set up against the seller the breach of warranty in diminution or extinction of the price; or

"(b.) Maintain an action against the seller for damages for the breach of warranty.

"(2.) The measure of damages for breach of warranty is the estimated loss directly and naturally resulting, in the ordinary course of events, from the breach of warranty.

"(3.) In the case of a breach of warranty of quality such loss is *primâ facie* the difference between the value of the goods at the time of delivery to the buyer and the value they would have had if they had answered to the warranty.

"(4.) The fact that the buyer has set up the breach of warranty in diminution or extinction of the price, does not prevent him from maintaining an action for the same breach of warranty if he has sustained further damage.

"(5.) Nothing in this section shall prejudice or affect the buyer's right of rejection in Scotland as declared by this Act."

"**54.** Nothing in this Act shall affect the right of the buyer or seller to recover interest or any special damages in any case where by law interest or special damages may be recoverable, or to recover money paid where the consideration has failed."

Rescission of the contract for breach of warranty.

The right to rescind the contract and return the goods is dealt with by an earlier section of the same Act.

When condition is to be treated as warranty.

"**11.**—(1) In England or Ireland—

"(a.) Where a contract of sale is subject to any condition to be fulfilled by the seller, the buyer may waive the condition, or may elect to treat the breach of such condition as a breach of warranty, and not as a ground for treating the contract as repudiated.

"(b.) Whether a stipulation in a contract of sale is a condition the breach of which may give rise to a right to treat the contract as repudiated, or a warranty the breach of which may give rise to a claim for damages, but not to a right to reject the goods and treat the contract as repudiated, depends in each case upon the construction of the contract. A stipulation may be a condition, though called a warranty in the contract (*x*).

"(c.) Where a contract is not severable, and the buyer has accepted the goods, or part thereof, or where the contract is for specific goods, the property in which has passed to the buyer, the breach of any condition to be fulfilled by the seller can only be treated as a breach of warranty, and not as a ground for rejecting the goods and treating the contract as repudiated (*y*), unless there be a term of the contract, express or implied, to that effect.

"(2.) In Scotland, failure by the seller to perform any material part of a contract of sale is a breach of contract, which entitles the buyer either within a reasonable time to reject the goods and treat the contract as repudiated, or to retain the goods and treat the failure to perform such material part as a breach which may give rise to a claim for compensation or damages. **The Scotch rule.**

"(3.) Nothing in this section shall affect the case of any condition or warranty, fulfilment of which is excused by law by reason of impossibility or otherwise."

Damages for breach of warranty of trade-mark.

The warranty implied by the Merchandise Marks Act will accordingly operate to enable an innocent purchaser of goods which have been forfeited under that Act, or which have led to a prosecution, entailing expenses upon him, to recover damages in respect of the loss or expenses from the vendor, for such damages directly and naturally

(*x*) See *Behn* v. *Burness*, 3 B. & S. 756; 32 L. J. Q. B. 204 (1863), Blackburn on Sale, 2nd ed., p. 198.

(*y*) *Street* v. *Blay*, 2 B. & Ad. 460 (1831); *Heyworth* v. *Hutchinson*, L. R. 2 Q. B. 447 (1867); *Hooper* v. *Balfour*, 62 L. T. 646 (1890); *Re Green and Balfour*, 63 L. T. 97, 325 (1890).

result in the ordinary course of events from the breach of warranty. It will also enable the purchaser to recover from the vendor any damages which may have been recovered from the purchaser by a sub-purchaser upon a resale by him, at any rate where the goods were known by the vendor to have been bought for the purpose of resale (*z*).

Indemnity to manufacturer infringing a trade-mark at his customer's request.

A manufacturer has at common law, and apart from any question of implied warranty, a right of indemnity by his customer, if, in compliance with the customer's orders, he innocently places a mark upon goods made for him, and the mark turns out to be an infringement of some third person's trade-mark, so that the manufacturer is rendered liable to an action by the owner of the trade-mark (*a*).

(*z*) *Hammond* v. *Bussey*, 20 Q. B. D. 79 (1887), C. A.; *Agius* v. *Great Western Colliery Co.*, (1899) 1 Q. B. 413. See further, as to consequential damages, *The Argentino*, L. R. 13 P. D. 191 (1888), C. A.

(*a*) *Dixon* v. *Fawcus*, 3 Ell. & Ell. 537; 30 L. J. Q. B. 137 (1861). As to the defence of the manufacturer in any such case upon proceedings under the Merchandise Marks Act, see sect. 2 (2), sect. 6, and sect. 19 (3) of that Act, and Book II., Chap. I., below.

CHAPTER XVIII.

TRADE-LIBEL.

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There is no threats action in respect of a trade-mark;

UNDER sect. 32 of the Patents, &c. Act, 1883, an action for damages or an injunction lies against any person claiming to be a patentee, who by circulars, advertisements, or otherwise, threatens any other person with legal proceedings or liability, at the instance of anyone who is aggrieved by the threats (*a*). The section does not extend to threats in respect of the use of a trade-mark or trade-name, and there is no precisely corresponding right apart from it. So that the publication in good faith of a statement that the plaintiff is infringing the defendant's trade-mark, and that the defendant intends to

(*a*) See Edmundson Patents, p. 348, 2nd ed., p. 470; Lawson on the Patents, &c. Acts, 3rd ed., p. 321; *Challender* v. *Royle*, 36 C. D. 425; 4 R. P. C. 363 (1887), C. A.; *Johnson* v. *Edge*, (1892) 2 Ch. 1; 9 R. P. C. 112, C. A.; and *Skinner* v. *Shew*, (1893) 1 Ch. 413; and as to damages, *S. C.*, (1894) 2 Ch. 581; and *Skinner* v. *Perry*, 11 R. P. C. 406 (1894).

take proceedings against all persons dealing in the infringing goods, is not actionable, and cannot be restrained by injunction (*a*). In a recent passing off case (*b*), a counterclaim which alleged threats merely without malice was ordered to be struck out as disclosing no reasonable cause of action.

but the threats may amount to libel or slander of title.

But disparaging statements calculated to injure the plaintiff's trade or to diminish the value of his goods, if they are not made in good faith, are actionable; and the continued publication of them after they have been shown, or have been held by the Court (*c*), to be untrue may be restrained (*d*). For they amount to libels on the plaintiff in the way of his trade, or to slander of title (*e*).

A warning against infringements, &c. may be issued in good faith.

A fair warning to the public, or to probable purchasers of the goods, or to customers of the businesses concerned, by a trader that he regards the conduct of another as an infringement of his rights, if published in good faith, and in the belief that it is well-founded, is not libellous (*d*), although it may turn out to be mistaken (*f*). So, anyone who thinks his trade-name is likely to be confused with that of another business may publish a warning that there is no connection

(*a*) *Colley* v. *Hart*, 44 C. D. 179; 6 R. P. C. 17 (1888), North, J. (interim injunction refused as to the trade-mark). Also at the trial, 7 R. P. C. 101, at p. 113.

(*b*) *Ripley* v. *Arthur & Co.*, 18 R. P. C. 82 (1901) Farwell, J.

(*c*) *Burnett* v. *Tak*, 45 L. T. 713 (1882), Kay, J.

(*d*) *Wren* v. *Weild*, L. R. 4 Q. B. 730 (1869), a patent threats action before the Act of 1883. In *Halsey* v. *Brotherhood*, 19 C. D. p. 392 (1881), a similar action, Lindley, L. J., said: "*Wren* v. *Weild* comes to this: that if I am a patentee, so long as I act honestly, I am entitled to say, without running the risk of having an action for damages brought against me, that somebody is infringing my patent, or that somebody else's manufacture is an infringement of my patent. . . . If I say it dishonestly, I am so liable; and if I know that what I say is untrue, it would not take much to persuade a jury that I was acting dishonestly."

(*e*) A false and malicious statement in writing, printing, or by word of mouth, injurious to any person's title to property, and causing special damage, is an actionable slander of title. Tindal, C. J., in *Malachy* v. *Soper*, 3 Bing. N. C. 371 (1835).

(*f*) In *Dicks* v. *Brooks*, 15 C. D. p. 40 (1880), Bramwell, L. J., said: "Although, according to our opinion, they would have been wrong in their law with respect to its being a piracy, I think their saying so would not have been actionable, because a man is not bound to be correct in his statement of law, though he is bound to be correct in his statement of

between his business and the other (*g*). And this, notwithstanding the pendency of proceedings in which the right of the proprietor of the other to use the name or marks he has adopted comes into question (*h*). But under pretence of the honest publication of a fair warning there is no excuse for an allegation that the goods of the other party are spurious (*i*), or that he is foisting a fictitious article upon the public (*j*), or is fraudulently endeavouring to pass off his goods as those of the person who issues the advertisement or circular complained of (*k*).

Suggestion that the plaintiff's goods are spurious.

Thus, in *Thorley's Cattle Food Co.* v. *Massam* (*l*), the defendants had published an advertisement warning the public that any goods purporting to be Thorley's Cattle Food, and not signed by their trade-name "Joseph Thorley," were not of their manufacture, and alleging that they were the only persons possessed of the secret recipe according to which the food was compounded, and also a circular stating that the plaintiffs were seeking to "foist upon the public an article which they pretend is the same as that manufactured by the late Joseph Thorley." The defendants were the executors of the late Joseph Thorley, the inventor of the cattle food, and they were carrying on his business; but the statement that they alone possessed the secret recipe, and the suggestion that the goods of the plaintiffs were not prepared according to it, were both false, for one Josiah Thorley, a brother of Joseph

facts." "To support such an action it is necessary for the plaintiffs to prove (1), that the statements complained of were untrue; (2), that they were made maliciously, *i.e.*, without just cause or excuse; (3), that the plaintiffs have suffered special damage thereby": per Lord Davey, in *Royal Baking Powder Co.* v. *Wright, Crossley & Co.*, 18 R. P. C. 95 (1901), H. of L. See also the passage as to *bona fides*, below, p. 532.

(*g*) *Thorley's Cattle Food Co.* v. *Massam*, 14 C. D. 763 (1880), C. A.; *William Coulson and Sons* v. *James Coulson and Sons*, 3 Times L. R. 740 (1887), Div. Court. In the last case the defendants added to their warning a statement that the plaintiff firm was lately bankrupt.

(*h*) *Coats* v. *Chadwick*, (1894) 1 Ch. 347, Chitty, J.; see p. 534, below; *Anderson* v. *Liebig, &c. Co.*, 45 L. T. 757 (1881), Chitty, J.

(*i*) *Thorley's Case*, *supra*.

(*k*) *Coats* v. *Chadwick*, *supra*.

(*l*) *Supra*; *Liebig, &c. Co.* v. *Anderson*, 55 L. T. 206 (1887), Chitty, J.

Thorley, who had obtained the recipe from him, was manager of the plaintiff company (*m*). An injunction was granted at the trial to restrain the defendants from advertising, or representing, or suggesting in their advertisements or circulars, that they, or the proprietors of their testator's business, were alone possessed of the secret recipe, and from representing or suggesting, or doing anything calculated to represent or suggest, that the cattle food manufactured or sold by the plaintiffs was spurious or not genuine.

And in *Thomas* v. *Williams* (*n*), the publication of circulars suggesting that the goods of the plaintiff were not genuine, but were imitations of goods sold by the defendants, was restrained.

But a mere puff of the defendant's own goods, or a statement that they are superior to those of a rival trader, even if untrue and the cause of damage to the latter, is not actionable (*o*). And it cannot be made actionable by proof of malice (*o*).

(*m*) A suit for an injunction by the executors to restrain the use of the name *Thorley's Cattle Food* by the company had been abandoned, after an application in it for an interim injunction had failed; 6 C. D. 583, Malins, V.-C. But, subsequently, the executors succeeded in a trade-name and passing-off action against the company, *ante*, p. 510.

(*n*) 14 C. D. 864 (1880), Fry, J.; *Liebig, &c. Co.* v. *Anderson*, note (*l*) "only genuine brand."

(*o*) *Hubbuck* v. *Wilkinson*, (1899) 1 Q. B. 86, C. A., adopting the opinion expressed by Herschell, L.C., in *White* v. *Mellin*. In the latter case ((1894) 3 Ch. 276; (1895) A. C. 154), the defendant, a chemist, had placed upon the goods of the plaintiff, Mellin, which he sold, an advertisement of *Vance's Food*, a rival food for infants. The advertisement stated that *Vance's Food* was "far more nutritious and healthful" for infants and invalids "than any yet offered." The plaintiff complained of this as a trade-libel. Romer, J., dismissed the action at the close of his case. The C. A. ordered a new trial, but this order was reversed by the H. L. on the ground that neither the untruth of the statement complained of, nor that it had caused special damage to the plaintiff, had been proved. Both points were essential to the plaintiff's case. Lord Watson also held that, notwithstanding the manner in which the statement had been affixed to and sold with the plaintiff's goods, it was not, in any legal sense, published of and concerning them. Lord Herschell said (at p. 164): "I entertain very grave doubts whether any action can be maintained for an alleged disparagement of another's goods merely on the allegation that the goods sold by the party who is alleged to have

Special damage must be proved.

In an action for a trade-libel, as distinguished from an ordinary personal libel, proof of special damage—*i.e.*, that the publication of the libel has actually injured the business or property of the plaintiff—is essential (*p*). If the libel is "in its very nature intended, or reasonably likely to produce," and "in the ordinary course of business does produce, a general loss of business, as distinct from the loss of this or that known customer, evidence of such general decline of business is admissible" to prove special damage (*q*).

If the injury proved is trifling and no threat to repeat the publication is proved, the action should be dismissed (*r*).

The interruption of an illegal trade cannot be legal damage (*s*).

And in a case where the only evidence of damage to the plaintiff, by the publication of a libellous circular misstating the result of an action for passing off the plaintiff's goods as those of the defendant, was the plaintiff's own affidavit alleging that his business had fallen off, and the plaintiff had delayed bringing his action for three months after he first knew of the publication, North, J., assessed the damages at 5*l.*, but granted an injunction, and gave the plaintiff the costs of the action (*t*). But a disparaging statement with regard to a trader's goods may be an ordinary libel upon the

Statement may be a personal libel.

disparaged his competitor's goods are better either generally or in this or that particular respect than his competitor's are." His lordship put aside the question of malice. The other learned lords concurred in this view. See also *Magnolia Metal Co.* v. *Tandem Smelting Syndicate*, 17 R. P. C. 477 (1900), H. of L.

(*p*) *White* v. *Mellin*, *supra*, approving *Evans* v. *Harlow*, 5 Q. B. 624 (1844); *British Empire Type Co.* v. *Linotype Co.*, 79 L. T. 8 (1898), C. A. *Royal Baking Powder Co.* v. *Wright, Crossley & Co.*, 18 R. P. C. 95 (1901), H. of L. The contrary had formerly been held: see cases cited in *White* v. *Mellin* and *Hayward* v. *Hayward*, *infra*.

(*q*) *Ratcliffe* v. *Evans*, (1892) 2 Q. B. 524, C. A.

(*r*) *Dicks* v. *Brooks*, 15 C. D. 22 (1879), C. A. There the defendants, who owned the copyright in an engraving of Millais' "Huguenots," had threatened proceedings against persons who bought copies of the plaintiff's paper containing a woolwork pattern, wrongly alleged to be an infringement of the copyright. Only two or three numbers were shown to have been returned or not sold in consequence of the threats.

(*s*) Per Lord Robertson, in *Royal Baking Powder Co.'s Case*, note (*p*).

(*t*) *Hayward & Co.* v. *Hayward & Sons*, 34 C. D. 198 (1886).

trader personally and, accordingly, be actionable without proof of special damage. Such, for instance, would be the case if the goods were described as worthless (*t*) or spurious (*u*). To write of a trader that he sells such goods is clearly defamatory.

A threat or warning may be made, if *bonâ fide*.

It is essential, in order to entitle the plaintiff to redress in respect of the publication of a threat or warning, that he should make out that the statements complained of are not published in good faith. He must show that the defendant was not saying what he did in defence of his own right, or, as he believed, in defence of his own right—for the defendant might make a mistake (*x*). Upon an application, therefore, for an interim injunction to restrain the publication of threats by the defendant, it is not sufficient proof, if it is any evidence at all, of want of good faith, to show that he has commenced an action for infringement of trade-mark, or for passing off goods against the plaintiff, but has neglected to apply in it for an interlocutory injunction (*y*); nor to show even a long delay in bringing an action for infringement, if the delay is reasonably explained (*z*).

Misleading report of a trade-mark action.

The publication of a misleading report of a trade-mark action, or of an order obtained by the successful party therein either at the trial or on an interlocutory application, may be a trade-libel falling within the principles of the cases referred to in this chapter. Thus, where an action for passing off had failed and been dismissed without costs, because the evidence showed only a few instances of representations that the defendant's goods were those of the plaintiffs, and also that

(*t*) *British Empire Type Co.* v. *Linotype Co.*, 79 L. T. 8 (1898). The defendants published a statement that the plaintiffs' machines had been removed, after a very short trial, from several newspaper offices. The plaintiffs got a verdict at the trial, and the C. A. refused a new trial on the ground stated in the text.

(*u*) See *The Liebig Case*, above, p. 530.

(*x*) Per Lindley, M. R., in *Royal Baking Powder Co.* v. *Wright, Crossley & Co.*, 16 R. P. C. 217, (1899) C. A. In the House of Lords the decision was unanimously affirmed, the majority of the learned lords holding that special damage was not proved, 18 R. P. C. 95.

(*y*) *Anderson* v. *Liebig's Extract of Meat Co.*, 45 L. T. N.S. 757 (1881), Chitty, J.; and note (*s*).

(*z*) *Incandescent Gas Light Co.* v. *Sunlight Incandescent Co.*, 14 R. P. C. 180 (1897), Stirling, J.

these representations were made by the defendant's agents without his knowledge or authority, the defendant offered an undertaking that he would never make such representations, and this undertaking was inserted in the order at the desire of the judge. The plaintiffs then published a circular headed "Caution," which, referring to the action, alleged that:—

"By the judgment the defendant was ordered to undertake not to represent that his firm is, or that the plaintiff's firm is not, the original firm of Richard Hayward & Co.," and added that the plaintiffs, "finding that serious misrepresentations were in circulation to their prejudice, felt themselves compelled to bring the above action." In a subsequent action (*a*), brought by the former defendants against the former plaintiffs, the circular was held to be untrue and libellous, and to have been published maliciously, and an injunction was granted to restrain its further publication.

True statements are not libellous.

So far as the case against an advertisement or other publication rests upon its being a libel, proof that the statements complained of in it are, in fact, true, is an answer to any action for damages, or an injunction in respect of its publication (*b*). It makes no difference that ignorant readers might misunderstand it (*c*).

Accordingly, an action for publishing a statement that certain persons, meaning the plaintiff company, had wrongfully used the word *Singer* to designate machines not manufactured by the *Singer* company, which came on for trial after the *Singer* company had established, in a passing off action against the plaintiff company, that the use of the word by the latter was actually wrongful, was dismissed with costs (*b*).

Evidence to construe the libel.

The meaning of the statements complained of is determined by the Court itself, and unless circumstances are proved tending to show that their actual meaning, in the particular

(*a*) *Hayward & Co.* v. *Hayward & Sons*, 34 C. D. 198 (1886), North, J.; *Liebig's, &c. Co.* v. *Anderson*, 55 L. T. 206 (1887), Chitty, J.

(*b*) *Nähmaschinen Fabrik, &c.* v. *Singer Manufacturing Co.*, 10 R. P. C. 310 (1893), Romer, J.; and the *Baking Powder Case*, note (*x*).

(*c*) *Incandescent Gas Light Co.* v. *Sunlight Incandescent Co.*, 14 R. P. C. 180 (1897), Stirling, J.

case, is different from the natural meaning, evidence cannot be adduced to prove that they were not understood according to it (*d*).

Solicitor.

A solicitor who has made the publication merely as agent for the real defendants should not be joined as a defendant (*e*).

Publication of an apology.

So the publication of an apology actually made by the plaintiffs to the defendants is justifiable, though it may have been extracted from the plaintiffs under duress of civil or criminal proceedings in respect of the false marking of their goods (*f*).

But a statement pending proceedings, whether true or not, may be a contempt of Court.

But the publication of a statement which turns out to be true may be improper pending legal proceedings in which the matters it refers to are in issue, not as being libellous, but as contempt of Court, if it tends to interfere with the fair trial of the action, or to embarrass one of the parties in the preparation or conduct of his case. And such contempt may be punished by imprisonment (*g*), fine, or sequestration of goods, or the publication may be restrained by injunction, upon a summary application by motion in the action (*h*). The reluctance of the Court to interfere by interlocutory injunction to restrain the further publication of an alleged libel which the defendant justifies, does not extend to such cases as these. As already stated, the parties are at liberty to warn the trade as much as they like, notwithstanding the pendency of the action; but they are bound to refrain during its pendency from public discussion on the merits or demerits of the case (*i*). "You can warn as much as you like," Kay, J., said, in *Goulard* v. *Lindsay* (*h*), "but can you advertise: 'I have brought an action against A. B. which is certain to succeed'?" And the

(*d*) Note (*x*), above.

(*e*) Note (*c*), above.

(*f*) *Fisher* v. *Apollinaris Co.*, L. R. 10 Ch. 297 (1875), L. JJ.

(*g*) *Roach* v. *Hall*, 2 Atk. 469 (1742), Hardwicke, L. C. The respondents were imprisoned for publishing statements calling some of the witnesses "affidavit men." *Kitcat* v. *Sharp*, 31 W. R. 227 (1883), Fry, J. (defendant restrained from publishing the statement of claim and correspondence).

(*h*) *Coats* v. *Chadwick*, (1894) 1 Ch. 347, Chitty, J. The plaintiffs, in an action for passing off, were restrained from publishing a circular charging the defendants with fraudulent imitation of their goods. *Goulard* v. *Lindsay*, 4 R. P. C. 189 (1887), Kay, J. (a patent case).

(*i*) Per Chitty, J., (1894) 1 Ch. 350.

learned judge added that to advertise a positive statement that the defendants had infringed the plaintiff's patent was wrong.

Statement in reply to one published by the other side.

It is no answer to an application for an injunction in respect of a publication alleged to be a contempt of Court, to say that it was made in reply to a statement published by the applicant himself with reference to the same matter, although this circumstance may influence the Court in dealing with the costs of the application (*k*).

But every publication bearing upon the matters in question *pendente lite* is not a contempt. A fair and accurate report of interlocutory proceedings, for instance, is allowable (*l*). And the Court may refuse to restrain a report which it thinks unfair or discreditable to the persons responsible for it, if not convinced that the report is calculated to obstruct the course of justice, or to prejudice the public mind (*m*).

Undertaking as to damages.

Where the publication of a statement *pendente lite* is restrained as being a contempt of Court, the applicant is not required to give an undertaking to be answerable in damages to the respondent for any loss occasioned by the injunction if it turns out that the respondent was in the right (*n*), as is usual upon the grant of an interlocutory injunction, for the publication is wrong in any event, whether the statements are found in the end to be false or to be well-founded.

Contempts by newspaper editors.

The rule under which the publication of biassed comments reflecting on matters in issue in pending litigation and calculated to interfere with the fair trial of the action, is restrained, is of general application, and it is not confined to publications made by, or at the instance of, interested parties.

(*k*) *Coleman* v. *West Hartlepool Ry. Co.*, 8 W. R. 734 (1860), Wood, V.-C.

(*l*) A newspaper report published contemporaneously, if otherwise libellous, would be privileged under the Law of Libel Amendment Act, 1888.

(*m*) *Brook* v. *Evans*, 29 L. J. Ch. 616 (1860), Stuart, V.-C., and L. JJ. The plaintiffs advertised that they had established that they first used the word *Glacé*, but that the defendants relied on the lapse of time as an answer to the motion, although the plaintiffs had constantly protested against the defendants' use of the word. The defendants, in fact, had not been called upon on the motion.

(*n*) *Fenner* v. *Wilson*, (1893) 2 Ch. 656, Kekewich, J.

Applications under it to commit the editors of newspapers were very frequent a few years ago, and, in spite of the constantly expressed reluctance of the judges to interfere where it is not necessary to protect the fair prosecution of the action (*o*), the applications generally result in the costs incurred, or part of them (*p*), and sometimes a substantial fine (*q*), being thrown upon the respondents if they have ventured at all beyond a mere accurate report, or a colourless account of the proceeding.

Injunction to restrain trade-libels.

Before the Judicature Act the Courts had no jurisdiction to restrain the publication of a libel, even though it affected the plaintiff's trade or property (*r*); but the jurisdiction is conferred by that Act upon all the divisions of the High Court, and it has been exercised in many cases (*s*).

Interlocutory injunction.

The Court has also jurisdiction to interfere by interlocutory injunction to restrain the further publication of an alleged trade-libel, which is the subject of an action, until the hearing (*t*). But it will only do so if it is satisfied, upon the facts and evidence before it, that the statements complained of are false (*u*), however much the balance of convenience

(*o*) In *Re Clements*, 46 L. J. Ch. 383 (1877), Jessel, M. R., said: "I say that a judge should be most careful to see that the cause cannot be fairly prosecuted to a hearing unless this extreme mode of dealing with persons brought before him on accusations of contempt should be adopted." In *The Plating Co.* v. *Farquharson*, 17 C. D. 49 (1881), the C. A. dismissed an application to commit the editor of a paper in respect of an advertisement asking for subscriptions and evidence to assist the appeal in a patent case. In *Re Martindale*, (1894), 3 Ch. 193, North, J., refused with costs motions to commit the editors of several papers who had innocently copied from another paper.

(*p*) See *Duncan* v. *Sparling*, The Times, 9th March, 1894.

(*q*) *Re The Crown Bank*, 44 C. D. 649 (1890) (a bad case of contempt).

(*r*) *Prudential Assurance Association* v. *Knott*, L. R. 10 Ch. 142 (1875), Cairns, L. C. and L. JJ.

(*s*) *Thorley's Cattle Food Co.* v. *Massam*, 6 C. D. 582 (1877), Malins, V.-C.; 14 C. D. 763 (1880), Malins, V.-C., and C. A.; *Thomas* v. *Williams*, 14 C. D. 864 (1880), Fry, J.; *Saxby* v. *Easterbrook*, 3 C. P. D. 339 (1878), Div. Court, and the cases cited below.

(*t*) *Lee* v. *Gibbings*, 67 L. T. 263 (1892), Kekewich, J., and the cases next cited.

(*u*) *Collard* v. *Marshall*, (1892) 1 Ch. 571, Chitty, J. The libel was that the plaintiffs were "sweaters," and that their work was not properly executed. The defendants said the statements were, in substance, true, but did not suggest that they had any further evidence not before the Court. They were willing to treat the motion as the trial. An interim

may be in favour of staying the publication (*x*), and only in the clearest cases (*y*)—where, as it has been put, the plaintiff's case is so strong that if the jury at the trial found for the defendant, their verdict would be set aside as unreasonable (*z*).

For the question, libel or no libel, is peculiarly a question for a jury; and in order to interfere before the hearing the Court must determine that question in advance, without the jury's assistance (*z*). The reluctance to interfere by interlocutory injunction is so strong, that the cases cited of *Bonnard* v. *Perryman* (*a*), and *Monson* v. *Tussaud* (*b*), seem to show that, where the defendant alleges justification, and reserves the particulars of his case and the evidence in support of it, the injunction ought never to be granted. In any case, the probability of very serious injury to the plaintiff if the libellous statements are allowed to continue must be made out (*c*).

Action survives to executors.

An action in respect of a trade-mark for slander of title, unlike a mere personal libel, survives to the executors since it occasions an injury to the estate of the testator (*d*).

injunction was granted. *Punch* v. *Boyd*, 16 L. R. Ir. 476 (1885).

(*x*) *Société des Manufactures des Glaces* v. *Tilghman's Patent Sand Blast Co.*, 25 C. D. 1 (1883), C. A.

(*y*) *Monson* v. *Tussaud*, (1894) 1 Q. B. D. 671, C. A., per Davey, L. J. (case of a personal libel).

(*z*) Per Lord Esher, M. R., in *Coulson* v. *Coulson*, 3 Times L. R. 846, adopted in *Bonnard* v. *Perryman*, (1891) 2 Ch. 269, C. A.; *Lee* v. *Gibbings*, *supra*.

(*a*) See note (*z*).

(*b*) Note (*y*). These were not, however, trade libels, but the rule was applied in *Champion & Co.* v. *The Birmingham Vinegar Brewery Co.*, 10 Times L. R. 163 (1893), Div. Court, which was a trade case.

(*c*) *Salomons* v. *Knight*, (1891) 2 Ch. 294, North, J., and C. A.; *Mogul Steamship Co.* v. *McGregor*, *Gow & Co.*, 15 Q. B. D. 476 (1885), Coleridge, L. C. J., and Fry, L. J.

(*d*) *Hatchard* v. *Mège*, 18 Q. B. D. 771 (1887), Div. Court.

CHAPTER XIX.

TRADE-SECRET AND TRADE-NAME.

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Use of the trade-name of a secret preparation.

It has been shown that anyone is entitled to use a name or mark for the goods to which that name or mark is properly applied (*a*). Thus, anyone who is in possession of goods made or sold by the owner of a trade-mark or trade-name, may apply the trade-name or trade-mark to them (*b*), and may, for instance, replace the old labels upon the goods by new ones (*c*). So, the name of a secret preparation may be used by anyone for goods actually prepared according to the recipe (*d*), for they are the goods indicated by the name, whether prepared by the original inventor of the recipe, or his successors in business, or not. Until the secret is discovered or betrayed the goods of the original inventor or his successors can be the only goods to which the

(*a*) See Chap. II., p. 32, and Chap. XV., p. 368.

(*b*) *Condy* v. *Taylor*, 56 L. T. 891 (1887), Kekewich, J.

(*c*) *Farina* v. *Silverlock*, 6 De G. M. & G. 214; 26 L. J. Ch. 11 (1856), Cranworth, L. C., cited, p. 32.

(*d*) *Canham* v. *Jones*, 2 V. & B. 218; 13 R. R. 70 (1813), Plumer, V.-C. (*Velno's Vegetable Syrup*). The case was decided on demurrer, although the bill alleged facts which would now be held sufficient to support a passing-off case like that of *The Yorkshire Relish*, note (*e*). *James* v. *James*, L. R. 13 Eq. 421 (1872), Romilly, M. R. (*Lieutenant James' Horse Blister*); *Condy* v. *Mitchell*, 37 L. T. N.S. 268, 766 (1877), Bacon, V.-C., and C. A. (*Condy's Fluid*); and see the injunction in *Siegert* v. *Findlater*, 7 C. D. 801 (1878), Fry, J., cited p. 368 (*Angostura Bitters*). In *Benboic* v. *Low*, 44 L. T. N.S. 875 (1881),

name is applicable, or which are denoted by it (*e*); but when other people can make them, the difficult question of fact, discussed in previous chapters of this book (*f*) arises, whether the name is merely that of the goods themselves, or that of goods of the kind prepared or sold by the original inventor or his successors in business. This was clearly put by Fry, J., in the *Angostura Bitters Case* (*g*). "I cannot say," the learned judge said, "that Meinhard (*h*) may not, if he can, make a bitter identical with the plaintiffs', and, if he does, I cannot prevent him from selling it as *Angostura Bitters*. It is to be observed that the person who produces a new article, and is the sole (*i*) maker of it, has the greatest difficulty (if it is not an impossibility) in claiming the name of that article as his own, because, until somebody else produces the same article, there is nothing to distinguish it from. No distinction can arise from using the name of the class so long as the class consists of only one species, for then the name of the species and the name of the class will be the same."

The use of the name or secret may be a breach of contract or of confidence.

But, as regards any particular person, the use of a mark or name which is open to the world at large may be restrained by reason of a contract which he has entered into, or of circumstances which make it contrary to conscience for him to avail himself of the general right. Putting aside cases of express

Bacon, V.-C., held that an outgoing partner who retained the receipt could use the name of a secret preparation. The question whether the defendant could have used the name in *The Yorkshire Relish Case* (next note), if he had discovered the secret, was left open by the H. L. Lord Davey (1897, A. C. at p. 717; 14 R. P. C. at p. 732) said he saw no reason to differ from the opinion of Fry, J., in *The Angostura Bitters Case*, and of Lindley, L. J., in the case in question, that he could have done so.

(*e*) Thus, in *Birmingham Vinegar Brewery Co.* v. *Powell*, (1897) A. C. 710; 14 R. P. C. 720, the defendants were restrained from describing their sauce as *Yorkshire Relish* without clearly distinguishing it from the plaintiff's sauce. They had not succeeded in discovering the recipe, but only in making a wonderful match. See above, p. 459.

(*f*) Above, pp. 36 *et seq.*, and p. 476.

(*g*) *Siegert* v. *Findlater*, 7 C. D. 801, at p. 813.

(*h*) The maker of the defendant's bitters.

(*i*) On the principle of *Dent* v. *Turpin* (above, p. 360), if there were two or three makers only, each of them might claim to restrain an outsider from using the name. See observations of Lord Watson during the argument in the *Yorkshire Relish Case*, 14 R. P. C. at p. 726.

contract,—as where, for instance, a partner or servant has covenanted not to use the firm name, or any particular name or marks, or not to engage in any particular business, after the determination of the partnership or employment,—the most important cases of this kind are cases of trade-secrets. The law relating to trade-secrets does not properly fall within the scope of this book, but as it touches upon the limitation of trade-mark and trade-name rights referred to above, it is convenient to shortly refer to the leading cases on the subject.

Wherever secret information has been obtained und circumstances which import a contract not to disclose or make use of it, or by breach of confidence, or under other circumstances which make the disclosure, or the use of the information, contrary to conscience, the Court will restrain the person who has obtained it, or anyone to whom it has been communicated by him, from using or disclosing it (*k*).

Information obtained by breach of contract or of confidence.

Thus, in *Prince Albert* v. *Strange* (*l*), the publication of a catalogue of a number of etchings made by the late Queen and Prince Albert for their private use and amusement, and never published or authorized to be published by them, and the exhibition of the etchings, was restrained, the copies of the etchings which had passed into the defendant's possession having been obtained surreptitiously and in breach of confidence from or through a printer employed to print them. And in *Morison* v. *Moat* (*m*) the defendant, who had obtained the secret of manufacturing *Morison's Universal Medicine* from his father, was restrained from using it. Both the defendant and his father had formerly been in partnership with the

(*k*) For a case in which the Court enforced the trusts of a settlement of a trade secret, see *Green* v. *Folgham*, 1 S. & S. 398; 1 L. J. o.s. Ch. 203 (1822).

(*l*) 2 De G. & Sm. 652; 1 Mac. & G. 25; 18 L. J. Ch. 120 (1849), Knight-Bruce, V.-C., and Cottenham, L. C.

(*m*) 9 Hare, 241; 20 L. J. Ch. 513; 21 *ibid.* 248 (1851), Turner, V.-C., and Knight-Bruce and Lord Cranworth, L. JJ., App., p. 648. The case of *Canham* v. *Jones*, 2 Ves. & B. 219; 13 R. R. 70, was distinguished by Turner, V.-C., on the ground that it was not put forward as one of breach of confidence or contract; but the report shows that the bill stated the employment of the defendant, and that the plaintiff's counsel, on the demurrer, to some extent rested their case on breach of confidence. The case would now be differently decided on the alleged facts.

plaintiff, but the father of the defendant, to whom alone the original inventor had disclosed the secret, had entered into a bond not to divulge it to any other person. The injunction restrained the defendant, his agents, &c., from selling, under the title of *Morison's Universal Medicine*, any medicine made by him or under his directions, and also from making any medicines according to the secret, or in any manner using the secret of compounding the medicines, or any part thereof.

Information obtained by a clerk;

Injunctions have been granted on the same principles to restrain the use or publication of secret information obtained by a clerk or servant in the course of his employment (*n*)—and it is said that "every clerk employed in a merchant's counting-house is under an implied contract that he will not make public that which he learns in the execution of his duty as a clerk" (*o*)—of a list of the names and addresses of the plaintiff's customers copied by the defendant from his books when employed as his manager (*p*); of a table of details of the dimensions of machinery designed by, or for the plaintiffs, collected from their plans by one of their draftsmen, although the details could all have been gathered from the machines made according to the designs and sold, if access could have been obtained to them (*q*); of materials for the construction of a book of advertisements collected by the plaintiff's advertising canvassers (*r*); of lectures delivered to a class of students, and not published or authorized to be published by the lecturer (*s*); of private letters written by the plaintiff, or by a person whose estate the plaintiff repre-

table of dimensions by engineer's draftsman;

book of advertisements by canvasser;

lectures;

private letters;

(*n*) *Vouatt* v. *Winyard*, 1 Jac. & W. 394 (1820), Eldon, L. C.

(*o*) Per Wigram, V.-C., in *Tipping* v. *Clarke*, 2 Hare, 383 (1842); and per North, J., in *Pollard* v. *Photographic Co.*, 40 C. D. 345 (1888). See next case.

(*p*) *Robb* v. *Green*, (1895) 2 Q. B. 1, 315, Hawkins, J., and C. A.; damages for breach of the implied contract to observe good faith were also recovered.

(*q*) *Merryweather* v. *Moore*, (1892) 2 Ch. 518, Kekewich, J. The defendant had been apprenticed to the plaintiffs, and had remained in their employment after his articles expired; cf. *Reuter's Telegram Co.* v. *Byron*, cited below, p. 543.

(*r*) *Lamb* v. *Evans*, (1892) 3 Ch. 462; (1893) 1 Ch. 218, Chitty, J., and C. A.

(*s*) *Abernethy* v. *Hutchinson*, 3 L. J. Ch. o.s. 214 (1824), Eldon, L. C.; *Caird* v. *Sime*, 12 App. Cas. 326 (1887).

copies of pictures by lithographer;

sents (*t*); of copies of the plaintiffs' pictures, delivered to the defendants for the making of copies, in excess of the number made for and delivered to the plaintiffs (*u*); and of prints from a photographic negative likeness of the plaintiff, which the defendants had been employed by the plaintiff to take (*x*).

photographs of the plaintiff.

The jurisdiction rests on implied contract.

"Different grounds have been assigned for the exercise of the jurisdiction. In some cases it has been referred to property, in others to contract, and in others, again, it has been treated as founded upon trust or confidence, meaning, as I conceive, that the Court fastens the obligation on the conscience of the party, and enforces it against him in the same manner as it enforces, against a party to whom a benefit is given, the obligation of performing a promise, on the faith of which the benefit has been conferred" (*y*). But it is submitted that the true ground is always implied contract (*z*), for if information, which both parties understand the present possessor intends to be kept, and to remain secret, is communicated by him to another, or the means of obtaining it are placed by him within the reach of another, for particular purposes, for instance, in the course of an employment, an undertaking not to use or disclose the information ought almost necessarily to be inferred.

As already stated, the jurisdiction extends to enable the Court to restrain a third party from using secret information which has been, to his knowledge, obtained or communicated in breach of faith (*a*) or contract. On similar grounds the right of a person, who has collected information and supplied it for the sole use of his customers, to restrain them from disclosing it to others (*b*), and to restrain others from surrepti-

(*t*) *Perceval* v. *Phipps*, 2 Ves. & B. 19 (1813), Plumer, V.-C.; *Earl of Lytton* v. *Devey*, 54 L. J. Ch. 293 (1884), Bacon, V.-C.

(*u*) *Tuck and Sons* v. *Priester*, 19 Q. B. D. 629 (1887), C. A.

(*x*) *Pollard* v. *Photographic Co.*, note (*o*).

(*y*) Per Turner, V.-C., in *Morison* v. *Moat*, 20 L. J. Ch. p. 522. So, per Kekowich, J., in *Merryweather* v. *Moore*, (1892) 2 Ch. p. 522.

(*z*) *Merryweather* v. *Moore*, *supra*; *Reuter's Telegram Co.* v. *Byron*, 43 L. J. Ch. 661 (1874), Jessel, M. R.; *Robb* v. *Green*, above, note (*p*), was decided on the ground that there is an implied contract to keep good faith on the part of a servant.

(*a*) Page 540, notes (*l*) and (*m*).

(*b*) *Exchange Telegraph Co.* v. *Gregory*. (1896) 1 Q. B. 147. C. A.

tiously obtaining it from the subscribers, has been protected (*c*).

Use of agent's information where no breach of contract or confidence.

The mere fact that the defendant obtained information as and while he was the agent of the plaintiff, is not a sufficient ground for restraining him from using it, provided there is nothing of a secret character in the information itself, or confidential or surreptitious in the manner in which it was communicated or obtained, so that a contract not to communicate or use it can be implied. "The plaintiffs here do not seek to restrain the defendant from publishing anything," Jessel, M. R., said, in *Reuter's Telegram Co.* v. *Byron* (*d*), "but from making use of knowledge acquired while the relation of principal and agent subsisted, after that relation had terminated. Now I am not aware of any authority in which this has been done in the absence of a contract, expressed or implied." And he added, "the jurisdiction of the Court cannot be stretched on an interlocutory application. I do not mean to say it cannot be done at all." The circumstances of the case just cited were, that the plaintiffs had invented a large number of telegraphic cyphers indicating the names of their customers, which were communicated to the defendant while he was the plaintiffs' agent, and after he had left their employment, and started a rival business, he sent circulars to the customers, stating that he had their cyphers, and soliciting their custom. It was said that the defendant had committed no breach of confidence with regard to the cyphers, because these were known to the customers, and could have been obtained by the defendant from such of them as chose to do business through him. It may be doubted whether the importance of having access to the large number of cyphers invented or collected by the plaintiffs was fully appreciated in this case, and whether the decision is consistent with the reasoning accepted in the later cases of *Lamb* v. *Evans*, and *Merryweather* v. *Moore*, cited above (*e*). It was, however, as appears from the judgment of the learned Master of the Rolls, a decision on an interlocutory application only.

Reuter's Co. v. *Byron.*

(*c*) *Exchange Telegraph Co.* v. *Central News*, (1897) 2 Ch. 48, Stirling, J.
(*d*) See note (*z*), *ante*, p. 542.
(*e*) Page 541.

The principle stated in the judgment, and quoted above, is undoubtedly sound, whatever may be thought of its application to the facts of the case.

No injunction unless there is danger of the secret being communicated.

Following the ordinary rule in regard to injunctions, no injunction to restrain the communication of a secret will be granted unless by reason of a threat or otherwise the Court is satisfied that there is a danger of the communication being made (*e*).

(*e*) *Morison* v. *Moat*, 20 L. J. Ch. p. 529.

CHAPTER XX.

REGISTRATION OF FOREIGN AND COLONIAL TRADE-MARKS.

BEFORE the introduction of the Register of trade-marks a foreigner, not being an alien enemy, was allowed to sue for the infringement of his trade-mark in the English Courts (*a*), provided that the trade-mark had become his trade-mark in England by user, or to prevent or obtain damages for the passing off the goods of others as his goods, in the same way and on the same terms as an English subject. And many treaties existed by which this country agreed to give to the subjects of other countries the same right of protection, in respect of their trade-marks, as it gave to its own subjects (*b*). The prohibition contained in sect. 77 of the present Act, and the corresponding section of the Act of 1875, restraining actions in respect of the infringement of unregistered trade-marks (*c*), however, apply to the trade-marks of foreigners (*d*), and therefore actions for infringement could not, since 1875 (in general (*c*)), be brought by a foreigner without his trade-mark being registered in England; actions for passing off, to which the prohibitory sections of the former or the present Acts do not apply, remaining as before.

A foreigner, or any resident in a British possession, may apply for and obtain registration under sect. 62; but if he does not apply under the convention mentioned below, and is out of the United Kingdom at the time of making the

(*a*) *The Collins Co.* v. *Reeves*, 28 L. J. Ch. 56 (1858), Stuart, V.-C.

(*b*) See a paper presented to Parliament, 1872, C. 633. For later instances of similar treaties, see the Convention between Great Britain and Guatemala, July 20, 1898 (1899, C. 9504), which withdrew from the International Convention during 1895, and the Convention between Great Britain and Luxemburg, Jan. 25, 1900 (1900, C. 31).

(*c*) For the precise effect of the section, see its terms, and Chap. XII., pp. 312, 320.

(*d*) *Goodfellow* v. *Prince*, 35 C. D. 9 (1887), C. A.: see above, pp. 316, 323.

application, he must give an address for service in the United Kingdom (*e*); and under sects. 103 and 104 of the Act, further provisions are made in his favour if he is a subject of a state in respect of which, or a British subject resident in a British possession to which, these sections have been, by Order in Council, declared to be applicable.

The sections referred to, so far as they relate to trade-marks (*f*), provide that—

International arrangements for protection of inventions, designs, and trade-marks.

"103. (1.) If her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states for mutual protection of trade-marks, then any person who has applied for protection for any trade-mark in any such state, shall be entitled to registration of his trade-mark under this Act, in priority to other applicants; and such registration shall have the same date as the date of *the protection obtained* [the application (*g*)] in such foreign state.

"Provided that his application is made, in the case of a trade-mark, within four months from his applying for protection in the foreign state with which the arrangement is in force.

"Provided that nothing in this section contained shall entitle the proprietor of the trade-mark to recover damages for infringements happening prior to the date of the actual registration of his trade-mark in this country (*h*).

"(2.) The use in the United Kingdom, or the Isle of Man, during such period of the trade-mark, shall not invalidate the registration of the trade-mark.

"(3.) The application for the registration of a trade-mark under this section must be made in the same manner as an ordinary application under this Act (*i*). Provided that, in the case of trade-marks, any trade-mark the registration of which has been duly applied for

(*e*) Act of 1888, s. 8 (62 (6)), *ante*, p. 65.

(*f*) The words referring only to patents or designs are here omitted; the full text is printed in the Appendix, p. 669.

(*g*) Act of 1888, s. 6.

(*h*) The ordinary rule is, that where trade-mark rights exist, damages for infringements before the registration may be recovered: *Barlow* v. *Johnson*, 7 R. P. C., p. 411 (1890), Chitty, J., *ante*, p. 316. Cf. with this sub-section the International Copyright Act. See *Mould* v. *Groenings*, (1891) 2 Q. B. 443; and *Schauer* v. *Field*, (1893) 1 Ch. 35.

(*i*) Sect. 62, Chap. IV., p. 75.

in the country of origin may be registered under this Act (*k*).

"(4.) The provisions of this section shall apply only in the case of those foreign states with respect to which her Majesty shall from time to time by Order in Council declare them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state (*l*).

Provision for colonies and India.

"104. (1.) Where it is made to appear to her Majesty that the legislature of any British possession has made satisfactory provision for the protection of (inventions, designs, and) trade-marks, (patented or (*m*)) registered in this country, it shall be lawful for her Majesty from time to time, by Order in Council, to apply the provisions of the last preceding section, with such variations or additions, if any, as to her Majesty in Council may seem fit to such British possession.

"(2.) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if its provisions had been contained in this Act; but it shall be lawful for her Majesty in Council to revoke any Order in Council made under this Act" (*l*).

The International Convention.

At the time when these sections were passed into law, the International Convention for the Protection of Industrial Property, as it was originally settled at Paris, had been drawn up and agreed to by several of the countries which are parties to it, and in the following year (*n*) this country acceded to the Convention. Practically all civilized States, except Germany, Austria, Russia and Norway, have now acceded to the original Convention.

International registration of trade-marks.

At a subsequent conference at Madrid, in 1891, besides an agreement to endow the International Bureau at Berne, two Conventions were signed by most of the States of the Union. Of these one, which was signed by Great Britain (*o*), related to false indications of origin; the other, signed by Belgium, Brazil, France, Italy, the Netherlands, Portugal, Spain,

(*k*) See p. 553.

(*l*) For list of States and Possessions to which the sections apply, see Appendix, p. 762.

(*m*) The brackets are not part of the Act: see note (*f*), above.

(*n*) 20th March, 1883.

(*o*) See *post*, p. 771.

Switzerland, and Tunis, but not by Great Britain, established a system for the international registration of trade-marks (*p*). The principles of this system are admirably explained by M. Frey-Godet, Secretary to the International Bureau at Berne, in a paper read by him before the London Congress of the International Association for the Protection of Industrial Property, in 1898 (*q*). "The proprietor of the trade-mark makes an application for international registration to the Government of his native country, which then forwards his request to the International Office at Berne. The latter registers the trade-mark, and notifies this registration to all the States which have become parties to the Arrangement of Madrid, and afterwards publishes a description of the trade-mark, with all the data in connection with it, in a publication entitled *Les Marques Internationales*, which forms an appendix to *La Propriété Industrielle*, the official organ of the Office.

"The registration of the trade-mark at the International Office produces absolutely the same effect as if the trade-mark had been registered on the same day in all the contract States. . . . The trade-marks judged inadmissible must be refused at latest during the year following the notification by which the Berne Office has made known the registration of the trade-mark to the contract States. When a State refuses legal protection to a trade-mark registered internationally, the proprietor enjoys the same means of appeal as if he had made the application to the national registration department of the State concerned.

"The effect of international registration lasts for twenty years; but it can only be invoked so long as the trade-mark remains protected in the country of origin. Nevertheless, if a trade-mark has been temporarily deprived of protection in that country owing to delay in renewing the application, it is sufficient to make a fresh application in order again to set in operation the international protection which had remained in abeyance. This is, then, only an expansion of the protection which the trade-mark enjoys in the country of origin. Con-

(*p*) The text of this arrangement will be found in the Appendix, p. 773.

(*q*) Trans. Inter. Assoc. for the Protection of Ind. Prop., Vol. II. (1898), p. 102.

sequently every modification relating to the property of an international trade-mark (annulment, erasure, renunciation, transfer, &c.) must be notified by the national Government to the International Office, which makes a memorandum of this and forwards the information to the various contract States.

"Whoever wishes to effect the international registration of a trade-mark must pay a fee of 100 francs, which goes to the International Office, and a national fee, which goes to the country of origin. Each country fixes at its pleasure the amount of this fee, which is supposed to be an equivalent for the labour furnished by the Government of the country on the occasion of the international registration of the trade-mark to which it refers. France, for instance, imposes a fee of 25 francs; Switzerland a fee of 5 francs only, whilst Belgium exacts none at all.

"The international and national fees together are always inferior in amount to the total of national fees which it would be necessary to discharge in the different contract countries in order to obtain in each of them the national registration of the trade-mark (165 francs). But the amount of the official fee is insignificant in comparison with the expenses which would be entailed by translations, authentications, agent's fees, &c., if the application for registration of a trade-mark were contemplated in each of the States adhering to the arrangement."

Obstacles to Great Britain's accession.

The objection of Great Britain to accede to this arrangement is based on several grounds with which M. Frey-Godet deals in succession. It does not appear that the point has ever been taken on behalf of this country that international registration, by diminishing the number of national applications for registration of foreign trade-marks, would at the same time reduce the registration fees collected by the British Government. But if such an argument were advanced, M. Frey-Godet's answer is twofold. In the first place, Great Britain would not grudge the expenditure of a few thousand francs in order to be assured of a valuable advantage to her commerce. In the second place, it is by no means certain that the fee collected by Great Britain on international applications effected by British subjects, added

to that derived from the surplus receipts of the service of registration, would not make up for the diminution in the number of ordinary registrations. A second objection, and one which has greater weight, may be put in this way: British trade-mark law is based on a registration effected by a national government. To a system of this kind it is impossible to assimilate one of registration carried out in a foreign country. M. Frey-Godet's answer is that our internal legislation by which copyright is only granted to literary works if they have been entered at Stationers' Hall, does not apply to works produced in the countries forming part of the Literary and Artistic Union. It may be noted in passing, that Article V. of the Madrid Arrangement preserves the right of the contracting states to reject any trade-mark presented for registration under the international scheme to which it could object if an application were made for its registration in the ordinary course. The Patent Office would, therefore, be free to examine trade-marks for which international registration was desired, and to reject those which were inadmissible on the ground of internal legislation. Our internal legislation, however, gives rise to several difficulties of its own. Sect. 64, sub-sect. (2) of the Act of 1883 requires an applicant in his application for registration to indicate the essential elements of his trade-mark, and to disclaim what is non-essential. Again, sect. 65 of the Act of 1883 provides that "a trade-mark must be registered for particular goods or classes of goods"; and in this country trade-marks must be published in the official journal of the Patent Office. How are these provisions to be severally adjusted to the system of international registration? As regards disclaimers, M. Frey-Godet's suggestion is that the applicant might be required expressly to disclaim the non-essential parts of his trade-mark before embarking on a law-suit. A similar procedure is, no doubt, in force in this country in regard to patents. But this solution of the problem does not deal with the inconvenience that would be caused to applicants for national (or even international) registration by the uncertainty as to what were the essential parts of marks already on the Register of Trade-Marks. The

difficulty as to publication might be met, as M. Frey-Godet points out, by the annexation to the national publication of a trade-mark either of the publication of the Berne Office, or, preferably, of an authenticated translation of it.

The International Convention.

The text of the International Convention of Paris to which, as already stated, this country is a party, and a list of the countries and British possessions to which the above sections have been made applicable by Orders in Council, are set out in the Appendix (*r*).

The convention and the accession thereto of this country may be referred to by the Court as a matter of history, in order to enable it to understand under what circumstances the sections of the Act were passed (*s*); but the terms of the convention cannot be employed as a guide to interpret the sections (*t*), for a treaty with a foreign State binds the subjects of the Crown only in so far as it has been embodied in legislation passed into law in the ordinary way (*u*).

Foreign trade-mark may be refused registration.

The provisions of the sections, in fact, do not carry out the international agreements constituted by the convention, for, by Art. VI. of the Convention, it is agreed that "every trade-mark duly registered in the country of origin shall be admitted for registration, and protected in the forms originally registered in all other countries of the Union" (*v*); and by clause 4 of the final protocol, it is explained that this article "is to be understood as meaning that no trade-mark shall be excluded from protection in any State of the Union, from the fact alone that it does not satisfy, in regard to the signs composing it, the conditions of the legislation of the State, provided that on this point it comply with the legislation of the country of origin, and that it had been properly registered in the said country of origin"; but it has, nevertheless, been decided that, in order to be qualified for registration, a mark tendered under these sections, just as any other mark which is sought to be registered, must fall within the descriptions

(*r*) Pages 762, 764.

(*s*) *Carter Medicine Co.'s Tm.*, (1892) 3 Ch. 472; 9 R. P. C. 401, North, J.

(*t*) *Californian Fig Syrup Co.'s Tm.*, 40 C. D. 620; 6 R. P. C. 126 (1888), Stirling, J.

(*u*) See last case, and *Walker* v. *Baird*, (1892) A. C. 491.

(*v*) *I.e.*, the union of the contracting states for the protection of industrial property.

of sect. 64. So that the words *Syrup of Figs* (*x*), and the words *Carter's Little Liver Pills* (*y*), were refused registration as trade-marks, although registration of them respectively had been duly applied for and actually obtained in the United States, one of the States to which sect. 103 has been applied.

The effect of the decisions just referred to is to reduce the operation of the Convention, in regard to trade-marks (*z*) in this country, to very narrow limits. As between applicants for the registration of new marks, or marks acquired as trade-marks since the application for protection in a foreign State within the Union, the applicant in the foreign State is to have priority, provided that he makes his application in this country within four months from the date of the foreign application on which he relies. And this priority is not affected by the success or failure of the foreign application.

Publication of foreign trade-mark.

The proviso that use of the trade-mark in this country during the period of four months shall not invalidate the registration, is surplusage, if it is directed to use by the applicant himself, as it seems intended to be, for the publication or use of a mark by the applicant before registration in no case prejudices a right to registration. The proviso might have some useful meaning and operation, if it were construed to prevent an opponent, who had first used the trade-mark in question in this country after the application in a foreign State by the applicant for registration, from relying on his use of the mark, or the title acquired by him in consequence of that use, as an objection to the registration of the applicant. But so long as the Convention is not embodied in legislation, as already stated, it can have no operation upon the right to registration at all. It might, however, it is submitted, properly affect the Comptroller's discretion.

(*x*) *Californian Fig Syrup Co.'s Tm.*, 40 C. D. 620; 6 R. P. C. 126 (1888), Stirling, J.

(*y*) *Carter Medicine Co.'s Tm.*, (1892) 3 Ch. 472; 9 R. P. C. 401, North, J.

(*z*) Another part of the convention, relating to false marking and false trade description and the seizure on importation of falsely marked goods, has been carried into effect by the Merchandise Marks Act, see p. 624, below.

The last clause of sub-sect. (3), providing that "any trade-mark the registration of which has been duly applied for in the country of origin may be registered under this Act," does not give an independent or new right of registration under the Act (*a*), and it seems to bear no other construction than that suggested on behalf of the Comptroller in *The Carter Medicine Co. Case* (*a*), namely, that "may be registered" is to be read as "may be the subject of application for registration," although this construction reduces it also to surplusage.

The application of the sections to any foreign State can, under no circumstances, afford any answer to a motion under sect. 90 to remove from the Register a mark which was originally registered without sufficient cause (*b*).

(*a*) *Californian Fig Syrup Co.'s Tm.*, and *Carter Medicine Co.'s Tm.*, *supra*. In *Vidal's Patent*, 15 R. P. C. 721 (1898), Sir R. Webster, A.-G., said:—"I am clearly of opinion that, when a person claims under those articles, he cannot claim greater privileges than a national applicant, and that he is liable to the same restrictions as a subject or citizen of the country in which he is making the application."

(*b*) *Vignier's Tm.*, 6 R. P. C. 490 (1889), Kay, J. (*Monobrut Champagne*).

Book II.

THE CRIMINAL LAW OF FALSE MARKING.

CHAPTER I.

THE MERCHANDISE MARKS ACT, 1887.

(50 & 51 Vict. c. 28.)

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A SHORT introductory account of the Merchandise Marks Act, 1887 (*a*), and of the Act of 1862, which it repealed and replaced, will be found in Chap. I. of Book I. (p. 16), and the nature of the contents and subject-matter of the Act can be readily gathered from the table placed at the head of this chapter, and sects. 2, 3, 4, 5, 6 of the Act which are set out below. The table of sections given in the Queen's

(*a*) This Act is quoted throughout this and the following chapter as "M. M. A. 1887," and the Merchandise Marks Act, 1891, as "M. M. A. 1891." The Report of the Select Committee of the House of Commons of 1862 is quoted as "M. M. A. Report, 1862," that of the Committee of 1887 as "M. M. A. Report, 1887," that of the Committee of 1890 as "M. M. A. Report, 1890," and that of the Committee of 1897 as "M. M. A. Report, 1897."

Printers' copy and the text of the statute itself are printed at length in the Appendix (p. 805).

The most important substantive enactments of the Merchandise Marks Act, 1887, are comprised in the sub-sects. (1) and (2) of sect. 2 of the Act, which enumerate the principal offences against which the Act was directed; the greater part of the remainder of the statute being directed to the definition and explanation of the terms employed in the sub-sections referred to, and the provision of machinery for the prosecution and punishment of the offences created by them. In addition to the provisions relating to these offences, the Act contains a very important provision (sect. 16) prohibiting the importation of deceptively or spuriously marked goods, and some special provisions as to marks on watches (sects. 7 and 8). Two subsidiary sections of the Act—namely, sect. 17, dealing with the statutory warranty implied by the sale of marked goods (*b*), and sect. 20, imposing a penalty for false representations as to royal warrants (*c*)—are considered in other chapters of this work.

Sect. 2 is divided into six sub-sections, which deal respectively with the offences against the Act, (1) and (2); penalties, (3) (*d*); destruction of forfeited articles, (4) (*e*); appeals against convictions, (5) (*f*); and prosecutions, (6) (*ff*).

It provides as follows:—

Offences as to trade-marks and trade descriptions.

"**2.**—(1.) Every person who—

"(a) forges any trade-mark; or

"(b) falsely applies to goods any trade-mark or any mark so nearly resembling a trade-mark as to be calculated to deceive; or

"(c) makes any die, block, machine, or other instrument for the purpose of forging, or of being used for forging, a trade-mark; or

"(d) applies any false trade description to goods; or

(*b*) Book I., Chap. XVII., p. 520.
(*c*) Below, p. 641.
(*d*) Page 611.
(*e*) Page 611.
(*f*) Page 617.
(*ff*) Page 612.

"(e) disposes of or has in his possession any die, block, machine, or other instrument for the purpose of forging a trade-mark; or

"(f) causes any of the things above in this section mentioned to be done,

shall, subject to the provisions of this Act, and unless he proves that he acted without intent to defraud, be guilty of an offence against this Act.

"(2.) Every person who sells, or exposes for, or has in his possession for, sale, or any purpose of trade or manufacture, any goods or things to which any forged trade-mark or false trade description is applied, or to which any trade-mark or mark so nearly resembling a trade-mark as to be calculated to deceive is falsely applied, as the case may be, shall, unless he 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;

be guilty of an offence against this Act.

"(3.) Every person guilty of an offence against this Act shall be liable (p. 611)—

"(i) on conviction on indictment, to imprisonment, with or without hard labour, for a term not exceeding two years, or to fine, or to both imprisonment and fine; and

"(ii) on summary conviction to imprisonment, with or without hard labour, for a term not exceeding four months, or to a fine not exceeding twenty pounds, and in the case of a second or subsequent conviction to imprisonment, with or without hard labour, for a term not exceeding six months, or to a fine not exceeding fifty pounds; and

"(iii) in any case, to forfeit to her Majesty every chattel,

article, instrument, or thing by means of or in relation to which the offence has been committed.

"(4.) The Court before whom any person is convicted under this section may order any forfeited articles to be destroyed or otherwise disposed of as the Court thinks fit (p. 611).

"(5.) If any person feels aggrieved by any conviction made by a court of summary jurisdiction, he may appeal therefrom to a court of quarter sessions (p. 617).

"(6.) Any offence for which a person is under this Act liable to punishment on summary conviction may be prosecuted, and any articles liable to be forfeited under this Act by a court of summary jurisdiction may be forfeited, in manner provided by the Summary Jurisdiction Acts: Provided that a person charged with an offence under this section before a court of summary jurisdiction shall, on appearing before the Court, and before the charge is gone into, be informed of his right to be tried on indictment, and if he requires be so tried accordingly."

Offences by a corporation or a partnership.

Every person (s. 2 (1)).—Person means person or persons (*g*), and includes any body of persons corporate or unincorporate (*h*). According to the letter of the statute, therefore, a corporation or a private partnership, or trade society, could, as such, be convicted and fined for an offence under the statute; and in various cases such convictions have taken place (*i*), although the point as to whether corporations or partnerships are within the statute has not been expressly raised and determined. In modern cases, however, no difficulty has been felt in construing statutes so as to cast a duty, which is enforceable through the criminal law, upon corporations (*k*), notwithstanding the objections that a corporation cannot act except through its agents, who have no authority to do any

(*g*) 52 & 53 Vict. c. 63, s. 1.

(*h*) M. M. A. 1887, s. 3 (1).

(*i*) Cf. *Jones Brothers' Case*, Times, Jan. 9 and 16, 1899.

(*k*) See *The Queen* v. *Tyler*, (1891) 2 Q. B. 588, and the cases there cited; and per Lord Blackburn in *Pharmaceutical Society* v. *London and Provincial Supply Association*. 5 App. Cas. at p. 869 (1881).

criminal or other illegal act (*l*); that a principal is never criminally liable (*m*) for the acts of his agent which he has not specially authorized, unless expressly made so by statute in any particular case (*n*); and that a specific criminal intent cannot be attributed to a corporation (*o*). It would be a serious curtailment of the usefulness of the Act if the limited liability companies, by which so much of the trade of the country is now carried on, could not be reached by the pecuniary penalties instituted by it; for proceedings against their officers for their own share in causing or participating in the offences charged might often be inadequate to stop the mischief aimed at by the Act (*p*).

If a corporation can be convicted under the Act and fined, there seems to be o principle upon which unincorporated bodies can be held to be outside its operation. And where all the members of a partnership are individually guilty of an offence there is no further difficulty in holding the partnership itself liable also, since its property, upon which the fine inflicted would be levied, is the property of the several partners. A question may, however, arise—if some partners establish on their own account one of the defences specified in the Act, for instance, show that they acted without intent to defraud, under sect. 2 (1), or that they complied with the provisions of sect. 2 (2), (a) and (b), while others fail to do

(*l*) *Re The Royal British Bank, Ex parte Nicol*, 3 De G. & J. 387; 28 L. J. Ch. 257 (1859).

(*m*) It was held in *The Queen* v. *Stephens*, L. R. 1 Q. B. 702 (1865), that the owner of works carried on by agents for his profit might be indicted for a nuisance committed by the agents without his knowledge and against his general directions, on the ground that the case was in substance a civil proceeding.

(*n*) *Chisholm* v. *Doulton*, 22 Q. B. D. 736 (1889); *Budd* v. *Lucas*, (1891) 1 Q. B. 408.

(*o*) On the general question of the liability of a corporation for crimes, see Brice's Ultra Vires, 3rd ed., Chap. XIII., and for torts, Chap. XII., and Buckley on the Companies Acts, 7th ed., pp. 101 and 532; *Barwick* v. *English Joint Stock Bank*, L. R. 2 Ex. 259 (1866); *Houldsworth* v. *City of Glasgow Bank*, 5 App. Cas. 317 (1880); and *British Mutual Banking Co., Ld.* v. *Charnwood Forest Ry. Co.*, 18 Q. B. D. 714 (1887); *Cornford* v. *Carlton Bank, Ld.*, (1899) 1 Q. B. 392; (1900) 1 Q. B. 22; 68 L. J. Q. B. 196, 1020, Darling, J., and C. A. (in the Court of Appeal the point was abandoned).

(*p*) See per Denman, C. J., in *The Queen* v. *Great North of England Ry. Co.*, 9 Queen's Bench Rep. 315; 16 L. J. M. C. 16 (1846).

so—whether the partnership, and through it the innocent partners, according to their interest in its property, are liable to be fined for the offences charged, because the proceedings have been taken against the firm. The case is precisely similar to that of an offending corporation having some innocent corporators; and, it is submitted, the question must be answered in the affirmative.

Liability of servants and workmen.

As regards persons employed on behalf of others, see sect. 6 (*q*). That section does not apply to offences under the clauses in sect. 2 (1) (a) and sect. 2 (1) (e), although it is difficult to see why it should not. And as regards the acts of a servant, done in obedience to the instructions of his master, see sect. 19 (3) (*r*).

Sect. 2 (1) deals with three groups of offences: forging trade-marks, (a), (c), and (e); falsely applying trade-marks to goods, (b); and applying false trade descriptions, (d); the general clause (f) adding the following offence—causing any of the other offences to be committed.

1. Forging Trade-Marks.

Sect. 2 (1).

"(a) Forges any trade-mark;

"(c) Makes any die, block, machine, or other instrument for the purpose of forging, or of being used for forging, a trade-mark;

"(e) Disposes of or has in his possession any die, block, machine, or other instrument for the purpose of forging a trade-mark."

What is a trade-mark.

Trade-Mark.]—For the purposes of the Act—

"The expression 'trade-mark' means a trade-mark registered in the Register of Trade-Marks kept under the Patents, Designs, and Trade-Marks Act, 1883, and includes any trade-mark which, either with or without registration, is protected by law in any British possession or foreign State to which the provisions of the 103rd section (*s*) of the Patents, Designs, and Trade-Marks Act, 1883, are, under Order in Council, for the time being applicable" (*t*).

(*q*) "Persons employed," p. 598.
(*r*) Page 597.
(*s*) See Book I., Chap. XX., p. 545.
(*t*) Sect. 3 (1). Appendix, p. 762.

Registered trade-mark.

The Register is kept under sect. 78 of the Patents, &c. Act, and the questions: What may be Registered? (*u*) and What is the Effect of Registration? (*x*) have already been discussed at length. Any entry made on the Register without sufficient cause may be expunged or varied by the Court, upon application, under sect. 90 of the Patents, &c. Act (*y*).

Proof of registration is effected by a copy of, or extract from, the Register, purporting to be certified by the Comptroller, and sealed with the seal of the Patent Office (*z*), or by a certificate purporting to be under the hand of the Comptroller (*a*).

Where the trade-mark is improperly registered.

The question may arise whether registered, in the above definition, means only "actually registered," or means "properly registered." It is submitted that registered in fact is the true construction, for any other would, to a great extent, defeat the operation of the Act. It cannot have been intended that, in the summary proceedings before two justices contemplated by the Act, inquiries should be entered upon, such as those undertaken on applications under sect. 90, to remove trade-marks from the Register: for instance, inquiries whether a registered trade-mark was a common mark or a descriptive mark, or whether, if registered as an old mark, it was in fact used as registered before the 13th of August, 1875 (*b*). A similar question arises with regard to "the proprietor" of a registered trade-mark (*c*). By sect. 76 of the Act of 1883, the registration of a person as the proprietor of a trade-mark is *primâ facie* evidence of his right to the exclusive use of the trade-mark, and is, after the expiration of five years from the date of registration, conclusive evidence of his right to the exclusive use of the trade-mark, subject to the provisions of the Act. And, in civil proceedings, it has been held, under this provision, that registration after five years is conclusive, both as to the title of the proprietor and as to the propriety of the registration itself, in the absence of an application to

(*u*) Sects. 62 and 64, Book I., Chap. VIII., p. 115.

(*x*) Sects. 75 and 76, Chap. XII., p. 302.

(*y*) Chap. XI., p. 262.

(*z*) Act of 1883, s. 89.

(*a*) *Ibid.*, s. 96.

(*b*) See Book I., Chap. XI., p. 262, "Rectification of the Register."

(*c*) *Infra*, p. 564.

rectify, under sect. 90 (*d*). No doubt, if a plausible claim for rectification were seriously put forward in criminal proceedings based upon a registered trade-mark, an adjournment, to enable an application to the High Court to be made under sect. 90, would be granted pending the result of such application. And the existence of such a claim might of itself, in many cases, be sufficient to negative the intent to defraud, which is an element of each of the offences under the M. M. A., sect. 2 (1), or to show that the person charged had acted innocently, within the meaning of the M. M. A., sect. 2 (2).

The M. M. A. 1862.

The Act of 1862 applied only to trade-marks as defined by the Act (*e*). No register of trade-marks existed when the Act was passed.

Unregistered trade-marks.

Unregistered trade-marks within the United Kingdom are not protected by the Act as trade-marks, but they are in many cases protected by the provisions relating to the application of a false trade description under the extension of that term contained in sect. 3 (2) and (3) (*f*). The number of such trade-marks in use is enormous, exceeding, it is said, the number of registered trade-marks (*g*); and, as has been shown in the earlier part of this book, infringements of them, in general, can be restrained in actions for "passing off" (*h*), even where, under sect. 77 (*i*) of the Act of 1883, they do not form the subject of an action for infringement, properly so called.

Trade-marks in British possessions.

"British possession," in the definition of a trade-mark, means any part of his Majesty's dominions, exclusive of the United Kingdom, and where parts of such dominions are under both a central and a local legislature, all parts under the central legislature are, for the purposes of this definition, to be deemed one British possession (*k*).

(*d*) *Apollinaris Co.* v. *Herrfeldt*, 4 R. P. C. 478 (1887), C. A.; *Pinto* v. *Badman*, 8 R. P. C. 181, (1891), C. A., above, p. 308 *et seq.*

(*e*) 25 & 26 Vict. c. 88, s. 2, set out *ante*, p. 25.

(*f*) See below, pp. 588—592.

(*g*) M. M. A. Report, 1887, evidence of Mr. Courtenay Boyle, Qq. 400, 420. The bulk of the cotton marks are unregistered; evidence of Mr. Wright, Q. 3981.

(*h*) Book I., Chap. XVI., p. 446.

(*i*) *Ibid.* Chap. XII., p. 317.

(*k*) Interpretation Act, 1889 (52 & 53 Vict. c. 63), s. 18 (2).

By sect. 9—

"In any indictment, pleading, proceeding, or document, in which any trade-mark or forged trade-mark is intended to be mentioned, it shall be sufficient, without further description and without any copy or facsimile, to state that trade-mark or forged trade-mark to be a trade-mark or forged trade-mark." Trade-mark, how described in pleading.

Forges.]—By sect. 4—

"A person shall be deemed to forge a trade-mark who either— What is forging a trade-mark.

"(a) without the assent of the proprietor of the trade-mark makes that trade-mark or [a[1]] (*l*) 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" (*m*).

So that the phrase covers the three distinct offences, (a), [a[1]], and (b).

At common law the offence of forgery is the making or alteration of a writing or document to the prejudice of another person's right with intent to defraud (*n*), and a trade-mark is not a writing or document within the definition (*o*). But the sale of goods under a spurious mark, which the vendor knew to be spurious, has been held in many cases to constitute obtaining money by false pretences (*p*). Forgery of a trade-mark at common law.

In *R.* v. *Smith* (*o*), where the prisoner was charged with having forged imitations of Borwick's baking powder labels,

(*l*) [a[1]] is not in the Act.

(*m*) Below, p. 601. Cf. sect. 5 (3), p. 569.

(*n*) Not necessarily to defraud a particular person. 24 & 25 Vict. c. 98, s. 44; Archbold, 22nd ed., p. 672.

(*o*) *R.* v. *Smith*, 8 Cox, 32; 27 L. J. M. C. 225 (1858), C. C. R.; Seb. Dig. p. 89.

(*p*) *R.* v. *Dundas*, 6 Cox, 380; *R.* v. *Ardley*, L. R. 1 C. C. R. 301; Seb. Dig. "False Pretences."

Pollock, C. B., said:—"The issuing of this wrapper without the stuff within it would be no offence. In the printing of these wrappers there is no forgery; the real offence is the issuing them with fraudulent matter in them" (*q*). The offence under the M. M. A. is, however, complete, whether the forged trade-marks be applied to goods or not, unless intent to defraud is disproved. The application of a trade-mark, whether forged or genuine, to goods other than the goods of the proprietor of the trade-mark is an offence under sects. 2 (1) (b), 2 (1) (d), and 3 (2).

The proprietor.

(a) *The proprietor*]—is the registered proprietor (*r*), or his assignee, who is possessed of the goodwill of the business for which the trade-mark in question was acquired and used (*s*). It has been held, in civil cases, that the assignee of a registered trade-mark need not register the assignment before commencing proceedings to restrain, or to obtain damages in respect of, an infringement (*t*), and the rule will, no doubt, apply also in proceedings under the M. M. A. The question, whether a defendant charged under the Act can go behind the Register and deny the title of the registered proprietor, has already been referred to (*u*).

"Proprietor" includes any body of persons, corporate or unincorporate (*x*).

Assent of the proprietor.

Without the assent of the proprietor, &c.]—The owner of goods of the kind which a trade-mark is properly used to indicate—that is to say, goods of the manufacture or selection, &c. (*y*) of the proprietor of the trade-mark—and of the class for which the trade-mark is used, is entitled to apply the trade-mark to them. He may, for instance, lawfully replace soiled labels (*z*), or refill, with the proprietor's goods,

(*q*) Cf. the civil case of *Farina* v. *Silverlock*, above, p. 32.

(*r*) Act of 1883, sect. 78. Cf. *ante*, p. 65.

(*s*) *Ibid.* sect. 70, Book I., Chap. XIII., p. 324, Assignment and Devolution of Trade-marks.

(*t*) *Ihlee* v. *Henshaw*, 31 C. D. 323; 3 R. P. C. 15 (1886), North, J. See, however, above, p. 317.

(*u*) *Ante*, p. 561.

(*x*) Sect. 3 (1).

(*y*) Book I., Chap. II., p. 52; Chap. XIX., p. 538.

(*z*) *Farina* v. *Silverlock*, 1 K. & J. 509; 24 L. J. Ch. 632; 6 De G. M. & G. 214; 26 L. J. Ch. 11 (1855), Wood, V.-C., and Cranworth, C.

stamped bottles or cases, and he may label goods purchased in bulk, and broken up into smaller quantities, with the vendor's mark (*a*). Where such goods have been purchased of the proprietor, it is submitted, he would be estopped from denying his assent to the use of the trade-mark. In any case such use would not be use with intent to defraud. And if it were shown that the marks made by the person charged were made solely for such use, he would not, it is submitted, be guilty of any offence under the Act. In *Farina* v. *Silverlock* (*z*), Lord Cranworth held, that the defendant, a printer, who copied the Farina Eau de Cologne labels, was not guilty of infringement if he established his allegation that he printed the copies only to replace worn-out labels properly used in connection with the plaintiff's scent; but this he in fact failed to do (*b*).

[a[1]] *So nearly resembling, &c.*]—This is taken from the civil law with regard to trade-marks. Such resemblance is the test of infringement where a mark is not actually copied (*c*). The rules of comparison adopted in the Courts have been stated in the earlier part of this work (*d*). And it has been shown that the persons whom the alleged spurious mark must be calculated to deceive are, in actions for infringement or passing off, taken to be any class of probable purchasers of the goods in connection with which the marks are to be used, whether the immediate purchasers from the manufacturers, the ultimate purchasers from the last retailers, or intermediate purchasers. Foreign purchasers are to be considered, if the marks circulate in foreign markets, and the bearing of their probable ignorance of the English language upon the question whether the resemblance between the marks before the Court is calculated to deceive is also material. There seems no ground for holding that buyers within the United Kingdom only are to be considered in the application of the Act.

Making a mark nearly resembling a trade-mark.

Where a trade description is used only so as to be brought

(*a*) *Condy* v. *Taylor*, 56 L. T. 891 (1887), Kekewich, J., and *ante*, pp. 368 and 369.

(*b*) 30 L. T. 242; 31 L. T. 99, Q. B.; and 4 K. & J. 650, Wood, V.-C.

(*c*) Book I., Chap. XV., p. 373.

(*d*) Pages 224 *et seq.*, 373 *et seq.*

to the notice of expert dealers in the goods to which it is applied, it is not treated by the Custom House authorities as false or falsely applied, under sect. 16 of the Act, if it does not deceive such dealers, although it might deceive the buyers who have no expert knowledge (*e*). It may be assumed that a corresponding construction would be applied in the case of marks which nearly resemble trade-marks.

The phrase "so nearly resembling," &c., appears also in sect. 2 (1) (b) and sect. 5 (3). In sect. 3 (2), the words used are "calculated to lead persons to believe that the goods (to which a false trade description is applied) are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really are." This is the deception a forged or false trade-mark is calculated to produce, and it is difficult to see how the more general expression "calculated to deceive" in the present and the first above-named sub-sections can have any different meaning.

Falsifying a trade-mark.

(b) *Falsifies any genuine trade-mark.*]—The assent of the proprietor (*f*) is no defence under this head—that is, unless it in fact negatives any intent to defraud.

This sub-section reproduces the substance of part of sect. 5 of the Act of 1862.

An alteration of a genuine trade-mark, such as to make it resemble another registered trade-mark, might fall under (a) or [a[1]].

The retailer of goods bearing a trade-mark might alter the mark with intent to pass off it, and the goods upon which it appeared, as his own. The use of a trade-mark so altered would fall within sect. 2 (1) (b) and sect. 5 (1) (d) as a false application of the trade-mark, and it might also amount to the application of a false trade description within sect. 2 (1) (d) and sect. 3 (2). The sub-section is probably intended to meet cases of fraudulent alterations, such as that suggested, where no use or application can be proved.

(*e*) See below, p. 636. (*f*) *Ante*, p. 564.

2. Falsely applying a Trade-Mark to Goods.

Sect. 2 (1).

"(b) Falsely applies to goods any trade-mark (*g*), or any mark so nearly resembling (*h*) a trade-mark as to be calculated to deceive."

Goods.]—This is defined by sect. 3 (1) to mean anything which is the subject of trade, manufacture, or merchandise. Goods.

Trade-marks are registered only for definite classes of goods (*i*), and the rights of the proprietor of a trade-mark are restricted to goods of the class for which it is registered, and for which it is actually used or intended to be used. He can have no right in respect of its user upon goods in which he does not deal (*k*). It is submitted, upon the same principle, that it would not be an offence under this head to apply a trade-mark registered for cotton goods, for instance, to ironware, without the assent of the proprietor of the trade-mark, even if such use could be held to be a use with intent to defraud.

Applies to goods.]—By sect. 5— Sect. 5 (1).

"(1.) A person shall be deemed to apply a trade-mark or a mark or a trade description to goods who— Applying marks and descriptions.

"(a) applies it to the goods themselves; or

"(b) applies it to any covering, 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, or 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.

(*g*) Page 560, "trade-mark."

(*h*) Page 565, "So nearly resembling."

(*i*) Act of 1883, sects. 65 and 66; Book I., Chap. V., p. 96.

(*k*) See above, p. 307.

Sect. 5 (2). Covering. Label.

"(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 a 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" (*l*).

What is a sufficient application of a spurious trade-mark to goods to constitute an infringement has already been considered (*m*).

Sub-sect. (1) (c) covers such cases as the refilling of bottles to which a trade-mark or trade description has previously been applied (*n*).

Sub-sect. (1) (d) is exceedingly general in its terms. It has been held, in cases of trade description, to extend to a description in an invoice sent with the goods (*o*), even where the description was originally made verbally, and was added to the invoice at the request of the purchaser of the goods (*p*).

A trade description is not "applied" to goods within the meaning of the Act unless it is physically applied (*q*).

In *Starey* v. *Chilcorth Gunpowder Co.* (*r*), the false trade description was painted on the barrels in which gunpowder was delivered by government contractors to the government agents.

The words "calculated to lead to the belief," &c., at the end of the sub-section, may be compared with the corre-

(*l*) For sect. 5 (3) see next page.

(*m*) See above, pp. 369 and 491.

(*n*) As in *Wood* v. *Burgess*, 24 Q. B. D. 162 (1889), a case under the Act; and the infringement cases cited on p. 369, *ante*.

(*o*) *Budd* v. *Lucas*, (1891) 1 Q. B. 408, Pollock and Charles, JJ.

(*p*) *Coppen* v. *Moore* (No. 1), (1898) 2 Q. B. 300; 67 L. J. Q. B. 689. And see *Cameron* v. *Wiggins*, (1901) 1 Q. B. 1.

(*q*) *Langley* v. *Bombay Tea Co., Ld.*, (1900) 2 Q. B. 460; 69 L. J. Q. B. 752, Grantham and Channell, JJ. In a recent Scotch case the offence was held to have been committed although the defendant, while appropriating the trade-mark and bottles of the prosecutor, put his own labels on the bottles as well: *Burns* v. *Turner*, 25 Ct. of Sess. Ca. 4th ser. 38 (1898), Lord Justice Clerk Kingsburgh, Lord Trayner, Lord Moncrieff.

(*r*) 24 Q. B. D. 90 (1888), Coleridge, L. C. J., and Mathew, J.

sponding words "calculated to deceive," used elsewhere in the Act (*s*).

Falsely applies, &c.]—By sect. 5—

"(3.) A person (*t*) shall be deemed to falsely apply to goods (*u*) a trade-mark or mark, who without the assent of the proprietor (*x*) of a trade-mark (*y*) applies (*z*) such trade-mark, or a mark so nearly resembling it as to be calculated to deceive (*a*); 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" (*b*).

This sub-section corresponds to sect. 4 (*a*) (*c*), defining the offence of forging a trade-mark. The reference in it to a mark resembling a trade-mark is redundant, as to falsely apply a mark so nearly resembling a trade-mark, &c. is, by sect. 2 (1) (b), declared to be a distinct offence.

3. Applying a False Trade Description to Goods.

"(d) Applies any false trade description to goods" (*d*). Sect. 2 (1) (d).

The sale of goods under a false trade description may constitute an offence of cheating or obtaining goods by false pretences at common law. The application of a false trade description was made a substantive offence by the Act of 1862, from sect. 7 of which Act the provisions in the present Act under this head are substantially taken. That Act did not, and the present Act does not, extend to descriptions of quality as apart from kind; but it is the intention of the present Act, under the sections dealing with trade-marks, of which the office is to indicate the maker, vendor, or selector of the marked goods (*e*), and which are, therefore, of the nature of trade descriptions, and under the sections dealing

The Act does not extend to false descriptions of quality.

(*s*) See above, p. 565.
(*t*) "Person," p. 558.
(*u*) "Goods," p. 567.
(*x*) "Proprietor," p. 564; "assent of the proprietor," p. 564.
(*y*) "Trade-mark," p. 560.
(*z*) "Applies to goods," p. 567.
(*a*) "So nearly resembling," p. 565.
(*b*) Below, p. 601; cf. sect. 4, p. 563.
(*c*) Page 563.
(*d*) "Goods," p. 567.
(*e*) See Book I., Chap. II., p. 52.

with false trade descriptions, extended by sect. 3 (2) and (3) to marks in general which fill the office of trade-marks, to reach all false merchandise marks, other than marks of quality (*f*).

Trade description.]—By **sect. 3 (1)**—

What is a trade description.

"The expression 'trade description' means any description, statement, or other indication, direct or indirect—

"(a) as to the number (p. 573), quantity, measure (p. 573), gauge, or weight (p. 573) of any goods, or

"(b) as to the place or country in which any goods were made or produced (p. 574), or

"(c) as to the mode of manufacturing or producing any goods (p. 578), or

"(d) as to the material of which any goods are composed (p. 578), or

"(e) as to any goods being the subject of an existing patent (p. 579), privilege, or copyright;

Customary trade description.

and the use of any figure (*g*), word, or mark which,

(*f*) *Quality.*—Adulteration, or the sale of goods not of the nature or quality demanded, or pretended, is made a criminal offence by other statutes in many special instances. By far the most important of these statutes are the Sale of Food and Drugs Acts, 1875, 1879 and 1899 (38 & 39 Vict. c. 63, and 42 & 43 Vict. c. 30 and 62 & 63 Vict. c. 51), by which it is an offence to mix injurious ingredients with any article of food, or any drug, with intent that the same may be sold, or to sell the article of food or drug so mixed; to sell articles of food or drugs not of the nature, substance, and quality demanded by the purchaser; to abstract from an article of food, with intent that the same may be sold without notice, any part of it so as injuriously to affect its quality, substance, or nature, or to sell (without notice) the article so altered, and to import margarine and other foods insufficiently described upon their containers. For cases under these Acts, see the Law Reports Digest, "Adulteration." Among other statutes may be mentioned 6 & 7 Will. 4, c. 37 (bread); 4 Geo. 2, c. 14, 17 Geo. 3, c. 29 (tea); 5 Geo. 1, c. 11, s. 23 (coffee); 37 & 38 Vict. c. 49, s. 14, 48 & 49 Vict. c. 51, s. 8 (beer); 32 & 33 Vict. c. 112 (seeds); 56 & 57 Vict. c. 56 (agricultural fertilizers and feeding stuffs); and the Margarine Act, 1887 (50 & 51 Vict. c. 29).

(*g*) *I.c.*, numeral. *Ex parte Stephens*, 3 C. D. 660, see above, p. 198.

according to the custom of the trade (p. 581), is commonly taken to be an indication of any of the above matters, shall be deemed to be a trade description within the meaning of this Act."

And by the M. M. A. 1891, s. 1, it is provided that— M. M. A. 1891.

"[f] the Customs entry (h) relating to imported goods shall, for the purposes of the M. M. A. 1887, be deemed to be a trade description applied to goods." Customs entry.

It has now been decided by a Divisional Court (confirming the view expressed in the 1st edition of this work) that the provisions of sect. 2 (2) of the M. M. A. 1887, which make it an offence to sell goods to which a false trade description is applied, do not apply where the description is entirely verbal, still less where it is a mere inference from conduct, *e.g.*, the act of a salesman in handing over to a customer a parcel (alleged to contain a false trade description) without comment (*i*). The whole framework of the statute, with the exception of sect. 20 (*inf.*, p. 641), points to the necessity for a written or printed mark, or a physical mark in some other sense than a purely verbal description. But unintelligible writing may be explained by a statement made at the time of sale (*j*). Where a merely verbal description is the subject of complaint, proceedings may be taken under the Sale of Food and Drugs Acts (*k*). Verbal trade description.

The non-inclusion of verbal statements leaves a large class of frauds untouched by the Act (*l*). Goods, for instance, which have passed through the Customs under cover of an explanation placed upon their coverings may be sold retail Frauds effected under cover of verbal false descriptions.

(*h*) See p. 583, below.

(*i*) *Coppen* v. *Moore* (No. 1), (1898) 2 Q. B. 300; 67 L. J. Q. B. 689, Wright and Darling, JJ.; *Langley* v. *Bombay Tea Co. Ld.*, (1900) 2 Q. B. 460, Grantham and Channell, JJ.

(*j*) *Cameron* v. *Wiggins*, (1901) 1 Q. B. 1, Lawrance and Kennedy, JJ.; evidence to show that "N. M." meant New Zealand Mutton, was held to be admissible.

(*k*) *Coppen* v. *Moore* (No. 1), per Wright, J., (1898) 2 Q. B. at p. 304; 67 L. J. Q. B. at p. 690.

(*l*) Proceedings may be taken under the Sale of Food and Drugs Acts in cases coming within those statutes: see *Coppen* v. *Moore* (No. 1), (1898) 2 Q. B., per Wright, J., at p. 304; 67 L. J. Q. B. at p. 690.

without the explanation, and with a verbal false description; as, of course, may also goods which, bearing no description at all, or no false description, could not be stopped on importation, or home-made goods. Mr. Poland, K.C., has expressed the view that the imitation of the crystals of Demerara sugar in beet-root sugar, and its sale as Demerara sugar, was not an offence under the Act (*m*). Sales upon such verbal false statements may, however, amount to the offence of cheating, or obtaining money by false pretences, if they are deliberate false statements of matters of fact known to the person charged, and are made in order to induce, and do actually induce, the buyer to purchase.

Imitation Demerara sugar.

Imitations of "get-up."

Goods may be passed off as those of the manufacture or merchandise of some person other than the person whose they are, without an explicit description of them as the goods of the first person, or any piracy or colourable imitation of his trade-mark or trade-name. This fraud forms the ground of a civil action (*o*). Such imitations may be false trade descriptions applied to the goods under sect. 3 (2) (*p*).

Words forming part of the goods.

Words forming part of the goods upon which they appear cannot, it would seem, be taken to be a trade description applied to those goods within the meaning of the Act, although they may, in fact, give or suggest some description, statement, or other indication within the definition just cited, for the description is treated in the definition as an addition to the "goods," which are complete without it. This is the view taken by the Customs authorities in the application of sect. 16 (*q*). For instance, English words in verses on Christmas cards; the title of a book; the words *fast* and *slow* upon the regulator of a watch; mottoes and words of friendship on handkerchiefs, crockery, and so forth, are not treated by the Customs authorities as indications that the goods were produced in an English-speaking country. "On *such* goods, made abroad, it has been

(*m*) See the case and opinion set out, M. M. A. Report, p. 166.

(*o*) Book I., Chap. XVI., p. 446.

(*p*) *Infra*, p. 588.

(*q*) See M. M. A. Report, 1890, Appendix I., p. 275, a paper handed in by Mr. Follett, Solicitor of the Board of Customs, from which the illustrations in the text are taken.

thought" by the Customs authorities "wiser to regard (with some exceptions) English wording which goes no further than above mentioned (that is to say, which does not go into such statements as 'printed in England,' or 'very superfine cards,' or 'London lever watch,' &c.), as part of the 'goods,' and as not, therefore, rendering the goods liable under the Act, even though the general appearance given to them may be on this account, and on account of the wording, unquestionably English" (*r*).

Trade description may be a trade-mark.

The trade description may be a trade-mark or part of a trade-mark (*s*), or may include a trade-mark (*t*); but the case of a false name or initials is dealt with specially (*u*).

Number.

(a.) *Number, &c.*]—This sub-section is directed to descriptions applied to coverings (*x*) purporting to contain a specified or indicated number, quantity, &c., of goods, as well as to descriptions attached to the goods themselves. It meets frauds, such as the practice of marking upon cotton goods the number of laps or folds by a figure so placed as to be "commonly taken" to indicate the number of yards in the marked piece, the true number of yards being in fact less than the number marked (*y*).

It has been questioned whether the words in the clause cover indications of width, dimension, and weight per unit of length, which are of great importance in the textile trades; but it is submitted that they do, and it is said that the Manchester magistrates have so construed them (*z*).

Measure.

Measure.]—The description of casks of beer as *barrels* in an invoice sent with them, has been held to be a statement within the definition that the casks contain thirty-six gallons each (*a*).

Weight.

Weight.]—In a civil case it has been held that goods done up in cases and supplied according to contract, the cases being

(*r*) From the paper referred to in the last note.

(*s*) Sect. 3 (1). "False trade description," p. 584.

(*t*) Sect. 3 (2), p. 588.

(*u*) Sect. 3 (3), p. 590.

(*x*) Sect. 5 (2), p. 567.

(*y*) See the evidence of Mr. Bailey, Qq. 1966 *et seq.*, M. M. A. Report, 1890.

(*z*) See previous note.

(*a*) *Budd* v. *Lucas*, (1891) 1 Q. B. 408, Pollock, B., and Charles, J.

marked as one-pound cases, could not be forced upon a purchaser if they were actually under the weights indicated, although not deficient by more than an alleged customary allowance, on the ground that the purchaser could not sell them without committing an offence under the Act (*b*).

Where a description is applied to goods showing that the weight supplied is less than that for which the customer asks, no offence against sect. 3 (1) (a) is committed (*c*).

(b.) *Place or country.*]—This sub-section was regarded by many of the advocates of the bill as the most important clause of the definition; it is under cover of it that goods made abroad and so marked as to suggest that they are made in England are brought within the Act, and are made liable to seizure by the Customs authorities in accordance with sect. 16 (*d*).

Place of origin.

The chief difficulty in the application of this clause of the definition arises from the fact that the clause is apparently framed on the assumption that all goods will be wholly made or produced in one place or country, whereas in fact many kinds of goods are worked upon in several before they are finished and ready for the market, or are made up of parts made or produced in different countries. *Bischop* v. *Toler* (*e*) was a case of this kind. A person had in his possession, for sale, margarine packed in cardboard boxes, marked with the words, "French factory." The margarine consisted of a substance, called *Le Dansk*, manufactured from animal fat at a factory in Paris, and sent thence to a factory at Southampton, where, by admixture with Danish butter and English milk, it assumed the form in which it was offered for sale. It was only when the margarine assumed this form that it was described as *Le Dansk*. The words "French

(*b*) *Hooper* v. *Balfour*, W. N. (1890) 61; 62 L. T. 616; *Green and Balfour's Arbitration*, W. N. (1890), 139, 156, Kay, J., and C. A.; and see *Guinness, Son & Co., Ld.* v. *Wythe*—a case decided by a metropolitan police magistrate—30 L. Jo. 455 (1895).

(*c*) *Langley* v. *Bombay Tea Co., Ld.*, (1900) 2 Q. B. 460; 69 L. J. Q. B. 725, Grantham and Channell, JJ.

(*d*) And in accordance with the agreements arrived at by the Commissioners at the International Convention, Conference of Rome, in 1886. This convention has not been ratified.

(*e*) 65 L. J. M. C. 1 (1895), Lord Russell of Killowen, L. C. J., and Cave, J.

factory" were held to be a "false trade description" within sects. 2 and 3 of the M. M. A. 1887, inasmuch as the margarine first became a finished product in England, while it was sold in circumstances which represented it to the buyer as having been manufactured in France. It has been held by a metropolitan police magistrate that the principle laid down in the *Le Dansk* case, that an article becomes a finished product at the time when it assumes the form in which it is offered for sale, although applicable to chemical combinations in which the several parts are lost in the whole composition, is not applicable to mechanical combinations in which all the parts remain unaltered, and that therefore the description of a watch, in which at least three wheels and four pinions of the "train," in addition to other parts of greater or less importance, were of foreign origin, as an "English lever" was a false trade description (*f*).

The difficulty above referred to is partly met by the definition of a false trade description as one which is false in a material respect, for this reduces it to a question of fact. No doubt, any Court, in determining whether the indication of a particular country as the place of manufacture was false in this sense or not, would be guided by the custom of the trade in the goods concerned, that is, supposing it to be consistent with honesty. The description of goods partly made in each of two countries as made in a third would, it may be assumed, be indefensible under any custom, unless it fell within the general saving of sect. 18 as a "conventional" or "generic" description lawfully and generally used at the

(*f*) *Lancashire Watch Co.* v. *H. D. Williamson, Ld.*, Times, March 5, 1900. In the Q. B. D. (*Williamson* v. *Tierney*, 17 T. L. R. 174 (1901), Lord Alverstone, L. C. J., Kennedy and Phillimore, JJ.) the Court held that the mere fact that part of the watch was made abroad was not sufficient to make the description false, but that if the magistrate decided the case on what he held to be the recognised meaning of the word "English" as applied to watches, his decision would not be disturbed. In re-stating the case the learned magistrate said that he came to the conclusion, as a determination of fact upon evidence produced before him, that in the watch trade no watch was regarded as an English watch, or was rightly called English, which contained foreign parts of material importance other than the hair- and main-spring, or things of comparatively insignificant character, such as screws, and that certain parts of the watches were of most material importance, and were imported from abroad in such a condition that they were foreign parts when they arrived in this country, and remained foreign parts after they had been operated upon, polished, and fitted into the watch by the appellants. The Court, therefore, dismissed the appeal.—Times, April 17th, 1901.

passing of the Act, as, for instance, *French polish*, *American leather*, or *Indian rubber*. The last-mentioned section, however, extends to a trade description of place or country calculated to mislead as to the place or country where the goods to which it is applied were actually made or produced (the goods not being actually made or produced in the place or country indicated or suggested), only if there is added to the trade description, immediately before or after the name of that place or country, in an equally conspicuous manner with that name, the name of the place or country in which the goods were actually made or produced, with a statement that they were made or produced there (*g*). From this has arisen the now familiar notices, "made in Germany," "made in France," &c. (*gg*).

It is to be observed that the provision in sect. 18 requiring the addition of the name of the place or country of actual manufacture is only applicable where the trade description is calculated to mislead (*h*). It is not necessary, for instance, to mark *Morocco* leather or *Brussels* carpets as made in England, since the term is not calculated to lead any buyer to think the leather was made in Morocco or the carpet in Brussels.

Evidence of country of origin.

By sect. 10 (2)—

> "In the case of imported goods, evidence of the port of shipment shall be *primâ facie* evidence of the place or country in which the goods were made or produced."

And the port of shipment is stated in the Customs entry (*i*), which is now itself a trade description applied to the goods referred to by it (*k*).

Customs practice as to country of origin.

The practice of the Customs authorities, under sect. 16, with regard to the matters above referred to, was described by Mr. Follett, to the Committee of 1890, in the following terms (*l*): "As general rules, the board have acted on the principle that goods must (as indeed is in accordance with sect. 10 of the Act) be held *primâ facie* to have been the

(*g*) Sect. 18, *infra*, p. 594; and see *Bischop* v. *Toler*, *ubi sup.*, at pp. 2 and 3.

(*gg*) In *Robinson & Barnsdale, Ld.'s Case*, the words "made in England" on the back of a cigar-box did not save from a conviction for applying a false trade description to boxes of English-made cigars, which bore the words Havannah and Santiago, &c. —Times, April 2nd, 1901.

(*h*) Cf. "So nearly resembling," *ante*, p. 565.

(*i*) Below, p. 583.

(*k*) M. M. A. 1891, s. 1.

(*l*) *Ante*, p. 572, n. (*q*).

make or produce of the country from which they last come; and that if a qualifying description to that effect is remonstrated against on the ground that it would be untrue as to a material part, there must be a statement as to that part. For instance, if there were an importation of German cutlery with the name of an English dealer, and a qualification of *made abroad* were objected to on the ground that the handles (taking it to be knives), or the woodwork (taking it to be planes), were made in England and sent out by the dealer to be fitted, then it would be required that these should be stated, *blades (or woodwork) made in Germany*. Similarly (although as to the important part of the goods the circumstances are just reversed), it was required that if British goods were sent abroad to be finished in any respect, as, for instance, yarns to be dyed, that fact must be stated, *dyed abroad*, when they are re-imported.

Goods finished abroad.

"As regards goods coming in in an incomplete state, or merely as parts of an intended complete article, the Board have felt that they could do no more than deal with them as they stand, taking care that there is no description either of the parts themselves or of the whole goods to which they are going to be added which can form an incorrect indication as to the make of the imported portion."

Foreign goods finished in England.

In the case of goods imported through the ports of a country other than that of their origin, for example, Swiss goods coming through a French port and marked as Swiss, the practice of the authorities is to detain them until a declaration by the importer, or other evidence regarded as satisfactory, is tendered to show that the goods are in fact Swiss.

Imports from inland country.

It has been held in an Irish case that the description of bacon which was killed in America, and was cured by the defendant Lipton partly in America and partly in Ireland, as "Lipton's cure," and "own cure at Lipton's market," was not a false trade description; although the magistrates and one of the judges who heard the case thought the use of the description by an Irish shopkeeper was likely to be deceptive (*m*).

(*m*) *R.* v. *Lipton*, 32 L. R. Ir. 115 (1893), Q. B. D. See also *R.* v. *Bramall*, Times, December 18th, 1891, where a description of machine-cut files as "hand-cut" was held to be an offence.

In a case where a tradesman sold bacon, which really came from Ireland, as "finest Wiltshire cut," and was prosecuted for applying a false trade description to the commodity, the defence was successfully set up, both before the justices and in the High Court, that the description referred, not to the place of origin of the bacon, but to the cut (*n*).

It is provided by **sect. 16** (4) (*o*) that—

Goods bearing the name of an English place.

> "Where there is on any goods a name which is identical with or a colourable imitation of the name of a place in the United Kingdom, that name, unless accompanied by the name of the country in which such place is situate, shall be treated for the purposes of this section as if it were the name of a place in the United Kingdom."

This provision is expressly restricted to the purposes of the section in which it occurs, that is, the section dealing with the importation of deceptively or spuriously marked goods; but the rule laid down in the clause would probably be adopted in regard to any suggested false trade description by the use upon goods of a name like the name of an English, Scotch, or Irish place. Goods marked simply "Rugby," for example, would be taken to be falsely described if made in Rugby, Tennessee.

(c.) *Mode of manufacturing, &c.*]—In the Irish case referred to above it was also held that the description in question was not an offence within this clause (*p*).

Material.

(d.) *Material, &c.*]—In a case where goods were marked and described as "natural wool" goods, this was held by the magistrates at Leicester to be an indication within the definition that the goods were all, or substantially all, woollen, although a custom to call cheap mixtures of cotton and a little wool "natural wool" was alleged (*q*).

(*n*) *Morris* v. *Royle*, 31 L. Jo. 339 (1896). See also *Harrod's Stores Case*, Times, Jan. 9, 1898, in which it was held on the facts that the term "Dresden" as applied to china indicated the factory from which the wares came, and not the style of decoration.

(*o*) See further, p. 634, and "Customs entry," p. 583.

(*p*) See note (*m*), *ante*, p. 577.

(*q*) *Leicester Case*, *Times* Newspaper, 20 Oct. 1893; and see *Meadows* v. *Catesby & Sons*, 107 L. T. Jo. 440 (1899), where it was held, by a metropolitan police magis-

"Flannelette" has been held by a metropolitan police magistrate not to be a "false trade description," although the material was found on analysis to consist entirely of cotton, without the faintest trace of any wool. Except for a ticket bearing the word "flannelette," with the price, attached to the goods, no representation was made to the public as to the meaning of the word "flannelette." The magistrate was not satisfied that it was believed by the public to contain wool, or was bought on that ground, and he held that "flannelette" might fairly be construed as meaning "an article not quite equal to flannel, but clearly resembling it, and much cheaper" (*r*).

(e.) *Existing patent.*]—By **sect. 105** of the Patents, &c. Act, 1883, it is provided that— Patent.

Sect. 105 of the Act of 1883.

"(1) Any person who represents that any article sold by him is a patented article when no patent has been granted for the same, or describes any design or trade-mark applied to any article sold by him as registered when it is not so, shall be liable for every offence on summary conviction to a fine not exceeding 5*l.*

"(2) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or a trade-mark is registered if he sells the article with the word 'patent,' 'patented,' 'registered,' or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to the article."

Application for a patent (*s*), or provisional protection (*t*),

trate, a false trade description to describe a mattress containing sixty or seventy per cent. of jute or hemp as a "wool" mattress. There have also been convictions where trinkets were invoiced as composed of 800 parts silver out of 1,000, whereas they fell considerably short (Birmingham, *Pell's Case*), and where carbolic acid was sold as *Condy's Fluid* (Wandsworth, *Hall's Case*). See paper by Mr. G. B. Ellis on "The Merchandise Marks Act" in the *Trans. Chart. Inst. of Pat. Agents*, Vol. XVII., p. 83.

(*r*) *Whiteley's Case*, Times, Jan. 16, 1895; and see *Nicholl's Case*, (1896), a prosecution before a metropolitan police magistrate for selling lard solidified with beef stearine as pure lard.

(*s*) So held by a magistrate in *R.* v. *Crampton*, 3 R. P. C. 337 (1886). See further as to this section below, Book II., Ch. II., p. 639.

(*t*) So held by a magistrate in *R.* v. *Wallis*, 3 R. P. C. 1 (1886).

does not authorize the use of the words patent or patented so as to avoid the penalty of this enactment; but the acceptance of the complete specification for a patent does, for it entitles the applicant to "the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance" (*t*).

The section just cited from the Patents, &c. Act does not apply to the case of a representation in respect of an article for which a patent has at some time been granted, but which has ceased to exist by effluxion of time or otherwise; the M. M. A. is not so limited. On the other hand, the section applies to every representation within its terms, whether made with intent to defraud or not.

There is no provision similar to sub-sect. (2) of the above section in the M. M. A., and the use of the words patent or patented does not necessarily, therefore, amount to a description, statement, or other indication that the goods to which they are applied are subject to an existing patent. A false claim of patent rights contained in a trade-mark is a bar to the interference of the Court for the protection of the trade-mark, and the cases decided on this subject will, no doubt, apply, so far as they go, in the construction of the present sub-section; but they do not lay down any definite rules (*u*).

In *Gridley* v. *Swinborne* (*v*), a case under the present Act, Coleridge, L. C. J., said that where the original patentee continued to use his old labels containing the word *patent*, there was no necessary implication of fraud; and the Court held that the defendant, who had sold goods, made from gelatine, under a patent which expired in 1847, as *Swinborne's patent refined isinglass*, was not guilty of any offence under the Act. In a case at Wolverhampton, however, Messrs. H. & T. Vaughan, lock manufacturers, were convicted under sub-sect. (c) for selling locks stamped "Vaughan's

(*t*) Act of 1883, s. 15. And see *R.* v. *Townsend*, 13 R. P. C. 265 (1896, Worship Street Police-court; *per curiam* in *Gruebel's Case*, Times Nov. 22, 1894.

(*u*) See Book I., Chap. XV., p. 401, above.

(*v*) 52 J. P. 739, 791; 5 T. L. R. 71 (1888), Coleridge, L. C. J., and Grantham, J.

Patent" for which there was no existing patent, although the article was of their own manufacture (*x*); and it was held in a later case at the Mansion House to be no defence to a charge of selling articles marked "Patent," in contravention of sect. 105 of the Act of 1883, that the defendant's specification had been officially "accepted" by the Patent Office, although sect. 15 of that Act provides that on acceptance the applicant shall have the like privileges and rights as if a patent had been sealed on the day of acceptance (*y*).

In a recent case in Ireland, the defendants had sold a box of baking powder bearing a label with the words "Trade Mark—Royal—Registered," and on the obverse side the words "Manufactured by Royal Baking Powder Company, New York." The label in question was not registered in England, though it was registered in the United States. It was held that the use of the word "Registered" amounted to a representation that the word was registered in the United Kingdom, which was not affected by the words describing where the article was manufactured, and that accordingly a contravention of sect. 105 had been committed (*z*). But the use of the words "Trade Mark" is not necessarily a representation that the mark is registered (*a*).

Custom of the trade (*b*).]—Custom does not here mean the custom of merchants, which is part of the common law (*c*), or any of the six *consuetudines* mentioned by Coke (*d*). It is more akin to the custom or usage of a particular trade or market which is resorted to in order to import terms into commercial contracts not inconsistent with their words, or to explain the meaning of the expressions employed in them, that is, a particular custom to be established by evidence (*e*), Custom of the trade.

(*x*) Times, Feb. 25, 1888. Day and Channell, JJ., was a similar case.

(*y*) *Gimbel's Case*, Times, Nov. 22, 1894. But see *R.* v. *Townsend*, 13 R. P. C. 255 (1896, Worship Street Police Court.

(*z*) *Wright Crossley & Co.* v. *William Ibbion & Co.*, 15 R. P. C. 21 (1898), O'Brien, L. C. J., O'Brien and Boyd, JJ. *MacSymons' Stores, Ld.* v. *Mattheworth*, 16 R. P. C. 748 (1898).

(*a*) *Sea Sea Co.* v. *Britten* (1899), 1 Ch. 692; 16 R. P. C. 137.

(*b*) Cf. "Common repute" in sect. 7, below, p. 620.

(*c*) Blackstone, Vol. 1, p. 74.

(*d*) 2 Inst. 58.

(*e*) *Wigglesworth* v. *Dallison*, 1 Sm. L. C., 10th ed., p. 528, and the cases cited in the notes.

or to the "custom of the country" imported into agricultural tenancies and leases, of which it is said it "must be applied to the approved habits of husbandry in the neighbourhood under circumstances of the like nature" (*f*). The custom is, therefore, the existing and generally recognized practice or usage of the trade, whether old or recent; but if recent, sufficiently old to have become generally recognized and followed (*g*).

The words may be compared to those used in the first sentence of sect. 18—"lawfully and generally applied to goods of a particular class, or manufactured by a particular method, to indicate the particular class or method of manufacture of such goods" (*h*).

In judging whether an alleged trade-mark, or a mark tendered for registration as a trade-mark, is calculated to deceive by reason of its resemblance to another trade-mark or otherwise, the Civil Courts, as has already been shown, consider all the circumstances of the trade concerned, and admit the evidence of persons engaged in the trade as experts (*i*).

The evidence to prove a custom within the definition above stated must obviously be similar to the expert evidence just mentioned—that is to say, it must be given by persons engaged in the trade, whether as manufacturers, merchants, or retailers, or by persons in the employment of such persons, or otherwise practically acquainted (for instance, as conductors of technical or trade journals) with the customs they depose to.

In a case where the question was whether the imposition on a vest of German manufacture, after its importation into England, of the words "Dr. Jaeger's Sanitary Woollen System Company, Sole Concessionnaires: Pure Wool Warranted," was a "false trade description" under sect. 2 (1),

(*f*) 2 Platt, 279, cited in Stroud's Dic. s. v.

(*g*) "Usage of trade is a general and prevailing course of business, and witnesses who are called to prove it should cause their minds to revolve over instances known to them of its having been acted upon." *Hall v. Benson*, 7 C. & P. 711.

(*h*) See p. 594.

(*i*) Book I., Chapter X., "Restrictions on Registration," pp. 237, 247.

evidence was held admissible as to whether, according to the custom of the trade, the imposition of such words would be taken to indicate English manufacture (*j*).

In a case where an alleged custom in the furniture trade, to deliver goods upon sale or return, was set up in answer to a claim under the reputed ownership clauses of the Bankruptcy Act, Cave, J., said the question was, "whether it amounted to a custom of the trade of so notorious a character that anyone making inquiry of persons cognizant of the trade might ascertain that it was a custom" (*k*).

The part of the sub-section relating to the custom of the trade does not, by implication, exclude other evidence to explain the meaning of unintelligible writing (*l*).

Customs entry.

Customs entry.]—The Customs entry for imported goods is a statement made up from the bill of lading (*m*) for purposes of Customs duty, and signed and declared to be true by the importer or his agent. It contains the name of the port or place from whence the goo[illegible]come, and a description of the number of packages and [illegible]the quantity and description of goods, in accordance with the requirements of the Official Import List. It was made a trade description under the principal Act by the Act of 1891, upon the recommendation of the Committee of 1890, and in accordance with the following passage from their report: "The evidence given before your Committee has, in their opinion, conclusively proved that goods (notably, articles of consumption) come into this country in large quantities in an adulterated form, but cannot, according to the evidence given by the Customs authorities, be detained under sect. 3 (d) (*n*) of the M. M. A.,

Report of the M. M. A. Committee of 1890 on fraudulent importations.

(*j*) *Watson* v. *Dr. Jaeger's Sanitary Woollen System Co.*, 13 T. L. R. 150 (1897), Wright and Bruce, JJ. Evidence was also held admissible in this case as to alleged statements of the defendants' salesmen that the goods were English. The case was remitted on these points, but the summons was dismissed, both the alleged custom and the statements above mentioned having been held not to be proved. An appeal by case stated by the Board of Trade was proposed, but not taken. See 32 L. J. p. 262.

(*k*) *Ex parte Nasmith*, 2 T. L. R. 339 (1886).

(*l*) *Cameron* v. *Wiggins* (1901), 1 Q. B., Lawrance and Kennedy, JJ.

(*m*) See Mr. Seymour's evidence, M. M. A. Report, 1890, Q. 4824.

(*n*) False trade description as to the material of which any goods are composed.

because, in most instances, they bear no trade description as defined by sects. 3 and 5 of the said Act. Your Committee are of opinion that much harm is being done to legitimate trade by the impunity with which spurious articles are introduced into this country. They therefore propose that the Act should be amended by making the Customs 'entry,' which must bear a description of the goods imported, a 'trade description' within the meaning of the Act. The adoption of this amendment would, in the opinion of your Committee, give the Customs power to detain goods, the 'trade description' of which is false as to the material of which they are composed."

No general obligation to mark the place of origin.

The Committee refused to recommend that it should be made compulsory to mark all goods with an indication of origin, on the ground that this "would seriously restrict trade, and virtually destroy the business of warehousemen, commission agents, and small masters."

False trade description (*o*).]—By **sect. 3** (1)—

What is a false trade description.

"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 last part of the definition would have been more appropriately placed in the definition a "trade description" (*p*).

The "false name or initials of a person" is specially dealt with by sect. 3 (3) (*q*), and the definition just stated is expanded by sect. 3 (2), which is set out below (*r*).

So that "false trade description" under the Act includes—

(1. A trade description false in a material respect as regards the goods to which it is applied.

(*o*) "Trade description," p. 570.
(*p*) "Trade description," p. 570.
(*q*) Below, p. 590.
(*r*) Page 588.

(2.) An alteration of a trade description, whether false or not, such as to make it false in a material respect.

(3.) Figures, words, or marks, or an arrangement or combination thereof, such as are reasonably calculated to lead persons to believe that the goods to which they are applied are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really are (sect. 3 (2)).

(4.) A false name or initials within sect. 3 (3) (*s*).

False.]—False is construed by the Customs authorities in the application of sect. 16 to mean, not "misleading" but simply "untrue" (*t*). It is immaterial that the buyer was not deceived (*u*). The expression "false description" is taken from the Act of 1862, s. 7, where it certainly means a description intended to deceive, since it is coupled with the phrase "for the purpose of falsely indicating, &c.," but the construction just mentioned seems, on the whole, to be that intended by the Act, for *false* is contrasted with *genuine* in sects. 2 (2) (a), 4 (b), 6 (c), and 17; false declarations are referred to in sect. 8 (3); and sect. 18 seems to contemplate that some false descriptions within its scope may not be misleading. It is doubtful, however, whether, for the purposes of the Act, there is any substantial difference in effect between the two meanings. The essence of a description is that it should suggest something, and if it suggests what is untrue it is misleading.

In *The Patent Isinglass Case* (*v*), Coleridge, L. C. J., said that a false description within the Act meant something more than a mere inaccurate or mistaken description. There must be a criminal intent, a *mens rea* in the application; this is inferred because the Act creates criminal offences, and the construction adopted is consistent with the reference to "intent to defraud" in sect. 2 (1), and the defence that the person charged had "acted innocently," which is admitted by sect. 2 (2).

(*s*) Below, p. 590.

(*t*) See Mr. Follett's evidence, *ante*, p. 572, n. (*q*).

(*u*) See *Kirchenheim* v. *Salmon & Gluckstein*, (1898) 2 Q. B. 19; 67 L. J. Q. B. 601, Lord Russell of Killowen, C. J., Hawkins, Day, Wills, and Wright, JJ.

(*v*) *Gridley* v. *Swinborne*, 52 J. P. 739, 791: 5 T. L. R. 71 (1888).

Material respect.

False in a material respect.]—This expression was chosen, after much consideration, to meet the case of descriptions which are partly false; for instance, descriptions of mixed or composite goods, referring to some or one only of their composite parts. The clause was inserted "because it was considered impossible to test the exact percentage of a particular material, the name of which was assigned to the article" (*x*). Under it, the Court is left to decide as a question of fact whether it is false, for example, to describe textile goods made partly of cotton as *natural wool* (*y*); a material consisting entirely of cotton as "flannelette" (*z*); a cask containing less than thirty-six gallons of beer as a barrel (*a*); gelatine made from cod sounds as patent isinglass (*b*); or a watch with an English case and an English movement but a Swiss regulator, as an English watch (*c*); or, generally, goods partly made in the United Kingdom and partly abroad, as made in the United Kingdom (*d*).

Materially or substantially false.

"False in a material respect" is here treated as equivalent to materially or substantially false, so that the question is one of degree, and as regards some of the attributes referred to in the definition of trade description, no other meaning could be given to it. A description of weight, for example, can only be false by being too great or too small. But, as regards some of the other attributes referred to, the phrase seems more properly to mean that the matter falsely stated is material to be truly stated to the persons concerned, that is, the probable buyers, or others to whom the description is addressed. For example, if goods go through different stages in the course of manufacture in different countries, it is conceivable that only the country where they are finished, or where any other

(*x*) See the evidence of Mr. Courtenay Boyle, assistant secretary to the Board of Trade, M. M. A. Report, 1887, Qq. 38 *et seq.*

(*y*) See *The Leicester Case*, *ante*, p. 578, *Times* Newspaper, Oct. 20, 1893.

(*z*) *Whitley's Case*, *Times*, Jan. 16, 1895.

(*a*) *Budd* v. *Lucas*, (1891) 1 Q. B. 408.

(*b*) *Gridley* v. *Swinborne*, 52 J. P. 739, 791; 5 T. L. R. 71 (1888).

(*c*) As to watches, see *Williamson* v. *Tierney*, 17 T. L. R. 174 (1900) (*English Lever*), and above, p. 575; also sect. 7, below, p. 620. It is said that all English watches have Swiss regulators.

(*d*) See p. 574, "place or country," and *R.* v. *Lipton*, *ante*, p. 577.

particular stage is passed, is material to be named (*e*), and that, therefore, for the purposes of the Act, the goods may be well described only as made in that country (*f*). So, if the material of which goods are made is a metallic alloy, as the gold of commerce, it may be immaterial to state truly the nature of the baser metal (provided there is no false statement as to its absence, or its proportion in the mixture).

Doctrine of equivalents inapplicable.

The materiality of a false trade description cannot be made dependent on a "doctrine of equivalents." If an article is sold under such a description—*e.g.*, machine-made cigarettes as "guaranteed hand-made"—the false description will not cease to be material because the article sold was as good as, or better than, that asked for by the purchaser (*g*).

Limits of error allowed.

The Committee of 1890 were strongly urged to recommend the adoption, as part of the Act, of certain definite limits in regard to measure, within which a deficiency from the measure actually indicated by a trade description should not be, but beyond which it should be deemed to be, false in a material respect; but they declined to suggest the enactment as a rule of law of what they regarded as properly a matter of evidence.

The limits suggested by the Manchester Chamber of Commerce in 1888, and adopted under the Indian Merchandise Marks Act, are set out in the Appendix (*h*).

Alteration of a trade description.

Alteration.]—The person who makes the alteration which causes the trade description to be false, applies the false trade description (*i*).

This clause of the definition relates only to alterations of the description, not to alterations of the goods described so that the description becomes false as applied to them. An

(*e*) Cf. the case of watches, below, p. 622.

(*f*) But see *Bischop* v. *Toler*, 65 L. J. M. C. 1 (1895), *ante*, p. 574.

(*g*) *Kirschenboim* v. *Salmon & Gluckstein*, (1898) 2 Q. B. 19; 67 L. J. Q. B. 601, Lord Russell of Killowen, C. J., Hawkins, Day, Wills, and Wright, JJ. The term "hand-cut" has been held by a Metropolitan police magistrate to be a false trade description when applied to machine-cut tobacco: *Cohen, Wrenn & Co.'s Case*, *Times*, May 3, 1899.

(*h*) Page 863. M. M. A. Report, 1890, p. 322. Evidence of Mr. Bailey, Q. 2024.

(*i*) Cf. forgery of a trade-mark by altering a genuine trade-mark, sect. 4 (b), above, p. 563.

alteration, for example, by the adulteration of marked goods, such as to make them cease to be the goods described, may be an offence against the Act, if, within sect. 5 (1) (c) or (d), the person making the alteration applies the description to the altered goods, since it is false as regards them.

Application of false trade description.

Applies any false trade description.]—Sect. 5 defines when a person shall be deemed to apply a trade description to goods. It has been already set out (*k*).

By **sect. 3**—

"(2.) The provisions of this Act respecting the application of a false trade description to goods shall extend to the application to goods (*l*) of any such figures (*m*), words (*n*), 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."

This sub-section does not in terms refer to goods to which a false trade description has been applied, as the next and corresponding sub-sect. 3 (3) does. It is difficult to see any reason for the change of language, and, it is submitted, it makes no difference in the construction of the Act, for it is not possible to extend the definition of "application" without extending correspondingly the class of things to which the application is made.

The name *Chilworth Gunpowder Co., Ld.*, placed by contractors for the supply of gunpowder to the Government, upon barrels of powder, in the place where the name of the contractor was required to be inserted, was held in *Stacey* v. *Chilworth Gunpowder Co.* (*o*) to be a false trade description, the powder being imported German powder, and not the manufacture of the defendants, and it being clear, as the Court held, that, in the particular case, contractor meant manufacturer, the defendants having dealt with the Govern-

(*k*) Above, p. 567.

(*l*) See sect. 5, above, p. 567.

(*m*) *I.e.*, numerals. *Ex parte Stephens*, 3 C. D. 659 (1876), Jessel, M. R.

(*n*) For names and initials, see sect. 3 (3), below, p. 590.

(*o*) 24 Q. B. D. 90 (1889), Coleridge, L. C. J., and Mathew, J.

ment as manufacturers only, although it is commonly a word of ambiguous meaning, capable of signifying either maker or vendor, or both. This decision must have been under sect. 3 (2), for sect. 3 (3) did not apply; but the question suggested above was not argued or referred to.

An unregistered trade-mark may be a trade description.

The sub-section makes the offence of applying a false trade description include that of forging a (registered) trade-mark, which is itself a separate offence under sect. 2 (1) (a), and also that of forging a trade-mark which is unregistered and not a trade-mark within the meaning of the Act (*p*), for the office of a trade-mark is to indicate that goods are the manufacture or merchandise of the persons with whose business or goods the trade-mark is identified by registration or use.

Names and initials.

The following sub-section deals with false names and initials. That sub-section may possibly be held to be restricted to a very small class of such names and initials (*q*), and the question may then arise whether names and initials which are so used as not to fall within it, are *words* within the present sub-section. On a strict construction it may be difficult to hold that a general word in one sub-section can include a particular meaning introduced by an appropriate word into a co-ordinate sub-section immediately following the first; but there are many cases of overlapping sections and provisions in the present Act, and, if it be necessary in order to carry out the obvious intention of the Act, it is submitted that the interpretation suggested ought to be adopted.

Calculated to lead persons to believe, &c.

Calculated to lead, &c.]—The phrase may be compared with "calculated to deceive," of sect. 2 (2) and sect. 4 (a) (*r*), and with "intent to defraud" of sect. 2 (1) (*s*). The persons intended are any class of probable purchasers of, or dealers in, the goods, so that it would be no defence to prove that the immediate purchasers, the persons to whom the goods falsely described were sold, if the offence were committed upon a sale, were not in fact deceived. This is the rule adopted in infringement cases (*t*). In such cases proof of

(*p*) See sect. 3 (1), above, p. 560. "trade-mark."

(*q*) See below, p. 591.

(*r*) Above, p. 565.

(*s*) Page 603, *post*.

(*t*) See Book I., Chap. X., p. 224; Chap. XV., p. 378.

actual deception is not a necessary part of the plaintiff's case (*u*), although its unexplained absence may be significant, if the alleged deceptive mark has been long in the market (*x*); and it is no excuse for the defendant to show that the actual buyers from him of the spuriously marked goods knew whose goods they were. They generally do know, and are parties to the intended frauds (*y*).

(4.) By sect. 3—

False name or initials.

"(3.) The provisions of this Act respecting the application of a false trade description to goods, or respecting goods to which a false trade description is applied (*z*), shall extend to the application to goods of any false name or initials of a person (*a*), and to goods with the false (*b*) name or initials of a person applied, in like manner as if such name or initials were a trade description, and for the purpose of this enactment the expression false name or initials means, as applied to any goods, any name or initials of a person which—

"(a) are not a trade-mark (*c*) or part of a trade-mark, and

"(b) are identical with, or a colourable imitation of the name or initials of a person carrying on business in connection with goods of the same description, and not having authorized the use of such name or initials, and (*d*)

"(c) are either those of a fictitious person or of some person not *bonâ fide* carrying on business in connection with such goods."

This is an awkwardly drawn sub-section, not in harmony with the remainder of the Act. The insertion of the negative clause (a), for instance, is not in accord with the general plan of allowing sections creating similar and similarly punished offences to overlap, and the expression colourable imitation

(*u*) Above, p. 375.

(*x*) Page 249.

(*y*) *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 472 (1887), C. A., cited p. 427.

(*z*) This clause is omitted from the last sub-section 3 (2).

(*a*) "Person," sect. 3 (1), p. 558.

(*b*) Cf. "false trade description," sect. 3 (1), p. 584, and "falsely apply," sect. 5 (3), p. 569.

(*c*) "Trade-mark," *i.e.*, registered trade-mark, sect. 3 (1), p. 560.

(*d*) *Quære*, "or." see p. 591.

is in other sections represented by the phrase "so nearly resembling, &c."

The sub-section seems to be intended to extend the protection of the Act to trade-names which are protected by the civil law much in the same way as trade-marks (*e*), and also to stay frauds perpetrated by the use of "blind names" (*f*), that is, names belonging, in fact, to no one, but so used as to appear to be the names of respectable firms.

By the letter of the sub-section, a name or initials, to fall within its terms must fulfil each of the conditions (a), and (b), and (c); but it is submitted that the second *and* should be *or*, for no name can be identical with the name of a person carrying on business in connection with the goods, and at the same time be that of a person not *bonâ fide* so carrying on business (*g*). The Courts have no difficulty in reading *or* for *and* where the context requires it (*h*).

Reading (b) and (c) as alternatives, the operation of the sub-section is to forbid the use of any false name or initials (not being a registered trade-mark (*i*), or part of a registered trade-mark) which is either an unauthorized copy or imitation of a trade-name or trade-initials, or is the trade-name or trade-initials of no one, or no one *bonâ fide* carrying on business, *i.e.*, is a "blind name." If this is the correct view of the sub-section, it is an offence within sect. 2 (1) (d) or sect. 2 (2), to apply to any goods any name or initials of a person other than the trade-name of a person who has authorized the application, or to sell, &c., any goods to which any name or initials of a person, other than the trade-name of a person applied with his authority, have been applied.

For the civil law relating to trade-names, see Book I., Chap. XVI., and for the right of a man to honestly use his own name in his trade, p. 500.

(*e*) See Book I., Chap. XVI., p. 446.

(*f*) Below, p. 593.

(*g*) The view suggested has now been adopted by the Q. B. D. in Ireland, *R.* v. *Lipton*, *infra*, p. 594.

(*h*) As in *Townsend* v. *Read*, 10 C. B. N.S. 317; 30 L. J. M. C. 245; and see Stroud's Dictionary, "or for and."

(*i*) Or trade-mark which, either with or without registration, is protected by law in any British possession or foreign state to which the provisions of sect. 103 of the Act of 1883 are applied. See p. 560.

Name.]—"The expression 'name' includes any abbreviation of a name" (*k*).

False name or initials.]—The adjective false governs the whole sub-section. Its effect seems to be to restrict the operation of the section to names and initials which are not the personal or the trade-names or initials of the persons applying them (*l*).

(a) *Not a trade-mark.*]—Trade-mark means trade-mark registered or otherwise within sect. 3 (1) (*m*). Many trade-marks consist of or include the names of their proprietors, or of the predecessors in trade of their proprietors, and a trade-name, if used in connection with the goods which its owner deals in, almost necessarily becomes a trade-mark if it is distinctive (*n*). The reason for excluding trade-marks and parts of trade-marks, seems to be that they are elsewhere dealt with under the heads of forgery and false application of a trade-mark (*o*); but this is not the case as regards parts of a trade-mark which do not so nearly resemble the trade-mark as to be calculated to deceive within the meaning of sect. 4 (*p*). Trade-marks which are or include names or initials, and which do not fall within the definition (*q*), are included within this sub-section if they comply with conditions (b) and [or] (c).

(b) *A colourable imitation, &c.*]—This expression is commonly used in infringement and passing off cases. It is equivalent to the phrase, used elsewhere in the Act, so nearly resembling as to be calculated to deceive (*r*), which has been already discussed.

Of the same description.]—Both trade-mark and trade-name rights are limited to the class of goods for which they are registered or used (*s*).

(*k*) Sect. 3 (1).

(*l*) Cf. "false," above, p. 585; and see p. 593, below.

(*m*) Page 560, "trade-mark."

(*n*) See Book I., Chap. VIII., p. 124, "name-marks."

(*o*) Sect. 2 (1) (a), p. 560; and 2 (1) (b), p. 567.

(*p*) Page 563.

(*q*) Page 560, "trade-mark."

(*r*) Sect. 4 (a), p. 565.

(*s*) See Book I., Chap. V., p. 96.

Not having authorized.]—This is more generally expressed than "without the assent of the proprietor," which is the phrase used elsewhere in the Act (*t*), and already discussed, but it has probably just the same meaning. Proof of authority of proprietor.

There is no provision in the present sub-section casting the onus of proving the authority in question upon the defendant. This is probably due to an oversight.

(c) *Either those of a fictitious person or of some person not bonâ fide carrying on business in connection with the goods.*]—Apart from this Act it is perfectly legal, and the practice is very common, for a trader to use as his trade-name some name other than his own, and either the name of his predecessors in business, or a name chosen for some other reason, not being such a name as to infringe the rights of any other person in respect of his trade-name (*u*). It is submitted that the Act does not make the practice illegal, but that the above sub-section, under clause (c), is directed against the application to goods of any name which is not the trade-name of the person who applies it, whether that trade-name is his personal name or not, for the whole sub-section is governed by the use of the words "false name" and "false name or initials," and the trade-name of the person using it is not a false name, nor are his trade-initials false initials (*x*). Trade-name of repute.

Evidence was given before the Committee of 1887 (*y*) of the fraudulent use of well-sounding names which were not trade-names at all, and were used, not to identify the goods to which they were applied with the person applying them, or with any other manufacturer or merchant, but to suggest that they were the manufacture or merchandise of some seemingly respectable firm. Spanish sounding names on pseudo Spanish cigars; "The Sheffield Knife Company," there being no such company, and the trade-names of defunct firms, were cited as examples of such "blind names" as they are called. Sub-sect. 3 (3) (c) seems to have been directed to Blind names.

(*t*) Sect. 4 (a), p. 563; sect. 5 (3), p. 569.

(*u*) Book I., Chap. XVI., p. 463.

(*x*) Cf. as to the meaning of false, p. 585, above.

(*y*) See, for instance, the evidence of Mr. Freeman, M. M. A. Report, 1887, Qq. 2871 *et seq.*; of Mr. Hughes, *ibid.* Q. 1805; and Mr. Lockwood, *ibid.* Q. 1992.

stop the use of such names as these. It was stated before the Committee of 1890, that the Act had failed in this particular (z), but the statement was made under the assumption that the conditions (a), (b), and (c) were all required to be complied with, (b) and (c) not being treated as alternative, as is suggested above. The Committee did not think fit to recommend any alteration of the sub-section.

Fictitious.]—The words "a fictitious or non-existing person," in sect. 7 (3) of the Bills of Exchange Act, 1882, have been held to apply to a case where the name used, as that of the payee of a forged bill, was the name of an actual person who was known to the acceptor and accustomed to have business dealings with him, but who had not, and was never intended by the drawer to have, any interest in the bill (*a*).

The description of bacon cured by Lipton as "Tracey's cure," where Tracey was Lipton's foreman curer, has been held, in Ireland, to be an offence under sect. 3 (3) (c); although a custom was alleged for bacon dealers to describe their second quality goods by the names of their foremen curers (*b*). No evidence of the custom was adduced.

Not bonâ fide *carrying on business, &c.*]—The name and initials of a person who is carrying on business in connection with the goods are dealt with under the preceding head, sect. 3 (3) (b).

Provisions of the Act as to false description not to apply in certain cases.

Conventional description.]—By sect. 18—

"Where at the passing of this Act (*c*), a trade description is lawfully and generally applied to goods of a particular class, or manufactured by a particular method, to indicate the particular class or method of manufacture of such goods, the provisions of this Act with respect to false trade descriptions shall not apply to such trade description when so applied: Provided that where such trade description includes the name of a place or country,

(z) Evidence of Mr. Hughes, M. M. A. Report, 1890, Q. 5011, and Mr. Follett, p. 277.

(*a*) *The Governor and Company of the Bank of England* v. *Vagliano Brothers*, (1891) A. C. 107; *Clutton* v. *Attenborough*, (1897) A. C. 90; 66 L. J. Q. B. 221.

(*b*) *R.* v. *Lipton*, 32 L. R. Ir. 115 (1892), Q. B. D.

(*c*) 23 August, 1887.

and is calculated to mislead as to the place or country where the goods to which it is applied were actually made or produced, and the goods are not actually made or produced in that place or country, this section shall not apply unless there is added to the trade description, immediately before or after the name of that place or country, in an equally conspicuous manner, with that name, the name of the place or country in which the goods were actually made or produced, with a statement that they were made or produced there" (*d*).

This general saving with regard to what are commonly called "generic descriptions," but may more accurately be termed "conventional descriptions," seems to have been suggested by a discussion which took place before the Committee of 1887, as to whether the name *Balbriggan hose* (*dd*) was properly applied to hosiery manufactured in Ireland, at Balbriggan only, or to hosiery of the same description made at several places in England, and in particular at Nottingham. It is based upon the fact that descriptions at first applied to, and appropriate for, a group within a class, constantly become used for the whole class, and are at length as appropriate for the rest of it as for the particular group. The case of trade-marks in this way become *publici juris* by piracy, misuse or abandonment, has been several times noticed in the preceding book (*e*). *Liebig's Extract*, *American leather cloth*, *French chalk*, *patent leather*, are examples of conventional descriptions within the section. The question whether an alleged conventional description does indicate the particular class or method of manufacture of the goods, *i.e.*, the kind of goods, is of course a question of fact to be established by evidence. It corresponds to the question whether an alleged trade-mark or trade-name of goods was the symbol or name of any goods of the kind, or the symbol or name of the plaintiff's goods of the kind only, which constantly arose for determination in trade-mark cases before the Registration Acts, and still frequently arises in trade-name and passing off cases (*f*).

(*d*) Cf. p. 574, "place or country," and see the Madrid Convention, Art. IV., App., p. 772.

(*dd*) As to this instance, see Trade-Marks (India), Appendix, p. 866, and p. 634.

(*e*) See Chap. XIV., p. 338.

(*f*) See above, pp. 36 and 477.

It is to be noted that the section only applies to trade descriptions lawfully and generally applied at the passing of the Act.

"Lawfully" must mean not only so as not to be obnoxious to any then existing trade-name or trade-mark rights, or to particular statutes such as the Cutlers Acts (*g*), but also so as not to be within the prohibitions of the M. M. A. of 1862. That Act, however, contained a section (sect. 9) corresponding to sect. 18, but not limited to descriptions in use at the commencement of the Act. "Generally applied" means, it is submitted, applied by probable purchasers and persons dealing in the goods in question.

In *The Patent Isinglass Case* (*h*), the Court held that a good defence might have been raised under this section upon the finding of the magistrate that the article in question had been known to the trade as patent isinglass, although it was made from cod sounds. But it may be doubted whether such a finding would be sufficient if it were shown that the description deceived the public, although it was understood by the trade (*i*).

4. Causing an Offence to be Committed.

"(f) Causes any of the things above in this section mentioned to be done."

Sect. 2 (1). Master and servant.

Master and servant.]—The provisions of sect. 2 (2) of the M. M. A., 1887, make a master criminally liable for acts done by his servants in contravention of the section when acting within the general scope of their employment, although contrary to their master's orders, unless the master can show that he has acted in good faith and has done all that it was reasonably possible to do to prevent the commission of offences by his servant (*k*).

(*g*) Below, p. 641.

(*h*) *Gridley* v. *Swinborne*, 52 J. P. 739, 791; 5 T. L. R. 71 (1888), Coleridge, L. C. J., and Grantham, J. See also per Holmes, J., in *R.* v. *Lipton*, p. 594, note (*b*).

(*i*) See *Ford* v. *Foster*, L. R. 7 Ch. 611, cited p. 37, and above, p. 342. And see *Hooper* v. *Balfour*, W. N. (1890) 61, 139, cited *ante*, p. 574, under "weight."

(*k*) *Coppen* v. *Moore* (No. 2), (1898) 2 Q. B. 306; 67 L. J. Q. B. 689 (overruling a dictum of Pollock, B.,

By sect. 19 (3)—

"Nothing in this Act shall be construed so as to render liable to any prosecution or punishment any servant of a master resident in the United Kingdom who *bonâ fide* acts in obedience to the instructions of such master, and, on demand made by or on behalf of the prosecutor, has given full information as to his master."

It seems an obvious inference from this section and from sect. 6 (*l*), relating to persons employed by others in the ordinary course of business, that servants and persons employed who do not come within the terms of the sections are to be liable for acts done in obedience to the instructions of their masters or employers (though they may, of course, be able to show that they acted without intent to defraud, or innocently). And this accords with the ordinary law that every person who either actually does, or authorizes, or procures to be done, a criminal act is guilty of the crime (*m*).

Thus, under the Pharmacy Act, 1868 (*n*), an unregistered chemist's assistant has been held liable to penalties for selling poisons on behalf of his master who was himself duly registered.

Both sect. 19 (3) and sect. 6 are restricted to cases of masters or employers resident in the United Kingdom.

Bonâ fide.]—It is difficult to attach any definite meaning to this expression in the section. It can hardly be construed to import the requirements of reasonable precaution, and having no reason to suspect the genuineness of the trade-mark or trade description, expressed in sect. 6 (b) and (c). It may mean without knowledge of the illegal character of the act, or merely that the person excepted has in reality, and not colourably only, acted as a servant and in obedience to his master's instructions. The last meaning suggested, however, would make the words mere surplusage.

in *Budd* v. *Lucas*, (1891) 1 Q. B. 408), Lord Russell of Killowen, C. J., Sir F. H. Jeune, P., Chitty, L. J., Wright, Darling, and Channell, JJ.; and see further, as to the nature of the defence in such cases, *infra*, pp. 601, 609.

(*l*) See next page.

(*m*) See Archbold, 22nd ed., pp. 10 *et seq.*; and sect. 11, below, p. 690.

(*n*) 31 & 32 Vict. c. 121, s. 15. *The Pharmaceutical Society* v. *Wheeldon*, 24 Q. B. D. 683 (1890), Div. Court. An action for penalties,

On demand has given full information.]—Compare sect. 2 (2) (b), (*o*), and sect. 6 (d).

Persons employed.]—By sect. 6—

Exemption of certain persons employed in ordinary course of business.

"Where a defendant is charged with making any die, block, machine, or other instrument for the purpose of forging, or being used for forging a trade-mark, or with falsely applying to goods any trade-mark or any mark so nearly resembling a trade-mark as to be calculated to deceive, or with applying to goods any false trade description, or causing any of the things in this section mentioned to be done, and proves—

"(a) That in the ordinary course of his business he is employed, on behalf of other persons, to make dies, blocks, machines, or other instruments for making, or being used in making, trade-marks, or as the case may be, to apply marks or descriptions to goods, and that in the case which is the subject of the charge he was so employed by some person resident in the United Kingdom, and was not interested in the goods by way of profit or commission dependent on the sale of such goods; and

"(b) That he took reasonable precautions against committing the offence charged; and

"(c) That 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

"(d) That he gave to the prosecutor all the information in his power with respect to the persons on whose behalf the trade-mark, mark, or description was applied—

he shall be discharged from the prosecution, but shall be liable to pay the costs incurred by the prosecutor, unless he has given due notice to him that he will rely on the above defence."

This section appears, in effect, to offer to any person charged with either of the offences mentioned in it the alternative of satisfying the four requirements specified in it, or of proving that he acted without intent to defraud within the meaning of sect. 2 (1) (*p*). It is probable that

(*o*) Page 609, below.

(*p*) *Infra*, p. 603, "intent to defraud."

the latter will usually be the easier course, and it is submitted, although with some doubt, that in judging whether the defendant has acted without intent to defraud, the fact that he has not acted as the section indicates,—for instance, has taken no precautions,—is not to be regarded where he shows that he did not know, believe, or suspect, that the mark or description in question was forged, or false, or falsely applied.

The Bleachers' protest.

Much evidence was given before the Committee of 1887 on behalf of the Association of Bleachers, whose members are accustomed in the ordinary course of their business to mark trade-marks and descriptions upon goods, and to pack the goods according to their customers' orders, to show that from the enormous number of the marks (*q*) and descriptions employed in the textile trade, and the fact that many contain words in Oriental languages with which the bleachers are not acquainted, it would be a great hardship to cast upon them the duty of verifying the title to, and the genuineness of every mark furnished to them by their customers. The association presented a memorial to the chairman of the Committee protesting against the Bill under their consideration in its then form, and suggested for insertion into it a section nearly corresponding to the present section, but without the modifications (b), (c), and (d). The section was, no doubt, based upon these representations and proposals (*r*).

Clauses 2 (1) (a) ("forges any trade-mark"), and 2 (1) (e) ("disposes of or has in his possession any die, &c. for the purpose of forging a trade-mark") are omitted from the section, and so also is sub-sect. 2 (2) ("exposing, &c. for sale goods to which a forged trade-mark, &c. has been applied").

The first condition (a) is triple, so that the person charged must prove in all six propositions to bring himself within the section.

Precautions:—Information.]—Clauses (b) and (c) correspond to clause (a) of sect. 2 (2); clause (d) to clause (b) of sect. 2 (2), (*s*), except that the words "on demand made by

(*q*) 60,000 cotton marks were registered as trade-marks before 1887. There were probably many more unregistered, but in use.

(*r*) M. M. A. Report, 1887, pp. 254, 266.

(*s*) See below, pp. 604, 608.

or on behalf of the prosecutor" are there inserted. Under the present section, it seems, the party charged must volunteer the information if it is not demanded, but, on the other hand, he can give it at any time down to the hearing of the charge.

Costs.]—Compare sect. 14 (*t*). This penalty is omitted from sect. 2 (2), because the information there referred to must be given on demand as a condition of the special defence allowed by the sub-section.

Accessories.

Accessories.]—The offences dealt with by the Act are all misdemeanours, and there are, accordingly, no accessories to them. The provision of the Act of 1862 (sect. 13) making every person who shall aid, abet, counsel, or procure the commission of an offence under the Act guilty of a misdemeanour, has not been introduced into the present Act, and any such person can, consequently, only be convicted of an offence if he has committed it as a principal under sect. 2 (1) (f) ("causes any of the things above in this section mentioned to be done"), or under one of the special headings. Sect. 11, set out below, is not directed to the punishment of accessories generally, as the side-note wrongly suggests, but to the punishment of offences committed abroad.

Punishment of accessories [to offences committed abroad].

Offences committed abroad.]—By **sect. 11**—

> "Any person who, being within the United Kingdom, procures, counsels, aids, abets, or is accessory to the commission, without the United Kingdom, of any act, which, if committed in the United Kingdom, would under this Act be a misdemeanour, shall be guilty of that misdemeanour as a principal, and be liable to be indicted, proceeded against, tried, and convicted in any county or place in the United Kingdom in which he may be, as if the misdemeanour had been there committed."

The side-note to this section in the Queen's Printers' copy (punishment of accessories) is misleading. The section is directed to meet offences committed abroad by persons in the

(*t*) Page 616, below. Similar penalties as to costs are imposed by the Margarine Act, 1887 (50 & 51 Vict. c. 29), s. 7, and the Sale of Food and Drugs Act, 1875 (38 & 39 Vict. c. 63), s. 25.

United Kingdom. In general, offenders can only be prosecuted in the counties or districts where their offences were committed (*u*), and penal Acts are to be read, if possible, as not creating any offence to be committed outside the country for which they are enacted (*x*).

The Civil Courts will interfere by injunction to prevent steps being taken, or anything done within the jurisdiction, with a view to, or for the purpose of, infringing the plaintiff's trade-mark, or passing off goods as his abroad (*y*).

5. Defences under Sect. 2 (1).

The sub-section concludes with the words "shall, subject to the provisions of this Act, and unless he proves that he acted without intent to defraud, be guilty of an offence against this Act."

The provisions of the Act referred to are sect. 6 (*z*) (persons employed); sect. 13 (*a*) (vexatious indictments); sect. 15 (*b*) (limitation for prosecutions); and sect. 19 (3) (*c*) (servants acting under their masters' orders).

Unless he proves (*d*).]—The policy of the Act is, when once it has been established that a trade-mark has been made without the assent of the proprietor, or that a false description has been applied to goods, or that goods to which a forged trade-mark has been applied have been sold by the person charged (*e*), or any other thing done which, if done

Proof of innocence.

(*u*) See *Archbold*, 22nd ed., pp. 34 *et seq.* There are many exceptions by statute. See, in particular, as regards the places mentioned in the list at p. 763, 53 & 54 Vict. c. 37.

(*x*) *Macleod* v. *Att.-Gen. for New South Wales*, (1891) A. C. 455.

(*y*) *Rodgers & Son, Ld.* v. *Rottgen*, 5 T. L. R. 678 (1889), Kay, J.; *Société Anonyme des Verriers de l'Etoile's Tm.*, (1894) 1 Ch. 61; (1894) 2 Ch. 26; 10 R. P. C. 436; 11 R. P. C. 142, Stirling, J., and C. A.

(*z*) Page 598.

(*a*) Page 615.

(*b*) Page 615.

(*c*) Page 597.

(*d*) Cf. the second part of sect. (2), p. 607, and the Food and Drugs Act, 1875 (38 & 39 Vict. c. 63), s. 24, by which, if a defendant relies on any provision or exception in the Act, he must prove that he falls within it.

(*e*) The master is *prima facie* liable for the act of his servant, being within the scope of his employment, even though contrary to his orders,

with such a criminal intent as is contemplated by the Act, would be an offence, to cast upon the person charged the onus of disproving the existence of such intent, and this is carried further by casting upon him also the onus of proving the assent of the proprietor (*f*), where that is material. Great stress was laid upon this feature of the Act when the Bills upon which the Act was founded were before the Committee of 1887, as the almost total failure of the Act of 1862 was believed to be due to the necessity for the prosecutor in prosecutions under it to prove the intent to defraud (*g*). There are now upon the statute book a good many Acts by which the onus of proof of justification or excuse is cast on the person charged (*h*). For instance, the application of any of the marks scheduled to the Public Stores Act, 1875 (*i*), without authority (proof of which authority lies on the party accused), is a misdemeanour; and so is being found at night having in possession house-breaking implements without lawful excuse (proof of which excuse lies on the party charged) (*k*). Purchasing, or receiving, or having in possession forged bank-notes or bills, knowing them to be forged (*l*), and making or having in possession coining tools (*m*) without lawful authority (the proof of which authority lies on the party accused), are felonies. The Sale of Food and Drugs Act, 1875 (*n*), and the Margarine Act, 1887, are other instances (*o*).

but may meet that *prima facie* case successfully by showing that he acted without intent to defraud: *Coppen* v. *Moore* (No. 2), (1898) 2 Q. B. 306; 67 L. J. Q. B. 689, Lord Russell of Killowen, C. J., Sir F. H. Jeune, P., Chitty, L. J., Wright, Darling, and Channell, JJ.

(*f*) Sect. 4; sect. 3 (3). Proof of the authority required under sect. 3 (3) (b) is not thrown on the person charged.

(*g*) M. M. A. Report, 1887. See the evidence of Messrs. Hughes, Lockwood, and Uttley. The Committee of 1862 were strongly urged to report in favour of the insertion of similar provisions as to the onus of proof in the Act of that year, but they declined to do so. M. M. A. Report, 1862, evidence of J. T. Smith, Q. 2643.

(*h*) See a paper by Mr. J. T. Smith in M. M. A. Report, 1862, p. 162.

(*i*) 38 & 39 Vict. c. 25, s. 4.

(*k*) 24 & 25 Vict. c. 96, s. 58.

(*l*) 24 & 25 Vict. c. 98, s. 13.

(*m*) 24 & 25 Vict. c. 99, s. 24.

(*n*) See sects. 5 and 8. *Betts* v. *Armstead*, 20 Q. B. D. 771.

(*o*) Cf. also the presumption of guilty knowledge from evidence of possession of recently stolen goods. Archbold, 22nd ed., p. 313.

And by the common law, wherever the act charged is not indifferent, but in itself unlawful, the proof of justification or excuse in such case lies on the defendant, and on failure thereof, the law implies a criminal intent (*p*).

Intent to defraud.]—This does not mean intent to defraud any particular person (*q*). So that an offence may be committed, although precautions are taken to prevent the immediate purchaser from the person charged being deceived, as, for example, by adding to a false trade description upon a covering a label which bears the name of the person whose manufacture or merchandise the goods within the covering really are, or which is otherwise explanatory, for the label may be intended to be removed, and the goods passed on to the ultimate purchasers with the false trade description unqualified (*r*). Intent to defraud.

The provision of the Act of 1862, s. 12, that, where in proceedings in respect of an offence under that Act it should be necessary to allege or mention an intent to defraud, it should not be necessary to allege or prove an intent to defraud any particular person (*s*), has not been reproduced, probably because the onus of proof has, in the present Act, been shifted to the person charged. It appears that the absence of the provision makes no difference to the effect of the Act.

"The words 'intent to defraud' in this Act mean more than an intent to cheat a customer." They apply to cases "where a person uses a particular mark without any intent in so doing to induce a buyer to accept goods which might otherwise be rejected" (*t*). And in a case where the offence consisted in English manufacturers placing their name on

(*p*) Per Lord Mansfield, *R.* v. *Woodfall*, 5 Burr. 2667, note (1).

(*q*) *Wood* v. *Burgess*, *infra*. Cf. forging a trade-mark, above, p. 563, note (*u*).

(*r*) *Wood* v. *Burgess*, 24 Q. B. D. 162 (1889), Coleridge, L. C. J., and Mathew, J., a case under sect. 2 (2). And cf. "so nearly resembling," sect. 4 (a), *ante*, p. 565, and "calculated to lead," sect. 3 (2), above, p. 589; and the civil law rule, above, pp. 225, 381, and *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), C. A.

(*s*) Similar sections occur in 24 & 25 Vict. c. 98, s. 44 (forgery), 24 & 25 Vict. c. 96, s. 88 (false pretences), and 24 & 25 Vict. c. 97, s. 58 (malicious injuries to property).

(*t*) Per Mathew, J., in *Starey* v. *Chilworth Gunpowder Co.*, 24 Q. B. D. 90 (1889). See also the judgment of Channell, J., in *Christie, Manson & Woods* v. *Cooper* (1900), 2 Q. B. 522.

goods manufactured by other persons, but equal in quality to their own (*u*), Coleridge, L. C. J., said: "In the present case all further controversy is superfluous when once one has ascertained with certainty what *fraud* means in the Act. I agree that if the word is used in the sense of putting off a bad article on a customer in order to get money unfairly, there is no evidence here of anything of the kind having been done. On the contrary, it is expressly found that the article supplied was as good as that contracted for. But that, I think, is not the correct meaning of the word *fraud* as used in this Act of Parliament. The Act is directed against the abuse of trade-marks, and the putting off on a purchaser of not a bad article, but an article different from that which he intended to purchase and believes he is purchasing. It would apply to cases where a particular article, manufactured by a particular person, had acquired a wide-spread reputation (as, for instance, happened in the celebrated case of the fish sauces (*v*)), and some one supplied another and a different article under that name, so as to make the purchaser take something which he did not know he was taking."

On the other hand, the Act does not apply to mere cases of inaccurate or mistaken descriptions. The charges under it are criminal charges, and, according to the ordinary rule, a criminal intent—a *mens rea* in the person charged—must be made out (*x*). It is immaterial that the buyer was not deceived (*y*).

Giving information.

Reasonable precautions. — Giving information.] — Where special defences are provided by the Act, in sect. 2 (2) (a) and (b) (*z*), and sect. 6 (*a*), the matters to be proved by the person charged include, that he took all reasonable precautions against committing an offence against the Act, and that he

(*u*) See note (*t*), *ante*, p. 603.

(*v*) *Burgess* v. *Burgess*, 3 De G. M. & G. 896; 22 L. J. Ch. 675, cited p. 501.

(*x*) *Gridley* v. *Swinborne*, 52 J. P. 739, 791; 5 T. L. R. 71 (1888), Coleridge, L. C. J., and Grantham, J.; *Budd* v. *Lucas*, (1891) 1 Q. B. 408.

(*y*) See *Kirschenboim* v. *Salmon & Gluckstein*, (1898) 2 Q. B. 19; 67 L. J. Q. B. 601, Lord Russell of Killowen, C. J., Hawkins, Day, Wills, and Wright, JJ.

(*z*) Below, pp. 607, 608.

(*a*) Above, p. 598.

gave all the information in his power (*b*) with respect to the persons from whom he obtained the marked goods, or the person on whose behalf the mark or description in question was applied. No doubt it was intended by the draughtsmen of the Act to make these matters tests of innocent conduct on all charges under the Act, but it is submitted that the provisions respecting them cannot be imported into sections, as the above section, where they are not expressed; in fact, this has recently been held to be so in regard to sect. 2 (2) (c) (*c*). The most ordinary evidence to show that the party charged acted without intent to defraud, or "otherwise innocently" (*d*), would be evidence of ignorance of the facts on which the charge is based: for instance, evidence that he did not know or suspect that the mark forged was a trade-mark; that the goods to which the trade description was applied were not the goods described; or evidence that he believed he had the assent or authority of the proprietor of the trade-mark in question to apply it.

Evidence of the defendant and his wife.

Evidence of the defendant.]—By **sect. 10** (1) (in any prosecution for an offence against this Act)—

> "A defendant, and his wife, or her husband, as the case may be, may, if the defendant thinks fit, be called as a witness, and, if called, shall be sworn and examined, and may be cross-examined and re-examined in like manner as any other witness."

Rebutting evidence.]—If the person charged gives, or calls evidence to show that he acted without intent to defraud, the prosecutor may give rebutting evidence, and, in particular, evidence of transactions similar to the offence charged, in which the person charged was concerned, and antecedent (but, it is said, not subsequent (*e*)) to that offence (*f*).

(*b*) See also sect. 19 (3), above, p. 597.

(*c*) *Christie, Manson & Woods* v. *Cooper*, (1900) 2 Q. B. 522, Grantham and Channell, JJ.; and see "otherwise acted innocently," below, p. 610.

(*d*) Sect. 2 (2) (c), *infra*, p. 610.

(*e*) *R.* v. *Holt*, 30 L. J. M. C. 11 (1861).

(*f*) *Budd* v. *Lucas*, (1891) 1 Q. B. 408, Pollock, B., and Charles, J. Evidence of previous short deliveries. *R.* v. *Francis*, L. R. 2 C. C. R. 128, a case of false pretences. See Archbold, 22nd ed., p. 285.

The above provisions seem to be impliedly superseded by the Criminal Evidence Act, 1898 (61 & 62 Vict. c. 36). But the extent to which that statute repeals such provisions has not yet been determined (*f*).

6. Sale or Possession of Falsely-Marked Goods.

Sub-sect. 2 (2) provides that—

"Every person (*g*) who sells, or exposes for, or has in his possession for, sale, or any purpose of trade or manufacture, any goods or things to which any forged trade-mark (*h*) or false trade description (*i*) is applied (*k*), or to which any trade-mark or mark so nearly resembling a trade-mark as to be calculated to deceive is falsely applied (*l*), as the case may be, shall" (unless he establishes one of specified defences (*m*)) "be guilty of an offence against this Act."

Cases where possession or sale is an offence *prima facie*.

Some other cases where possession is made an offence *prima facie*, are collected at p. 602. Imitating the mark of the Birmingham Proof House for gun barrels, or knowingly selling any barrel bearing an imitation of such mark (*n*); marking the mark of a hammer on cutlery not made of hammered steel, or having in possession for the purposes of sale articles so marked; marking cutlery, or having in possession for sale cutlery marked, with a false indication of quality, or with the words *London* or *London made*, unless the cutlery were manufactured in the city of London (*o*), or within twenty miles thereof, are misdemeanours.

By the Margarine Act, 1887, s. 6 (*p*), it is provided that every package, whether open or closed, and containing marga-

(*f*) See *R.* v. *Dunning*, 34 L. J. 33 (1899), C. C. C.; *R.* v. *Brazil*, 34 L. J. 132; 63 J. P. 138; (1899), Sussex Assizes, Wills, J. As to cross-examination in reference to previous convictions, see *Charnock* v. *Merchant*, (1900) 1 Q. B. 474.

(*g*) Page 558.

(*h*) Pages 560, 563.

(*i*) Pages 570, 584.

(*k*) Page 567.

(*l*) Page 569.

(*m*) See p. 607.

(*n*) 53 Geo. 3, c. 115.

(*o*) 59 Geo. 3, c. 7. See a paper by Mr. J. T. Smith, M. M. A. Report, 1862, p. 162.

(*p*) 50 & 51 Vict. c. 29. This section is amended in certain details by the Sale of Food and Drugs Act, 1899 (62 & 63 Vict. c. 51).

rine (*q*), shall be branded or marked in a certain way, and that "if such margarine be exposed for sale, by retail, there shall be attached to each parcel thereof so exposed, and in such manner as to be clearly visible to the purchaser" a specified label. It has been held that a parcel of margarine placed behind a screen out of the sight of purchasers in a shop, and from which portions were cut for sale to them, is not (*r*), but that parcels done up in wrappers and placed in the shop so that the wrappers, but not the margarine itself, could be seen by purchasers, are "exposed for sale" within the meaning of this section (*s*). In a later case, slices of bread, spread with a mixture of Danish butter and margarine, and also haddocks on which was put margarine cut from a lump kept on a shelf, were sold at a refreshment room for consumption on the premises; no margarine was sold to customers to take away, and the establishment was conducted strictly as a refreshment house. There were no labels either on the slices or on the lump of margarine; but notices were posted in the shop that "Nothing but a mixture of the best Danish butter and margarine is sold at this establishment." It was held that the margarine had not been exposed for sale by retail within the meaning of sect. 6 of the Act of 1887, and that the machinery of that section was inapplicable to such a course of business (*t*).

7. Defences under Sect. 2 (2).

Sub-sect. (2) declares the person charged, if he falls within the earlier part of the sub-section, to be guilty of an offence against the Act—

"Unless he proves—

"(a) That having taken all reasonable precautions

(*q*) The provisions of the Margarine Act, 1887, as to margarine, are now extended to margarine cheese, by the Sale of Food and Drugs Act, 1899 (62 & 63 Vict. c. 51), s. 5.

(*r*) *Crane* v. *Laurence*, 25 Q. B. D. 152 (1890), Cave and Smith, JJ. See also case of *Butter Association* v. *Edmonds*, 30 L. Jo. 214 (1895).

(*s*) *Wheat* v. *Brown*, (1892) 1 Q. B. 418, Lawrance and Wright, JJ.

(*t*) *Moore* v. *Pearce's Dining and Refreshment Rooms*, (1895) 2 Q. B. 657; 73 L. T. 400, Lord Russell of Killowen, C. J., Cave, J. See also *World's Tea Co.* v. *Gardner*, 59 J. P. 358 (1895), Day and Wright, JJ.

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 (*u*) 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 (*x*); or

"(c) That otherwise he had acted innocently."

The onus of establishing the innocence of any person charged, whose case is shown to fall within the earlier part of the section, is, therefore, as under the corresponding sub-section (1) (*y*), already considered, cast upon the person charged. Clauses (a) and (b) of sub-sect. (2) of sect. 2 apply to cases where the goods in question are in the possession of the accused for sale, or are sold with the forged trade-mark or false trade description already stamped upon or otherwise applied to them. But any defendant to whose case clauses (a) and (b) applies is entitled to prove that he "acted innocently" otherwise than by proving that he had taken all reasonable precautions against committing the offence, and that he had no reason to suspect the genuineness of the trade-mark or trade description (*z*). Where the false trade description is applied on the occasion and as part of the terms of sale, the accused must rely for his exculpation upon clause (c)—viz., by showing that he had acted innocently (*a*).

The special defences (a) and (b) correspond to (b), (c), and (d) of sect. 6 (*b*), except that the information here re-

(*u*) Page 605. Cf. sect 6 (c), p. 598, and sect. 17, p. 520, and also "false," p. 585.

(*x*) Pages 599, 604 and 609.

(*y*) Page 601.

(*z*) *Christie, Manson and Woods* v. *Cooper*, (1900) 2 Q. B. 522, Grantham and Channell, JJ. See also p. 610.

(*a*) *Coppen* v. *Moore* (No. 2), (1898) 2 Q. B. 306, at p. 313; 67 L. J. Q. B. 689, at p. 693; *Christie, Manson and Woods* v. *Cooper*, *ubi supra*. In this case the appellants had catalogued goods for sale by auction as "Dresden china," but, having received information before the sale leading them to doubt the genuineness of the marks on the china, they sold it "for what it was." It was held that the absence of *mens rea* was a good defence, and the conviction by the magistrate was quashed.

(*b*) Page 598.

ferred to is to be given on demand, and in sect. 6 there is a special provision as to costs, which does not occur here. Rebutting evidence may be given by the prosecution to displace these defences (*c*).

Gave all the information.]—In the evidence given before the Committees of 1862 and 1887, great stress was laid upon the importance of compelling retail traders and others found in possession of spurious goods, or found offering them for sale, to give such information as should lead to the discovery of the real, or the original, offenders. For frauds by false marking can usually only be detected when the goods are offered to the general public, and the goods are then in the hands of persons who are, or may be, or may speciously pretend to be, innocent of the frauds. Mr. Hindmarch, Q. C., the draughtsman of the Act of 1862, described the provisions for disclosure as of the essence of the Bill upon which the Act was founded (*d*). Information as to principal offender.

By sect. 6 of the last-mentioned Act (*e*), a person who sold, &c. any article together with a forged trade-mark, &c., was bound, upon demand in writing, by or on behalf of the persons whose trade-mark was forged, &c., and within twenty-four hours after the demand, to give full information in writing of the name and address of the person from whom, and the time when, he obtained the article. And any justice of the peace might order such information to be given. Refusal or neglect to comply with the order was punishable by a penalty of 5*l.*, and was *primâ facie* evidence of guilty knowledge at the time when he sold the article, on the part of the person refusing or neglecting. Provision for disclosure in the M. M. A. 1862.

There is no provision in the present Act corresponding to this and enabling an order for disclosure to be made, or making refusal or neglect to give information evidence of guilty knowledge or intent. Proof that the person charged has given all the information in his power is made a term of the special defences under sect. 2 (2) (b), and sect. 6 (d), and under sect. 14 the Court, upon a prosecution, in making an

(*c*) Page 605.
(*d*) M. M. A. Report, 1862, Q. 2865.
(*e*) 25 & 26 Vict. c. 88. The section is much abbreviated.

order for costs, may have regard to the information given by, and the conduct of, the defendant and prosecutor respectively; but it is quite conceivable that a defendant might refuse to give information with impunity, except as to payment of costs, and secure an acquittal under the general defences of sect. 2 (1) (without intent to defraud), or sect. 2 (2) (c) (acted innocently). In a civil action against him, based upon the same offences, the person charged could, of course, be compelled to make the disclosure on "discovery," if it were relevant to the issues raised.

"Otherwise acted innocently."

(c) *That otherwise he had acted innocently.*] — Compare "without intent to defraud," above, p. 603. Whether the defendant tenders evidence or not, and whether any of the special defences sanctioned by the Act is set up or not, the Court must, in order to convict, be satisfied that he acted with a criminal intent in doing the acts complained of (*f*). But where the defendant has knowingly applied a false trade description to goods, he cannot bring himself within clause (c) by showing that he had no intention of deceiving the buyer, but acted from some other motive, *e.g.*, a desire to save expense by using up a stock of old labels which had ceased to be a true description of the goods to which they were applied (*g*).

The statute enables a defendant to prove that he had "acted innocently" otherwise than by proving that he had taken all reasonable precautions against committing the offence, and that he had no reason to suspect the genuineness of the trade-mark or trade description, &c. (*h*). Innocence of any intention to infringe the Act might co-exist with a suspicion as to the genuineness of the mark or description (*i*).

(*f*) *Gridley* v. *Swinborne*, 52 J. P. 739, 791; 5 T. L. R. 71 (1888), Coleridge, L. C. J., and Grantham, J.

(*g*) *Kirschenboim* v. *Salmon & Gluckstein*, (1898) 2 Q. B. 19; 67 L. J. Q. B. 601, Lord Russell of Killowen, C. J., Hawkins, Day, Wills, Wright, JJ.

(*h*) *Christie, Manson and Woods* v. *Cooper*. See note (*a*).

(*i*) Per Channell, J., (1900) 2 Q. B. at p. 529.

8. Punishment.

By sect. 2 (3) and (4)—

"(3.) Every person guilty of an offence against this Act shall be liable—

"(i.) on conviction on indictment, to imprisonment, with or without hard labour, for a term not exceeding two years, or to fine, or to both imprisonment and fine; and — Fine and imprisonment.

"(ii.) on summary conviction to imprisonment, with or without hard labour, for a term not exceeding four months, or to a fine not exceeding twenty pounds, and in the case of a second or subsequent conviction to imprisonment, with or without hard labour, for a term not exceeding six months, or to a fine not exceeding fifty pounds; and

"(iii.) in any case, to forfeit to her Majesty every chattel, article, instrument, or thing by means of or in relation to which the offence has been committed. — Forfeiture of the goods.

"(4.) The Court before whom any person is convicted under this section may order any forfeited articles to be destroyed or otherwise disposed of as the Court thinks fit."

Forfeiture and destruction (*k*).]—Sect. 21 of the Act of 1862 authorized the Court in any suit at law or in equity for forging a trade-mark, &c., to order the goods bearing the spurious marks to be destroyed; and the various sections of the Act imposing penalties contained provisions for forfeiture and destruction to the same effect as the sections set out above.

It has been shown in the earlier part of the book that the Court of Chancery would have interfered, and now the High Court of Justice interferes, independently of sect. 21 of the Act of 1862, to order the destruction of spuriously marked articles, but that if the marks can be completely removed, the

(*k*) Cf. sect. 12 (3), p. 619, by which compensation for loss may be awarded to an innocent party out of the proceeds of forfeited goods. And as to forfeiture on importation, see sect. 16, p. 624.

Court permits this to be done without requiring the articles to be destroyed (*l*).

9. Prosecution.

By sect. 2—

"(6.) Any offence for which a person is under this Act liable to punishment on summary conviction may be prosecuted, and any articles liable to be forfeited under this Act by a Court of summary jurisdiction may be forfeited, in manner provided by the Summary Jurisdiction Acts (*m*): Provided that a person charged with an offence under this section before a Court of summary jurisdiction shall, on appearing before the Court, and before the charge is gone into, be informed of his right to be tried on indictment, and if he requires be so tried accordingly."

The Court in Scotland is the Sheriff Court (*n*), and the Summary Jurisdiction Acts there mean the Summary Procedure Act, 1864, and any Acts amending the same (*n*). In Dublin, the Summary Jurisdiction Acts are the Acts regulating the powers and duties of justices of the peace for the police district of Dublin metropolis, and, as regards the rest of Ireland, the "Summary Jurisdiction Acts" means the Petty Sessions (Ireland) Act, 1851, and any Act amending the same. The "Court of summary jurisdiction" means justices acting under those Acts (*o*).

Indictment and information.]—For forms of these, see the Appendix, p. 844.

Official prosecutions.]—It is provided by sect. 2 of the M. M. A. 1891, that—

Official prosecutions.

"2.—(1.) The Board of Trade may, with the concurrence of the Lord Chancellor, make regulations providing that in cases appearing to the Board to affect the general

(*l*) Book I., Chap. XV., p. 421.

Slazenger & Sons v. *Feltham & Co.*, 6 R. P. C. 531 (1889), C. A.

(*m*) 42 & 43 Vict. c. 49.

(*n*) Sect. 21. Any aggrieved person can prosecute in Scotland, with the concurrence of the Procurator Fiscal: *Burns* v. *Turner*, 25 Ct. of Sess. Ca., 4th ser., 38 (1898), Lord Justice Clerk Kingsburgh, Lord Trayner, Lord Moncrieff.

(*o*) Sect. 22. The compromise of a prosecution is, it seems, not improper. See *Fisher* v. *Apollinaris Co.*, 10 L. R. Ch. 297 (1875), L. JJ.

interests of the country, or of a section of the community, or of a trade, the prosecution of offences under the M. M. A. 1887, shall be undertaken by the Board of Trade, and prescribing the conditions on which such prosecutions are to be so undertaken. The expenses of prosecutions so undertaken shall be paid out of moneys provided by Parliament.

"(2.) All regulations made under this section shall be laid before Parliament within three weeks after they are made if Parliament is then sitting, and if Parliament is not then sitting, within three weeks after the beginning of the next session of Parliament, and shall be judicially noticed, and shall have effect as if enacted by this Act, and shall be published under the authority of her Majesty's Stationery Office.

"(3.) Nothing in this Act shall affect the power of any person or authority to undertake prosecutions otherwise than under the said regulations."

This provision was made upon the recommendation of the Committee of 1890.

The regulations made by the Board of Trade under the Act (*p*) are set out in the Appendix, p. 840. The fifth of such regulations provides that the Board may, before undertaking a prosecution at the instance of any applicant, require the applicant to give security for costs on such terms and in such manner as it thinks proper.

It is provided by sect. 1 of the Merchandise Marks (Prosecution) Act, 1894 (*q*), that—

> The powers exercisable by the Board of Trade under the M. M. A. 1891, with respect to the prosecution of offences under the M. M. A. 1887, may, in cases which appear to the Board of Agriculture to relate to agricultural or horticultural produce, be exercised by

(*p*) 21 May, 1892. A list of the prosecutions instituted by the Board of Trade from Jan. 1888 to the end of 1896 will be found in the *Trans. Chart. Inst. Pat. Agents*, 1897-98, at p. 130.

(*q*) 57 & 58 Vict. c. 19. The Act is to be read with the M. M. A. 1887 and 1891.

that Board, and in such cases the former Act shall apply as if the Board of Agriculture were referred to therein instead of the Board of Trade.

By sect. 2 it is provided that—

"This Act shall not apply to Ireland."

This Act was passed in accordance with a recommendation of a Select Committee of the House of Lords, appointed in 1893, to consider the question of the marking of foreign meat (*r*).

The regulations made by the Board of Agriculture under the Act of 1894 are set out in the Appendix, p. 841.

A circular letter, dated 1st February, 1895, addressed by the Board of Agriculture to secretaries of Chambers of Agriculture, agricultural societies and farmers' clubs, on the working and interpretation of the Merchandise Marks (Prosecution) Act, 1894, will be found in the Appendix, *post*, p. 842.

Indictment, right to be tried by.

Right to be tried by indictment.]—If notice of this right be not given to the person charged on his appearing in Court, and before the charge is gone into, the proceedings are invalid (*s*). And, *semble*, it is immaterial whether or not the defendant knew of his right to be tried by jury, and whether or not the Court knew before the proceedings commenced that he intended to plead guilty in the course of the case (*t*). This was so held in a case under sect. 17 of the Summary Jurisdiction Act, 1879, by which a similar duty of informing a defendant, charged with one of the offences included under the section, of his right to be tried by a jury is cast upon the Court of summary jurisdiction (*u*). There are numerous special Acts comprising corresponding provisions (*x*).

(*r*) 1893 (214), p. xviii. par. 110.

(*s*) Cf. 38 & 39 Vict. c. 63, s. 14, under which it is a condition precedent to the right of the purchaser of adulterated goods to take proceedings, that he should have given the seller notice of his intention to have the goods analysed. *Parsons* v. *Birmingham Dairy Co.*, 9 Q. B. D. 172 (1882), Div. Court. See also *Carle* v. *Elkington*, 40 W. R. 510; *R.* v. *Cockshott*, (1898) 1 Q. B. 582; 67 L. J. Q. B. 467, Wright and Darling, JJ.

(*t*) *R.* v. *Cockshott*, *supra*.

(*u*) Last case and *Re Holeton*, *Times* Newspaper, 29 June, 1885; Stone's Justices' Manual, 31st ed., p. 43.

(*x*) See Glen's Summary Jurisdiction Acts, 6th ed., p. 126.

Limitation of prosecutions.]—By sect. 15—

Limitation.

"No prosecution for an offence against this Act shall be commenced after the expiration of three years next after the commission of the offence, or one year next after the first discovery thereof by the prosecutor, whichever expiration first happens."

Sect. 18 of the Act of 1862 was to the same effect. The ordinary period of limitation upon the summary prosecution of offences is six months (*y*).

A question may arise as to whether the above section applies to a prosecution for the special offences created by sect. 8 or sect. 20 of the Act (*z*), since the phrase "an offence against this Act" which occurs in it, is taken from sect. 2, and does not occur in those sections. It is submitted that sect. 15 does not apply, and that, accordingly, the ordinary rule of six months' limitation holds for prosecutions under sect. 8 or sect. 20.

Vexatious Indictments Act.]—By sect. 13—

Vexatious Indictments Act.

"The Act of the session of the twenty-second and twenty-third years of the reign of her present Majesty, chapter seventeen, intituled 'An Act to prevent vexatious indictments for certain misdemeanours' (*a*), shall apply to any offence punishable on indictment under this Act, in like manner as if such offence were one of the offences specified in section one of that Act, but this section shall not apply to Scotland."

The effect of this is, that no bill of indictment can be presented to, or found by, any grand jury for an offence under the Act, unless either the prosecutor has been bound over to prosecute or give evidence; or the person charged has been committed to or detained in custody, or has been bound over to answer an indictment for the offence; or the indictment is preferred with the consent of a judge, the attorney-general, or the solicitor-general. And where a justice refuses to commit, or to hold to bail a person charged with an

(*y*) Summary Jurisdiction Act, 1848, sect. 11; Stone's Justices' Manual, 31st ed., p. 36; Glen, pp. 39, 45.

(*z*) Sect. 8 (3) (false declaration as to watch). Sect. 20 (pretended royal warrant).

(*a*) 22 & 23 Vict. c. 17.

indictable offence under the Act to be tried for the same, the justice may, and must at the desire of the prosecutor, take the recognizance of the prosecutor to prosecute and transmit the recognizance, information, and depositions, if any, to the Court in which the indictment ought to be preferred, in the same manner as if he had committed the person charged for trial (*b*).

Costs.

By sect. 14—

> "On any prosecution under this Act the Court may order costs to be paid to the defendant by the prosecutor, or to the prosecutor by the defendant, having regard to the information (*c*) given by and the conduct of the defendant and prosecutor respectively."

This is subject to the special rule of sect. 6 (*d*), where the defence allowed by that section is set up.

The section gives the Court unlimited jurisdiction over the costs, without reference to the result of the prosecution, except so far as this is made a subject for consideration by the reference to conduct. It may be compared with Ord. 65, r. 1 (*e*), and sect. 5 of the Judicature Act, 1890, which deal with the costs of civil proceedings (*f*). Under Ord. 65, r. 1, it is held that a lump sum, assessed by the Court, may be awarded as costs (*g*); that a successful plaintiff may be ordered to pay the costs of the action (*h*); but that the defendant cannot be ordered to pay them where the plaintiff had no cause of action (*i*). The discretion must, of course, be exercised judicially and on fixed principles of general application (*k*).

(*b*) Stone's Justices' Manual, 31st ed., p. 622.

(*c*) See above, p. 609, "information."

(*d*) Above, p. 598.

(*e*) See the note to this in the Annual Practice, from which the cases next cited are taken.

(*f*) As to costs in actions for infringement, see Book I., Chap. XV., p. 429.

(*g*) *Willmott* v. *Barber*, 17 C. D. p. 774 (1881); *Corporation of Bradford* v. *Pickles*, (1894) 3 Ch. 53; 63 L. J. Ch. 587.

(*h*) *Harris* v. *Petherick*, 4 Q. B. D. 611 (1879); *Fane* v. *Fane*, 13 C. D. 228 (1879).

(*i*) *Dicks* v. *Yates*, 18 C. D. 76 (1881); *Foster* v. *G. W. Ry. Co.*, 8 Q. B. D. 515 (1882).

(*k*) *Cooper* v. *Whittingham*, 15 C. D. 501 (1880); *Jones* v. *Curling*, 13 Q. B. D. 265 (1884); *The Monkseaton*, 14 P. D. 51 (1889). And see the trade-mark cases *Upmann* v.

The ordinary rule as to the costs of summary proceedings is, that if a conviction or order is made, the justices may order the defendant to pay to the prosecutor or complainant, and if the information or complaint is dismissed, the prosecutor or complainant to pay to the defendant, such costs as they think just and reasonable (*l*).

Where a fine ordered to be paid on a conviction by a Court of summary jurisdiction does not exceed five shillings, then, except so far as the Court may think fit to expressly order otherwise, an order shall not be made for payment by the defendant to the informant of any costs, and the Court shall, except so far as they think fit to expressly order otherwise, direct all fees payable or paid by the informant to be remitted or repaid to him; the Court may also order the fine or any part thereof to be paid to the informant in or towards the payment of his costs (*m*).

Under sect. 12 (3) (*n*) compensation may be awarded to an innocent party out of the proceeds realized from forfeited goods for any loss sustained by him in dealing with such goods.

Appeal.

By sect. 2 (5)—

> "If any person feels aggrieved by any conviction made by a court of summary jurisdiction, he may appeal therefrom to a court of quarter sessions."

The appeal will be governed by sect. 31 of the Summary Jurisdiction Act, 1879, and the provisions of that section must be complied with (*o*).

The decision of justices upon any point of law, or if it is alleged to be in excess of jurisdiction, may also be questioned by requiring the justices to state a case for the determination

Forrester, 24 C. D. 231 (1883), and the *American Tobacco Co.* v. *Guest*, (1892) 1 Ch. 630; 9 R. P. C. 218, cited above, pp. 429, 431.

(*l*) Summary Jurisdiction Act, 1848, sect. 18; Stone's Justices' Manual, 32nd ed., p. 66.

(*m*) Summary Jurisdiction Act, 1879, sect. 8.

(*n*) Page 619, below.

(*o*) See Glen's Summary Jurisdiction Acts, 6th ed., p. 148; Stone's Justices' Manual, 32nd ed., p. 89.

of the Queen's Bench Division (*p*); an order or conviction made by them without jurisdiction may be quashed upon a *certiorari* (*q*); and if they have refused to hear and determine a case in which they have jurisdiction they may be ordered to do so by *mandamus* (*q*).

Saving of other Proceedings.

By **sect. 19** (1) and (2)—

"(1.) This Act shall not exempt any person from any action, suit, or other proceeding which might, but for the provisions of this Act, be brought against him.

"(2.) Nothing in this Act shall entitle any person to refuse to make a complete discovery, or to answer any question or interrogatory in any action, but such discovery or answer shall not be admissible in evidence against such person in any prosecution for an offence against this Act" (*r*).

Search Warrant.

By **sect. 12**—

Where a prosecution is pending.

"(1.) Where, upon information of an offence against this Act (*s*), a justice has issued either a summons requiring the defendant charged by such information to appear to answer to the same, or a warrant for the arrest of such defendant, and either the said justice on or after issuing the summons or warrant, or any other justice, is satisfied by information on oath that there is reasonable cause to suspect that any goods or things by means of or in relation to which such offence has been committed are in any house or premises of the defendant, or otherwise in his possession or under his control in any place, such justice may issue a warrant under his hand by virtue of which it shall be lawful for any constable named or referred to in the warrant, to enter such house, premises, or place at any reasonable time by

(*p*) 20 & 21 Vict. c. 43, s. 3; 42 & 43 Vict. c. 49, s. 33. The statement of the case must be requested in writing within seven days of the date of the proceeding to be questioned. S. J. Rule 17; Stone, p. 83.

(*q*) See Stone, p. 86. See Shortt and Mellor's Crown Office Practice, pp. 114 *et seq.*

(*r*) Cf. sect. 23, by which rights, penalties, &c. under the M. M. A. 1862, are saved.

(*s*) Sect. 2 (1) and (2), p. 556.

day, and to search there for and seize and take away those goods or things; and any goods or things seized under any such warrant shall be brought before a court of summary jurisdiction for the purpose of its being determined whether the same are or are not liable to forfeiture (*t*) under this Act (*u*).

Where the owner of the goods cannot be found.

"(2.) If the owner of any goods or things which, if the owner thereof had been convicted, would be liable to forfeiture under this Act, is unknown or cannot be found, an information or complaint may be laid for the purpose only of enforcing such forfeiture, and a court of summary jurisdiction may cause notice to be advertised stating that, unless cause is shown to the contrary at the time and place named in the notice, such goods or things will be forfeited, and at such time and place the Court, unless the owner or any person on his behalf, or other person interested in the goods or things, shows cause to the contrary, may order such goods or things or any of them to be forfeited.

Disposal of forfeitures, compensation to innocent party.

"(3.) Any goods or things forfeited under this section, or under any other provision of this Act (*t*), may be destroyed or otherwise disposed of, in such manner as the Court by which the same are forfeited may direct, and the Court may, out of any proceeds which may be realized by the disposition of such goods (all trade-marks and trade descriptions being first obliterated), award to any innocent party any loss he may have innocently sustained in dealing with such goods."

Forfeiture without conviction.]—An offence against the Act comprises two distinct elements: first, the doing of one of the specified acts, for instance, making a trade-mark without the assent of the proprietor, applying a false trade description to goods, or having in possession for sale any goods to which a forged trade-mark is applied; and, secondly, doing this with intent to defraud, or not innocently, and without any of the special defences mentioned in the Act. The existence of the first element can be ascertained from the chattel, article, instrument, or thing by means of, or in relation to which the offence (*x*), if committed at all, has been committed; but the

(*t*) See sect. 2 (3) (iii), p. 611.

(*u*) As to search warrants generally, see Glen's Summary Jurisdiction Acts, 6th ed., p. 302, where a list of the numerous Acts authorizing the granting of them is given.

(*x*) Sect. 2 (3) (iii), p. 611.

existence of the second can only be established in relation to the conduct of a particular person, here referred to generally as "the owner" of the goods or things. The Act, however, in almost all cases casts the onus of establishing that he acted without intent to defraud, or otherwise innocently, or a special defence upon the person charged, and, in the absence of any evidence by "the owner," for the purpose of forfeiting the goods under the section, evidence supplied by inspection of the goods themselves, or otherwise given in relation to them, and the marks applied to them will be sufficient (*y*).

Marks on Watch Cases.

Application of the Act to watches.

By sect. 7—

"Where a watch case has thereon any words or marks which constitute, or are by common repute (*z*) considered as constituting, a description of the country (*a*) in which the watch was made, and the watch bears no description of the country where it was made, those words or marks shall *prima facie* be deemed to be a description of that country within the meaning of this Act, and the provisions of this Act with respect to goods to which a false trade description has been applied (*b*), and with respect to selling or exposing for or having in possession for sale, or any purpose of trade or manufacture, goods with a false trade description (*b*), shall apply accordingly, and for the purposes of this section the expression 'watch' means all that portion of a watch which is not the watch case" (*c*).

Gold or silver watch cases, whether of British make or imported into Great Britain, are required to be stamped with assay marks, of which the most important are the hall-marks, showing the standard of purity of the metal (*d*). Evidence was adduced before the Committee of 1887 to show that the English hall-mark upon a watch case containing a foreign movement was understood by buyers to be an indication that the movement was of English make, and, further, that the

(*y*) Cf. sect. 16, below, p. 627, "such goods."

(*z*) Cf. "custom of the trade," in sect. 3 (1), *ante*, p. 581.

(*a*) See sect. 3 (1), "place or country," p. 574.

(*b*) Sect. 2 (2).

(*c*) *I.e.*, The "movement."

(*d*) The statutes are very numerous. See Appendix, p. 847.

introduction of the letter *F* into the hall-marks put upon imported watch cases, which had been provided for by the Customs Tariff Act, 1876 (*e*), was not sufficient to enable buyers to distinguish foreign from English-made cases. The section set out above, and sect. 8 of the Act, were accordingly introduced for the purpose of preventing the assay marks from leading, or being used to lead, to deception (*f*). It is said that the provisions have been successful, and have proved highly beneficial to the English watch trades (*f*).

On examination, sect. 7 appears to be a special case falling within provisions elsewhere contained in the Act, for words or marks which constitute, or are by common repute considered as constituting a description of the country in which the movement was made, marked upon the case would seem to be a "trade description" within sect. 3 (1) (*g*), "applied to" the whole watch within sect. 5 (*h*), and if the movement has not, in fact, been made in the country indicated by the description, the trade description is false within sect. 3 (1) (*i*). This is another instance of overlapping, of which several cases occur in the Act. It is submitted that the construction of the wider general provisions ought not to be affected, in regard to watches, by the presence of the narrower special section here referred to (*j*).

The section applies only where the double condition that the watch case has upon it words or marks which constitute, or are by common repute considered as constituting a description, of the country where the movement was made, and that the movement bears no description of the country where it was made, is fulfilled. It does not, therefore, extend to the sale of a watch in a case marked so as to indicate that the movement was made in any country other than that where it was, in fact, made, if the movement itself is marked with a description of the country in which it was made, although a

(*e*) 39 & 40 Vict. c. 35, s. 1, amended by the Revenue Act, 1883 (46 & 47 Vict. c. 55), s. 10.

(*f*) See "Watches" in the indexes to the M. M. A. Reports, 1887 and 1890.

(*g*) Page 570.

(*h*) Page 567.

(*i*) Page 584.

(*j*) Cf. p. 589.

purchaser who did not notice or appreciate the conflict between the marks, might be misled by the mark on the case. But any such sale would, it is submitted, fall within the general provisions dealing with false trade descriptions of the Act.

Movements partly made abroad.

Description of the country where it was made.]—It is often difficult to say what country is the country where a movement was made, since almost, if not quite, all English movements contain foreign-made parts, for instance, the chain, hair spring, and regulator, and sometimes foreign-made movements are imported in the rough and are finished in England (*k*). In regard to the former case there was a general, but not unanimous, agreement among the expert witnesses called before the Committee of 1887 that, at any rate, if the foreign-made parts are only those mentioned, the movement may fairly be described as English made, but in regard to the latter there was a decided difference of opinion (*l*). This difficulty has already been referred to in considering what is meant by "false in a material respect" (*m*). It must be solved in each case according to the view the Court takes, having regard to such usages of the trade as are proved to exist, and as can be supposed to be familiar to the ultimate buyers.

Primâ facie be deemed.]—It is impossible to attach any sensible meaning to the words *primâ facie* in this section. They were probably intended only to enable the person charged to show that the words or marks in question do not constitute, and are not by common repute considered as constituting a description of the country in which the movement was made, as alleged, but for this they are both unnecessary and inappropriate.

Marking watch cases.]—By **sect. 8**—

"(1.) Every person (*n*) who after the date (*o*) fixed by Order in Council sends or brings a watch case,

(*k*) *Williamson* v. *Tierney*, 17 T. L. R. 174 (1900), and Times, April 18th, 1901, cited p. 575, was such a case.

(*l*) See "Watches" in the index to M. M. A. Report, 1887.

(*m*) Above, p. 586. See also "place or country," p. 574, and sect. 18, p. 594.

(*n*) Sect. 3 (1), p. 558, "person."

(*o*) 28 Nov. 1887: *London Gazette*, 9 Dec. 1887.

whether imported or not, to any assay office in the United Kingdom for the purpose of being assayed, stamped, or marked, shall make a declaration declaring in what country or place the case was made. If it appears by such declaration that the watch case was made in some country or place out of the United Kingdom, the assay office shall place on the case such a mark (differing from the mark placed by the office on a watch case made in the United Kingdom), and in such a mode as may be from time to time directed by Order in Council.

"(2.) The declaration may be made before an officer of an assay office, appointed in that behalf by the office (which officer is hereby authorized to administer such a declaration), or before a justice of the peace, or a commissioner having power to administer oaths in the Supreme Court of Judicature in England or Ireland, or in the Court of Session in Scotland, and shall be in such form as may be from time to time directed by Order in Council.

"(3.) Every person who makes a false declaration for the purposes of this section shall be liable, on conviction on indictment, to the penalties of perjury, and on summary conviction to a fine not exceeding twenty pounds for each offence" (*p*).

See sect. 7, above, p. 620. The Order in Council is printed in the Appendix, p. 837.

The section is only directed to secure that foreign-made cases shall bear a distinctive mark. It does not prevent English movements being put into foreign cases, or foreign movements into English cases.

The Committee of 1897 recommended that the marks of foreign origin placed upon watches or watch cases ought to be required in equally visible letters upon the dome or dial of the watch itself, inasmuch as the watch is often made abroad, but imported in order to be placed in a British hall-marked case and then sold as of home manufacture (*q*).

Watches and clocks.

Importation of marked watches.]—By sect. 42 of the Customs Act, 1876 (*r*), the importation of clocks and watches,

(*p*) See sect. 15, p. 615, "limitation."

(*q*) M. M. A. Report, 1897, p. 70.

(*r*) 39 & 40 Vict. c. 36.

or any other article of metal impressed with any mark or stamp representing, or in imitation of, any legal British assay, mark, or stamp, or purporting by any mark or appearance to be of the manufacture of the United Kingdom is prohibited.

10. Prohibition on Importation.

By **sect. 16** (*s*)—

"Whereas it is expedient to make further provision for prohibiting the importation of goods which, if sold, would be liable to forfeiture under this Act; be it therefore enacted as follows:

Goods liable to forfeiture under the Act, or bearing British or Irish trade-marks or names.

"(1.) All such goods, and also all goods of foreign manufacture bearing any name or trade-mark being or purporting (*t*) to be the name or trade-mark of any manufacturer, dealer, or trader in the United Kingdom, unless such name or trade-mark is accompanied by a definite indication of the country in which the goods were made or produced, are hereby prohibited to be imported into the United Kingdom, and, subject to the provisions of this section (*u*), shall be included among goods prohibited to be imported as if they were specified in section forty-two of the Customs Consolidation Act, 1876 (*x*).

Customs regulations.

"(2.) Before detaining any such goods or taking any further proceedings with a view to the forfeiture thereof under the law relating to the Customs, the Commissioners of Customs may require the regulations under this section, whether as to information, security, conditions, or other matters, to be complied with, and may satisfy themselves in accordance with those regulations that the goods are such as are prohibited by this section to be imported.

"(3.) The Commissioners of Customs may from time to time make, revoke and vary, regulations, either general or special, respecting the detention and

(*s*) The sub-sections are badly arranged. (4) should have been placed second.

(*t*) For the interpretation of "purports" in the Consolidated Instructions of 1900, see para. 5, Appendix, p. 819.

(*u*) *I.e.*, sub-sects. (2) and (3).

(*x*) 39 & 40 Vict. c. 36. See p. 623.

forfeiture of goods the importation of which is prohibited by this section, and the conditions, if any, to be fulfilled before such detention and forfeiture, and may by such regulations determine the information, notices, and security to be given, and the evidence requisite for any of the purposes of this section, and the mode of verification of such evidence.

Names like names of places in the United Kingdom.

"(4.) Where there is on any goods a name which is identical with or a colourable imitation of the name of a place in the United Kingdom, that name, unless accompanied by the name of the country in which such place is situate, shall be treated for the purposes of this section as if it were the name of a place in the United Kingdom.

Customs regulations.

"(5.) Such regulations may apply to all goods the importation of which is prohibited by this section, or different regulations may be made respecting different classes of such goods or of offences in relation to such goods.

"(6.) The Commissioners of Customs, in making and in administering the regulations, and generally in the administration of this section, whether in the exercise of any discretion or opinion, or otherwise, shall act under the control of the Commissioners of her Majesty's Treasury.

"(7.) The regulations may provide for the informant reimbursing the Commissioners of Customs all expenses and damages incurred in respect of any detention made on his information, and of any proceedings consequent on such detention.

"(8.) All regulations under this section shall be published in the 'London Gazette' and in the 'Board of Trade Journal.'

Customs Act, 1876.

"(9.) This section shall have effect as if it were part of the Customs Consolidation Act, 1876 (*y*), and shall accordingly apply to the Isle of Man as if it were part of the United Kingdom.

"(10.) Section two of the Revenue Act, 1883 (*z*), shall be repealed as from a day (*a*) fixed by regulations amending the last-cited section.

(*y*) 39 & 40 Vict. c. 36, s. 42, pp. 623, 627.

(*z*) 46 & 47 Vict. c. 55, s. 2.

(*a*) 1st of Jan., 1888. Customs Regulations of 1 Dec. 1887, Appendix, p. 834.

under this section, not being later than the first day of January, one thousand eight hundred and eighty-eight, without prejudice to anything done or suffered thereunder."

The International Conventions.

This section is a most important part of the scheme of the Act, for it, so far as it is effective, stops at the outset a class of frauds which, according to the evidence given before the Committees of 1862 and 1887, were widely prevalent and continually increasing, to the grave detriment of English manufacturers. Its main provisions are in accordance with the legislation now adopted in most civilized countries, under the International Convention, drawn up at the conference on the subject of Industrial Property and Merchandise Marks, at Paris, in 1883, and amended at the subsequent Conference at Madrid, in 1889. The terms of the several Conventions are set out in the Appendix, pp. 764—773.

According to English law these terms, or the terms of any of the numerous treaties concluded between this country and other countries for the mutual protection of the trade-mark and allied rights of their respective subjects, have no application to or between subjects, and cannot be recognized as having any legal effect, except so far as they have been embodied in the municipal law of the several countries (*b*). An English Court is not competent to inquire into a matter involving the construction of treaties or other acts of state, or to treat them as in any way operative to create or modify rights or duties, and the Crown cannot sanction any invasion by its officers of the rights of private individuals as they exist according to the municipal law, on the ground that it is necessary in order to comply with or compel obedience to a treaty (*c*).

(*b*) See Art. IX. of the International Convention; Book I. Chap. XX. p. 545; and *The Californian Fig Syrup Co.'s Tm.*, 40 C. D. 620; 6 R. P. C. 126 (1888), Stirling, J., decided on sect. 103 of the Patents, &c. Act, 1883; and *Lauri* v. *Renad*, (1892) 3 Ch. 402. The Court may refer to a treaty, in accordance with which an Act has been passed, to ascertain the circumstances to which the Act was intended to apply, as an aid to its construction. *Re Carter Medicine Co.'s Tm.*, (1892) 3 Ch. 472; 9 R. P. C. 401, North, J.

(*c*) *Walker* v. *Baird*, (1892) A. C. 491.

France was, apparently, the first country to take effective steps to stop the importation of goods made abroad, but bearing words or marks describing them as made in the country of importation (*d*); but sect. 42 of the Customs Act of 1876, amended by the now repealed section of the Revenue Act of 1883, was amply sufficient for the purpose, if it had been effectively enforced.

Sect. 42 of the Customs Act, 1876. Sect. 42 of the Customs Act, 1876, contains a list of goods among which the goods enumerated in this section are to be considered as included, and it provides that—

> "The goods enumerated and described in the following table of prohibitions and restrictions inwards are hereby prohibited to be imported or brought into the United Kingdom, save as thereby excepted (*e*); and if any goods so enumerated and described shall be imported or brought into the United Kingdom contrary to the prohibitions or restrictions contained therein, such goods shall be forfeited, and may be destroyed or otherwise disposed of as the Commissioners of Customs may direct" (*f*).

Only marked goods come within the prohibition. The policy of the Act is to prevent fraudulent marking, whether by means of forged trade-marks or false trade descriptions, and this section, as the remainder of the Act, only applies to goods which bear marks bringing them within its terms. There is no general obligation to stamp imported goods with any indication of origin (*g*). And if the deceptive marks which make such an indication necessary under the Act appear only upon the covering or package of goods, it is considered sufficient that the qualifying indication of origin should be stamped on the covering or package only also (*h*).

All such goods.]—The goods which are liable to forfeiture

(*d*) See M. M. A. Report, 1887, Index, "France."

(*e*) There are no general exceptions, but only exceptions relative to particular classes of goods, none of which are here material.

(*f*) For the section dealing with the importation of watches, see p. 623.

(*g*) M. M. A. Report, 1890; and see General Order, Consol. Instr. of 26 Feb. 1900, *post*, p. 818, par. 2.

(*h*) See below, p. 632, note (*p*).

under this section (*i*), in addition to those specially enumerated in sub-sect. (1), are goods which, if sold, would be liable to forfeiture under the Act, that is, by the joint operation of sect. 2 (3) (iii) and sect. 2 (1), goods or things to which any forged trade-mark (*k*) or false trade description (*l*) is applied (*m*), or to which any trade-mark (*n*), or mark so nearly resembling a trade-mark as to be calculated to deceive (*o*), is falsely applied (*p*). It is submitted that the words "*if sold*" must here be construed to mean if sold with such guilty intent as is necessary to justify a conviction under the Act (*q*). This is in accordance with the principle of throwing upon the person charged the onus of proving that he acted without intent to defraud, or that he is protected by one of the special defences specified in the Act, or that he acted otherwise innocently (*r*). Otherwise there could be no forfeiture under this part of the section, except where an offence would have actually been committed had the goods been sold; and sale by an innocent person would not constitute an offence. The construction contended for accords with the remainder of the section, and with the older Acts, for it is plain that the forfeitures constituted by the latter part of sub-sect. (1) are independent of proof of guilty intention on the part of anyone, and the clauses of sect. 42 of the Customs Consolidation Act of 1876, and sect. 2 of the Revenue Act of 1883, which are replaced by this section, contained no reference to the knowledge, intention, or purposes of the importer, or of any other person in relation to the goods (*s*).

Goods bearing English words or names.

So far as can be judged from the summary of agricultural produce detained under the Act in the years 1888 and 1889, which is appended to the M. M. A. Report, 1890, a very

(*i*) See the summary in the Customs General Order of 26 Feb. 1900, paragraphs 3, 4 and 19, Appendix, p. 818.

(*k*) Page 560.

(*l*) Page 584.

(*m*) Page 567.

(*n*) Page 560.

(*o*) Page 565.

(*p*) Page 569.

(*q*) The same construction is arrived at by treating sect. 2 (2) as imported without the qualifications contained in it. Cf. *Re Anglesea Colliery Co.*, L. R. 1 Ch. 555, a decision on sects. 38 and 74 of the Companies Act, 1862.

(*r*) Sect. 2 (2) (c), p. 610.

(*s*) Cf. sect. 12, "Search warrant," and "Forfeiture without conviction," pp. 618, 619.

large proportion of the goods seized upon importation is seized because they bear words or lettering in the English language (*t*).

As regards words forming parts of the goods on which they appear, see *ante*, p. 572; and as regards goods partly made in two or more countries, p. 574.

Goods from the Colonies or the United States.

The practice of the Customs House authorities in the matter was stated by Mr. Follett, in the paper already cited (*u*), to be based upon the conclusion that "the use of the English language and of English trade descriptions was misleading and *primâ facie* inadmissible on foreign goods; but that this could not be held to apply to foreign goods coming from the United States or the Colonies."

Goods bearing British or Irish trade-marks or names.

All goods of foreign manufacture, &c.]—The prohibition of this part of sub-sect. (1) is absolute (subject to the proviso contained in it) without regard to intention, or to any licence or right to use the name or trade-mark from the proprietor, and it applies where the name or trade-mark has been applied by the proprietor himself, or in accordance with his orders, for the section is intended to guard against the importation of goods which appear to be home-made, because they bear the name or trade-mark of a manufacturer, &c. in the United Kingdom, in cases where the name or trade-mark is used honestly, and in cases where it is used with, as well as where it is used without, the concurrence of the manufacturer (*x*). The last cases are already provided for, since the goods would be liable to forfeiture under the earlier parts of the Act.

Only manufactured goods are included.

Manufactured goods only come within this part of the sub-section, although the Act generally applies to all goods whatsoever which are the subject of trade, manufacture, or merchandise (*y*). According to the view of the Act taken by the Customs authorities, goods which have undergone any

(*t*) See sect. 3 (1) (b), "place or country," p. 574.

(*u*) M. M. A. Report, 1890, Appendix, p. 275.

(*x*) See Customs General Order, 26 Feb. 1900, r. 29, Appendix, p. 824.

(*y*) Sect. 3 (1), "goods,"

process of manufacture, for instance, ground wheat, or hides tanned in the least degree, are manufactured goods (*z*).

Bearing any name, &c.]—It is unfortunate that the expression "having applied to them," which is defined in the Act (*a*), was not here used instead of "bearing." It is doubtful whether a name or mark which is not placed upon the goods or their covering, but is otherwise used in connection with them in any manner calculated to lead to the belief that the goods are designated or described by it, would be borne by the goods within the meaning of the sub-section (*b*).

Name (*c*).]—This includes any abbreviation of a name (*d*), and, therefore, initials which are the equivalent of a name in the market, as, for instance, D. L. R. & Co. for De La Rue & Co. (*e*).

Trade-mark.]—According to the definition of the Act, trade-mark means a registered trade-mark, or a trade-mark which is protected in any British possession or foreign state to which the provisions of sect. 103 of the Patents, &c. Act, 1883, are applied (*f*); but the draughtsman of this section of the Act must have intended to include other marks, for a mark purporting to be the trade-mark of a manufacturer, and not being such trade-mark, could hardly be a registered trade-mark. It is probably impossible to adopt this meaning in the construction of the Act, having regard to the express words of the interpretation clause. In other parts of the Act marks nearly resembling trade-marks are specially mentioned (*g*).

Customs register of names and marks.

To enable the Customs officers to carry out the provisions of the section prohibiting the importation of goods marked with the names or trade-marks of manufacturers, dealers, or traders within the United Kingdom, registers of the names and trade-marks of such persons as choose to avail themselves

(*z*) M. M. A. Report, 1890, Evidence of Messrs. Seymour and Follett, Q. 286.

(*a*) Sect. 5, p. 567.

(*b*) This would be within sect. 5 (d), p. 567. And cf. the use of a trade-mark which constitutes an infringement, above, p. 369.

(*c*) See "names and initials," p. 589.

(*d*) Sect. 3 (1).

(*e*) Mr. Follett, M. M. A. Report, 1890, p. 276.

(*f*) Sect. 3 (1).

(*g*) *E.g.*, sect. 4 (a) and sect. 5 (3).

of them are kept at the various ports of the United Kingdom in accordance with rules 26—28 of the Customs General Order of 26th February, 1900 (*h*).

"Made in Germany."

Indication of the country, &c.]—The Committee of 1890 refused to recommend that the words "made abroad" be accepted as sufficient to pass the goods instead of the words "made in Germany," &c., then required, where, without the statement as to origin, the goods marked would fall within the section (*i*). But a recommendation to this effect has been made by the Committee of 1897 (*k*); and now with regard to (a) goods, whether manufactured or raw, having applied to them any description, figures, words, &c. which by being or including, either expressly or by reference, the name of a place in, or a part of, the United Kingdom, or otherwise constitute a statement or indication that the goods were made or produced in the United Kingdom, the words "made abroad" will be generally sufficient (*l*). With regard to (b) goods of foreign manufacture bearing any name or mark which is, or purports (*m*) to be, the name or trade-mark of a manufacturer, dealer, or trader in the United Kingdom, the name of the country is a sufficient indication without the words "Made in," if the name or trade-mark only appears. Where there is an address, as "John Smith, Sheffield," then the qualification must be "Made in Germany," or similar words. "Germany" alone would not counteract "Sheffield" (*n*). With regard to (c) goods, whether manufactured or raw, having applied to them a generally used trade description which, in indicating a particular class of goods or method of manufacture, includes expressly the name of a place in, or a part of, the United

(*h*) Appendix, p. 824. See the form of declaration on registration, p. 835.

(*i*) Cf. the case of goods bearing English words, pp. 572 and 577. Where a trade description suggesting an English origin has to be explained, and it does not fall within sect. 16 (1), the qualification "made abroad" is sufficient.

(*k*) M. M. A. Report, 1897, p. iv.

(*l*) Customs General Order of 26 Feb. 1900, rr. 4 (a), 7, 8, Appendix, pp. 819, 820.

(*m*) As to the meaning of "purports" in this connection, see the Customs General Order of 26 Feb. 1900, r. 5, Appendix, *post*, p. 819.

(*n*) Customs General Order of 26 Feb. 1900, rr. 4 (b), 8, Appendix, *post*, pp. 819, 820.

Kingdom, and is thereby calculated to mislead as to the place of manufacture or production of the goods, the full statement "Made" (*e.g.*) "in Germany" is required (*o*).

An indication which can readily be removed, for instance, words on a label attached by a string, is not accepted as sufficient to take the goods out of the section (*p*). It is, of course, a question of fact whether the explanation does accompany the objectionable name or trade-mark, and a merely pretended accompanying would be of no account.

The Customs officers are not expected to decide whether goods were actually made or produced in the country from which in the qualification they are stated to come: the name of *some* foreign country, or of some place in a foreign country, is sufficient (*q*). If the goods bear the name of a place identical with, or a colourable imitation of, the name of a place in the United Kingdom, the name should be accompanied by the name of the country in which the place is situated—*e.g.*, Boston, in Massachusetts, by the name "United States," or by the initials "U. S. A.," or even by the abridgement "Mass." (*r*).

In 1896 orders were given by the Customs to detain goods only where they bore marks raising a direct claim to British origin, or bearing a name or trade-mark of some one known firm having its principal place of business in the United Kingdom, without qualification. The Committee of 1897, however, expressed the opinion that while these orders have given great relief, it is unnecessary and uncalled-for to detain goods and insist upon a qualification because they are marked with English words of description, if intended for sale in this

(*o*) Customs General Order of 26 Feb. 1900, rr. 4 (c), 8, Appendix, *post*, pp. 819, 820.

(*p*) M. M. A. Report, 1890, Q. 1953. The Lords' Committee on the Marking of Foreign Meat (1893) have recently reported that: "Traders complain that importers are only compelled by the M. M. Act to apply the mark of foreign origin to the package, and that the contents are systematically branded by English importers with English titles." Report, p. x.

(*q*) Customs General Order of 26 Feb. 1900, r. 9, Appendix, p. 820. Cf. r. 30, App., p. 825, as to qualifying marks added as a condition of release.

(*r*) *Ibid.* r. 10, Appendix, p. 820. As to "initials" generally, see *ibid.* r. 12, Appendix, p. 820.

country, or with words in the language of that to which they are consigned, unless such words are calculated to deceive the purchaser in regard to the country of origin. The Committee added that the practice of the Customs should, in their opinion, be in the direction of requiring the excision of offending marks, rather than in that of adding a qualifying mark (*s*). In accordance with this recommendation (*s*) a rule has been laid down to the effect that trade descriptions in the English language applied to foreign goods are not to be regarded as a direct or indirect indication that the goods are of British or Irish origin, unless the Customs officers have good ground for considering that such trade descriptions are specially designed to convey, and do, in fact, convey, an impression of British or Irish origin for the goods (*t*). These regulations have considerably diminished the number of cases in which goods have had to be stopped (*u*).

Goods in transit.

Importation.]—In spite of a strong appeal from shipping agents and other traders, whose businesses were said to be adversely affected by the working of the Act, the Committee of 1890 refused to recommend the exclusion of goods in transit from the operation of the M. M. A.

Such a recommendation was, however, made by the Committee of 1897 (*x*), and although to give full effect to it an alteration in the law would be required, the Commissioners of Customs, acting in the spirit of the recommendation, have adopted the principle that no examination, transhipment, or transit of goods is to be made specially for the purpose of scrutinising marks, and such goods are not detained under the M. M. A. unless they infringe its provisions in one or other of the following ways:—(a) By bearing marks which raise a clear and direct claim to British origin; (b) by bearing the name or trade-mark of a manufacturer, dealer, or

(*s*) M. M. A. Report, 1897, p. iv.

(*t*) See 42nd Rep. Commrs. of Customs, 1898, p. 8; also Customs General Order of 26 Feb. 1900, r. 11, Appendix, *post*, p. 820.

(*u*) See 43rd Rep. Commrs. of Customs, 1899, p. 10,

(*x*) The objections to the inclusion of goods in transit are forcibly summed up in the M. M. A. Report, 1897, pp. iii, iv. Under the Madrid Convention of 1891, the authorities are not bound to effect the seizure of goods in transit. Appendix, p. 772,

trader in the United Kingdom; (c) by bearing a trade-mark specially registered at the Customs (*y*).

Name of place in the United Kingdom.

Name of place in the United Kingdom.]—Sub-sect. (4), dealing with offences effected by false trade descriptions as to place or country (*z*), is more stringent than the proviso of sect. 18, since that only applies where the use of the name of a place or country is calculated to deceive.

The three classes of cases under this sub-section have been set out above (*a*) in dealing with *Indication of the country of origin*. They include, as will be observed, in effect cases —(a) where the name is intended to refer to the place in the United Kingdom of which it is the name, and to that alone; (b) where the name is that of a foreign place to which it is intended to refer, for instance, Boston; (c) where the name has originally been taken from the place in the United Kingdom, but is used to describe the goods or their process of manufacture, without any reference to the place being intended.

(a) Goods supplied according to an order from an English trader to a foreign manufacturer requiring the latter to put the address of the former on goods manufactured for him, would come under the first class, and so also would goods bearing such inscriptions as "A present from Brighton," as well as goods expressly marked *English*, *Irish*, *London-made*, or with any similar express misstatements (*b*); (b) the second class, which relates to manufactured goods and not to entirely raw goods, is unimportant; (c) Kidderminster carpets, Windsor soap, Balbriggan hose, Shetland shawls (*c*), and Cheddar cheese, are examples of the third class. Where, however, such a description has become associated with a particular class of goods in a manner practically to preclude any probability of deception, as "Portland cement" and "Bath chaps," the description need not be accompanied by a state-

(*y*) 42 Rep. Commrs. of Customs, 1898, p. 8; General Order of 26 Feb. 1900, r. 36, Appendix, *post*, p. 825.

(*z*) Sect. 3 (1) (b), "place or country," p. 574; sect. 18, p. 594.

(*a*) See p. 631.

(*b*) Cf. Customs General Order of 26 Feb. 1900, rr. 4 (a), 37, Appendix, pp. 819, 826.

(*c*) These examples are given in the Customs General Order, r. 6, Appendix, p. 819.

ment of the country of actual production. This applies also to the case of colonial names describing, for instance, classes of wool, &c. where, although the names are British, the circumstances preclude mistake (*d*). The saving contained in sect. 18 with regard to conventional or generic descriptions (*e*) does not apply to sect. 16 (4), for the words of the latter are precise, that the name shall be treated as if it were the name of a place in the United Kingdom, and therefore not a description of the goods. In any case, however, the proviso of sect. 18 requires the name of the place or country where the goods were actually made or produced to be added, if the description includes the name of a place or country, and is calculated to mislead.

Customs regulations.]—The general orders (*f*) and other regulations (*f*) issued by the Customs authorities under the Acts are set out in the Appendix. The regulations provide, in accordance with the Act, that where goods are detected by the officers to be such as are prohibited to be imported, they are to be detained (*g*). They do not, however, contemplate that the officers will be competent of their own knowledge to detect the attempted infringement of the Act in all cases, or in all classes of cases (*h*); and accordingly they make provision for the officers to act upon information (*i*) given by private persons, for instance, by the owners of trade-marks or names which are likely to be wrongly used on imported goods, and in certain cases they require the informants to give security (*k*), or to make a deposit of money (*l*), as a condition of the detention of the goods. The register of names and trade-marks for the use of Custom officers has already been referred to (*m*).

An information relating to a forged trade-mark, alleged to

(*d*) Customs General Order, r. 6.

(*e*) Above, p. 594.

(*f*) Appendix, pp. 818 *et seq.*

(*g*) Pages 820, 832.

(*h*) General Order of 26 Feb. 1900, rr. 9, 12.

(*i*) Regulations 2 and 3. Form of notice to Customs officer, p. 834.

(*k*) Form of bond, p. 834. Regulations, 3, 4, 7, p. 833.

(*l*) General Order of 26 Feb. 1900, r. 47, p. 828.

(*m*) Page 630; General Order of 26 Feb. 1900, r. 26. Form of declaration, p. 835.

be one recognized in a British possession or foreign state, will not be good unless it relates to a possession or state to which sect. 103 of the Patents, &c. Act, 1883, has been applied by Orders in Council. A list of such possessions and states will be found at p. 762.

Special regulations as to particular goods.

Special regulations as to particular goods have been made in some cases, besides the general regulations just referred to. The earliest of these relate to watches (*n*). The other exemptions from detention under the Act are of packing cases (containing goods) having the name of a port or place of destination applied to them in which the goods are clearly not intended to be sold or exposed for sale (*o*); address marks, when they are merely and manifestly such, for purposes of carriage only (*p*); sardines from places other than France bearing the trade description *Sardines à l'huile* (*q*); samples or patterns, readily distinguished as such and valueless in themselves (so far as British origin is concerned) (*r*); goods not produced in the United Kingdom, such as wine, tea, and other produce not grown in this country, such as linseed, rapeseed, &c. (so far as British origin is concerned); this exemption is applied further to some special forms of manufacture which by shape, make or colour cannot be mistaken for the manufacture here of the same article, *e.g.*, Dutch cheese, of the kind well known to be made in Holland, bearing the initials of British dealers (*s*); "coverings," such as boxes, capsules, bottles, &c., if the marks, such as Royal arms, refer not to the coverings themselves, but to the goods to be covered, and it is shown to the satisfaction of the officer that they will be British goods, or goods as to which British marks are not objectionable (*t*). The rule last stated applies to coverings (such as ornamental boxes for tobacco, tea, or confectionery) with names on them of firms who have

Marks not intended to reach purchasers.

Address marks.

Sardines.

Goods not produced in United Kingdom.

"Coverings."

(*n*) General Order of 18 Jan. 1888, p. 836; and see General Order of 26 Feb. 1900, r. 45, p. 828.

(*o*) General Order of 26 Feb. 1900, r. 13, p. 821.

(*p*) *Ibid.* r. 13, p. 821.

(*q*) General Order of 18 Dec. 1888, p. 839.

(*r*) General Order of 26 Feb. 1900, r. 17, p. 822.

(*s*) *Ibid.* r. 18.

(*t*) *Ibid.* r. 14, p. 821. If, as rarely happens, the marks refer distinctly to the coverings, the case should be reserved for the Board. *Ibid.*

ordered the coverings for their own goods, or where such firms, though not having actually ordered the coverings themselves, consent in writing to their importation for such goods (*u*).

Grain sacks.

The name and address of a merchant in this country upon grain sacks are regarded as an indication that the grain is of British origin, and require the addition of a statement of the country of production. In the case of grain imported in bulk and transferred *after due entry and clearance* into sacks on board the importing ship, such marking of the sacks does not need to be qualified with a statement of the foreign origin of the grain (*x*). And by the General Order of the 26th of February, 1900 (*y*), discretionary powers have been conferred on officers, without a special order, to admit goods within the letter of the Act which are either articles, not dutiable, sent to an individual as presents or for personal use; articles, not new and manifestly private property, and old, used, or damaged articles sent into the United Kingdom for repairs; returned samples of no value, made by competing firms in the United Kingdom; certain foreign samples imported for purposes of manufacture or comparison, or British returned goods, not dutiable, or in respect of which no drawback could have been received.

Goods for private use.

Goods for repair.

Samples.

Returns.

Practice of the Customs authorities.

The authorities when they have seized goods as contravening the Act, either forfeit and destroy or sell them, or release them upon receiving satisfactory explanations, or upon the removal or qualification of the objectionable marks, and, in some instances, upon the payment of fines (*z*). The officers are directed to take care that, in all cases where the Board allow qualifying words to be added before the delivery of goods, such words are applied in characters clear, conspicuous and as indelible as the marks requiring qualification, and in close proximity to those marks (*a*).

Proceedings against the Customs authorities

Any proceedings taken against the Customs authorities or their officers, in respect of anything done or omitted in execution or intended execution of their duties under the

(*u*) General Order of 26 Feb. 1900, r. 15, p. 821.

(*x*) *Ibid.* r. 16, p. 821.

(*y*) Rr. 31—35, p. 823.

(*z*) See the return of goods detained in transit down to March, 1890, M. M. A. Report, 1890, Appendix, p. 326.

(*a*) General Order of 26 Feb. 1900, r. 41, p. 827.

Act, fall within the Public Authorities Protection Act, 1893 (*b*), so that the proceedings must be commenced within six months; judgment for the defendant carries costs as between solicitor and client; the defendant may plead a tender of amends, and if the plaintiff does not recover more than the amount tendered, the defendant is entitled to costs (but this provision is not to affect costs on any injunction in the action); and if, in the opinion of the Court, the plaintiff has not given the defendant a sufficient opportunity of tendering amends before the commencement of the proceedings, the Court may award to the defendant costs as between solicitor and client (*c*).

It has been held that an officer is not liable in trespass for detaining goods while in doubt whether they ought to be detained or not, and until the Commissioners of Customs had given directions concerning them, although he might, it was said, have been liable in damages for so detaining them for an unreasonable time (*d*). In an earlier case, it was held that for a wrongful refusal, except upon payment of an excessive amount of duty, to sign a bill of entry in order to enable goods to pass, an officer might be sued (*e*). The orders of his superior officer do not afford any defence for an officer who has acted illegally to the prejudice of any British subject (*f*).

(*b*) 56 & 57 Vict. c. 61, which has repealed 39 & 40 Vict. c. 36, ss. 267 to 272, and 40 & 41 Vict. c. 13, s. 4.

(*c*) This replaces the old requirement of one month's notice of action. Where at the trial by a judge with a jury of an action against a public authority the latter succeeds, but the judge is satisfied that such good cause appears as to warrant him, under R. S. C. O. 65, r. 1, in depriving the defendant authority of costs, he may do so notwithstanding sect. 1 of the Public Authorities Protection Act, 1893: *Bostock* v. *Ramsey Urban Council*, (1900) 1 Q. B. 357; (1900) 2 Q. B. 616, Lord Russell of Killowen, C. J. and C. A.; overruling the decision of Bruce, J., in *Cree* v. *St. Pancras Vestry*, (1899) 1 Q. B. 693; 68 L. J. Q. B. 389. The provision does not apply to appeals, *Fielden* v. *Morley Corporation*, (1900) A. C. 133.

(*d*) *Jacobsohn* v. *Blake*, 6 M. & G. 919; 7 Scott, N. R. 772 (1844).

(*e*) *Barry* v. *Arnaud*, 10 Ad. & Ell. 670 (1839).

(*f*) See *Walker* v. *Baird*, (1892) A. C. 491; *Sands* v. *Child*, 3 Lev. 352 (1693), and *Entick* v. *Carrington*, 19 State Trials, 1043 (1765). And see further *Raleigh* v. *Goschen*, (1898) 1 Ch. 73; 69 L. J. Ch. 59, Romer, J.

CHAPTER II.

MISCELLANEOUS MATTERS.

False representation as to grant of patent or registration of design or trade-mark.]—By **sect. 105** of the Patents, &c. Act, 1883—

Penalty on falsely representing articles to be patented.

"(1.) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade-mark applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction (*a*) to a fine not exceeding five pounds.

"(2.) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or a trade-mark is registered, if he sells the article with the word 'patent,' 'patented,' 'registered,' or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article."

The offences here dealt with are applications of false trade descriptions (*b*), but the liability to punishment under the M. M. A. would afford no answer to a prosecution under the above section (*c*).

And an infringement of the section is no bar to an application for the registration of the trade-mark which has been wrongly described as registered (*d*).

Sub-sect. (2), if taken literally, makes the use of "patent" unlawful in cases where, apart from its provision, the use of the word would not have been held to amount to a false or

(*a*) As to the Isle of Man, see Act of 1883, sect. 112; and as to Ireland, *ibid.* sect. 117.

(*b*) See M. M. A. 1887, s. 3 (*a*), above, pp. 570, 579.

(*c*) M. M. A. s. 19 (1), above, p. 618.

(*d*) *James' Tm.*, 33 C. D. 392; 3 R. P. C. 340 (1886), C. A.: see above, p. 407.

misleading claim of a patent right, as, for example, where no patent has ever existed but the word has become part of the trade-name of the goods and has been used by the manufacturer in his description of them (*e*). It also prohibits the use of such ordinary names of commerce as "patent leather" and "patent medicine" (*f*). It is submitted that some limitation must be placed upon the literal meaning of the enactment which will exclude these cases from the section (*g*). The use of the word "Registered" has been held to indicate registration in the United Kingdom (*h*).

Falsification of the Register of Patents, Designs, and Trade-marks.]—By **sect. 93** of the above-mentioned Act of 1883—

Falsification of entries in Registers.

"If any person makes or causes to be made a false entry in any Register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor."

False declaration as to country or place where a watch case was made.]—By **sect. 8** (3) of the **M. M. A. 1887**—

False declaration as to watch case.

"Every person (*i*) who makes a false declaration for the purposes of this section shall be liable, on conviction on indictment, to the penalties of perjury, and on summary conviction, to a fine not exceeding 20*l.* for each offence."

(*e*) *Edelsten* v. *Vick*, 11 Hare, 78 (1858), Wood, V.-C. (*Tayler & Co.'s Patent Solid-headed Pins*); see further, Book I. Chap. XV. p. 401; *Gridley* v. *Swinborne*, 52 J. P. 739, 791; 5 T. L. R. 71 (1888), Div. Court, *Swinborne's Patent Refined Isinglass*, held not to be a false trade description, see the last chapter, p. 580.

(*f*) See above, p. 403.

(*g*) Application for a patent, or provisional protection, does not authorize the use of the word patent; but, it is submitted, the acceptance of the complete specification of a patent does. See above, p. 580.

(*h*) *Wright, Crossley & Co.* v. *William Dobbin & Co.*, 15 R. P. C. 21 (1898) in Ireland. *MacSymons' Stores, Ld.* v. *Shuttleworth*, 15 R. P. C. 748 (1898) in England. See above, p. 581. The use of the words "Trade Mark," in relation to an unregistered trade-mark, is not necessarily an offence under the section: *Sen Sen Co.* v. *Britten*, (1899) 1 Ch. 692; 16 R. P. C. 137.

(*i*) "Person" includes corporation and partnership, above, p. 558; as to limitation of time for proceedings, see above, p. 615; for sect. 8, see p. 622.

False representation as to Royal warrant.]—By sect. 20 of the M. M. A. of 1887—

False representation as to Royal warrant.

"Any person (*j*) who falsely represents that any goods are made by a person holding a Royal warrant, or for the service of Her Majesty, or any of the Royal Family, or any government department, shall be liable, on summary conviction (*k*), to a penalty not exceeding 20*l*.

Unauthorized assumption of Royal arms.]—By sect. 106 of the Patents, &c., Act of 1883—

Penalty on unauthorised assumption of Royal arms.

"Any person who, without the authority of Her Majesty, or any of the Royal Family, or of any government department, assumes or uses in connection with any trade, business, calling, or profession, the Royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction (*l*) to a fine not exceeding 20*l*."

In a recent prosecution under this section the defendant unsuccessfully contended that he was entitled to use the Royal arms as he held a patent for an invention which he was using in his business, and the Patent Office was a Government department (*m*).

The Cutlers' Marks Act, 1819.

Cutlery marks.]—By the Act 59 Geo. 3, c. 7, it is forbidden to mark cutlery and the other goods mentioned in the Act with the figure of a hammer, unless the goods have been wrought or forged, or to place false marks of quality upon such goods, or to falsely mark them as London made; and the offences created by the Act extend to selling, or having in possession for the purposes of sale, such goods marked in breach of the Act. The material provisions of the Act (*n*) may be summarised as follows:—

Hammer marks.

1. Where any knives, knife-blades, forks, razors, razor-

(*j*) See note (*i*), above.

(*k*) In Scotland, in the Sheriff Court (sect. 21); and in the Dublin police district, the Courts of the justices under the Petty Sessions Act, 1851 (sect. 22).

(*l*) As to the Isle of Man, see Act of 1883, sect. 112; and as to Ireland, *ibid.* sect. 117.

(*m*) *Webber & Co.'s Case*, Times, Feb. 2, 1897.

blades, scissors, shears, and other articles of cutlery, edge tools and hardware requiring a cutting edge, of wrought steel, or of iron and steel, are made by means of the hammer, the maker may mark the figure of a hammer upon them before they are ground.

3. No one may mark such figure on any of the goods enumerated not so made, before the *bonâ fide* sale of the goods to the user, or have in his possession for the purpose of sale, or sell any such goods not so made, and being marked with such figure, under penalty of forfeiture of the goods and a fine of 5*l.* for every dozen.

Quality marks.

4. No one may mark on any of the goods enumerated, whether made with the hammer or cast in a mould, before the *bonâ fide* sale of the same to the user, "any word or words which shall or may denote or indicate the quality of such articles to be otherwise than the real and true quality thereof," or have in his possession for the purpose of sale, or sell any such goods so marked, under penalties as aforesaid.

London made.

5. No one may mark on any of the goods enumerated whether made with the hammer or cast in a mould, before the *bonâ fide* sale of the same to the user, the word or words *London* or *London made*, or any word or words having any similitude thereto, unless the goods were made in the City of London, or within twenty miles distance therefrom, or have in his possession, &c., or sell (as before) under a penalty of forfeiture and fine of 10*l.* a dozen articles.

Innocent purchasers.

7. Any one having in his possession for the purposes of sale, or selling any of the goods aforesaid contrary to the Act, who shall, before information or complaint laid against him, prove satisfactorily by oath before one or more justice or justices that he purchased the goods with the marks thereon without knowing they were marked contrary to the Act, and shall discover to two or more justices the name of the person from whom he bought, so that the latter shall be prosecuted to conviction, shall not be liable to penalties himself (*o*), but shall be entitled to two-thirds of the penalty recovered from his vendor, as any other informer.

Counterfeiting Sheffield corporate marks.

The Cutlers' Co. Act of 1814 contains a provision inflicting penalties upon any person who counterfeits or imitates assigned corporate marks; and by sect. 81 (13) of the Patents, &c. Act of 1883, this provision has been extended to any mark entered

(*n*) Sect. 17 has been repealed by the Stat. Law Rev. Act, 1873, and sect. 2 by the Stat. Law Rev. Act, 1874, sects. 8—10 in part, and sects. 11—13 and 15 wholly, repealed by 47 & 48 Vict. c. 43, s. 4.

(*o*) Cf. M. M. A. sect. 2, "unless he proves," above, pp. 601, 607.

in the Sheffield Register (*p*). The section of the first-mentioned Act is as follows (*q*) :—

"If any member or members of the Cutlers' Company, or any other person or persons using, exercising, or carrying on any of such arts or trades as aforesaid within the said lordship or liberty, or six miles compass of the same, shall at any time after the passing of this Act strike, engrave, impress or use, or cause or procure to be stricken, engraved, impressed or used upon his or their goods, wares, or manufactures, any mark, device, stamp, or impression, with intent to counterfeit or imitate any mark or device assigned, or which may hereafter be assigned, by the said master, wardens, or searchers and assistants of the said company, to be used by any other person, the person or persons so offending shall, for every such offence, forfeit and pay (in lieu of the penalty imposed by the said last recited Act (*r*)) any sum not exceeding 20*l*., one moiety whereof shall be paid to the person whose mark shall have been so counterfeited or imitated, and the other moiety to the said master and wardens of the said company; and the provisions in the said last recited Act (*r*) contained for the recovery and application of the penalty thereby imposed shall be used, applied, and put in force for the recovery and application of the penalty hereby made payable, as fully and effectually as if the same provisions were in this Act severally and separately repeated and re-enacted."

The sections of the Cutlers' Co. Act of 1791 (*s*), which are referred to and incorporated by the last-mentioned section, provide (sect. 26) that the penalties may be sued for by the company, or (sect. 27) recovered summarily before a justice or justices of the West Riding of York, or of the county of Derby, who shall have power to award costs, and to issue a distress warrant, or, if the goods of the offender are insufficient, to commit him to the House of Correction for one month to enforce payment of the penalty. Sect. 28 contains a form of conviction, and sect. 29 gives an appeal to quarter sessions.

Statutes relating to particular goods.

A number of statutes of little general importance, requiring special marks to be placed upon particular classes of goods, are summarized in the Appendix, p. 846.

(*p*) Above, p. 111.

(*q*) 54 Geo. 3, c. 119, s. 5 (local).

(*r*) The Cutlers' Co. Act of 1791, see above, p. 102.

(*s*) 31 Geo. 3, c. 58 (local).

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APPENDIX.

No. 1.

THE PATENTS, DESIGNS, AND TRADE-MARKS ACT, 1883,

As amended by the Act of 1888 (*a*).

ARRANGEMENT OF SECTIONS.

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80. Fees for registration, &c.

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81. Registration by Cutlers' Company of Sheffield marks.

(*a*) These Acts have been printed from Mr. Lewis Edmunds' "Patents, &c. Acts, Consolidated," by his permission.

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111. General saving for jurisdiction of courts.
112. Isle of Man.
[112a. Jurisdiction of Lancashire Palatine Court.]

Repeal; Transitional Provisions; Savings.
113. Repeal and saving for past operation of repealed enactments, &c.
114. Former Registers to be deemed continued.
115. Saving for existing rules.
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117. General definitions.

The FIRST SCHEDULE.—Forms of application, &c.

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46 & 47 Vict. c. 57.

An Act to amend and consolidate the Law relating to Patents for Inventions, Registration of Designs, and of Trade-Marks. [25th August, 1883.]

51 & 52 Vict. c. 50.

An Act to amend the Patents, Designs, and Trade-Marks Act, 1883. [24th December, 1888.]

*** The general text of the Act of 1883 is adhered to. The repealed parts are printed in italics, and the additions in square brackets. The amending Act and section are quoted in the margin.

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

PART I.—Preliminary.

1. This Act may be cited as the Patents, Designs, and Trade-Marks Act, 1883. Short title.

By Act 1888, s. 29, the principal Act of 1883, and the Amending Acts of 1885, 1886, and 1888, may be cited collectively as the Patents, Designs, and Trade-Marks Acts, 1883 to 1888.

The Acts of 1885 and 1886 do not relate to trade-marks.

2. This Act is divided into parts, as follows:— Division of Act into parts.

Part I.—Preliminary.
II.—Patents.
III.—Designs.
IV.—Trade-Marks.
V.—General.

3. This Act, except where it is otherwise expressed, shall commence from and immediately after the thirty-first day of December one thousand eight hundred and eighty-three. Commencement of Act.

[The Act of 1888 shall, except so far as is thereby otherwise specially provided, commence and come into operation on the first day of January one thousand eight hundred and eighty-nine.] Act, 1888, s. 28.

What Act applied to pending registrations, p. 121.

PART IV.—Trade-Marks.

Registration of Trade-Marks.

Application for registration.

62. (1.) The Comptroller may, on application by or on behalf of any person claiming to be the proprietor of a trade-mark, register the trade-mark.

The Comptroller, p. 57, and sect. 82.
Discretion to refuse registration, although the mark tendered is within sect. 64, p. 69.
Intention to use mark necessary, p. 119.
Registration of trade-marks, Chap. IV., p. 63.
Person includes firm or partnership (Rule 7, p. 692), and body corporate, sect. 117. See also Instructions 11, p. 726.
Proprietor, see as to who may apply to register, p. 65.
Procedure on application to register, p. 75.
Application by agent, p. 68. The agent must be authorised to the satisfaction of the Comptroller. Rule 9, p. 692, and Instructions 12, p. 726.

Act, 1888, s. 8.

(2.) The application must be made in the form set forth in the First Schedule to this Act, or in such other form as may be from time to time prescribed, and must be left at, or sent by post to *the Patent Office in the prescribed manner* [such place and in such manner as may be prescribed].

Form of application, p. 75, Form F., p. 706.
Address of the Patent Office, p. 56; Instructions 8, p. 725; Rule 8, p. 692.
Applications in classes 23, 24, or 25 go to the Manchester Branch Office, Chap. VII., p. 113; Instructions 8, p. 725; Rule 8, p. 692.
As to Sheffield marks, see Chap. VI., p. 101, sect. 81, Rules 56—59, p. 701.

(3.) The application must be accompanied by the prescribed number of representations of the trade-mark, and must state the particular goods or classes of goods in connexion with which the applicant desires the trade-mark to be registered.

Representations, Instructions 9, 15 and 16, pp. 725, 726; Rules 14 and 15, p. 694.
Classes of goods, Chap. V., p. 96; list of classes, p. 715.

(4.) The Comptroller may, if he thinks fit, refuse to register a trade-mark, but any such refusal shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the Comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

Discretion to refuse, p. 69.
Applicant is entitled to be heard before the refusal, p. 74, sect. 64, Rules 17 and 18, p. 695.
Appeal to Board of Trade, p. 86; Forms, pp. 707, 737; Rules 20 to 26, p. 695.
Registration subject to conditions, p. 92. See also sect. 69 (3).

(5.) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court; and in that event the Court

shall have jurisdiction to hear and determine the appeal and may make such order as aforesaid.

Reference of the appeal to the Court, p. 88.
No direct appeal to the Court, p. 88.
The Court, p. 88, sect. 117 (1).
Summons or notice of motion, p. 89; Forms, pp. 735 *et seq.*
Costs, p. 93.
An order of the Court allowing an appeal must be served on the Comptroller, Rule 46, p. 700.

[(6.) Where an applicant for the registration of a trade-mark otherwise than under an international convention is out of the United Kingdom at the time of making the application he shall give the Comptroller an address for service in the United Kingdom, and if he fails to do so the application shall not be proceeded with until the address has been given.] Act, 1888, s. 8.

Page 76, cf. opponent's address, sect. 69 (6).
International Convention, Chap. XX., p. 545, sect. 103. The Convention is printed at p. 764.
As to applications to rectify where the registered proprietor is resident abroad, see p. 288.

63. Where registration of a trade-mark has not been or shall not be completed within twelve months from the date of the application, by reason of default on the part of the applicant, *the application shall be deemed to be abandoned* [the Comptroller shall give notice of the non-completion to the agent employed on behalf of the applicant, and, if at the expiration of fourteen days from that notice the registration is not completed, shall give the like notice to the applicant, and if at the expiration of the latter fourteen days, or such further time as the Comptroller may in special cases permit, the registration is not completed, the application shall be deemed to be abandoned]. Limit of time for proceeding with application. Act, 1888, s. 9.

Abandonment of application, pp. 76, 283.
It is no bar to a subsequent application by the same person and in respect of the same mark, p. 77.

64. (1.) *For the purposes of this Act, a trade-mark must consist of or contain at least one of the following essential particulars:—* Conditions of registration of trade-mark. Repealed. Act, 1888, s. 10.

(*a*) *A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or*

(*b*) *A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade-mark; or*

(*c*) *A distinctive device, mark, brand, heading, label, ticket, or fancy word or words not in common use.*

Fancy word, p. 158.
Not in common use, p. 168.
Name of person, p. 168.

(2.) *There may be added to any one or more of these particulars*

any letters, words, or figures, or combination of letters, words, or figures, or of any of them.

(3.) *Provided that any special and distinctive word or words, letter, figure, or combination of letters or figures or of letters and figures used as a trade-mark before the thirteenth day of August one thousand eight hundred and seventy-five may be registered as a trade-mark under this part of this Act.*

Conditions of registration of trade-mark.

Act, 1888, s. 10.

64. [(1.) For the purposes of this Act, a trade-mark must consist of or contain at least one of the following essential particulars:—

As to what marks may be registered as trade-marks, see Chap. VIII., p. 115.

As to what Act applies to pending registrations, p. 121, Act of 1883, sect. 113; Act of 1888, sect. 27, p. 683.

For comparison with repealed sections, see p. 118.

Essential particulars, pp. 122, 201.

Additions, p. 124, sect. 64 (2). Additions common to the trade, p. 204, sect. 74.

(a) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or

Name marks, p. 124; trade-name, p. 462.
Name of imaginary person not included, p. 125.
Mere name in nominative case, p. 127.
Particular and distinctive manner, p. 128.

(b) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade-mark; or

Signature, p. 120.

(c) A distinctive device, mark, brand, heading, label, or ticket; or

Distinctive, pp. 132—140; loss of distinctiveness, p. 339.
Descriptive marks, pp. 36, 140, 163, 178.
The mark must be distinctive, apart from colour, pp. 150, 194.
Distinctiveness is an essential element of a trade-mark, apart from the Acts, Chap. II., p. 34.
Device, p. 141; copyright design, p. 86, n.; words not a device, p. 141.
Mark, p. 147.
Brand, p. 147.
Heading, p. 149; line headings, p. 150.
Label, p. 150; disclaimer of words in, pp. 153, 207.
Ticket, p. 156.

(d) An invented word or invented words; or

(d) not qualified by (e), p. 172.
Word marks, p. 156.
Invented word, p. 171; standard of invention, pp. 173—176.
Whether applicant need be first user, p. 177.
Decisions, pp. 177, 178.

(e) A word or words having no reference to the character

or quality of the goods, and not being a geographical name.]

Page 178. Descriptive words, pp. 36 *et seq.*, 163 *et seq.*
Secondary distinctive meaning of word *primâ facie* descriptive, pp. 36, 140, 165.
Decisions, pp. 181, 182.
Geographical names, pp. 157, 160, 182.
Decisions, p. 184.

[(2.) There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures, or combination of letters, words, or figures, or of any of them, but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade-mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the Register.]

Additions and disclaimers, Chap. IX., p. 197.
Effect of disclaimer, p. 209.
Addition of matter common to the trade, sect. 74, p. 204.
Disclaimer of person's own name, see next sub-section.
"Figures" means "numerals," *Ex parte Stephens*, 3 C. D. 659 (1876), Jessel, M.R.
Essential particulars, pp. 122, 201.
Disclaimer of devices, p. 199.
Additions to labels, pp. 201, 207.

[(3.) Provided as follows:

(i) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof:

Page 202.
Part of name, p. 203.
Possessive case, p. 204.
As to a trader's right of monopoly in his trade-name, see p. 202, Chap. XVI., pp. 452, 462; and as to whether it is the right of anyone to trade honestly under his own name, pp. 500 *et seq.*

(ii) Any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures, used as a trade-mark before the thirteenth day of August one thousand eight hundred and seventy-five, may be registered as a trade-mark under this part of this Act.]

Registration of old marks, p. 184. Not all old marks come within the clause, p. 185.
"Figure" means "numeral," *Ex parte Stephens*, 3 C. D. 659 (1876), Jessel, M.R.
13th August, 1875, date of commencement of first Registration Act.
Special and distinctive, p. 185; cf. distinctive in sub-sect. (1) (c), pp. 132—140.
Used as a trade-mark, p. 189, and Chap. II., p. 23. The mark must have been used as it is to be registered, p. 191.
Alteration of registered old mark under sect. 92, p. 298.
Common addition to old mark, sect. 74, p. 204.

Connection of trade-mark with goods.

65. A trade-mark must be registered for particular goods or classes of goods.

Classification of goods, Chap. V., p. 96; list of classes, p. 715.
A trade-mark is assignable only in connection with the goodwill of the business concerned in the goods for which it is registered, sect. 70.
Registration for part of a class, pp. 97, 219.

Registration of a series of marks.

66. When a person claiming to be the proprietor of several trade-marks which, while resembling each other in the material particulars thereof, yet differ in respect of (*a*) the statement of the goods for which they are respectively used or proposed to be used, or (*b*) statements of numbers, or (*c*) statements of price, or (*d*) statements of quality, or (*e*) statements of names of places, seeks to register such trade-marks, they may be registered as a series in one registration. A series of trade-marks shall be assignable and transmissible only as a whole, but for all other purposes each of the trade-marks composing a series shall be deemed and treated as registered separately.

Series of marks, p. 100; Representations, Rules 14 and 30, pp. 694, 696; Instructions 17, p. 726.

Trade-marks may be registered in any colour.
Act, 1888, s. 11.

67. A trade-mark may be registered in any colour [or colours], and such registration shall (subject to the provisions of this Act) confer on the registered owner the exclusive right to use the same in that or any other colour [or colours].

Colour, p. 194. The mark must be distinctive, apart from colour, p. 142.

Advertisement of application.
Act, 1888, s. 12.

68. Every application for registration of a trade-mark under this part of this Act shall as soon as may be after its receipt be advertised by the Comptroller [unless the Comptroller refuse to entertain the application].

Advertisement, p. 77; Rules 27 to 30, p. 696; Instructions 20 to 27, p. 727.
Notice of refusal is to be given to the applicant, Rule 19, p. 695; see further, as to refusal, sect. 62 (4).

Opposition to registration.
Act, 1888, s. 13, sub-ss. 1, 2.

69. (1.) Any person may within *two months* [one month or such further time, not exceeding three months, as the Comptroller may allow] of the *first* advertisement of the application, give notice in duplicate at the Patent Office of opposition to registration of the trade-mark, and the Comptroller shall send one copy of such notice to the applicant.

Opposition, pp. 79—86; Rule 31, p. 697; Instructions 32, p. 728; Summary of procedure, p. 82; Forms, pp. 708 *et seq.*
Opposition is limited to the grounds stated in the notice, p. 84; amendment, p. 84.

Act, 1888, s. 13, sub-s. 3.

(2.) Within *two months* [one month] after receipt of such notice or such further time as the Comptroller may allow, the applicant may send to the Comptroller a counter statement in

duplicate of the grounds on which he relies for his application, and if he does not do so, shall be deemed to have abandoned his application.

Counter-statement, Form, p. 736.
Abandonment: cf. abandonment of application, sect. 63. Apparently the abandonment of the opposition would not estop the opponent from applying to remove the mark from the Register under sect. 90, see *Arbenz' application*, 35 C. D., at p. 257; 4 R. P. C. p. 145, (1887) C. A.
Enlargement of time, p. 84.

(3.) *If the applicant sends such counter statement, the Comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall require him to give security in such manner and to such amount as the Comptroller may require for such costs as may be awarded in respect of such opposition; and if such security is not given within fourteen days after such requirement was made or such further time as the Comptroller may allow, the opposition shall be deemed to be withdrawn.* Repealed. Act, 1888, s. 13, sub-s. 4.

The requirement of security from an opponent was abandoned at the suggestion of Lord Herschell's Committee, Report of 1888, xiii.

(4.) *If the person who gave notice of opposition duly gives such security as aforesaid, the Comptroller shall inform the applicant thereof in writing, and thereupon the case shall be deemed to stand for the determination of the Court.*

[(3.) If the applicant sends such counter-statement the Comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall, after hearing the applicant and the opponent, if so required, decide whether the trade-mark is to be registered, but his decision shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the opponent and the Comptroller, and may make an order determining whether, and subject to what conditions (if any), registration is to be permitted.] Act, 1888, s. 13, sub-s. 4.

Appeal to Board of Trade and to the Court, pp. 86—93; cf. sect. 62 (4) and (5).
Costs, p. 93.
Forms, pp. 635 *et seq.*
Modification of application on appeal, p. 91.
Registration *subject to conditions*, p. 92, and see limitation of the registration and variation in its form, p. 282; and registration with a note, pp. 58, 99 (class of goods), p. 195 (colour), and p. 219 (use).

[(4.) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court, and in that event the Court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid.]

See last note.
An order of the Court, disallowing an opposition, must be served on the Comptroller, Rule 46, p. 700.

[(5.) If the applicant abandons his application after notice of opposition in pursuance of this section, he shall be liable to pay

to the opponent such costs in respect of the opposition as the Comptroller may determine to be reasonable.]

If a counter-statement is put in, it would seem that costs cannot be given against an applicant.

The power to give costs in respect of an abandoned application was conferred, at the suggestion of Lord Herschell's Committee, with a view to spare owners of registered trade-marks the expense of contesting unwarrantable applications to register marks which would prejudice their rights.

There is no power to give costs, in respect of proceedings before the Comptroller, against an opponent: *Australian Wine Importers' Tm.*, 41 C. D. 278; 6 R. P. C. 311 (1889), C. A.: *Brandreth's Tm.*, 9 C. D. 618 (1878), Jessel, M. R.

[(6.) Where the opponent is out of the United Kingdom, he shall give the Comptroller an address for service in the United Kingdom.]

Page 90.

Assignment and transmission of trade-mark.

70. A trade-mark, when registered, shall be assigned and transmitted only in connexion with the goodwill of the business concerned in the particular goods or classes of goods for which it has been registered, and shall be determinable with that goodwill.

Classes of goods, sect. 65. Registration is restricted to the goods for which the mark is registered, p. 307; and trade-mark rights are limited by the actual signification of the trade-marks, that is, to the goods of the original proprietor, or his successor in business, upon which it has been used, pp. 30, 307, 361.

Assignment and devolution, Chap. XIII., p. 324.

Assignment where a mark has been registered in the wrong name, pp. 68, 283.

Registration of assignments and transmissions, sects. 78 and 87, Rules 36 to 40, p. 698. Form of request for the registration of a subsequent proprietor, Form K., p. 708. Such registration before action is not essential in order to enable the subsequent proprietor to sue for infringement: *Ihlee* v. *Henshaw*, 31 C. D. 323; 3 R. P. C. 15 (1886), North, J.; but registration before the time of hearing has been held to be necessary: *Magnolia Metal Co.* v. *Atlas Metal Co.*, 14 R. P. C. 389, (1897) Collins, J., and see p. 317.

Determination of trade-mark rights, Chap. XIV., p. 338.

Conflicting claims to registration.

71. Where each of several persons claims to be registered as proprietor of the same trade-mark, the Comptroller may refuse to register any of them until their rights have been determined according to law, and the Comptroller may himself submit or require the claimants to submit their rights to the Court.

Page 212, Rules 44 and 45, p. 699. The Comptroller may require a written or oral explanation from any of the claimants in regard to his claim, Rule 43, p. 603. Old marks, up to three, which have existed independently as trade-marks, are allowed to be registered; if there are more than three, they are treated as common marks: see the "three marks rule," pp. 207, 214, and sect. 74 (3).

An old mark may be registered although a similar mark has been on the Register for five years: *Jackson* v. *Napper*, p. 385.

Restrictions on registration.

72. (1.) Except where the Court has decided that two or more persons are entitled to be registered as proprietors of the same trade-mark, the Comptroller shall not register in

respect of the same goods or description of goods a trade-mark identical with one already on the Register with respect to such goods or description of goods.

Duplicate marks, Chap. X., p. 212.
"Except, &c.," refers to sect. 71.
Same goods or *description of goods*, p. 217.
An order of the Court, allowing registration under this section, must be served on the Comptroller, Rule 46, p. 700.

(2.) [Except as aforesaid] the Comptroller shall not register with respect to the same goods or description of goods a trade-mark *so nearly resembling* [having such resemblance to] a trade-mark already on the Register with respect to such goods or description of goods as to be calculated to deceive. Act, 1888, s. 14.

See last note.
Mark resembling a registered mark, Chap. XII., pp. 220 to 252.
Comptroller's discretion, p. 69.

73. It shall not be lawful to register as part of or in combination with a trade-mark any words the *exclusive* use of which would by reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a court of justice, or any scandalous design. Further restriction on registration. Act, 1888, s. 15.

Deceptive marks, Chap. XIII., pp. 253 to 261.
"*Exclusive*" was omitted as misleading, at the suggestion of Lord Herschell's Committee, Report of 1888, p. xiii.
Cf. sect. 86, which forbids the registration of a trade-mark, the use of which would, in the Comptroller's opinion, be contrary to law or morality.

74. (1.) Nothing in this Act shall be construed to prevent the Comptroller entering on the Register, in the prescribed manner, and subject to the prescribed conditions, as an addition to any trade-mark— Saving for power to provide for entry on Register of common marks as *additions to* trade-marks.

(a) In the case of an application for registration of a trade-mark used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive device, mark, brand, heading, label, ticket, letter, word, or figure, or combination of letters, words, or figures, though the same is common to the trade in the goods with respect to which the application is made;

(b) In the case of an application for registration of a trade-mark not used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive word or combination of words, though the same is common to the trade in the goods with respect to which the application is made;

Additions and disclaimers, Chap. IX., p. 197; cf. sect. 64 (2).
What is registered as part of the mark is not an addition, *Clement et Cie.'s Tm.*, (1900) 1 Ch. 114; 16 R. P. C. 173 and 611; see also p. 208.
"Distinctive" means *primâ facie* distinctive: *Burland* v. *Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889); for its meaning in sect. 64, see pp. 131—140.

"Common to the trade" means open to the trade, p. 206; see the case last cited.

Clause (a), dealing with old marks, is wider than clause (b), because the policy of the Acts is to register old marks exactly as they were used: p. 170; *Phillips' Tm.*, (1891) 3 Ch. 139; 8 R. P. C. 469, Chitty, J.; *Henry Clay & Co.'s Tm.*, (1892) 3 Ch. 549; 9 R. P. C. 449, Kekewich, J.

Common words in a distinctive label need not be disclaimed, p. 207.

Repealed. Act, 1888, s. 16.

(2.) *The applicant for entry of any such common particular or particulars must, however, disclaim in his application any right to the exclusive use of the same, and a copy of the disclaimer shall be entered on the Register.*

Act, 1888, s. 16.

[(2.) The applicant for registration of any such addition must, however, state in his application the essential particulars of the trade-mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the Register.

Provided that a person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof.]

The amendment is in accord with that of sect. 64 (2) and (3) (i), p. 199.
As to honest trade under one's own name, see pp. 202, 500 *et seq.*

(3.) Any device, mark, brand, heading, label, ticket, letter, word, figure, or combination of letters, words, or figures, which was or were, before the thirteenth day of August one thousand eight hundred and seventy-five, publicly used by more than three persons on the same or a similar description of goods shall, for the purposes of this section, be deemed common to the trade in such goods.

The "three mark rule," pp. 207, 214.

13th of August, 1875, is the date of commencement of the first Registration Act.

Effect of Registration.

Registration equivalent to public use.

75. *Registration of a trade-mark shall be deemed to be equivalent to public use of the trade-mark.*

Act, 1888, s. 17.

[Application for registration of a trade-mark shall be deemed to be equivalent to public use of the trade-mark, and the date of the application shall for the purposes of this Act be deemed to be, and as from the first day of January one thousand eight hundred and seventy-six to have been, the date of the registration.]

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Continued registration not necessarily equivalent to continued user, p. 306.

Effect of registration, Chap. XII., p. 302. As to the acquisition of trade-marks by user, see Chap. II., p. 24.

Date of application. It was the practice, from the first, to register the

entry as of the date when the application was received by the Registrar, see Rule 20 of the Rules of 1876, and Rule 32 of the Rules of 1883. The amendment was made to give this practice statutory authority; report of Lord Herschell's Committee, p. xiii.

Entry post-dated, *Hayward's Case*, p. 233.

Right of first proprietor to exclusive use of trade-mark.

76. The registration of a person as proprietor of a trade-mark shall be primâ facie evidence of his right to the exclusive use of the trade-mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence of his right to the exclusive use of the trade-mark, subject to the provisions of this Act.

Page 306. Registration is evidence of title, conclusive only after five years, p. 361.

Rectification of the Register after five years, p. 383.

Test of infringement where the registered mark is actually copied, p. 371 For deceptive resemblance, see pp. 224—252, and pp. 372—382.

See note to sect. 71.

Restrictions on actions for infringement, and on defence to action in certain cases.

77. 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 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 thirteenth of August one thousand eight hundred and seventy-five, 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.

Registration as a condition precedent to an action for infringement, p. 312.

The prohibition does not affect actions for passing off, p. 317. It applies to foreigners, pp. 316, 357.

13th of August, 1875, is the date of commencement of the first Registration Act.

Certificate, p. 315; Rule 60, p. 702: Instructions 35, p. 730; Form of application, Form L., p. 709; Fee 1*l.*

Certificate as to exclusive use and costs thereon. Act, 1888, s. 18.

[**77a.** In an action for infringement of a registered trade-mark the Court or a judge may certify that the right to the exclusive use of the trade-mark came in question, and if the Court or a judge so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or judge trying the subsequent action certifies that he ought not to have the same.]

Pages 292 and 436.

This section was added on the precedent of sect. 31, which applied to patent actions only.

Although the validity of the trade-mark be raised on an application to remove it, yet where such application and an action by the proprietor for

infringement are heard together and on the same evidence, the certificate may be given. *Field, Ld.* v. *Wagel Syndicate Ld.*, (1900) 1 Ch. 651, 17 R. P. C. 266.

Register of Trade-Marks.

Register of trade-marks.

78. There shall be kept at the patent office a book called the Register of Trade-Marks, wherein shall be entered the names and addresses of proprietors of registered trade-marks, notifications of assignments and of transmissions of trade-marks, and such other matters as may be from time to time prescribed.

Cf. sect. 87.

The Register, Chap. III., p. 56. The date of the application for registration, and such other particulars as the Comptroller thinks necessary, are to be entered, Rule 34, p. 693.

An application to the Court has been allowed under this section where the Comptroller refused to register an assignment, p. 333; *Bancroft's Tm.*, 5 R. P. C. 209 (1888), Stirling, J.

Quære, whether an abandoned mark can be removed under the section, p. 348.

Removal of trade-mark after fourteen years, unless fee paid.

79. (1.) At a time not being less than two months nor more than three months before the expiration of fourteen years from the date of the registration of a trade-mark, the Comptroller shall send notice to the registered proprietor that the trade-mark will be removed from the Register unless the proprietor pays to the Comptroller before the expiration of such fourteen years (naming the date at which the same will expire) the prescribed fee: and if such fee be not previously paid, he shall at the expiration of one month from the date of the giving of the first notice send a second notice to the same effect.

Page 349. The cause of the removal is to be entered, Rule 47, p. 700.

(2.) If such fee be not paid before the expiration of such fourteen years the Comptroller may after the end of three months from the expiration of such fourteen years remove the mark from the Register, and so from time to time at the expiration of every period of fourteen years.

Fee 1*l.*, Form X., p. 714.

(3.) If before the expiration of the said three months the registered proprietor pays the said fee together with the additional prescribed fee, the Comptroller may without removing such trade-mark from the Register accept the said fee as if it had been paid before the expiration of the said fourteen years.

Additional fee, 10*s.*, Form Y., p. 714.

(4.) Where after the said three months a trade-mark has been removed from the Register for non-payment of the prescribed fee, the Comptroller may, if satisfied that it is just so to do, restore such trade-mark to the Register on payment of the prescribed additional fee.

Additional fee, 1*l.*, Form Z., p. 714.

(5.) Where a trade-mark has been removed from the Register for non-payment of the fee or otherwise, such trade-mark shall nevertheless for the purpose of any application for registration during *the five years* [one year] next after the date of such removal, be deemed to be a trade-mark which is already registered [unless it is shown to the satisfaction of the Comptroller that the non-payment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under that proprietor or under his bankruptcy is using the trade-mark.]

Act, 1888, s. 19, sub-s. 1.

Act, 1888, s. 19, sub-s. 2.

Page 350.

Fees.

80. There shall be paid in respect of applications and registration and other matters under this part of this Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of her Majesty's Exchequer in such manner as the Treasury may from time to time direct.

Fees for registration, &c.

List of fees, p. 703.

Sheffield Marks.

81. With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called the Cutlers' Company) and the marks or devices (in this Act called Sheffield marks) assigned or registered by the master, wardens, searchers, and assistants of that company, the following provisions shall have effect:

Registration by Cutlers' Company of Sheffield marks.

Sheffield marks, Chap. VI., p. 101, Rules 56 to 59, p. 701.
"Metal goods" is defined in sub-sect. (14).

(1.) The Cutlers' Company shall establish and keep at Sheffield a new Register of trade-marks (in this Act called the Sheffield Register):

(2.) *The Cutlers' Company shall enter in the Sheffield Register, in respect of cutlery, edge tools, or raw steel and the goods mentioned in the next sub-section all the trade-marks entered before the commencement of this Act in respect of cutlery, edge tools, or raw steel and such goods in the Register established under the Trade-Marks Registration Act,* 1875, *belonging to persons carrying on business in Hallamshire, or within six miles thereof, and shall also enter in such Register, in respect of the same goods, all the trade-marks which shall have been assigned by the Cutlers' Company and actually used before the commencement of this Act, but which have not been entered in the Register established under the Trade-Marks Registration Act,* 1875:

Act, 1888, s. 20, sub-s. 1.

Act, 1888, s. 20, sub-s. 1.

[(2.) The Cutlers' Company shall enter in the Sheffield Register, in respect of metal goods as defined in this section, all the trade-marks entered before the first day of January one thousand eight hundred and eighty-nine in respect of metal goods either in the Register established under the Trade-Marks Registration Act, 1875, or in the Register of trade-marks under this Act, belonging to persons carrying on business in Hallamshire or within six miles thereof. The Cutlers' Company shall also, on request made in the prescribed manner, enter in the Sheffield Register, in respect of metal goods, all the trade-marks which shall have been assigned by the Cutlers' Company and actually used before the first day of January one thousand eight hundred and eighty-four, but which have not been entered in either of the said other Registers:]

38 & 39 Vict. c. 91.

Act, 1888, s. 20, sub-s. 2.

(3.) An application for registration of a trade-mark used *on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge* [on metal goods] shall, if made after the commencement of this Act by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company:

(4.) Every application so made to the Cutlers' Company shall be notified to the Comptroller in the prescribed manner, and unless the Comptroller within the prescribed time gives notice to the Cutlers' Company that he objects to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner:

(5.) If the Comptroller gives notice of objection as aforesaid, the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may appeal to the Court:

(6.) Upon the registration of a trade-mark in the Sheffield Register the Cutlers' Company shall give notice thereof to the Comptroller, who shall thereupon enter the mark in the Register of trade-marks; and such registration shall bear date as of the day of application to the Cutlers' Company, and have the same effect as if the application had been made to the Comptroller on that day:

Act, 1888, s. 20, sub-s. 3.

(7.) *The provisions of this Act, and of any general Rules made under this Act, with respect to application for registration in the register of trade-marks, the effect of such registration, and the assignment and transmission of rights in a registered trade-mark shall apply in the case of applications and registration in the Sheffield Register; and notice of every entry made in the Sheffield Register must be given to the Comptroller by the Cutlers' Company, save and except that the provisions of this sub-section shall not*

prejudice or affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield Register:

[(7.) The provisions of this Act and of any general Rules made under this Act with respect to the registration of trade-marks, and all matters relating thereto, shall, subject to the provisions of this section, apply to the registration of trade-marks on metal goods by the Cutlers' Company, and to all matters relating thereto; and this Act and any such general Rules shall, so far as applicable, be construed accordingly with the substitution of the Cutlers' Company, the office of the Cutlers' Company, and the Sheffield Register, for the Comptroller, the Patent Office, and the Registrar of Trade-Marks, respectively; and notice of every entry, cancellation, or correction made in the Sheffield Register shall be given to the Comptroller by the Cutlers' Company: provided that this section shall not affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield Register:] Act, 1888, s. 20, sub-s. 3.

(8.) Where the Comptroller receives from any person not carrying on business in Hallamshire or within six miles thereof an application for registration of a trade-mark used *on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge* [on metal goods], he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company: Act, 1888, s. 20, sub-s. 2.

(9.) At the expiration of five years from the commencement of this Act the Cutlers' Company shall close the Cutlers' register of corporate trade-marks, and thereupon all marks entered therein shall, unless entered in the Sheffield Register, be deemed to have been abandoned:

(10.) A person may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield Register as proprietor of two or more trade-marks:

(11.) A body of persons, corporate or not corporate, may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield Register as proprietor of a trade-mark or trade-marks:

(12.) Any person aggrieved by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner, appeal to the Comptroller, who shall have power to confirm, reverse or modify the decision, but the decision of the Comp-

troller shall be subject to a further appeal to the Court:

Person aggrieved, cf. sect. 90, p. 265.

(13.) So much of the Cutlers' Company's Acts as applies to the summary punishment of persons counterfeiting Sheffield corporate marks, that is to say, the fifth section of the Cutlers' Company's Act of 1814, and the provisions in relation to the recovery and application of the penalty imposed by such last-mentioned section contained in the Cutlers' Company's Act of 1791, shall apply to any mark entered in the Sheffield Register:

See pp. 102 and 643.

Act, 1888, s. 20, sub-s. 4.

[(14.) For the purposes of this section the expression "metal goods" means all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal.]

[(15.) For the purpose of legal proceedings in relation to trade-marks entered in the Sheffield Register a certificate under the hand of the master of the Cutler's Company shall have the same effect as the certificate of the Comptroller.]

Certificate of the Comptroller, sect. 96, Rule 60, p. 702.

PART V.—General.

Patent Office and Proceedings thereat.

Patent Office.

82. (1.) The Treasury may provide for the purposes of this Act an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office.

As to the Patent Office, Trade-Marks Branch, see Chap. III., p. 56.

(2.) Until a new patent office is provided, the offices of the Commissioners of Patents for inventions and for the registration of designs and trade-marks existing at the commencement of this Act shall be the patent office within the meaning of this Act.

(3.) The Patent Office shall be under the immediate control of an officer called the Comptroller-General of patents, designs, and trade-marks, who shall act under the superintendence and direction of the Board of Trade.

Pages 57, 74.

(4.) Any act or thing directed to be done by or to the Comptroller may, in his absence, be done by or to any officer for the time being in that behalf authorized by the Board of Trade.

Officers and clerks.

83. (1.) The Board of Trade may at any time after the passing of this Act, and from time to time, subject to the approval of the Treasury, appoint the Comptroller-General of patents, designs, and trade-marks, and so many examiners and other officers and clerks with such designations and duties as the Board of Trade think fit, and may from time to time remove any of those officers and clerks.

(2.) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and the same and the other expenses of the execution of this Act shall be paid out of money provided by Parliament.

Seal of patent office.

84. There shall be a seal for the Patent Office, and impressions thereof shall be judicially noticed and admitted in evidence.

Cf. sect. 89, sealed and certified copies of the Registers; and sect. 96, the certificate of the Comptroller to be evidence.

Trust not to be entered in Registers.

85. There shall not be entered in any Register kept under this Act, or be receivable by the Comptroller, any notice of any trust expressed, implied, or constructive.

The section does not forbid the entry of a note upon the Register stating the effect of an undertaking limiting the right of user of the trade-mark, see pp. 58, 99 (class of goods), 195 (colour), 219 (use of mark), 282 (note entered under sect. 90), where instances of orders made will be found. The decision in *Dewhurst's Tm.*, (1896) 2 Ch. 137; 13 R. P. C. 288, seems, however, to have changed the practice; at all events as to geographical limitations.

By reason of this section, and sect. 87, the registered proprietor can make a good title to any purchaser of the trade-mark and of the goodwill of the business concerned (sect. 70), who has no notice of any equitable rights in the trade-mark or goodwill existing in any third person.

But a registered assignee who takes an assignment with notice of an equitable title in a third person takes subject to his rights, see the patent case, *New Ixion Tyre and Cycle Co., Ltd.* v. *Spilsbury*, (1898) 2 Ch. 137, 484; 15 R. P. C. 380, 567.

Refusal to grant patent, &c. in certain cases.

86. The Comptroller may refuse to grant a patent for an invention, or to register a design or trade-mark, of which the use would, in his opinion, be contrary to law or morality.

Cf. sect. 73.

Entry of assignments and transmissions in Registers.

87. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, or to a registered trade-mark, the Comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent, copyright in the design, or trade-mark, in the Register of patents, designs, or trade-marks, as the case may be. The person for the time being entered in the Register of patents, designs, or trade-marks, as proprietor of a patent, copyright in a design or trade-mark, as the case may be, shall, subject to [the provisions of this Act and to] any rights appearing from such Register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with, the same and to give effectual receipts for any consideration for

Act, 1883, s. 21.

such assignment, licence, or dealing. Provided that any equities in respect of such patent, design, or trade-mark may be enforced in like manner as in respect of any other personal property.

Assignment and devolution of trade-marks, Chap. XIII., p. 324. Registration of assignments, p. 331, Rules 36 to 40, p. 698.

As to notice of equities, see note to sect. 85.

Licence to use a trade-mark, p. 335. Licensee cannot sue, pp. 336, 359. Licence as a defence is an infringement action, p. 393.

Inspection of and extracts from Registers.

Act, 1888, s. 22.

88. Every Register kept under this Act shall at all convenient times be open to the inspection of the public, subject to [the provisions of this Act and to] such regulations as may be prescribed; and certified copies, sealed with the seal of the patent office, of any entry in such Register shall be given to any person requiring the same on payment of the prescribed fee.

Inspection, searches and indexes, pp. 60, 61. Hours of inspection, Rule 52, p. 700. Searches, Instructions 7, p. 725. Fees, for inspection or searching, 1*s.* for every quarter of an hour; for office copy of documents, for every 100 words (but never less than 1*s.*), 4*d.*; for certifying office copies, MS. or printed, 1*s.*

Sealed copies to be received in evidence.

89. Printed or written copies or extracts, purporting to be certified by the Comptroller and sealed with the seal of the patent office, of or from patents specifications disclaimers and other documents in the patent office, and of or from Registers and other books kept there, shall be admitted in evidence in all Courts in her Majesty's dominions, and in all proceedings, without further proof or production of the originals.

Cf. sect. 84, seal of the patent office; and sect. 96, the certificate of the Comptroller.

Fees, see sect. 88.

Rectification of Registers by Court.

Act, 1888, s. 23.

90. (1.) The Court may on the application of any person aggrieved by the omission without sufficient cause of the name of any person [or of any other particulars] from any Register kept under this Act, or by any entry made without sufficient cause in any such Register, make such order for making, expunging, or varying the entry, as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit.

Rectification of the Register, Chap. XI., p. 262. As a defence, p. 383.

An entry may be rectified after five years' registration, notwithstanding sect. 76, p. 309.

"Made without sufficient cause" includes "existing without sufficient cause," *Batt's Trs.*, (1898) 2 Ch. 432; 15 R. P. C. 534; above, p. 277.

Costs, p. 293. Security for costs by a foreigner, p. 289.

Procedure, p. 285. The Court, p. 285. Four clear days' notice of the application must be given to the Comptroller, Rule 49, p. 700.

Forms, p. 742. Fee, 10*s.*

(2.) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to

decide for the rectification of a Register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

Damages, p. 201.

(3.) Any order of the Court rectifying a Register shall direct that due notice of the rectification be given to the Comptroller.

An office copy of the order, with a notice in Form N., p. 710, must be left at the patent office forthwith, Rule 46, p. 700. Publication of the order, Rule 50, p. 700.

Power for Comptroller to correct clerical errors.

91. The Comptroller may, on request in writing accompanied by the prescribed fee—

(a) Correct any clerical error in or in connexion with an application for a patent, or for registration of a design or trade-mark; or

Pages 78, 84. The Comptroller has a general power to amend documents and correct irregularities in procedure under Rule 54, p. 78.
Fee on request to amend application, 5*s*. Form Q., p. 711.

(b) Correct any clerical error in the name, style, or address of the registered proprietor of a patent, design, or trade-mark.

Page 295. Form of request, Q., p. 711. Fee 5*s*. Alteration of address, Rule 48, p. 700. Form N., p. 710. Fee 5*s*. Fee on entry of a rectification or alteration other than of alteration of address, or cancellation of the entry or part of it at the owner's request, 10*s*.

(c) Cancel the entry or part of the entry of a trade-mark on the Register: provided that the applicant accompanies his request by a statutory declaration made by himself, stating his name, address, and calling, and that he is the person whose name appears on the Register as the proprietor of the said trade-mark.

Page 295. Statutory declaration, Rules 61, 62, pp. 702, 703. Form P., p. 710. Form of request, O., p. 710. Fee 5*s*.

Act, 1888, s. 24.

[(d) Permit an applicant for registration of a design or trade-mark to amend his application by omitting any particular goods or classes of goods in connexion with which he has desired the design or trade-mark to be registered.]

Page 78. The sub-section was added to allow an applicant to disclaim any right to use the mark for some of the goods in the register class or classes to which his application refers, in order, for instance, to avoid opposition by the proprietors of trade-marks used or registered for the disclaimed goods. Report of Lord Herschell's Committee, p. xiv. Form of request, Q., p. 711. Fee 5*s*.
As to amendments on appeal, see p. 91.

Alteration of registered mark.

92.—(1.) The registered proprietor of any registered trade-mark may apply to the Court for leave to add to or alter such mark in any particular, not being an essential particular within the meaning of this Act, and the Court may refuse or grant leave on such terms as it may think fit.

Alterations in non-essential particulars, p. 297.
Alterations of old marks, pp. 297, 298.
"Such mark," not the registration, p. 297.
Procedure, p. 300.
Forms, p. 742. Fee 10*s*.

(2.) Notice of any intended application to the Court under this section shall be given to the Comptroller by the applicant; and the Comptroller shall be entitled to be heard on the application.

Fourteen days' notice of the application must be given to the Comptroller, and if the application is granted representations of the trade-mark as altered must be sent to him, Rule 51, p. 700.

(3.) If the Court grants leave, the Comptroller shall, on proof thereof and on payment of the prescribed fee, cause the Register to be altered in conformity with the order of leave.

An office copy of the order with a notice in Form N., p. 710, must be left at the patent office forthwith, Rule 46, p. 700. Publication of the order, Rule 50, p. 700.

Falsification of entries in Registers.

93. If any person makes or causes to be made a false entry in any Register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such Register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanour.

Exercise of discretionary power by Comptroller.

94. Where any discretionary power is by this Act given to the Comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a trade-mark or design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent.

Pages 69, 74, and 78. The course of events laid down by the rules is as follows:—Notice by the Comptroller to the applicant of his objection; application by the applicant to be heard, Form E., p. 705, within one month; ten days' notice by the Comptroller of a time when the applicant may be heard; notice by the applicant to the Comptroller whether he desires to be heard or not, within five days; Rules 17 to 19, p. 695. See also pp. 82 and 83. Fees, on hearing by the Comptroller, payable by the applicant, and by the opponent respectively, 1*l*.

Power of Comptroller

95. The Comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this

Act, apply to either of the law officers for directions in the matter. to take directions of law officers.

See p. 57, note (g), and p. 74, note (t).

96. A certificate purporting to be under the hand of the Comptroller as to any entry, matter, or thing which he is authorized by this Act, or any general rules made thereunder, to make or do, shall be primâ facie evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone. Certificate of Comptroller to be evidence.

Page 61, Rule 60.
Cf. sect. 84, seal of the patent office, and sect. 89, sealed and certified copies to be evidence.
Request for certificate for use in obtaining registration abroad, Form R.; for use in legal proceedings, Form S.; for other general certificates, Form T 1.; form of general certificate, U.; request for copy of official notification of registration, Form V., pp. 711—713.
Fees for the various certificates, p. 701.

97. (1.) Any application, notice, or other document authorized or required to be left, made, or given at the patent office or to the Comptroller, or to any other person under this Act, may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left, made or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post. Applications and notices by post.

(2.) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

98. Whenever the last day fixed by this Act, or by any Rule for the time being in force, for leaving any document or paying any fee at the patent office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day, or days if two or more of them occur consecutively. Provision as to days for leaving documents at office.

The Comptroller has a general power to enlarge the times prescribed by the Rules, Rule 55, p. 701.

99. If any person is, by reason of infancy, lunacy or other inability, incapable of making any declaration or doing anything required or permitted by this Act or by any Rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or if there be none, any person appointed by any Court or judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration or a declaration as nearly Declaration by infant, lunatic, &c.

corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted.

Declarations, Rules 61, 62, p. 702.

The Comptroller has a general power to dispense with any act or thing required to be done by the Rules, or any document or declaration or evidence to be signed, made, or produced, Rule 53, p. 701.

Transmission of certified printed copies of specifications, &c.

100. Copies of all specifications, drawings, and amendments left at the patent office after the commencement of this Act, printed for and sealed with the seal of the patent office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the patent office; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

Power for Board of Trade to make general rules for classifying goods and regulating business of patent office.

101. (1.) The Board of Trade may from time to time make such general rules and do such things as they think expedient, subject to the provisions of this Act—

(a) For regulating the practice of registration under this Act:

(b) For classifying goods for the purposes of designs and trade-marks:

(c) For making or requiring duplicates of specifications, amendments, drawings, and other documents:

(d) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, amendments and other documents:

(e) For securing and regulating the making, printing, publishing and selling of indexes to, and abridgments of, specifications and other documents in the patent office; and providing for the inspection of indexes and abridgments and other documents:

(f) For regulating (with the approval of the Treasury) the presentation of copies of patent office publications to patentees and to public authorities, bodies and institutions at home and abroad:

(g) Generally for regulating the business of the Patent Office, and all things by this Act placed under the direction or control of the Comptroller, or of the Board of Trade.

(2.) Any of the forms in the First Schedule to this Act may be altered or amended by rules made by the Board as aforesaid.

The forms prescribed by the Rules of 1890 are printed at pp. 705 *et seq.* They must be used in all cases to which they are applicable, Rule 5, p. 691.

(3.) General rules may be made under this section at any time after the passing of this Act, but not so as to take effect before the commencement of this Act, and shall (subject as hereinafter mentioned) be of the same effect as if they were contained in this Act, and shall be judicially noticed.

The Rules of 1890, showing also the amendments made by the Rules of 1897 and 1898, are printed at pp. 691 *et seq.* They repeal all former rules, Rule 63.

"Prescribed," where it occurs in the Act, means prescribed by any of the schedules to the Act, or by general rules under or within the meaning of the Act, sect. 117.

(4.) Any rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next session of Parliament, and they shall also be advertised twice in the official journal to be issued by the Comptroller.

(5.) If either House of Parliament, within the next forty days after any rules have been so laid before such House, resolve that such rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule or to the making of any new rules or rule.

Annual reports of Comptroller

102. The Comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which each report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.

Proceedings of Board of Trade. Act, 1888, s. 25.

[**102a.** (1.) All things required or authorized under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.]

[(2.) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorized in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.]

[(3.) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.]

International and Colonial Arrangements.

International arrangements for protection

103. (1.) If Her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states for mutual protection of inventions, designs, and trade-

of inventions, designs, and trade-marks.

marks, or any of them, then any person who has applied for protection for any invention, design, or trade-mark in any such state, shall be entitled to a patent for his invention or to registration of his design or trade-mark (as the case may be) under this Act, in priority to other applicants; and such patent or registration shall have the same date as the *date of the protection obtained* [date of the application] in such foreign state.

Act, 1885, s. 6.

Provided that his application is made, in the case of a patent within seven months, and in the case of a design or trade-mark within four months, from his applying for protection in the foreign state with which the arrangement is in force.

Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade-mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trade-mark in this country, as the case may be.

Registration of foreign and colonial trade-marks, Chap. XX., p. 545.

The International Conventions of 1883 (signed at Paris, 20th March, 1883; ratified 6th June, 1884) and 1891 (signed at Madrid, 14th April, 1891; ratified 15th June, 1892) are printed at pp. 764—773, and the list of foreign states to which the section is applicable at p. 762.

Great Britain did not sign the arrangement relating to the International Registration of Trade-Marks of 1891, above, p. 547, and p. 773.

(2.) The publication in the United Kingdom, or the Isle of Man, during the respective periods aforesaid, of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trade-mark, shall not invalidate the patent which may be granted for the invention, or the registration of the design or trade-mark:

This seems to be surplusage so far as regards trade-marks, see p. 552.

(3.) The application for the grant of a patent, or the registration of a design, or the registration of a trade-mark under this section, must be made in the same manner as an ordinary application under this Act: provided that, in the case of trade-marks, any trade-mark the registration of which has been duly applied for in the country of origin may be registered under this Act:

Page 553.

(4.) The provisions of this section shall apply only in the case of those foreign states with respect to which Her Majesty shall from time to time by Order in Council declare them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state.

Provision for colonies and India.

104. (1.) Where it is made to appear to Her Majesty that the legislature of any British possession has made satisfactory pro-

vision for the protection of inventions, designs, and trade-marks, patented or registered in this country, it shall be lawful for Her Majesty from time to time by Order in Council to apply the provisions of the last preceding section, with such variations or additions, if any, as to Her Majesty in Council may seem fit, to such British possession.

Registration of foreign and colonial trade-marks, Chap. XX., p. 545.
List of British Possessions to which the section is applicable, p. 762.
Definition of British Possession, sect. 117.

(2.) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the order, take effect as if its provisions had been contained in this Act; but it shall be lawful for Her Majesty in Council to revoke any Order in Council made under this Act.

Offences.

Penalty on falsely representing articles to be patented.

105. (1.) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade-mark applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction to a fine not exceeding five pounds.

(2.) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or a trade-mark is registered, if he sells the article with the word "patent," "patented," "registered," or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article.

Page 639, also 401 *et seq.*, 407, and cf. the application of a false trade description under the M. M. A. pp. 569, 579.

Penalty on unauthorized assumption of Royal arms.

106. Any person who, without the authority of Her Majesty, or any of the Royal Family, or of any Government Department, assumes or uses in connexion with any trade, business, calling, or profession, the Royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction to a fine not exceeding twenty pounds.

Page 641.

Scotland, Ireland, &c.

Saving for Courts in Scotland.

107. In any action for infringement of a patent in Scotland the provisions of this Act, with respect to calling in the aid of an assessor, shall apply, and the action shall be tried without a jury, unless the Court shall otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process

of the Courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those Courts.

For the purposes of this section "Court of Appeal" shall mean any Court to which such action is appealed.

Summary proceedings in Scotland.

108. In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the sheriff court.

Proceedings for revocation of patent in Scotland.

109. (1.) Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only.

(2.) Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act.

Reservation of remedies in Ireland.

110. All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only.

An entry registered in the name of an Irish proprietor can be rectified under sect. 90 by the English Courts: *Re King & Co.'s Tm.*, (1892) 2 Ch. 462; 9 R. P. C. 350; Kekewich, J., and C. A. pp. 285, 288.

General saving for jurisdiction of Courts.

111. (1.) The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in any proceedings relating to patents or to designs or to trade-marks; and with reference to any such proceedings in Scotland, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either division of the said Court; and with reference to any such proceedings in Ireland, the terms "the Court" and "the Court of Appeal" respectively mean the High Court of Justice in Ireland and her Majesty's Court of Appeal in Ireland.

See note to sect. 110; and as to rectification of the Register, pp. 285, 286.

(2.) If any rectification of a Register under this Act is required in pursuance of any proceeding in a Court in Scotland or Ireland, a copy of the order, decree, or other authority for the rectification, shall be served on the Comptroller, and he shall rectify the Register accordingly.

Isle of Man.

112. This Act shall extend to the Isle of Man, and—

(1.) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man, in proceedings for infringement or in any action or proceeding respecting a patent, design, or trade-mark competent to those Courts;

(2.) The punishment for a misdemeanour under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court;

(3.) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

Jurisdiction of Lancashire Palatine Court. Act, 1888, s. 26.

[**112a.** The Court of Chancery of the County Palatine of Lancaster shall, with respect to any action or other proceeding in relation to trade-marks the registration whereof is applied for in the Manchester Office, have the like jurisdiction under this Act as Her Majesty's High Court of Justice in England, and the expression "the Court" in this Act shall be construed and have effect accordingly.

Provided that every decision of the Court of Chancery of the County Palatine of Lancaster in pursuance of this section shall be subject to the like appeal as decisions of that Court in other cases.]

Repeal, Transitional Provisions, Savings.

Repeal and saving for past operation of repealed enactments, &c.

113. The enactments described in the Third Schedule to this Act are hereby repealed. But this repeal of enactments shall not—

(a) Affect the past operation of any of those enactments, or any patent or copyright or right to use a trade-mark granted or acquired, or application pending, or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this Act; or

(b) Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if this Act had not been passed; or

(c) Take away or abridge any protection or benefit in relation to any such action or proceeding.

As to which Act applied to the registration of a trade-mark where the application was pending at the date of commencement of a new Act, see p. 121. And see sect. 27 of the Act of 1888, p. 683.

Former Registers to be deemed continued.

114. (1.) The Registers of patents and of proprietors kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the Register of patents kept under this Act.

(2.) The Registers of designs and of trade-marks kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the Register of designs and the Register of trade-marks kept under this Act.

Saving for existing rules.

115. All general rules made by the Lord Chancellor or by any other authority under any enactment repealed by this Act, and in force at the commencement of this Act, may at any time after the passing of this Act be repealed altered or amended by the Board of Trade, as if they had been made by the Board under this Act, but so that no such repeal alteration or amendment shall take effect before the commencement of this Act; and, subject as aforesaid, such general rules shall, so far as they are consistent with and are not superseded by this Act, continue in force as if they had been made by the Board of Trade under this Act.

Saving for prerogative.

116. Nothing in this Act shall take away abridge or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof.

General Definitions.

General definitions.

117. (1.) In and for the purposes of this Act, unless the context otherwise requires,—

"Person" includes a body corporate:

"The Court" means (subject to the provisions for Scotland, Ireland, and the Isle of Man) Her Majesty's High Court of Justice in England:

"Law officer" means Her Majesty's Attorney-General or Solicitor-General for England:

"The Treasury" means the Commissioners of Her Majesty's Treasury:

"Comptroller" means the Comptroller General of Patents, Designs, and Trade-Marks.

"Prescribed" means prescribed by any of the Schedules to this Act, or by general rules under or within the meaning of this Act:

"British possession" means any territory or place situate within Her Majesty's dominions, and not being or forming part of the United Kingdom, or of the Channel Islands, or of the Isle of Man, and all territories and places under one legislature, as hereinafter defined, are deemed to be one British possession for the purposes of this Act:

"Legislature" includes any person or persons who exercise legislative authority in the British possession; and where there are local legislatures as well as a central legislature, means the central legislature only.

In the application of this Act to Ireland, "summary conviction" means a conviction under the Summary Jurisdiction Acts,

that is to say, with reference to the Dublin Metropolitan Police District, the Acts regulating the duties of justices of the peace and of the police for such district, and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1851, and any Act amending it.

SCHEDULES.

The First Schedule.

FORMS OF APPLICATION, &c.

FORM F.

Section 62.

Form of Application for Registration of Trade-Mark.

See Form F., Trade-Marks Rules, 1890, p. 706.

The Third Schedule.

Section 113.

Enactments repealed.

38 & 39 Vict. c. 91. [1875.]	The Trade-Marks Registration Act, 1875.
39 & 40 Vict. c. 33. [1876.]	The Trade-Marks Registration Amendment Act, 1876.
40 & 41 Vict. c. 37. [1877.]	The Trade-Marks Registration Extension Act, 1877.

No. 2.

PATENTS, DESIGNS, AND TRADE-MARKS ACT, 1888.

(51 & 52 Vict. c. 50.)

*** The several sections of this Act are printed and annotated together with the principal Act above; they are printed here for convenience of reference.

An Act to amend the Patents, Designs, and Trade-Marks Act, 1883. [24th December, 1888.]

46 & 47 Vict. c. 57.

WHEREAS it is expedient to amend the Patents, Designs, and Trade-Marks Act, 1883, hereinafter referred to as the principal Act:

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

Registor of patent agents.

1.—(1.) After the first day of July one thousand eight hundred and eighty-nine a person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a patent agent in pursuance of this Act.

(2.) The Board of Trade shall, as soon as may be after the passing of this Act, and may from time to time, make such general rules (*a*) as are in the opinion of the Board required for giving effect to this section, and the provisions of section one hundred and one of the principal Act shall apply to all rules so made as if they were made in pursuance of that section.

(3.) Provided that every person who proves to the satisfaction of the Board of Trade that prior to the passing of this Act he had been bonâ fide practising as a patent agent shall be entitled to be registered as a patent agent in pursuance of this Act.

(4.) If any person knowingly describes himself as a patent agent in contravention of this section he shall be liable on summary conviction to a fine not exceeding twenty pounds.

(5.) In this section "patent agent" means exclusively an agent for obtaining patents in the United Kingdom.

(*a*) Register of Patent Agents Rules, 1889 and 189[illegible] *Institute of Patent Agents* v. *Lockwood*, (1894) A. C. 347; 11 R. P. C. 473; *Slurry* v. *Graham*, (1899) 1 Q. B. 406; 16 R. P. C. 108

Amendments of 46 & 47 Vict. c. 57.

2. For section seven of the principal Act the following section shall be substituted, namely:—

s. 7, as to applications.

"7. (1.) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not, or have not, been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject matter of the invention, the Comptroller may refuse to accept the application, or require that the application, specification, or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the Comptroller so directs, bear date as from the time when the requirement is complied with.

"(2.) Where the Comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer.

"(3.) The law officer shall, if required, hear the applicant and the Comptroller, and may make an order determining whether, and subject to what conditions (if any), the application shall be accepted.

"(4.) The Comptroller shall, when an application has been accepted, give notice thereof to the applicant.

"(5.) If, after an application for a patent has been made, but before the patent thereon has been sealed, another application for a patent is made, accompanied by a specification bearing the same or a similar title, the Comptroller, if he thinks fit, on the request of the second applicant, or of his legal representative, may, within two months of the grant of a patent on the first application, either decline to proceed with the second application or allow the surrender of the patent, if any, granted thereon."

s. 9, as to disclosure of reports of examiners.

3. In sub-section five of section nine of the principal Act the words "other than an appeal to the law officer under this Act" shall be omitted.

s. 11, as to opposition to grant of patent.

4. In sub-section one of section eleven of the principal Act the words from "or on the ground of an examiner" to "a previous application," both inclusive, shall be omitted, and there shall be added in lieu thereof the following words, namely, "or on the ground that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification."

s. 18, as to amended specifications.

5. For sub-section ten of section eighteen of the principal Act the following sub-section shall be substituted, namely:—

"(10.) The foregoing provisions of this section do not apply when, and so long as any action for infringement or proceeding for revocation of a patent is pending."

s. 52, as to inspection of designs.

6. After sub-section one of section fifty-two of the principal Act the following words shall be added; namely,

"Provided that where registration of a design is refused on the ground of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered."

s. 58, as to piracy of registered designs.

7.—(1.) In section fifty-eight of the principal Act the words "or cause to be applied" shall be added after the word "apply."

(2.) To the same section the following words shall be added: "Provided that the total sum forfeited in respect of any one design shall not exceed one hundred pounds."

s. 62, as to application for registration.

8.—(1.) In sub-section 2 of section sixty-two of the principal Act for the words "the patent office in the prescribed manner" shall be substituted the words "such place and in such manner as may be prescribed."

(2.) To the same section of the principal Act the following sub-section shall be added:—

"(6.) Where an applicant for the registration of a trade-mark otherwise than under an international convention is out of the United Kingdom at the time of making the application he shall give the Comptroller an address for service in the United Kingdom, and if he fails to do so the application shall not be proceeded with until the address has been given."

s. 63, as to limit of time for proceeding with application.

9. In section sixty-three of the principal Act for the words "the application shall be deemed to be abandoned" shall be substituted the words "the Comptroller shall give notice of the non-completion to the agent employed on behalf of the applicant, and, if at the expiration of fourteen days from that notice the registration is not completed, shall give the like notice to the applicant, and if at the expiration of the latter fourteen days, or such further time as the Comptroller may in special cases permit, the registration is not completed, the application shall be deemed to be abandoned."

s. 64, as to fancy words.

10.—(1.) For section sixty-four of the principal Act the following section shall be substituted, namely—

"**64.**—(1.) For the purposes of this Act, a trade-mark must consist of or contain at least one of the following essential particulars:

"(a) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or

"(b) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade-mark; or

"(c) A distinctive device, mark, brand, heading, label, or ticket; or

"(d) An invented word or invented words; or

"(c) A word or words having no reference to the character or quality of the goods, and not being a geographical name.

"(2.) There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures, or combination of letters, words, or figures, or of any of them, but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade-mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the Register.

"(3.) Provided as follows:

"(i.) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof:

"(ii.) Any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures used as a trade-mark before the thirteenth day of August one thousand eight hundred and seventy-five, may be registered as a trade-mark under this part of this Act."

s. 67, as to colours of trade-marks.

11. In section sixty-seven of the principal Act the words "or colours" shall be added after the word "colour" in each place where that word occurs.

s. 68, as to advertisement of applications.

12. In section sixty-eight of the principal Act after the word Comptroller shall be added the words "unless the Comptroller refuse to entertain the application."

s. 69, as to opposition to registration.

13.—(1.) In sub-section one of section sixty-nine of the principal Act for the words "two months" shall be substituted the words "one month or such further time, not exceeding three months, as the Comptroller may allow."

(2.) In the same sub-section the words "first" shall be omitted.

(3.) In sub-section two of the same section for the words "two months" shall be substituted the words "one month."

(4.) For sub-sections three and four of the same section the following sub-sections shall be substituted; namely,

"(3.) If the applicant sends such counter-statement the Comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall, after hearing the applicant and the opponent, if so required, decide whether the trade-mark is to be registered, but his decision shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the opponent and the Comptroller, and may make an order determining whether, and subject to what conditions (if any), registration is to be permitted.

"(4.) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court, and in that event the Court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid.

"(5.) If the applicant abandons his application after notice of opposition in pursuance of this section he shall be liable to pay to the opponent such costs in respect of the opposition as the Comptroller may determine to be reasonable.

"(6.) Where the opponent is out of the United Kingdom he shall give the Comptroller an address for service in the United Kingdom."

s. 72, as to restrictions on registration.

14. In sub-section two of section seventy-two of the principal Act, the following words shall be added at the beginning of the sub-section, namely, "except as aforesaid," and for the words "so nearly resembling" shall be substituted the words "having such resemblance to."

s. 73, as to restriction on registration.

15. In section seventy-three of the principal Act the word "exclusive" shall be omitted.

s. 74, as to additions to trade-marks.

16. For sub-section two of section seventy-four of the principal Act the following sub-section shall be substituted; namely,

"(2.) The applicant for registration of any such addition must, however, state in his application the essential particulars of the trade-mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the Register.

"Provided that a person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof."

s. 75, as to effect of registration.

17. For section seventy-five of the principal Act the following section shall be substituted; namely,

"Application for registration of a trade-mark shall be deemed to be equivalent to public use of the trade-mark, and the date of the application shall for the purposes of this Act be deemed to be, and as from the first day of January one thousand eight hundred and seventy-six to have been, the date of the registration."

Certificate as to exclusive use and costs thereon.

18. After section seventy-seven of the principal Act the following section shall be added and numbered 77A; namely,

"In an action for infringement of a registered trade-mark the Court or a judge may certify that the right to the exclusive use of the trade-mark came in question, and if the Court or a judge so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as

between solicitor and client, unless the Court or judge trying the subsequent action certifies that he ought not to have the same."

Amendments of 46 & 47 Vict. c. 57.

19.—(1.) In sub-section five of section seventy-nine of the principal Act, for the words, "the five years" shall be substituted the words "one year."

s. 79, as to removal of trade-mark from the Register.

(2.) To the same sub-section the following words shall be added; namely, "unless it is shown to the satisfaction of the Comptroller that the nonpayment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under that proprietor or under his bankruptcy is using the trade-mark."

s. 81, as to Sheffield marks.

20.—(1.) For sub-section two of section eighty-one of the principal Act the following sub-section shall be substituted:

"(2.) The Cutlers' Company shall enter in the Sheffield Register, in respect of metal goods as defined in this section, all the trade-marks entered before the first day of January one thousand eight hundred and eighty-nine in respect of metal goods either in the Register established under the Trade-Marks Registration Act, 1875, or in the Register of trade-marks under this Act, belonging to persons carrying on business in Hallamshire or within six miles thereof. The Cutlers' Company shall also, on request made in the prescribed manner, enter in the Sheffield Register, in respect of metal goods, all the trade-marks which shall have been assigned by the Cutlers' Company and actually used before the first day of January one thousand eight hundred and eighty-four, but which have not been entered in either of the said other Registers."

38 & 39 Vict. c. 91.

(2.) In sub-sections three and eight of the same section, for the words "on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge," shall be substituted the words "on metal goods."

(3.) For sub-section seven of the same section the following sub-section shall be substituted:

"(7.) The provisions of this Act and of any general rules made under this Act with respect to the registration of trade-marks, and all matters relating thereto, shall, subject to the provisions of this section, apply to the registration of trade-marks on metal goods by the Cutlers' Company, and to all matters relating thereto; and this Act and any such general rules shall, so far as applicable, be construed accordingly, with the substitution of the Cutlers' Company, the office of the Cutlers' Company, and the Sheffield Register, for the Comptroller, the Patent Office, and the Register of Trade-Marks, respectively; and notice of every entry, cancellation, or correction made in the Sheffield Register shall be given to the Comptroller by the Cutlers' Company: Provided that this section shall not affect any life estate and interest of a widow of the holder of any

Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield Register."

(4.) To the same section the following sub-sections shall be added; namely,—

"(14.) For the purposes of this section the expression 'metal goods' means all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal.

"(15.) For the purpose of legal proceedings in relation to trade-marks entered in the Sheffield Register a certificate under the hand of the master of the Cutlers' Company shall have the same effect as the certificate of the Comptroller."

s. 87, as to entry of assignments, &c.

21. In section eighty-seven of the principal Act, after the words "subject to," shall be added the words "the provisions of this Act and to."

s. 88, as to inspection.

22. In section eighty-eight of the principal Act, after the words "subject to," shall be added the words "the provisions of this Act and to."

s. 90, as to rectification of Register.

23. In section ninety of the principal Act, after the words "of the name of any person," shall be added the words "or of any other particulars."

s. 91, as to correction of errors.

24. To section ninety-one of the principal Act the following sub-section shall be added; namely,

"(d) Permit an applicant for registration of a design or trade-mark to amend his application by omitting any particular goods or classes of goods in connection with which he has desired the design or trade-mark to be registered."

Proceedings of Board of Trade.

25. After section one hundred and two of the principal Act the following section shall be added and numbered 102A; namely,

"(1.) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.

"(2.) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

"(3.) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified."

Jurisdiction of Lancashire Palatine Court.

26. After section one hundred and twelve of the principal Act the following section shall be added and numbered 112A; namely,

"The Court of Chancery of the County Palatine of Lancaster shall, with respect to any action or other proceeding in relation to trade-marks the registration whereof is applied for in the Manchester Office, have the like jurisdiction under this Act as Her Majesty's High Court of Justice in England, and the expression 'the Court' in this Act shall be construed and have effect accordingly.

"Provided that every decision of the Court of Chancery of the County Palatine of Lancaster in pursuance of this section shall be subject to the like appeal as decisions of that Court in other cases."

Construction of principal Act.

27. The principal Act shall, as from the commencement of this Act, take effect subject to the additions, omissions, and substitutions required by this Act, but nothing in this Act shall affect the validity of any act done, right acquired, or liability incurred before the commencement of this Act.

Commencement of Act.

28. This Act shall, except so far as is by this Act otherwise specially provided, commence and come into operation on the first day of January one thousand eight hundred and eighty-nine.

Short title.

29. This Act may be cited as the Patents, Designs, and Trade-Marks Act, 1888, and this Act and the Patents, Designs, and Trade-Marks Acts, 1883 to 1886, may be cited collectively as the Patents, Designs, and Trade-Marks Acts, 1883 to 1888.

No. 3.

THE TRADE-MARKS REGISTRATION ACTS, 1875—77.

THE TRADE-MARKS REGISTRATION ACT, 1875.

38 & 39 Vict. c. 91.

An Act to establish a Register of Trade-Marks.

[13th August, 1875.]

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

Registration of trade-marks.

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

Characteristics of registered trade-mark.

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

Title of first proprietor of a trade-mark.

3. *The registration of a person as first proprietor of a trade-mark shall be* primâ facie *evidence of his right to the exclusive use of such trade-mark, and shall, after the expiration of five years from the date of such registration, be conclusive evidence of his right to the exclusive use of such trade-mark, subject to the provisions of this Act as to its connection with the goodwill of a business.*

Title of proprietor claiming by transmitted proprietorship.

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

Rectification of Register.

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

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

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

The Court may direct an issue to be tried for the decision of any question of fact which may require to be decided for the purposes of this section.

Whenever any order has been made rectifying the Register the Court shall by its order direct that due notice of such rectification be given to the Registrar.

Restrictions on Registry of trade-marks.

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

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

Establishment of Registry and general rules.

7. *Subject as aforesaid, a Register office shall be established from and after such time (not being later than the first day of January one thousand eight hundred and seventy-six), in such manner and*

with such officers, and at such salaries, to be paid out of moneys provided by Parliament, as the Lord Chancellor may, with the consent of the Treasury, direct; and the Lord Chancellor may from time to time, with the assent of the Treasury as to fees, make, and, when made, alter, annul, or vary, such general rules as to the Registry of trade-marks, and as to notices to be given by advertisement before the registration of trade-marks, and as to the classification of goods for the purposes of this Act, and as to the registration of first and subsequent proprietors of trade-marks, and as to the fees to be charged for registration, and also for the continuance of a trade-mark on the Register or otherwise, and as to the removal from the Register of any trade-mark, as to notices, and as to the persons entitled to inspect the Register, and as to any proceedings to be taken to obtain the judgment or leave of the Court in any matter in which the judgment or leave of the Court is required to be obtained under this Act, and generally for the purpose of carrying into effect this Act, as he may deem expedient.

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

Certificate of Registrar to be evidence.

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

Provision as to Cutlers' Company and Sheffield corporate marks.

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

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

(2.) *When any person, after the passing of this Act, applies to the said master, wardens, searchers, and assistants to assign to him any mark or device, notice of such application, with a copy of such mark or device, shall, within the prescribed time and in the prescribed manner, be delivered to the Registrar under this Act; and such mark or device*

shall not be assigned until after the expiration of the prescribed period from the giving of such notice. In like manner, when any person applies for the registration under this Act of a trade-mark as belonging to any goods or class of goods specified in section two of the Cutlers' Company's Act of 1860, *notice of such application, with a copy of such trade-mark, shall, within the prescribed time and in the p escribed manner, be delivered to the Cutlers' Company; and such trade-mark shall not be registered until after the expiration of the prescribed period from the giving of the last-mentioned notice:*

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

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

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

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

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

10. *For the purposes of this Act—* Definitions (*a*).

A trade-mark consists of one or more of the following essential particulars; that is to say,

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(*a*) See sect. 64 of the present Act, *ante*, p. 650.

A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or
A written signature or copy of a written signature of an individual or firm; or
A distinctive device, mark, heading, label, or ticket;
and there may be added to any one or more of the said particulars any letters, words, or figures, or combination of letters, words, or figures; also
Any special and distinctive word or words or combination of figures or letters used as a trade-mark before the passing of this Act may be registered as such under this Act.
"Prescribed" means prescribed by general rules made in pursuance of this Act; and
"Court" means any of Her Majesty's superior courts of law or equity at Westminster, or any Court to which the jurisdiction of such Courts may be transferred, or any one or more of such Courts which may be declared to be the Court for the purposes of this Act by such general rules as aforesaid; but the provisions of this Act conferring a special jurisdiction on the Court as above defined shall not, excepting so far as such jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in causes, actions, suits, or proceedings relating to trade-marks; and if the Register requires to be rectified in consequence of any proceedings in any such Court in Scotland or Ireland, due notice of such requirements shall be given to the Registrar, and he shall rectify the Register accordingly.

Short title of Act.

11. *This Act may be cited for all purposes as the Trade-Marks Registration Act*, 1875.

THE TRADE-MARKS REGISTRATION AMENDMENT ACT, 1876.

39 & 40 Vict. c. 33.

An Act for the Amendment of the Trade-Marks Registration Act, 1875. [24th July, 1876.]

38 & 39 Vict. c. 91.

Whereas by the Trade-Marks Registration Act, 1875, *in this Act referred to as the principal Act, it is provided that from and after the first day of July one thousand eight hundred and seventy-six, a person shall not be entitled to institute any proceeding to prevent the infringement of any trade-mark as defined by the principal Act until and unless such trade-mark is registered in pursuance of that Act:*
And whereas by reason of the number of trade-marks, and especially by reason of the difficulties attending the registration of trade-marks in relation to textile fabrics, it has been found impossible to

complete the registration of existing trade-marks within the time specified by the said section; and it is therefore expedient to prolong the time for the completion of such registration as aforesaid, and otherwise to amend the principal Act:

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

Amendment of s. 1 of the principal Act.

1. *There shall be repealed so much of section one of the principal Act as provides that from and after the first day of July one thousand eight hundred and seventy-six, a person shall not be entitled to institute any proceeding to prevent the infringement of any trade-mark as defined by that Act until and unless such trade-mark is registered in pursuance of that Act, and in place thereof be it enacted that—*

From and after the first day of July one thousand eight hundred and seventy-seven, 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.

Saving of marks and devices not capable of being registered under Act.

2. *When an application by any person to register as a trade-mark a device, mark, name, word, combination of words, or other matter or thing proposed for registration as a trade-mark, which has been in use as a trade-mark before the passing of the recited Act, has been refused, it shall be the duty of the Registrar, on request, and on payment of the prescribed fee, to give to the applicant a certificate of such refusal, and a certificate so granted shall be conclusive evidence of such refusal.*

Short title.

3. *This Act may be cited for all purposes as the Trade-Marks Registration Amendment Act*, 1876.

THE TRADE-MARKS REGISTRATION EXTENSION ACT, 1877.

40 & 41 Vict. c. 37.

An Act for extending the Time for the Registration of Trade-Marks, in so far as relates to Trade-Marks used in Textile Industries. [6th August, 1877.]

Whereas by section one of the Trade-Marks Registration Amendment Act, 1876, *it is provided that from and after the first day of* 39 & 40 Vict. c. 33.

July one thousand eight hundred and seventy-seven, 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 Trade-Marks Registration Act, 1875 (*referred to in such Amendment Act and in this Act as the principal Act*), *until and unless such trade-mark is registered in pursuance of the principal 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 is in the said Act thereafter mentioned:*

38 & 39 Vict. c. 91.

And whereas by reason of the difficulties attending the registration of trade-marks used in the textile industries it has been found impossible to complete the registration of such trade-marks within the time specified by the said section, and it is therefore expedient to prolong such time as aforesaid:

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

Extension of time for registration of trade-marks used in textile industries.

1. *In so far as relates to the registration of trade-marks used in the textile industries, but not further or otherwise, section one of the Trade-Marks Registration Amendment Act*, 1876, *shall be construed as if for the words "from and after the first day of July one thousand eight hundred and seventy-seven" there were substituted the words "from and after the first day of January one thousand eight hundred and seventy-eight, or such further time as Her Majesty may by Order in Council determine."*

Definition of "trade-marks used in the textile industries."

2. *The expression in this Act "Trade-marks used in the textile industries" means the trade-marks relating to goods comprised in Classes* 23 *to* 35, *both inclusive, of the First Schedule to the Rules under the Trade-Marks Registration Acts*, 1875—76, *dated September*, 1876.

Short title of Act.

3. *This Act may be cited for all purposes as "The Trade-Marks Registration Extension Act*, 1877," *and this Act and the Trade-Marks Registration Amendment Act*, 1876, *and the Trade-Marks Registration Act*, 1875, *may be cited together as "The Trade-Marks Registration Acts*, 1875—77."

No. 4.

TRADE-MARKS RULES, 1890.

(As Amended by the Trade-Marks Rules, 1897 and 1898 (*a*).)

By virtue of the provisions of the Patents, Designs, and Trade-Marks Acts, 1883 to 1888, the Board of Trade do hereby make the following Rules:—

Preliminary.

1. These Rules may be cited as the Trade-Marks Rules, 1890, and shall come into operation from and immediately after the 31st day of December, 1890.

Interpretation.

2. In the construction of these Rules any words herein used defined by the said Acts shall have the meanings thereby assigned to them respectively. Interpretation.

Fees.

3. The fees to be paid in pursuance of the said Acts, so far as they relate to trade-marks, shall be the fees specified in the First Schedule hereto. Fees.

Forms.

4. The Form F in the First Schedule to the Patents, Designs, and Trade-Marks Act, 1883, shall be altered or amended by the substitution therefor of the Form F in the Second Schedule to these Rules. Forms.

5.—(1) An application for registration of a trade-mark shall be made in the Form F in the Second Schedule to these Rules; (2) the remaining forms in such schedule may be used in all cases to which they are applicable.

Classification of Goods.

6. For the purposes of trade-marks registration and of these Rules goods are classified in the manner appearing in the Third Schedule hereto. Classification of goods.

If any doubt arises as to what class any particular description of goods belongs to, the doubt shall be determined by the Comptroller.

Application for Registration.

7. An application for registration of a trade-mark, if made by any firm or partnership, may be signed by some one or more members of such firm or partnership, as the case may be. Application by firm.

If the application be made by a body corporate it may be

(*a*) The repealed Rules are printed in italics, and the substituted Rules in square brackets, the amending Rules being referred to in the margin.

signed by the secretary or other principal officer of such body corporate.

Address of application.

8. Where a trade-mark for registration of which application is made is in Classes 23, 24 or 25 of the Third Schedule to these Rules, the applicant shall address and send his application to the Manchester Trade-Marks Branch, 48, Royal Exchange, Manchester. Other applications (except applications which under section 81 of the said Acts should be made to the Cutlers' Company) shall be addressed and sent to the Patent Office, Trade-Marks Branch, 25, Southampton Buildings, Chancery Lane, London, W.C.

Agency.

9. *An application for registration and all other communications between the applicant and the Comptroller may be made by or through an agent duly authorised to the satisfaction of the Comptroller.*

Rule 2 of 1898 (*a*).

[An application for registration and all other communications between the applicant and the Comptroller may be made by or through an agent duly authorised to the satisfaction of the Comptroller, but the Comptroller shall not be bound to recognise as such agent, or to receive further communications from, any person whose name, by reason of his having been adjudged guilty of disgraceful professional conduct, has been erased from the Register of Patent Agents kept under the provisions of the Patents, Designs, and Trade Marks Act, 1888, relating to the registration of patent agents, and not since restored.]

Acknowledgment of application.

10. On receipt of the application the Comptroller shall furnish the applicant with an acknowledgment thereof.

Contents of form of application.

11. Where application is made to register a trade-mark which was used by the applicant or his predecessors in business before the 13th of August, 1875, the application shall contain a statement of the time during which and of the person by whom it has been so used in respect of the goods mentioned in the application (*b*).

Size, &c. of documents.

12. Subject to any other directions that may be given by the Comptroller, all applications, notices, counter-statements, representations of marks, papers having representations affixed, or other documents required by the said Acts or by these Rules to be left with or sent to the Comptroller or to the Cutlers' Company, shall be upon foolscap paper of a size of 13 inches by 8 inches, and shall have on the left-hand part thereof a margin of not less than one inch and a half.

(*a*) Rule 1 is as follows:—"These Rules may be cited as the Trade Marks Rules, 1898, and shall come into operation from and immediately after the date hereof" (September 15th, 1898).

(*b*) Where the user claimed has been by a firm, it is not necessary to state the names of the persons who were from time to time members of the firm, nor to insert the words "and their predecessors in business for the time being." (*Wright, Crossley & Co.'s Application*, (1900) 2 Ch. 218; 17 R. P. C. 386, Byrne, J.) Stirling, J., had previously held (*Bryant & May's Tm.*, 17 R P. C. at p. 396) a statement of user by the applicants or their predecessors in title to be sufficient.

Representations of trade-mark.

13. *Subject to any other directions that may be given by the Comptroller, three representations of each trade-mark, except in the case of marks applied for in Classes* 23 *to* 35 *inclusive, must be supplied upon paper of the size aforesaid, and must be of a durable nature. One of such representations must be made upon or affixed to the form of application, the others upon separate half-sheets. In the case of trade-marks exceeding the limits of the foolscap paper of the size aforesaid, such marks may be pasted and folded upon the sheets of foolscap.*

In the case of marks applied for in Classes 23 *to* 35 *inclusive, the applicant shall supply four representations of each mark for each class.*

Where a drawing or other representation or specimen cannot be given in manner aforesaid, a specimen or copy of the trade-mark may be sent either of full size or on a reduced scale, and in such form as the Comptroller may think most convenient.

The Comptroller may, if dissatisfied with the representation of a trade-mark, require a fresh representation, either before he proceeds with the application or before he registers the trade-mark.

The Comptroller may also, in exceptional cases, deposit in the Patent Office a specimen or copy of any trade-mark which cannot conveniently be shown by a representation, and may refer thereto in the Register in such manner as he may think fit.

Substituted by Rule 2 of 1897 (*c*).

[13. Every application for registration of a trade-mark shall contain a representation of the mark affixed to it in the square which the Form F coutains for that purpose.

Where the representation exceeds such square in size the representation shall be mounted upon linen, tracing cloth or other material that the Comptroller may consider suitable. Part of the mounting shall be affixed in the space aforesaid, and the rest may be folded over.

With every application for registration sent to the Manchester Trade Marks Branch, there shall be supplied four additional representations of each mark on the Form G, exactly corresponding with that on the application Form F, and noted with all such particulars as may from time to time be required by the Comptroller or by the Keeper of Cotton Marks at Manchester. Such particulars shall, if required, be signed by the applicant or his agent.

In the case of marks applied for in any of the Classes 5, 6, 7, 11, 12, 13, 14, 22, 26, 27, 28, 29, 30, 31, 32, 33, 34 and 35, there shall be sent with the application four additional representations of each mark on the Form G, exactly corresponding with that affixed to the application in Form F, and noted with all such particulars as may from time to time be required by the Comptroller. Such particulars shall, if required, be signed by the applicant or his agent.

(*c*) Rule 1 is as follows :—"These Rules may be cited as the Trade Mark Rules, 1897, and shall come into operation from and immediately after the date hereof" (December 31st, 1897).

In the case of marks applied for in any other class there shall be sent with the application three additional representations of each mark on the Form G, exactly corresponding to that affixed to the application Form F, and noted with all such particulars as may from time to time be required by the Comptroller. Such particulars shall, if required, be signed by the applicant or his agent.

All representations of marks must be of a durable nature, but the applicant may in case of need supply in place of representations on the Form G, half-sheets of strong foolscap of the size aforesaid with the representations affixed thereon and noted as aforesaid.

Applications for the registration of the same mark in different classes shall be treated as separate and distinct applications.

The Comptroller, if dissatisfied with any representation of a mark, may at any time require another representation satisfactory to him to be substituted before proceeding with the application.

Where a drawing or other representation or specimen cannot be given in manner aforesaid, a specimen or copy of the trade-mark may be sent either of full size or on a reduced scale, and in such form as the Comptroller may think most convenient.

The Comptroller may also, in exceptional cases, deposit in the Patent Office a specimen or copy of any trade-mark which cannot conveniently be shown by a representation, and may refer thereto in the Register in such manner as he may think fit.]

Representations of a series of trade-marks.

11. *When an application relates to a series of trade-marks differing from one another in respect of the particulars mentioned in section* 66 *of the said Acts, a representation of each trade-mark of the series shall be made or affixed upon the form of application and also upon each of the separate half-sheets of paper aforesaid.*

Substituted by Rule 2 of 1897 (*d*).

[14. When application is made for the registration of a series of trade-marks under section 66 of the Patents, Designs, and Trade Marks Act, 1883, a representation of each trade-mark of the series shall be affixed, as aforesaid, to the application upon Form F, and to each of the accompanying Forms G.]

Translation of foreign characters.

15. *Wherever a mark consists of or includes words printed in other than Roman character, there shall be given at the foot or on the back of each representation a translation of such words, signed by the applicant or his agent.*

Substituted by Rule 2 of 1897 (*d*).

[15. When a trade-mark contains a word or words in other than Roman characters, there shall be endorsed on the application in Form F, and on each of the accompanying representations in Form G, a sufficient transliteration and translation to the satisfaction of the Comptroller of each of such words, and every such endorsement shall be signed by the applicant or his agent.

Where a trade-mark contains a word or words in a language other than English, the Comptroller may ask for an exact trans-

(*d*) See note (*c*) above.

lation thereof, and if he so requires such translation shall be endorsed and signed as aforesaid.]

Mode of sending notices, &c.

16. Any application, statement, notice, or other document authorized or required to be left, made, or given at the Patent Office, or to the Comptroller, or to any other person under these Rules, may be sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

Exercise of Discretionary Powers.

Hearing by Comptroller.

17. Before exercising any discretionary power given to the Comptroller by the said Acts adversely to the applicant for registration of a trade-mark, the Comptroller shall (if so required by the applicant within one month from the date of the Comptroller's objection) give the applicant an opportunity of being heard personally or by his agent by sending the applicant ten days' notice of a time when he may be so heard.

Notice of wish to be heard before Comptroller.

18. Within five days from the date when such notice would be delivered in the ordinary course of post, the applicant shall notify to the Comptroller whether or not he intends to be heard upon the matter.

Notification of decision.

19. The decision of the Comptroller in the exercise of any such discretionary power as aforesaid shall be notified to the applicant.

Appeal to the Board of Trade.

Notice of appeal.

20. When any person intends to appeal to the Board of Trade from a decision of the Comptroller in any case in which an appeal is given by the said Acts, he shall, within one month from the date of the decision appealed against, leave at the Patent Office, Trade-Marks Branch, a notice of such his intention.

Grounds of appeal to be stated.

21. Such notice shall be accompanied by a statement in writing of the grounds of appeal, and of the appellant's case in support thereof.

Transmission of notice.

22. A copy of the notice of intention to appeal, accompanied by a statement of the case, shall also be forthwith sent to the Secretary of the Board of Trade, No. 7, Whitehall Gardens, London; and where there has been an opposition before the Comptroller, to the opponent or applicant, as the case may be.

Directions by Board.

23. The Board of Trade may thereupon give such directions (if any) as they may think fit with respect to evidence, or otherwise, for the purpose of the hearing of the appeal by the Board of Trade, or for the purpose of their referring the appeal to the Court to hear and determine the same.

Hearing of appeal.

24. Where the Board of Trade intend to hear the appeal, seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for the hearing, shall be given to the Comptroller and to the appellant, and where there has been an opposition before the Comptroller, to the opponent or applicant, as the case may be.

No appeal unless notice duly given.

25. No appeal shall be entertained of which notice has not been given within one month from the date of the decision appealed against, or such further time as the Comptroller may allow, except by special leave of the Board of Trade.

Evidence on appeal.

26. Subject to the directions and leave of the Board of Trade, the evidence to be used on an appeal to the Board of Trade in the matter of an opposition shall be the same as that used at the hearing before the Comptroller.

Advertisement of Application.

Advertisement of application.

27. Every application shall be advertised by the Comptroller in the official paper, during such times and in such manner as the Comptroller may direct, unless he refuse to entertain the application.

If no representation of the trade-mark be inserted in the official paper in connection with the advertisement of an application, the Comptroller shall refer in such advertisement to the place or places where a specimen or representation of the trade-mark is deposited for exhibition.

Definition of official paper.

28. The official paper for the purposes of these Rules shall be some paper published under the direction of the Board of Trade, or such other paper as such Board may from time to time direct.

Means of advertising trade-mark to be supplied to official paper.

29. For the purposes of such advertisement the applicant may be required to furnish a wood block or electrotype (or more than one, if necessary) of the trade-mark, of such dimensions as may from time to time be directed by the Comptroller, or with such other information or means of advertising the trade-mark as may be required by the Comptroller; and the Comptroller, if dissatisfied with the block or electrotype furnished by the applicant or his agent, may require a fresh block or electrotype before proceeding with the advertisement.

Advertisement of series.

30. When an application relates to a series of trade-marks differing from one another in respect of the particulars mentioned in section 66 of the said Acts, the applicant may be required to furnish a wood block or electrotype (or more than one, if necessary) of any or of each of the trade-marks constituting the series; and the Comptroller may, if he thinks fit, insert with the advertisement of the application a statement of the manner in respect of which the several trade-marks differ from one another.

Opposition to Registration.

Notice of opposition.

31.—(1.) A notice of opposition to the registration of a trade-mark shall state the ground or grounds on which the opponent intends to oppose the registration, and be signed by him or by his solicitor, and shall also contain an address for service in the United Kingdom, and shall be in the Form J in the Second Schedule to these Rules, with such variations as circumstances may require.

Opposition on the ground of trade-mark already on the Register.

(2.) Where the ground, or one of the grounds, of opposition is that the applicant is applying for the registration of a trade-mark identical with one already on the Register with respect to the same goods or description of goods, or having such resemblance to a trade-mark already on the Register with respect to such goods or description of goods as to be calculated to deceive, the notice shall state the date of registration, and the number on the Register of such trade-mark already on the Register.

Opponent's evidence.

(3.) Within two months after the expiration of one month, or such further time not exceeding three months, as the Comptroller may allow from the date of the advertisement of the application, the opponent shall leave at the Patent Office, Trade-Marks Branch, such evidence by way of statutory declaration as he may desire to adduce in support of his opposition, and deliver to the applicant copies thereof.

Applicant's evidence.

(4.) *Within one month from the delivery of the opponent's copies of his statutory declarations the applicant shall leave at the Patent Office, Trade-Marks Branch, his evidence by way of statutory declaration in answer, and deliver to the opponent copies thereof, and within seven days from such delivery the opponent shall leave at the Patent Office, Trade-Marks Branch, his evidence by way of statutory declaration in reply, and deliver to the applicant copies thereof. Such last-mentioned evidence shall be confined to matters strictly in reply.

Evidence in reply.

Closing of evidence.

(5.) No further evidence shall be left on either side except by leave of the Comptroller upon the written consent of the parties duly notified to him, or by special leave of the Comptroller given on an application made to him.

Applications for leave to adduce further evidence.

(6.) Either party making such application shall give notice thereof to the opposite party, who shall be entitled to oppose the application.

Appointment of time for hearing.

(7.) On the completion of the evidence the Comptroller shall, upon application by either party, upon Form E in the Second Schedule to these Rules, and upon payment of the prescribed fee, appoint a time for the hearing of the case, and shall give the parties at least seven days' notice of such appointment.

Disallowance of opposition in certain cases.

(8.) On the hearing of the case no opposition shall be allowed in respect of any ground not stated in the notice of opposition,

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* The counter-statement required by the Acts must also be delivered by the applicant within one month from the date of the receipt of the opponent's notice of opposition.

and where the ground or one of the grounds of opposition is that registration is being applied for in respect of a trade-mark identical with one already on the Register with respect to the same goods or description of goods, or having such resemblance to a trade-mark already on the Register with respect to such goods or description of goods as to be calculated to deceive, the opposition shall not be allowed upon such ground, unless the date of registration and the number on the Register of the said trade-mark already on the Register have been duly specified in the notice of opposition.

Decision to be notified to parties.

(9.) The decision of the Comptroller in the case shall be notified to the parties.

Register of Trade-Marks.

Time of registration of trade-marks.

32. As soon as may be after the expiration of one month from the date of the advertisement of the application, the Comptroller shall, subject to opposition to the application and the determination thereof, if he is satisfied that the applicant is entitled to registration, and on payment of the prescribed fee, enter the name, address, and description of the applicant in the Register of Trade-Marks as the registered proprietor of the trade-mark in respect of the particular goods or classes of goods described in his application.

Where applicant dies before registration, the trade-mark may be registered for successor to goodwill of business.

33. In case of the death of any applicant for a trade-mark after the date of his application, and before the trade-mark applied for has been entered on the Register, the Comptroller, after the expiration of the prescribed period of advertisement, may, on being satisfied of the applicant's death, enter on the Register, in place of the name of such deceased applicant, the name, address, and description of the person owning the goodwill of the business, if such ownership be proved to the satisfaction of the Comptroller.

Entries to be made in Register.

34. Upon registering any trade-mark the Comptroller shall enter in the Register the date on which the application for registration was received by the Comptroller, and such other particulars as he may think necessary.

Notice of registration.

35. The Comptroller shall send notice to the applicant of the registration of his trade-mark, together with a reference to the advertisement of such trade-mark in the official paper.

Request by subsequent proprietor.

36. Where a person becomes entitled to a registered trade-mark by assignment, transmission, or other operation of law, a request for the entry of his name in the Register as proprietor of the trade-mark shall be addressed to the Comptroller, and left at the Patent Office, Trade-Marks Branch.

Signature of request.

37. Such request shall in the case of an individual be made and signed by the person requiring to be registered as proprietor, and in the case of a firm or partnership by some one or

more members of such firm or partnership, or in either case by his or their agent respectively duly authorized to the satisfaction of the Comptroller, and in the case of a body corporate by their agent, authorized in like manner.

Contents of request.

38. Every such request shall state the name, address, and description of the person claiming to be entitled to the trade-mark (hereinafter called the claimant), and the particulars of the assignment, transmission, or other operation of law, by virtue of which he requires to be entered in the Register as proprietor, so as to show the manner in which, and the person or persons to whom, the trade-mark has been assigned or transmitted, and so as to show further that it has been so assigned or transmitted in connection with the goodwill of the business concerned in the particular goods or classes of goods for which the trade-mark has been registered.

Declaration to accompany request.

39. Every such request shall be accompanied by a statutory declaration to be thereunder written, verifying the several statements therein, and declaring that the particulars above described comprise every material fact and document affecting the proprietorship of the trade-mark as claimed by such request.

Further proof of title if required.

40. The claimant shall furnish to the Comptroller such other proof of title and of the existence and ownership of such goodwill as aforesaid as he may require for his satisfaction.

Body corporate.

41. A body corporate may be registered as proprietor by its corporate name.

Definition of applicant.

42. The term "applicant" in Rules 17, 18 and 19 shall include each of several persons claiming to be registered as proprietor of the same trade-mark.

Comptroller may require statement from rival claimants.

43. Whether all such persons so claiming require to be heard before the Comptroller or not, he may, before exercising the discretion vested in him by section 71 of the said Acts, require such persons, or any or either of them, to submit a statement in writing within a time to be notified by him, or to attend before him and make oral explanations with respect to such matters as the Comptroller may require.

Submission to Court of conflicting claims.

44. Where each of several persons claims to be registered as proprietor of the same trade-mark, and the Comptroller refuses to register any of them until their rights have been determined according to law, the manner in which the rights of such claimants may be submitted to the Court by the Comptroller, or if the Comptroller so require, by the claimants, shall, unless the Court otherwise order, be by a special case; and such special case shall be filed and proceeded with in like manner as any other special case submitted to the Court, or in such other manner as the Court may direct.

Settlement of special case.

45. Where the special case is to be submitted by the parties it may be agreed to by them, or if they differ, may be settled by the Comptroller, on payment of the prescribed fees.

Order of Court.

46. Where an order has been made by the Court in either of the following cases, viz. :—

(*a*) allowing an appeal under section 62 of the said Acts;

(*b*) disallowing an opposition to registration under section 69; or,

(*c*) under the provisions of sections 72, 90 or 92 of the said Acts,

the person in whose favour such order has been made, or such one of them, if more than one, as the Comptroller may direct, shall forthwith leave at the Patent Office, Trade-Marks Branch, an office copy of such order. The Register shall thereupon be rectified or altered, or the purport of such order shall otherwise be duly entered in the Register, as the case may be.

Removal of mark from Register.

47. Where a trade-mark has been removed from the Register for non-payment of the prescribed fee or otherwise, under the provisions of section 79 of the said Acts, the Comptroller shall cause to be entered in the Register a record of such removal and the cause thereof.

Alteration of address in Register.

48. If the registered proprietor of a trade-mark send to the Comptroller, together with the prescribed fee, notice of an alteration in his address, the Comptroller shall alter the Register accordingly.

Notice to Comptroller of applications to rectify Register.

49. Four clear days' notice of every application to the Court under section 90 of the said Acts, for rectification of the Register, shall be given to the Comptroller.

Publication of rectification or variation of Register.

50. Whenever an order is made by the Court for making, expunging, or varying an entry from or in the Register, the Comptroller shall, if he thinks that such rectification or variation should be made public, and at the expense of the person applying for the same, publish, by advertisement or otherwise, and in such manner as he thinks just, the circumstances attending the rectification or variation in the Register.

Notice to Comptroller of order of Court for alteration of trade-mark under section 92 of Acts.

51. Whenever the registered proprietor of any trade-mark intends to apply for the leave of the Court to add to or to alter such trade-mark, under section 92 of the said Acts, the notice to be given to the Comptroller shall be given fourteen days at least before such application. If leave be granted on such application the applicant shall forthwith supply to the Comptroller such a number of representations of the trade-mark as altered as he may deem sufficient.

Inspection of Register.

Hours of inspection.

52. The Register of Trade-Marks shall be open to the inspection of the public, on payment of the prescribed fee, on every week day, between the hours of ten and four, except on the days and at the times following :—

(*a*) Christmas Day, Good Friday, the day observed as Her Majesty's Birthday, days observed as days of public fast

or thanksgiving, and days observed as holidays at the Bank of England; or

(*b*) Days which may from time to time be notified by a placard posted in a conspicuous place at the Patent Office;

(*c*) Times when the Register is required for any purpose of official use.

Power to Dispense with Evidence.

Dispensing with evidence.

53. Where under these Rules any person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the Comptroller, or at the Patent Office, and it is shown to the satisfaction of the Comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the Comptroller, with the sanction of the Board of Trade, and upon the production of such other evidence, and subject to such terms as they may think fit, to dispense with any such act or thing, document, declaration, or evidence.

Amendments.

Amendment of documents.

54. Any document or drawing or other representation of a trade-mark for the amending of which no special provision is made by the said Acts may be amended, and any irregularity in procedure which in the opinion of the Comptroller may be obviated without detriment to the interests of any person may be corrected, if the Comptroller think fit, and on such terms as he may direct.

Enlargement of Time.

Comptroller may enlarge time.

55. The time prescribed by these Rules for doing any act, or taking any proceeding thereunder, may be enlarged by the Comptroller, if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms as he may direct.

Cutlers' Company.

Sheffield applications in duplicate.

56. All applications to the Cutlers' Company for registration of a trade-mark, under section 81 of the said Acts, shall be in duplicate, accompanied by the prescribed fees and representations.

Notice to Comptroller.

57. The Cutlers' Company shall, within seven days of the receipt by them of an application to register a trade-mark, send the Comptroller one copy of such application, by way of notice thereof, together with two representations of the mark for each class for which the applicant seeks registration.

Time within which Comptroller may object to application made at Sheffield.

58.—(1.) The time within which the Comptroller shall give notice to the Cutlers' Company of any objection he may have to the acceptance of an application for registration made to the said company shall be one month from the date of the receipt by the Comptroller of the notice from the said company of the making of the application.

Advertisement of application made at Sheffield.

(2.) If no such objection is made by the Comptroller, the Cutlers' Company shall require the applicant to send the Comptroller a wood block or electrotype as the Comptroller may direct, and the Comptroller shall, if satisfied with such wood block or electrotype, advertise the application in the same manner as an application made to him at the Patent Office.

Manner of notifying to Cutlers' Company application received by Comptroller.

(3.) The manner in which the Comptroller shall notify to the Cutlers' Company an application and proceedings thereon made as mentioned in sub-section 8 of section 81 of the said Acts shall be by sending to the Cutlers' Company a copy of the official paper containing the application of which notice is required to be given, with a note distinguishing such application.

Similarity of proceedings at London and at Sheffield.

59. The provisions of these Rules as to forms, representations, the proceedings on opposition to registration, registration, and all subsequent proceedings shall, as far as the circumstances allow, apply to all applications to register made to the Cutlers' Company, and to all proceedings consequent thereon.

Certificates.

Certificate by Comptroller.

60. The Comptroller, when required to give a certificate as to any entry, matter, or thing which he is authorized by the said Acts or any of these Rules to make or do, may, on receipt of a request in writing, and on payment of the prescribed fee, give such certificate; but every certificate of registration shall have specified on the face thereof whether the same is to be used in legal proceedings or for the purpose of obtaining registration in a foreign country, or for purposes other than use in legal proceedings or obtaining registration in a foreign country.

Declarations.

Manner in which, and persons before whom, declaration is to be taken.

61. The statutory declarations required by the said Acts and these Rules, or used in any proceedings thereunder, shall be made and subscribed as follows:—

(*a*) In the United Kingdom, before any justice of the peace, or any commissioner or other officer authorized by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding;

(*b*) In any other part of Her Majesty's dominions, before any court, judge, justice of the peace, or any officer authorized by law to administer an oath there for the purpose of a legal proceeding; and

(*c*) If made out of Her Majesty's dominions, before a British Minister, or person exercising the functions of a British Minister, or a Consul, Vice-Consul, or other person exercising the functions of a British Consul, or a notary public, or before a judge or magistrate.

Notice of seal of officer taking declaration to prove itself.

62. Any document purporting to have affixed, impressed, or subscribed thereto or thereon the seal or signature of any person hereby authorized to take such declaration in testimony of such declaration having been made and subscribed before him, may be admitted by the Comptroller without proof of the genuineness of any such seal or signature, or of the official character of such person or his authority to take such declaration.

Repeal.

Previous rules repealed.

63. All general rules as to the registration of trade-marks heretofore made by the Board of Trade under the Patents, Designs, and Trade-Marks Acts, 1883 to 1888, and in force on the 31st day of December, 1889, shall be, and they are hereby repealed, as from that date, without prejudice, nevertheless, to anything done under such rules, or to any application pending at the said date.

M. E. HICKS-BEACH,
President of the Board of Trade.

SCHEDULES.

FIRST SCHEDULE.

FEES.

	£	*s.*	*d.*
1. On application to register a trade-mark for one or more articles included in one class	0	5	0
2. For registration of a trade-mark for one or more articles included in one class	1	0	0
3. For registering a series of trade-marks, for every additional representation after the first in each class	0	5	0
4. On appeal from Comptroller to Board of Trade—by appellant	1	0	0
5. On notice of opposition for each application opposed—by opponent	1	0	0
6. On hearing by Comptroller—by applicant and by opponent respectively	1	0	0
7. On application to register a subsequent proprietor in cases of assignment or transmission, the first mark	1	0	0
8. For every additional mark assigned or transmitted at the same time	0	2	0
9. For continuance of mark at expiration of 14 years	1	0	0
10. Additional fee where fee is paid within three months after expiration of 14 years	0	10	0
11. Additional fee for restoration of trade-mark where removed for non-payment of fee	1	0	0

	£	s.	d.
12. For altering address on the Register, for every mark	0	5	0
13. For every entry in the Register of a rectification thereof or an alteration therein, not otherwise charged	0	10	0
14. For cancelling the entry or part of the entry of a trade-mark upon the Register, on the application of the owner of such trade-mark	0	5	0
15. On request to Comptroller to correct a clerical error, or permit amendment of application under section 91	0	5	0
16. For certificate of refusal to register a trade-mark under section 77	1	0	0
17. For certificate of refusal at the same time for more than one trade-mark, for each additional trade-mark after the first..	0	10	0
18. For certificate of registration to be used in legal proceedings..	1	0	0
19. For certificate of registration to be used for the purpose of obtaining registration in foreign countries	0	5	0
20. For certificate of Comptroller under section 96, other than certificate of registration to be used in legal proceedings, or for the purpose of obtaining registration in a foreign country..	0	5	0
21. For copy of notification of registration	0	2	0
22. Settling a special case by Comptroller.....	2	0	0
23. For inspecting Register, for every quarter of an hour	0	1	0
24. For making a search amongst the classified representations of trade-marks, for every quarter of an hour.....	0	1	0
25. For office copy of documents, for every 100 words (but never less than one shilling).....	0	0	4
26. For certifying office copies, MS. or printed	0	1	0
27. In cases where the wood block or electrotype of the trade-mark exceeds 2 inches in breadth or depth, or in breadth and depth—for every inch or part of an inch over 2 inches in breadth	0	2	0
For every inch or part of an inch over 2 inches in depth	0	2	0
28. Manchester Trade-Marks Office .....Same as above			
29. Sheffield Marks.....Same as above			
30. On appeal from Cutlers' Company, Sheffield, to Comptroller ..	1	0	0

M. E. HICKS-BEACH,
President of the Board of Trade.

Approved,

FRANK MOWATT,
Assistant Secretary for the Lords Commissioners of Her Majesty's Treasury.

SECOND SCHEDULE.

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PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form E.

Form of Application for Hearing by the Comptroller.

In Cases of Opposition, &c.

SIR,

of (*a*) hereby apply to be heard in reference to and request that I may receive due notice of the day fixed for the hearing.

Sir, your obedient Servant,

———.

To the Comptroller, Patent Office, Trade-Marks Branch,
25, *Southampton Buildings, London.*

(*a*) Here insert full address.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form F.

Application for Registration of Trade-Mark.

One representation to be fixed within this square, and two (*a*) others to be sent on separate half-sheets of foolscap.

Representations of a larger size may be folded, but must be mounted upon linen and affixed thereto.

(*a*) See now Rule 13 substituted by Rules of 1897, p. 693, above.

You are hereby requested to register the accompanying Trade Mark in Class , in respect of (*a*) in the name of (*b*) who claims to be the proprietor thereof (*c*).

The essential particulars of the Trade-Mark are the following (*d*)

and disclaim any right to the exclusive use of the added matter.

(Signed) —— (*e*).

Dated the day of , 18 .

To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

[Or where the application is for a mark in Classes 23, 24 or 25]

To the Comptroller, Manchester Trade-Marks Branch,
48, Royal Exchange, Manchester.

NOTE.—If the Trade-Mark has been in use in respect of the goods since before August 13th, 1875, state length of such user.*

(*a*) Only goods contained in one and the same class should be set out here. A separate application form is required for each separate class.

(*b*) Here insert legibly the full name address, and description of the individual firm or company. Add trading style (if any).

(*c*) Alter to "claim to be the proprietors thereof" in the case of a firm or company.

(*d*) See sub-sections (2) and (3) of section 64 of the Acts.

(*e*) To be signed by the applicant or by an agent duly authorized.

* As to the form of a claim of user by a firm, see *Wright, Crossley & Co.'s Application*, (1900) 2 Ch. 218; 17 R. P. C. 386.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

Form G.

Additional Representation of Trade-Mark, to accompany Application for Registration.

One representation of the Trade-Mark to be affixed within this square.

It must correspond *exactly*, in all respects, with the representation affixed to the Application Form.

Any representation of a larger size than foolscap may be folded, but must then be mounted upon linen and affixed thereto.

TWO of these ADDITIONAL REPRESENTATIONS of the Trade-Mark must accompany *each* Form of Application (*a*).

In the case of a Trade-Mark claimed in one of the CLASSES 23 to 35, THREE of these ADDITIONAL REPRESENTATIONS of the Mark must accompany the Form of Application (*a*).

(*a*) See now the new Rule 13 substituted by the Rules of 1897, p. 693, above.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form H.

Form of Appeal from the Comptroller to the Board of Trade.

I, (*a*) of (*a*) hereby give notice of my intention to appeal to the Board of Trade from (*b*) of the Comptroller of the day of 18 , whereby he (*c*) .

Accompanying this notice is a statement of my case for the decision of the Board of Trade.

(Signed) ——.

Dated day of 18 .

To the Comptroller, Patent Office, Trade-Marks Branch, 25 Southampton Buildings, London, and to [Name of Respondent to Appeal].

(*a*) Here insert full name and address of appellant.

(*b*) Here insert "the decision" or "that part of the decision," as the case may be.

(*c*) Here insert the decision complained of.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form I.

Fee for Registration of a Trade-Mark.

SIR,

In reply to your request I hereby transmit the prescribed fee for the registration of the Trade-Mark No. in Class .

I am, Sir, your obedient Servant,

——.

To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form J.

Notice of Opposition to Application for Registration.

[To be accompanied by an unstamped duplicate.]

In the matter of an application, No. by of .

I, (*a*) hereby give notice of my intention to oppose the registration of the Trade-Mark advertised under the above number for Class in the Trade-Marks Journal of the day of 18 , No , page .

The grounds of opposition are as follows:—(*b*)

(Signed) ——.

Dated the day of 18 .

Address for service:—

To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

(*a*) Here state full name and full address.
(*b*) See pp. 85 and 735.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form K.

Request to Enter Name of Subsequent Proprietor of Trade-Mark upon the Register, with Declaration in support thereof.

I, (*a*) hereby request that you will enter (*b*) name (*c*) in the Register of Trade-Marks as proprietor of the Trade-Mark No. in Class .

(*d*) entitled to the said Trade-Mark and to the goodwill of the business concerned in the goods with respect to which the said Trade-Mark is registered.

(*e*)

And I do solemnly and sincerely declare that the above several statements are true, and the particulars above set out comprise every material fact and document affecting the proprietorship of the said Trade-Mark as above claimed.

(*f*) And I make this solemn declaration conscientiously believing the

same to be true, and by virtuo of the provisions of the Statutory Declarations Act, 1835. (*g*) ——.

Declared at this day of 18 .

Before me,
(*h*) ——.

To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

(*a*) *Or* wo. Here insert name, full address, and description.
(*b*) My *or* our.
(*c*) *Or* names.
(*d*) I am, *or* we are.
(*e*) Here state whether Trade-Mark transmitted by death, marriage, bankruptcy, or other operation of law, and if entitled by assignment state the particulars thereof, as *e.g.*, "by deed dated the day of 18 , made between So-and-So of the one part."
(*f*) This paragraph is not required when the declaration is made out of the United Kingdom.
(*g*) To be signed here by the person making the declaration.
(*h*) Signature and title of the authority before whom the declaration is made.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form L.

Request for Certificate of Refusal to Register a Trade-Mark in use before 13th August, 1875.

In the matter of an application for registration of an old Trade-Mark, No. in Class .

SIR,

I, , of , the applicant in the above matter, hereby request you to furnish me with your Certificate of Refusal to Register the said Trade-Mark.

(*a*) ——.

Dated this day of , 18 .

To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

(*a*) Signature of applicant.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form M.

Notice of Application for Alteration of Address on Register of Trade-Marks.

In the matter of the Trade-Mark, No. registered in Class .

SIR,

NOTICE is hereby given that I , of , the registered proprietor of the Trade-Mark numbered as above, desire that my address on the Register of Trade-Marks be altered to

Dated this day of , 18 .

(*a*) ——.

To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

(*a*) Signature of proprietor.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) FORM N.

Notice of Order of Court for Alteration or Rectification of Register of Trade-Marks.

In the matter of the Trade-Mark, No. , registered in Class , in the name of

SIR,

NOTICE is hereby given that by an Order of the Court made on the day of , 18 , it was directed that the entry on the Register of Trade-Marks in respect of the Trade-Mark numbered as above should be rectified in the manner therein specified.

An office copy of the Order of the Court is enclosed herewith.

Dated this day of , 18 .

(*a*) ——.

To the Comptroller, Patent Office, Trade-Marks Branch, 25, Southampton Buildings, London.

(*a*) To be signed by the person interested or his agent.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) FORM O.

Form of Application by Proprietor of Registered Trade-Mark to Cancel Entry on Register.

Trade-Mark No. , Class , advertised in Trade-Marks Journal No. , page .
Name of registered proprietor or firm , place of business .
I, the undersigned, of , [*or* I, the undersigned, , a member of the firm of , of , on behalf of my said firm] apply that the entry upon the Register of the Trade-Marks in Class of the Trade-Mark No. may be cancelled.

The day of , 18 .

(Signed) ——.

This is the statement marked "O" referred to in the Declaration of , made before me the of , 18 .

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

FORM P.

Form of Declaration in support of Application for Cancellation of Trade-Mark by Owner.

I, , of ; [*or* I, , a member of the firm of , of], do hereby solemnly and sincerely declare, to the best of my knowledge and belief, as follows:—

(1) The application signed by me, and dated the day of , 18 , and marked with the letter "O," and shown to me at the time of making this Declaration, is true.

(2) I am the person whose name appears on the Register of Trade-Marks as the proprietor of the Trade-Mark referred to in the said application marked with the letter "O."

[*or* My said firm is the firm whose name appears on the Register of Trade-Marks as the proprietor of the Trade-Mark referred to in the said application marked with the letter "O."]

And I make this solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

(Signed) ——.

Declared at , this day of , 18 .
Before me .

If the declaration be made before a Commissioner to administer oaths it will require to be stamped with a 2*s.* 6*d.* impressed Inland Revenue stamp.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form Q.

Form of Request for Correction of Clerical Error or for Permission to amend Application under Section 91.

SIR,

I HEREBY request that .

To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form R.

Request for Certificate of Registration of Trade-Mark for use in obtaining Registration Abroad.

In the matter of the Trade-Mark, No. , registered in Class , in the name of .

SIR,

I, of , the registered proprietor of the above Trade-Mark, hereby request you to furnish me with your Certificate of Registration for use in obtaining registration of the same in (*a*) .

(*b*) ——.

Dated this day of , 18 .

To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

(*a*) Here state name of country in which registration is to be sought.
(*b*) Signature.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form S.

Request for Certificate of Registration of Trade-Mark to be used in Legal Proceedings.

In the matter of the Trade-Mark, No. , registered in Class , in the name of .

SIR,

I, , of , the registered proprietor of the above Trade-Mark, hereby request you to furnish me with your Certificate of Registration to be used in legal proceedings.

(*a*) ——.

Dated this day of , 18 .

To the Comptroller, Patent Office, Trade-Marks Branch, 25, Southampton Buildings, London.

(*a*) Signature.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form T.

Application for Settlement of a Special Case on Application to Register a Trade-Mark.

In the matter of the application of and of the application of .

SIR,

NOTICE is hereby given that I, of , and I, , of , are unable to agree upon the facts on which the opinion of the Court is to be taken, and that we request you to fix a day on which we may attend before you and obtain your finding on the matters of fact to be submitted to the Court as settled.

(*a*) ——.

Dated this day of 18 .

To the Comptroller, Patent Office, Trade-Marks Branch, 25, Southampton Buildings, London.

(*a*) To be signed by both parties.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form T 1.

Request for General Certificate of Comptroller (other than Certificate for use in Legal Proceedings or for use in obtaining Registration Abroad).

In the matter of the Trade Mark No. , in Class .

SIR,

I, , of , hereby request you to furnish me with your certificate, that (*a*) .

(*b*) ——.

Dated this day of , 18 .

To the Comptroller, Patent Office, Trade-Marks Branch, 25, Southampton Buildings, London.

(*a*) Here set out the particulars which the Comptroller is requested to certify.

(*b*) Signature.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form U.

General Certificate of Comptroller (other than Certificate for use in Legal Proceedings or for use in obtaining Registration Abroad).

Patent Office, Trade-Marks Branch,
London, 18 .

I, , Comptroller-General of Patents, Designs, and Trade-Marks, hereby certify .

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form V.

Request for Copy of Official Notification of Registration of Trade-Mark.

In the matter of the Trade-Mark, No. , registered in Class .

SIR,

I, of , the registered proprietor of the Trade-Mark above named, hereby request that you will furnish me with a copy of the official notification of the registration of the same.

(*a*) ——.

Dated this day of 18 .

To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

(*a*) Signature.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form W.

Form of Appeal from Cutlers' Company at Sheffield to Comptroller.

[*To be accompanied by an unstamped duplicate.*]

SIR,

I HEREBY give notice of appeal against the decision of the Cutlers' Company of Sheffield in regard to my application for registration of a Trade-Mark No. in Class for and I beg to submit my case (*a*) for your decision accordingly.

(*b*) ——.

Dated this day of 18 .

To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

(*a*) The statement of the case to be written upon foolscap paper (on one side only), with a margin of two inches on the left-hand side thereof.
(*b*) Signature.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form X.

Continuance of Mark at Expiration of Fourteen Years from the date of Registration.

SIR,

In pursuance of the notice received from you, I hereby transmit the prescribed fee of 1*l.* for continuance on the Trade-Marks Register of the Trade-Mark No. in Class .

Dated the day of 18 .

(*a*) ——.

To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

(*a*) Signature of proprietor.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form Y.

Additional Fee of 10*s. to accompany "Continuance Fee" (Form X) within Three Months after Expiration of Fourteen Years.*

SIR,

In pursuance of the notices issued by you, and of the provisions of sect. 79 (3) of the above Acts, I hereby transmit the additional fee of 10*s.* (along with Form X) for the continuance on the Trade-Marks Register of the Trade-Mark No. in Class .

Dated the day of 18 .

(*a*) ——.

To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

(*a*) Signature of proprietor.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form Z.

Restoration of Trade-Mark where Removed for Non-payment of Fee.

(*To accompany Form X.*)

SIR,

In pursuance of the notices issued by you, and of the provisions of sect. 79 (4) of the above Acts, I hereby transmit the additional fee of 1*l.* (along with Form X) for restoration to the Trade-Marks Register of the Trade-Mark No. in Class .

Dated the day of 18 .

(*a*)——.

To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

(*a*) Signature of proprietor.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

Application for Registration of Old Corporate Trade-Mark.

(CORPORATE TRADE-MARK.)

You are hereby requested to register the accompanying old Corporate Trade-Mark in Class , in respect of , in the name of , who claims to be the proprietor thereof.

(Signed) ——.

Dated the day of 18 .

To the Cutlers' Company, Cutlers' Hall, Sheffield.

M. E. HICKS-BEACH,
President of the Board of Trade.

THIRD SCHEDULE.

GENERAL NOTE.

Any wares made of mixed materials (for example, of both cotton and silk) shall be included in such one of the classes appropriated to those materials as the Comptroller may desire.

CLASSIFICATION OF GOODS (*a*).

	Illustrations.
	Note.—Goods are mentioned in this column by way of illustration, and not as an exhaustive list of the contents of a class.

(*a*) See Chap. V. p. 96.

By rule 6, "If any doubt arises as to what class any particular description of goods belongs to, the doubt shall be determined by the Comptroller."

An alphabetically arranged list comprising a great number of kinds of goods with references to their proper register classes, is published by

Class 1. Chemical substances used in manufactures, photography, or philosophical research, and anti-corrosives.	Such as— Acids, including vegetable acids; alkalies; artists' colours; pigments; mineral dyes.
Class 2. Chemical substances used for agricultural, horticultural, veterinary, and sanitary purposes.	Such as— Artificial manure; cattle medicines; deodorisers; vermin destroyers.
Class 3. Chemical substances prepared for use in medicine and pharmacy.	Such as— Cod liver oil; medicated articles; patent medicines; plasters; rhubarb.
Class 4. Raw or partly prepared vegetable, animal, and mineral substances used in manufactures, not included in other classes.	Such as— Resins; oils used in manufactures and not included in other classes; dyes, other than mineral; tanning substances; fibrous substances (*e.g.*, cotton, hemp, flax, jute); wool; silk; bristles; hair; feathers; cork; seeds; coal; coke; bone; sponge.
Class 5. Unwrought and partly wrought metals used in manufacture.	Such as— Iron and steel, pig or cast; iron, rough; iron, bar and rail, including rails for railways; iron, bolt and rod; iron, sheet, and boiler and armour plates; iron, hoop; lead, pig; lead, rolled; lead, sheet; wire; copper; zinc; gold, in ingots.
Class 6. Machinery of all kinds, and parts of machinery, except agricultural and horticultural machines included in Class 7.	Such as— Steam engines; boilers; pneumatic machines; hydraulic machines; locomotives; sewing machines; weighing machines; machine tools; mining machinery; fire engines.

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authority, and is called the "Guide to the Classification of Goods under the Patents, &c. Acts, 1883—1888." It is prefaced by the following direction:—

"If any person intending to apply for registration of a Trade-Mark is, on examining the following enumeration of goods, uncertain as to the class to which his goods belong, he should send to the Comptroller-General a letter addressed—

"The Comptroller-General,
"The Patent Office, Trade-Marks Branch,
"25, Southampton Buildings, Chancery Lane, London, W.C.

"giving a full description of the goods and of the purposes for which they are used. He will then be informed by the Comptroller-General what class he should name in his application."

Class 7.	
Agricultural and horticultural machinery, and parts of such machinery.	Such as— Ploughs; drilling machines; reaping machines; thrashing machines; churns; cyder presses; chaff cutters.
Class 8.	
Philosophical instruments, scientific instruments, and apparatus for useful purposes. Instruments and apparatus for teaching.	Such as— Mathematical instruments; gauges; logs; spectacles; educational appliances.
Class 9.	
Musical instruments.	
Class 10.	
Horological instruments.	
Class 11.	
Instruments, apparatus, and contrivances, not medicated, for surgical or curative purposes, or in relation to the health of men or animals.	Such as— Bandages; friction gloves; lancets; fleams; enemas.
Class 12.	
Cutlery and edge tools.	Such as— Knives; forks; scissors; shears; files; saws.
Class 13.	
Metal goods not included in other classes.	Such as— Anvils; keys; basins (metal); needles; hoes; shovels; corkscrews.
Class 14.	
Goods of precious metals (including aluminium, nickel, Britannia metal, &c.) and jewellery, and imitations of such goods and jewellery.	Such as— Plate; clock cases and pencil cases of such metals; Sheffield and other plated goods; gilt and ormolu work.
Class 15.	
Glass.	Such as— Window and plate glass; painted glass; glass mosaic; glass beads.
Class 16.	
Porcelain and earthenware.	Such as— China; stoneware; terra cotta; statuary porcelain; tiles; bricks.
Class 17.	
Manufactures from mineral and other substances for building or decoration.	Such as— Cement; plaster; imitation marble; asphalt.

Class 18.	
Engineering, architectural, and building contrivances.	Such as— Diving apparatus; warming apparatus; ventilating apparatus; filtering apparatus; lighting contrivances; drainage contrivances; electric and pneumatic bells.
Class 19.	
Arms, ammunition, and stores not included in Class 20.	Such as— Cannon; small arms; fowling pieces; swords; shot and other projectiles; camp equipage; equipments.
Class 20.	
Explosive substances.	Such as— Gunpowder; gun-cotton; dynamite; fog-signals; percussion caps; fireworks; cartridges.
Class 21.	
Naval architectural contrivances and naval equipments not included in Classes 19 and 20.	Such as— Boats; anchors; chain cables; rigging.
Class 22.	
Carriages.	Such as— Railway carriages; waggons; railway trucks; bicycles; bath chairs.
Class 23.	
(*a*) **Cotton yarn, and sewing cotton not on spools or reels.** (*b*) **Sewing cotton on spools or reels.**	
Class 24.	
Cotton piece goods of all kinds.	Such as— Cotton shirtings; long-cloth.
Class 25.	
Cotton goods not included in Classes 23, 24 or 38.	Such as— Cotton lace; cotton braids; cotton tapes.
Class 26.	
Linen and hemp yarn and thread.	
Class 27.	
Linen and hemp piece goods.	
Class 28.	
Linen and hemp goods not included in Classes 26, 27 and 50.	
Class 29.	
Jute yarns and tissues, and other articles made of jute not included in Class 50.	
Class 30.	
Silk, spun, thrown, or sewing.	

CLASS 31.	
Silk piece goods.	
CLASS 32.	
Other silk goods not included in Classes 30 and 31.	
CLASS 33.	
Yarns of wool, worsted, or hair.	
CLASS 34.	
Cloths and stuffs of wool, worsted, or hair.	
CLASS 35.	
Woollen and worsted and hair goods not included in Classes 33 and 34.	
CLASS 36.	
Carpets, floor-cloth, and oil-cloth.	Such as— Drugget; mats and matting, rugs.
CLASS 37.	
Leather, skins unwrought and wrought, and articles made of leather not included in other classes.	Such as— Saddlery; harness; whips; portmanteaus; furs.
CLASS 38.	
Articles of clothing.	Such as— Hats of all kinds; caps and bonnets; hosiery; gloves; boots and shoes; other ready-made clothing.
CLASS 39.	
Paper (except paperhangings), stationery, and bookbinding.	Such as— Envelopes; sealing wax; pens (except gold pens); ink; playing cards; blotting cases; copying presses.
CLASS 40.	
Goods manufactured from india-rubber and gutta-percha not included in other classes.	
CLASS 41.	
Furniture and upholstery.	Such as— Paperhangings; papier-mâché; mirrors; mattresses.
CLASS 42.	
Substances used as food, or as ingredients in food.	Such as— Cereals; pulses; olive oil; hops; malt; dried fruits; tea; sago; salt; sugar; preserved meats; confectionery; oil cakes; pickles; vinegar; beer clarifiers.
CLASS 43.	
Fermented liquors and spirits.	Such as— Beer; cyder; wine; whisky; liqueurs.

CLASS 44.	
Mineral and aërated waters, natural and artificial, including ginger-beer.	
CLASS 45.	
Tobacco, whether manufactured or unmanufactured.	
CLASS 46.	
Seeds for agricultural and horticultural purposes.	
CLASS 47.	
Candles, common soap, detergents; illuminating, heating, or lubricating oils; matches; and starch, blue, and other preparations for laundry purposes.	Such as— Washing powders; benzine collas.
CLASS 48.	
Perfumery (including toilet articles, preparations for the teeth and hair, and perfumed soap).	
CLASS 49.	
Games of all kinds and sporting articles not included in other classes.	Such as— Billiard tables; roller skates; fishing nets and lines; toys.
CLASS 50.	
Miscellaneous— (1.) Goods manufactured from ivory, bone, or wood, not included in other classes. (2.) Goods manufactured from straw or glass, not included in other classes. (3.) Goods manufactured from animal and vegetable substances, not included in other classes. (4.) Tobacco pipes. (5.) Umbrellas, walking-sticks, brushes, and combs. (6.) Furniture cream, plate powder. (7.) Tarpaulins, tents, rickcloths, rope, twine. (8.) Buttons of all kinds, other than of precious metal or imitations thereof. (9.) Packing and hose of all kinds. (10.) Goods not included in the foregoing classes.	Such as— Coopers' wares.

(Signed) **M. E. HICKS-BEACH,**
President of the Board of Trade.

No. 5.

INSTRUCTIONS TO PERSONS WHO WISH TO REGISTER TRADE MARKS.

Preliminary.

1. All communications relating to trade-marks, not being marks in Classes 23, 24 or 25, or Sheffield marks, should be addressed to the Comptroller, the Patent Office, Trade Marks Branch. All applications for registration should be in the English language.

They may be made by post, or left at the Patent Office, Trade Marks Branch, 25, Southampton Buildings, Chancery Lane, London, W.C. (*See* also paragraphs 8 and 33.)

For further particulars as to the method of making applications, *see* paragraph 9.

2. The fees in relation to trade-marks registration cannot be received at the Patent Office. They should be paid in exchange for the *stamped forms* required, which may be obtained at the following places:—

(a) The Inland Revenue Office, Royal Courts of Justice, London (Room No. 6).

(b) The following Post Offices in London:—
The General Post Office, E.C.
District Post Office, Lombard Street, E.C.
,, 195, Whitechapel Road, E.
,, 239, Borough High Street, S.E.
,, Charing Cross, W.C.
,, 28, Eversholt Street, Camden Town, N.W.
Post Office, 12, Parliament Street, S.W., or

(c) The Chief Post Office of the undermentioned cities and towns:—

In England and Wales.

Accrington.	Beverley.	Bristol.
Altrincham.	Birkenhead.	Bromsgrove.
Ashton-under-Lyne.	Birmingham.	Burnley.
Barnsley.	Blackburn.	Burslem.
Barrow-in-Furness.	Bolton.	Burton-on-Trent.
Bath.	Bradford.	Bury.
Bedford.	Brighton.	Cambridge.

IN ENGLAND AND WALES—*continued.*

Cardiff.	Knutsford.	Rotherham.
Carlisle.	Lancaster.	Rugby.
Chatham.	Leamington.	Salford.
Chester.	Leeds.	St. Helen's.
Clitheroe.	Leicester.	Scarborough.
Congleton.	Lichfield.	Sedgley.
Coventry.	Lincoln.	Sheffield.
Crewe.	Liverpool.	Southampton.
Croydon.	Macclesfield.	Stafford.
Darlaston.	Manchester.	Stalybridge.
Derby.	Middlesbrough.	Stockport.
Dewsbury.	Nantwich.	Stoke-on-Trent.
Doncaster.	Newcastle.	Stourbridge.
Dorchester.	Newport (Mon.).	Stourport.
Driffield.	Northallerton.	Sunderland.
Droitwich.	Northampton.	Swansea.
Dudley.	Nottingham.	Tamworth.
Durham.	Nuneaton.	Truro.
Exeter.	Oldbury.	Tunstall.
Gateshead.	Oldham.	Wakefield.
Goole.	Patrington.	Walsall.
Greenwich.	Plymouth.	Warrington.
Guildford.	Pontefract.	Wednesbury.
Halifax.	Portsmouth.	West Bromwich.
Hartlepool.	Prescot.	Whitby.
Huddersfield.	Preston.	Widnes.
Hull.	Reading.	Wigan.
Ipswich.	Redditch.	Wolverhampton.
Keighley.	Richmond (Yorks).	Wolverton.
Kendal.	Ripon.	Woolwich.
Kidderminster.	Rochdale.	York.
Knaresbro'.		

IN SCOTLAND.

Aberdeen.	Glasgow.	Leith.
Dumbarton.	Greenock.	Paisley.
Dundee.	Inverness.	Perth.
Edinburgh.	Lanark.	Renfrew.

IN IRELAND.

Belfast.	Dundalk.	Londonderry.
Cork.	Galway.	Waterford.
Dublin.	Limerick.	Wexford.

NOTE.—*Arrangements have also been made by which any of the forms required may be ordered at any Money Order Office in the United Kingdom not included in the above List.*

3. The following is a list of the stamped forms under the Patents, Designs, and Trade-Marks Acts, 1883—1888, which relate to trade-marks, and which may be obtained at the places mentioned above:—

TRADE MARKS.

Letter.	Title of Form.	Fee. £	s.	d.
E	Application for hearing by Comptroller, in oppositions..	1	0	0
F	Application for registration of trade-mark	0	5	0
G	Additional representation form	No stamp.		
H	Appeal to Board of Trade from decision of Comptroller..	1	0	0

TRADE-MARKS—*continued.*

Letter.	Title of Form.	Fee. £	*s.*	*d.*
I	Registration fee	1	0	0
J	Notice of opposition to application for registration	1	0	0
K	Request to enter name of subsequent proprietor, with declaration in support thereof	1	0	0
L	Request for certificate of refusal to register a trade-mark	1	0	0
M	Notice of application for alteration of address	0	5	0
N	Notice of order of Court for alteration or rectification of Register	0	10	0
O	Application to cancel entry of mark on Registor	0	5	0
Q	Request for correction of clerical error or for amendment of application under sect. 91	0	5	0
R	Request for certificate of registration for use abroad	0	5	0
S	Request for certificate of registration for use in legal proceedings	1	0	0
T	Application for settlement of a special case	2	0	0
T¹	Request for general certificate of Comptroller	0	5	0
V	Request for copy of official notification	0	2	0
W	Appeal from Cutlers' Company at Sheffield to Comptroller	1	0	0
X	Fee for continuance of trade-mark at expiration of fourteen years	1	0	0
Y	Additional fee where fee is paid within three months after expiration of fourteen years	0	10	0
Z	Additional fee for restoration of trade-mark where removed for non-payment of fee	1	0	0

Of the above forms, those bearing the letters F, G, and I, are kept in stock at the various offices named in paragraph 2. Any of the others when required must be bespoken.

If it should not be convenient to apply in person at any of the above offices, the forms may be ordered by persons in this country or abroad *by post* from the Controller of Stamps, Room No. 7, Inland Revenue Office, Somerset House, London, W.C.

An application by post for forms must be accompanied by a banker's draft, or by a Money Order or Postal Order, payable to the Commissioners of Inland Revenue, and crossed "Bank of England," for the value of the stamp together with the cost of the postage and of the *registration* of the letter in which the forms will be forwarded to the applicant.

SALE OF OFFICIAL PUBLICATIONS.

4. The Patents, Designs, and Trade Marks Acts, 1883—1888, and the Trade Marks Rules, 1890, should be carefully studied. Copies of the Acts and of the Rules can be purchased at the Sale Branch of the Patent Office. The price of the Acts and Rules together is 2*s.* 6*d.*, postage 2*d.*; of the Acts alone, 2*s.*, postage, 1½*d.*; and of the Rules alone, 6*d.*, postage, 1*d.* Sums exceeding 1*s.* should be remitted by Postal Order or Post Office Order.

5. Copies of the *Trade Marks Journal* may also be obtained from the Sale Branch of the Patent Office, 25, Southampton Buildings, London, W.C.

The price of the *Trade Marks Journal* is:—

Nos. 1 to 509 (Years 1876 to 1887) - -	1*s.*	*per number.*
Nos. 510 to 561 (Year 1888) - - -	1*s.* 6*d.*	,,
No. 562 and following Nos. from 1st January, 1889 - - - - -	6*d.*	,,

Definition of a Trade-Mark.

6. The definition of a trade-mark is given in the 64th section of the Acts, as follows:—

"(1.) For the purposes of this Act, a trade-mark must consist of or contain at least one of the following essential particulars:

(a) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or

(b) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade-mark; or

(c) A distinctive device, mark, brand, heading, label, or ticket; or

(d) An invented word or invented words; or

(e) A word or words having no reference to the character or quality of the goods, and not being a geographical name.

"(2.) There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures, or combination of letters, words, or figures, or of any of them, but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade-mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the Register.

"(3.) Provided as follows:—

(i.) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof;

(ii.) Any special and distinctive word or words, letter, figure, or combination of letters or figures or of letters and figures used as a trade-mark before the thirteenth day of August one thousand eight hundred and seventy-five may be registered as a trade-mark under this part of this Act."

Searches.

7. A person wishing to adopt a trade-mark should, before engraving a block and circulating impressions of the mark among his customers, make a search or a formal application for registration at the Trade-Marks Branch of tho Patent Office with the view of ascertaining whether his proposed mark is already registered, or whether, from its being calculated to deceive by a resemblance to other marks already on record, it would be refused registration under the 72nd section of the Acts.

The fee payablo by a person making a search amongst the classified representations of trade-marks is 1*s.* for each quarter of an hour. The fee for a formal application for registration is 5*s.* *See* paragraphs 9 and 3 of these Instructions as to the mode of making a formal application.

Complete searches amongst classified collections of marks in the *Cotton Classes* (Classes 23, 24 and 25) can only be made at the Manchester Branch Office, 48, Royal Exchange, Manchester. *See* paragraph 34.

The Comptroller does not undertake to make searches amongst the trade-marks recorded at his office, *except in connexion with formal applications for registration.*

Applications for Registration.

8. Applications sent by post should be addressed—

The Comptroller,
The Patent Office, Trade-Marks Branch,
25, Southampton Buildings,
London, W.C.

In the case of marks claimed in the Cotton Classes (23, 24 or 25), applications should be addressed—

The Comptroller,
Manchester Trade-Marks Branch,
48, Royal Exchange,
Manchester.

Agents and other persons who may be interested in more than one application are particularly requested to make communications relating to different applications in *separate* letters.

9. An application for the registration of a trade-mark consists of :—

(*a*) An application form (Form F) bearing an impressed stamp of 5*s.* (*see* paragraph 3).
(The applicant should, before filling up the form, carefully read the marginal notes.)

(*b*) Certain additional representations of the trado-mark, mounted on forms (Form G) (*see* paragraphs 3 and 15).

10. A *separate* application form is required for *each* class in

cases where the same trade-mark is claimed in more than one class of goods.

11. If the mark be the property of a firm, the Form F should be signed by a member of the firm, who should add, after his signature, "A Member of the Firm"; if of a company, by the secretary or other principal officer, who should add, after his signature and designation, "For the Company."

12. Applications may be made by agents in the names of and on behalf of the owners of trade-marks. The agent must be duly authorised in writing by the owner or owners; the authority to an agent should be signed by the owner or owners; in the case of a firm or of a company the authority should be signed in the same manner as indicated in the paragraph next above.

Applications made by agents should have, after the name of the agent, the description "Agent."

13. When an applicant for the registration of a trade-mark, otherwise than under an International Convention, is out of the United Kingdom at the time of making the application, he must give the Comptroller an address for service in the United Kingdom.

14. When the mark consists of or includes words printed in other than Roman characters, there should be given upon the forms a translation and a transliteration of such words, signed by the applicant or his agent.

In the case of marks claimed in Classes 23, 24 or 25, the applicant should state by what name the particular mark claimed would be referred to in the invoices of his house.

Additional Representations of Mark.

15. Each of the additional representations should be placed in the centre of a separate Form G.

In the case of a trade-mark which is claimed in any of the Classes 1 to 4, 8 to 10, 15 to 21, and 36 to 50, *three* additional representations are required for *each* class claimed.

In the case of a trade-mark claimed in any of the Classes 5 to 7, 11 to 14, or 22 to 35, *four* additional representations should be sent for *each* of such classes.

The representations of the mark on the Forms G must agree *in every respect* with each other, and with that on the Form F.

16. Representations of a mark of a large size may be folded. In that case they must, however, be backed with linen and firmly affixed to the forms. Representations must in no case be executed *in pencil*. They should be not only of a durable nature, but of such a kind as will admit of their being preserved and bound together in volumes as records of the property of the owners.

Series of Trade-Marks.

17. By section 66 of the Acts, the Comptroller is empowered to register under one registration a "series" of trade-marks

which, whilst they resemble each other in the material particulars, differ from each other in respect of statements of the goods for which they are used, of numbers, of statements of price, of statements of quality, or of statements of names of places. When an application is made for such a "series," a representation of *each* of the marks included in the series must be affixed to the Form F, and also to each of the Forms G.

Common or Open Marks.

18. In the case of a trade-mark used since before the 13th August, 1875, common or open marks of any kind may be registered in connection with it; but in the case of a trade-mark not so used, only such common or open marks as consist of *a word or of a combination of words* can be registered as a part of the mark.

In each case the applicant for entry of such common particular or particulars must disclaim the right to the exclusive use of the same in a note at the foot of the application form, such note to be signed by the applicant or his agent.

See section 74 of the Acts, sub-section 3, for definition of common marks.

Classification of Goods.

19. A guide to the classification of goods under the Trade-Marks Rules can be obtained on application at the Patent Office, Trade Marks Branch, and should be asked for if the applicant feels any difficulty in determining to which of the classes set out in the Third Schedule to the Rules the goods for which he uses his mark belong.

Advertisement in the "Trade-Marks Journal."

20. A trade-mark cannot in any case be entered upon the Register until one month after its advertisement in the official paper.

21. A wood-block or electrotype must be furnished for each mark in each class claimed, except in the case of Classes 23, 24 and 25, for which no blocks are required.

No block or electrotype should be forwarded until a formal demand for it is sent by the Comptroller.

22. In the case of a "series" of trade-marks differing only in respect of the particulars mentioned in section 66 of the Acts, a wood-block or electrotype must be furnished for each mark in the series, for each class claimed.

23. The wood-blocks or electrotypes furnished must correspond *exactly* with the representations, must afford *perfectly distinct* impressions of the marks, and must be upon a scale sufficiently large to reproduce the marks faithfully. Worn or mutilated blocks or electrotypes cannot be accepted.

24. The largest space available for the insertion of any single block or electrotype is five and a-half inches broad by seven and a-half inches deep.

When a block or electrotype *exceeds two inches in depth or breadth*, a charge for additional space is made, at the rate of two shillings for every inch or part of an inch in depth or breadth beyond the two inches.

25. The official number given by the Comptroller to a mark should *not* be cut on the face of the block or electrotype, but should be *marked upon the side* in such a manner as to secure identification.

26. All blocks or electrotypes should be sent to the Patent Office, Trade Marks Branch, together with the paper marked "Form 2," and with the representation of the mark sent for the guidance of the applicant in preparing the block or electrotype.

27. The blocks or electrotypes supplied for the advertisement of trade-marks cannot in any case be returned to applicants.

Restrictions on Registration.

28. Ornamental or coloured groundwork, such as tartans or checks, cannot be claimed as part of a mark unless such groundwork be included within the mark by some border or lines.

29. The words "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To counterfeit this is forgery," will not be registered under the Acts, and should not, therefore, appear upon the representations of trade-marks forming part of an application.

30. The following will not be registered as trade-marks, or as prominent parts of trade-marks, unless the marks have been used since before 13th August, 1875:—

The Royal Arms, or arms so nearly resembling them as to be calculated to deceive.

Representations of her Majesty the Queen, or of any member of the Royal Family.

Representations of the royal crown.

The national arms or flags of Great Britain.

31. When there appears on the face of a trade-mark an indication of the goods to which the mark is applied, the claim for its registration must be in respect of *those goods only*.

Oppositions.

32. Notice of opposition to the registration of a trade-mark (Form J) must be filed within one month (or such further time, not exceeding three months, as the Comptroller may allow) from the date of advertisement of the mark in the *Trade-Marks Journal*.

The applicant's counter-statement must be filed within one month from the date of receipt of the opponent's notice of opposition.

The opponent's evidence, in support of the opposition, must be filed within two months after the expiration of one month (or such further time, not exceeding three months, as the Comptroller may allow) from the date of advertisement of the mark in the *Trade-Marks Journal*, and a copy of such evidence must be forthwith sent to the applicant.

The applicant's evidence must be filed within one month from the delivery of the opponent's evidence, and a copy of such evidence must be forthwith sent to the opponent.

The opponent's evidence in reply must be filed within seven days from the delivery of the applicant's evidence, and a copy of such evidence must be forthwith sent to the applicant.

On the completion of the evidence, a hearing is appointed by the Comptroller. Each party attending the hearing must lodge the Hearing Fee Form (Form E, with 1*l.* stamp).

Form of Counter-statement.

The following is a form of commencement for a counter-statement:—

Patents, Designs, and Trade-Marks Acts, 1883—1888.

Trade-Marks.

In the matter of an application No.
and of the opposition thereto No.

In reply to the notice of opposition in this matter by of , I give notice by way of counter-statement that I rely for my application on the following grounds:—

(To be dated and signed by the *applicant* or his *solicitor*.)

To the Comptroller,
The Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

Cutlers' Company of Sheffield.

33. By section 81 of the Acts, application for the registration of trade-marks used on metal goods shall, if made by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company of Sheffield. *See* Rules 56 to 59.

Applications made to the Cutlers' Company in pursuance of section 81 of the Acts should be made on Form F, the address in the left-hand corner to be, "To the Cutlers' Company, Sheffield," instead of "To the Comptroller," and should be left at, or sent by post to, the Cutlers' Hall, Sheffield.

Each application should be accompanied by an unstamped copy on foolscap paper. *See* Rule 56.

Applications sent by post should be addressed—

The Law Clerk to the Cutlers' Company,
The Cutlers' Hall,
Sheffield.

Manchester Office.

34. For the convenience of merchants and manufacturers engaged in the cotton trade, and for the purpose of facilitating the recording of trade-marks used in respect of cotton goods, an office is open at 48, Royal Exchange, Manchester, where searches can be made, on payment of 1*s.* for each quarter of an hour, for marks in classes of textiles from Class 23 to Class 35.

Certificates.

35. The Comptroller's certificate in relation to a trade-mark is of four kinds, viz. :—

(i.) For use in legal proceedings.
(ii.) For use in applying for registration in foreign countries.
(iii.) Of any application made and of proceedings thereon.
(iv.) A certificate of refusal of a mark in use since before 13th August, 1875, and not registerable.

36. A person desirous of obtaining any of the above certificates should forward Form S, Form R, Form T 1, or Form L (*see* paragraph 3), as the case may be, to the Comptroller, giving the Comptroller's official number of the mark, and stating whether the certificate is required for use in legal proceedings, or for use in applying for the registration of the mark in a foreign country, or for what other purpose.

37. In every case where a certificate is required in respect of a cotton mark, or in respect of any trade-mark of which the representations or specimens forming part of the application for registration are *coloured*, or in respect of an application made, or in respect of an application refused, two unmounted copies of the mark must be supplied, agreeing *in every respect* with the representations forming part of the application for registration. Special attention should be paid to this requirement, as the certificate cannot in any such case be prepared until these unmounted copies are received by the Comptroller.

Registration of subsequent Proprietors of Registered Trade-Marks.

38. The request and declaration to be made by a subsequent proprietor on application for the registration in his name of a registered trade-mark must be made on Form K (*see* paragraph 3). In the case of a firm the Declaration K may be made by one member of the firm. In the case of a company the Declaration K should be made by a principal officer of the company.

C. N. DALTON,
Comptroller.

May, 1897.

No. 6.

OFFICIAL NOTICES PUBLISHED IN THE OFFICIAL JOURNAL (*a*).

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(*a*) These are from the year 1889 onwards.

Picture of Article—Name in Possessive Case.

Journal, No. 570, 1889, p. 220.

After the 31st March next, marks of the nature indicated below will not be accepted for registration as trade-marks under the Patents, Designs, and Trade-Marks Acts, 1883—1888:—

(1) Pictorial representations of goods to which the marks are to be applied.

(2) Names of persons in the possessive case in combination with the names of goods.

Notice as to Name Marks.

Journal, No. 606, Nov. 6th, 1889.

In future no more surname or combination of surname and christian name which might possibly be the name of an existing individual will be accepted for registration as a new trade-mark under sect. 64 of the Patents, Designs, and Trade-Marks Acts, 1883—1888, unless rendered in some particular and distinctive manner in accordance with sub-sect. 1 (*a*) of that section; and the same will apply to any christian name which is in use as a surname.

Authorisation of Agents.

Journal, No. 711, 1891, p. 1042.

Any agent forwarding to the Patent Office an application for the registration of a trade-mark must at the same time forward the applicant's authority to act as agent, unless he has already supplied a general authority, in which latter case he should with the application send a note of the date of such general authority.

Journal, No. 713, 1891, p. 1085.

(*As above in last with following addition.*)

If no authority be supplied the application may not be dealt with in the ordinary course, and communications respecting it will be sent to the applicant only.

INDEXES.

Journal, No. 714, 1891, p. 1123.

Alphabetical indexes to the words forming the essential or material feature of trade-marks as advertised in the several classes (except Classes 23, 24 and 25) have been compiled for the use of the public, and are placed in the Public Search Room.

ADVERTISEMENT OF CLAIMS AND DISCLAIMERS.

Journal, No. 715, 1891, p. 1147.

From the beginning of the year 1892 it is intended to print, in connection with the advertisement in the *Trade-Marks Journal* of applications for the registration of trade-marks, copies of all statements and disclaimers which may have been inserted in such applications in pursuance of the provisions of sects. 64 and 74 of the Patents, Designs, and Trade-Marks Acts, 1883 to 1888.

AUTHORISATION OF AGENTS.

Journal, No. 726, 1892, p. 153.

(As above in *Trade-Marks Journal*, No. 713, with following additions.)

In future an agent forwarding to the Patent Office an application for the registration of a trade-mark in the name of an applicant carrying on business out of the United Kingdom must at the same time forward the applicant's authority to act as agent.

GENERAL AUTHORISATIONS.

(This notice asks agents as far as possible to file with applications separate authorisations for each mark or series of marks.)

CLASS 50.

Journal, No. 781, 1893, p. 245.

The Comptroller desires to call attention to the increasing practice of applying for marks in Class 50 for goods contained in a very extended list of goods, which it is difficult to suppose would be generally dealt in by the same firm.

Class 50 being a miscellaneous class, the goods covered by a registration in this class should be very carefully specified, and care should be taken not to include goods for which the mark is not intended. The specifications of goods in applications in this class made after this date will be most carefully scrutinised, and evidence may be asked for as to points that may arise in consequence of such scrutiny.

Representations of Trade-Marks applied for in Classes 5, 6, 7, 11, 12, 13 and 14.

Journal, No. 873, 1894, p. 1021.

On and after the 1st January, 1895, it is proposed to establish for the convenience of the trade a complete collection of representations of pending applications in Classes 5, 6, 7, 11, 12, 13 and 14, to be kept by the Cutlers' Company at the Cutlers' Hall, Sheffield, for public inspection.

Applicants at this office for marks in these classes should therefore, on and after the 1st January, 1895, be so good as to furnish three forms "G," bearing representations of the mark applied for, instead of two. One of the forms "G" will be forwarded forthwith to the Cutlers' Company, who will preserve it, along with the applications made at Sheffield, until the mark is either refused registration or proceeds to advertisement, or is abandoned.

[*See the present Rule* 13.]

Official Crown Brands for Herring.

Journal, No. 882, 1895, p. 137.

[A notice by the Fishery Board for Scotland, calling attention to the official Crown Brands for Herrings prescribed under the Herring Fishery (Scotland) Acts, the unauthorised use of which is prohibited. Illustration of one of the Brands subjoined.]

Signatures on Trade-Marks.

Journal, No. 925, 1895, p. 1038.

In consequence of difficulties which have arisen as to the interpretation which should be put on the words in sub-sect. (1) of sect. 64 of the Act, "written signature of a firm," the Comptroller has been advised thereon, and is directed that they must be construed to mean a signature (actually used in the ordinary course of business) of the trading stylo under which the applicant has a *bonâ fide* right to trade, and which consists of a personal name or personal names, and that they do not include mere descriptive trading styles, such as "The Excellent Tea Company," or "The London Stout Company."

Blocks for Advertisement of Marks in the "Trade-Marks Journal."

Journal, No. 932, 1896, p. 115.

The attention of applicants is called to the necessity for supplying blocks for the *Trade Marks Journal* of sufficient size to show

clearly the features of the mark, and especially those features which are claimed as being essential particulars of the mark within the meaning of sect. 64 of the Statute, and any letterpress appearing on the mark.

Representations of Trade-Marks applied for in Class 22.

Journal, No. 993, 1897, p. 317.

With reference to the notice which appeared in this journal at the end of the year 1894 and the beginning of the year 1895, with regard to the establishment of a collection of marks, the subject of pending applications in certain classes, to be kept by the Cutlers' Company of Sheffield, it is now proposed to add representations of marks in Class 22 (carriages) to that collection.

Applicants, therefore, for marks in Class 22 should, on and after the 1st May, 1897, be good enough to furnish three forms "G," each bearing a representation of the mark applied for, instead of two. The other classes in which an extra representation is required for the Cutlers' Company are Classes 5, 6, 7, 11, 12, 13 and 14.

[*See the present Rule* 13.]

No. 7.

PRECEDENTS OF FORMS UPON AN OPPOSED APPLICATION TO REGISTER A TRADE-MARK AND ON APPEAL (*a*).

PAGE.
1. Application for registration 735
2. Notice of opposition 735
3. Counter-statement 736
4. Evidence in support 737
5. Application for hearing 737
6. Appeal to the Board of Trade 737
7. Case on appeal 737
8. Reference by the Board of Trade to the Court 740
9. Notice of motion for the determination of the appeal 740

1. Application for Registration.

(Form F., above, p. 706.)

2. Notice of Opposition.

(Form J., above, p. 708.)

(*Grounds of opposition.*)

1. We are the registered proprietors of a trade-mark in Class , for [*describing the goods*] registered on the of 18 , and numbered 1,234, and we use, and since the of , 18 , we have extensively used, the said mark as a trade-mark in our business as [*describing the business.*]

2. We also use, and since the of , 18 , we have extensively used, a mark consisting of [*describing it*] for [*describing the goods*] as a trade-mark, and also in our advertisements and price lists, in our said business.

3. The mark which the applicants by their application above referred to are seeking to register has such resemblance to our

(*a*) See Chap. IV., p. 63.

said registered trade-mark, numbered , and also to our said trade-mark in paragraph 2 hereof referred to, as to be calculated to deceive.

(For other grounds of opposition, see pp. 69, 85; Chap. VIII., p. 115, "What marks may be registered as trade-marks"; Chap. X., p. 211, "Restrictions on registration" (*b*).)

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3. Counter-statement.

(In answer to the Notice of Opposition, No. 2.)

[*Heading as in the Form*, p. 729.]

1. We [*the applicants*] deny that the mark which is the subject of our application has such resemblance to either of the marks referred to in tho notice of opposition herein as to be calculated to deceive.

2. [*Describing the principal differences between the applicants' mark, and the opponent's registered mark No.* 1,234.]

3. [*Describing the principal differences between the applicants' mark, and the mark referred to in paragraph* 2 *of the notice of opposition.*]

4. The last-mentioned mark is not a trade-mark, and the opponents have not used the same as a trade-mark. If our said mark bears any undue resemblance to tho said mark of the opponents (which we deny), the opponents will not in any way, nor will any right of which they are possessed, or to which they are entitled, be prejudiced by the registration of our said mark.

5. Our said mark has been used by us as a trade-mark in connection with the goods to which our application relates since the of , 18 , before the opponents had commenced to use either of their said marks, and if it bears any undue resemblance to the last-mentioned marks or either of them (which we deny), the said marks, or whichever of them our said mark so resembles, have, or has been, used as a trade-mark, if at all, and the opponents' alleged trade-mark, numbered 1,234, has been registered, in derogation of our rights, and our application to register ought not to be prejudiced by reason of such user or registration.

(Signed) ——.

To the Comptroller,
Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

(*b*) See also *Kutnow's Tm.*, 10 R. P. C. 403.

4. EVIDENCE IN SUPPORT OF THE APPLICATION OR OPPOSITION (*c*).

The formal parts of the declarations are as follows:—

[*Heading as in the counter-statement*, p. 729.]

We do solemnly and sincerely declare as follows: [*setting out the evidence of the declarants*].

And we make this declaration conscientiously believing the same to be true and by virtue of the Statutory Declarations Act, 1835.

Declared at in the City of London, this of 18 , before me, } (Signed) ———.

A commissioner for oaths.

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5. APPLICATION FOR HEARING BY THE COMPTROLLER.

(Form E., above, p. 705.)

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6. FORM OF APPEAL FROM THE COMPTROLLER TO THE BOARD OF TRADE.

(Form H., above, p. 707.)

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7. STATEMENT OF CASE (*d*).

[*Heading as in the counter-statement*, p. 729.]

1. The appellants, , are manufacturers and vendors of indiarubber hose covered with steel wire, which is wound helically round it by a process protected by certain patents. The opponents, , are vendors of indiarubber hose covered with steel wire, wound round it by a process which is different from that employed by the appellants.

2. On or about the of , 18 , the appellants

(*c*) This is given by statutory declaration. Rule 31 (3), (4), p. 81, and Rules 61, 62, p. 702. As to the Comptroller's power to dispense with evidence, see Rule 53, p. 701; and as to cases of infancy, lunacy, or other incapacity, sect. 99, p. 667.

(*d*) This is substantially the case made use of in *The Sphincter Co.'s Tm.*, 10 R. P. C. 84.

published a circular containing (*inter alia*) a representation of the device which they now seek to register as a trade-mark. The said circular and representation were registered at Stationers' Hall on the of , 18 , in the names of the appellants, and the copyright in the same is now and always has been vested in the appellants.

3. The said device consists of [*describing it*]. The said device was drawn on the instructions of the appellants, and was entirely novel in design, and it is a distinctive device. The appellants have extensively published and circulated the said circular and the said representation and device amongst persons concerned in the indiarubber and hose trade, and amongst their customers and others from the said of 18 , to the present time.

4. By their application, numbered , the appellants sought to register the said device as a trade-mark in Class 50, for use in connection with the hose manufactured or sold by them. The said application was opposed on the grounds following: that the opponents are the proprietors of a trade-mark in Class 50, for hose, registered on the of , 18 , under No. ; and that they had (as they alleged) used for a considerable time past a device consisting of [*describing it*] as an advertisement and description of their hose in price lists, circulars, &c.; and that the mark for which the appellants are applying for registration had (as was alleged) such a resemblance to their said registered trade-mark and advertisement as to be calculated to deceive.

5. The trade-mark of the opponents consists of [*describing it*]. It is totally different in design and appearance from the said device of the appellants, and the said device bears no resemblance whatever to it.

6. It is untrue that the opponents have ever used any device similar to or resembling the said device of the appellants, or such as could be mistaken for or confounded with the said device referred to in the appellants' application, or such that the registration of the latter as a trade-mark would be calculated to deceive.

7. The opponents exhibited to their declaration in opposition certain copies of price lists and advertisements, and among them a price list marked , containing a figure numbered No. 1. The said price list and figure were first issued and published on the of , 18 , as an advertisement, that is to say, years after the appellants had commenced to issue and publish their said device. The said figure No. 1 consists of [*describing it*]. The said figure is quite different in design and appearance from the said device of the appellants, and the said device bears no resemblance whatever to it.

8. The application was heard before the learned Registrar sitting for the Comptroller, and on the of 18 , he

gave his decision, and refused to allow the said device of the appellants to be registered.

9. The appellants crave leave to refer, for the purposes of their appeal, to all the evidence used at the hearing of their said application and of the opposition (*e*), and also to the written decision of the learned Registrar.

The appellants submit that, under the circumstances hereinbefore stated, the decision of the learned Registrar should be reversed, and the appellants' device No. above mentioned should be admitted to registration, on the following grounds:—

Grounds of appeal.

(1.) Because the said device is a distinctive device which the appellants are entitled to use and register as a trade-mark under the above-mentioned Acts.

(2.) Because the learned Registrar was wrong in holding that it has been the custom in the hose trade to advertise pictures of hoses resembling the said device, whereas no such custom was established by the evidence, and such custom, if established, would not be a good ground of objection to the registration of the said device.

(3.) Because the learned Registrar was wrong in holding that the said device resembles the said trade-mark of the opponents numbered No. , whereas the said device does not resemble the said trade-mark at all, or (alternatively) not so nearly as to be calculated to deceive.

(4.) Because the learned Registrar was wrong in holding that the said device resembles the said figure No. 1, and such resemblance, if it existed, would not be a good ground of objection to the registration of the said device.

The matters with which this appeal is concerned are of great importance to the appellants, and they are desirous that the same may be referred to the decision of the Court under sect. 69 of the above-mentioned Act (*f*).

(Signed) .

(*e*) See Rule 26, p. 696.

(*f*) If the Board of Trade see no reason for differing from the decision of the Comptroller, they sometimes refer the appeal at once to the Court and so save a step; and they generally do so, if either party gives them notice that he considers it desirable. See further, pp. 87, 88.

8. Form of Reference of the Appeal to the Court by the Board of Trade.

[*Title.*]

Whereas it appears expedient to the Board of Trade to refer the above-mentioned appeal to the Court. Now, therefore, the Board of Trade by virtue of the provisions of sub-sect. 4 of sect. 69 of the above-mentioned Act do hereby refer such appeal to the Court accordingly.

Dated this day of .

(Signed) ———,
Secretary to the Board of Trade.

Directions on Reference.

For the purpose of the above reference, the Board of Trade, pursuant to Rule 23 of the Trade-Marks Rules, 1890, hereby direct that the appellants make application by motion, summons, or otherwise, as they may be advised, to the Chancery Division of the High Court of Justice to hear and determine the said appeal, and that notice of such application be served upon the Comptroller-General of Patents, Designs, and Trade-Marks, and upon [*the opponents* (*a*)]. And that upon the hearing and determination of the said appeal, the appellants, the Comptroller and [*respondents*] be respectively at liberty to adduce such evidence by affidavit, examination, or cross-examination of witnesses and otherwise, as the Court may see fit to direct or permit (*b*).

Dated this day of .

(Signed) ———,
Secretary to the Board of Trade.

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9. Notice of Motion for the Determination of the Appeal.

18 , No. .

In the High Court of Justice,
Chancery Division,
Mr. Justice .

[*Heading as in the Counter-statement above, p.* 729.]

Take notice that the Court will be moved before the Honourable Mr. Justice at 10.30 in the forenoon

(*a*) Where the Comptroller has refused a mark on account of its resemblance to a registered mark, and the applicant appeals and the appeal is referred to the Court under sect. 62, the directions now usually given include a direction to serve the proprietor of such mark; see, for instance, *Application of Pomril, Ld.*, 18 R. P. C. 181 (1901), and above, p. 89.

(*b*) Where statutory declarations have been used before the Comptroller, directions for the use of these are given; see above, p. 90.

on the of , 18 , or so soon thereafter as counsel can be heard, by counsel, on behalf of the above-mentioned applicants , that the appeal of the applicants from the decision of the Comptroller-General of Patents, Designs, and Trade-marks upon their above-mentioned application (which has been referred by the Board of Trade to the Court) may be heard and determined: And for an order directing the Comptroller-General of Patents, Designs, and Trade-marks to proceed with the registration of the trade-mark referred to in the said application.

Dated this of , 18 .

(Signed) ———

Solicitors for the above-named .

To the Comptroller-General of Patents,
Designs, and Trade-marks,
and

To [*the opponents*].

No. 8.

NOTICE OF MOTION TO RECTIFY THE REGISTER.

18 . No.

In the High Court of Justice,
Chancery Division,
Mr. Justice .

In the matter of a Trade-mark numbered ,

And in the matter of the Patents, Designs, and Trade-Marks Acts, 1883-1888.

TAKE NOTICE that this Court will be moved before the Honourable Mr. Justice , on the of 18 , at 10.30 in the forenoon, or so soon thereafter as counsel can be heard, by counself on behalf of (*the applicant*) of (*address*), for an order that the Register of trade-marks kept under the above-mentioned Acts may be rectified (*as follows*):—

(1.) By the removal of the mark therein registered for class , and numbered .
(2.) By limiting the registration of the mark therein registered (&c.) for use in connection with part of the goods comprised in the said class only, namely,
(3.) By expunging from the said Register part of the said mark No. , namely,
(4.) By adding to the entry therein of the said mark No. , a disclaimer of any right on the part of the registered proprietor of the said mark to the exclusive use of part of the said mark, that is to say the words (*a*),

Or that such other order for the rectification of the said Register may be made as to the Court shall seem fit.

(Signed) ——.

To (*the registered proprietor*),
and
To the Comptroller-General of Patents, Designs, and Trade-Marks.

(*a*) For other forms of rectification see above, p. 278. For forms of orders, see Seton, 6th ed. vol. 3, p. 1989.

No. 9.

PRECEDENTS OF PLEADINGS IN ACTIONS FOR INFRINGEMENT AND PASSING OFF (*a*).

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1. Indorsement of Writ.

The plaintiff's claim is for—

(1.) An injunction to restrain the defendant, his servants, and agents, from infringing the plaintiff's registered trade-mark, No. 1234, and from passing off goods not of the plaintiff's manufacture as or for the goods of the plaintiff (*b*).

(2.) An account or damages.

(3.) Delivery up of the marked goods.

---

2. Statement of Claim.

1. The plaintiff and defendant are both manufacturers of hoes, shovels, and other hardware goods, carrying on business in Birmingham and also in London.

2. The plaintiff is the proprietor of a trade-mark consisting of the device of a circle and a triangle with a dagger placed between them, and the word "dagger" printed beneath the said device. The said trade-mark was registered, as an old mark, in the Register of trade-marks, under No. 1234, by the plaintiff, as the proprietor thereof, on the 1st of January, 1890, in Class 13 for hoes and shovels. The plaintiff's registered trade-mark.

3. The plaintiff, and his predecessors in the business carried on by the plaintiff as aforesaid, have extensively used the said trade-mark and also the said word "dagger" as a trade-mark upon hoes and shovels manufactured and sold by them since the year 1850, and the plaintiff continues to extensively use the said trade-mark and word in his said business. Use of the trade-mark.

(*a*) For the Forms given in the Appendix to the Rules of the Supreme Court, see p. 439. The first set of pleadings here given relate to an action for the infringement of a registered trade-mark, and also for passing off goods by the use of a trade-name and imitation of get-up. The paragraphs referring to each of the combined causes of action are readily distinguishable. The second set relate to an action for the infringement of an unregistered trade-mark.

(*b*) See a fuller form, p. 744, and other precedents, pp. 748 *et seq.*

Plaintiff's goods known as "dagger" hoes.

4. By reason of the user alleged in the last paragraph, the plaintiff's hoes and shovels marked with the said trade-mark and word have become known to purchasers or intending purchasers as "dagger" hoes and shovels; and "dagger" hoes and "dagger" shovels in the hardware trade mean respectively the hoes and shovels made and sold by the plaintiff.

Get-up of the plaintiff's goods.

5. The plaintiff is accustomed to paste upon the hoes and shovels manufactured and sold by him a number of small triangular labels arranged in the form of a circle and coloured alternately red and green, and hoes and shovels sold in the market and bearing triangular labels so arranged and coloured are known to purchasers or intending purchasers as, and are bought by them as and for, the goods of the plaintiff.

The infringing mark.

Imitation of the get-up.

6. The plaintiff has recently discovered, as the fact is, that the defendant is selling hoes and shovels not of the plaintiff's manufacture, bearing a mark consisting of the device of an oval and a square with a dagger placed between them, and having pasted upon them a number of small square labels arranged and coloured similarly to the labels used by the plaintiff, and referred to in paragraph 5 hereof.

Use of "dagger" by the defendant.

7. The plaintiff has also recently discovered, as the fact is, that the defendant has advertised and has invoiced and sold hoes and shovels, not of the plaintiff's manufacture, as "dagger" hoes and shovels.

Infringement of the registered trade-mark.

8. The use of the said device in paragraph 6 mentioned, and also of the word "dagger," as in paragraph 7 mentioned, is an infringement of the plaintiff's said trade-mark No. 1234.

Imitation of get-up.

9. The employment of the said square labels by the defendant is an unlawful imitation of the get-up of the plaintiff's goods referred to in paragraph 5 hereof.

Passing off goods: profits.

10. By reason of the unlawful acts aforesaid the defendant has sold and passed off, and has caused to be sold and passed off, large quantities of goods not of the plaintiff's manufacture as and for the plaintiff's goods, and has thereby gained large profits.

The plaintiff claims—

(1.) An injunction to restrain the defendant, his servants and agents, from infringing the plaintiff's said trade-mark, No. 1234, and from passing off goods not of the plaintiff's manufacture as or for the goods of the plaintiff. And in particular to restrain him and them from selling, offering for sale, or disposing of any hoes or shovels, not of the plaintiff's manufacture, bearing the device of a circle and a square with a dagger between them, or any other device colourably resembling the plaintiff's said trade-mark, or under the name "dagger" hoes or shovels, or having fixed upon them square labels arranged in a circle, or any other labels in imitation of the

get-up of the plaintiff's goods, in paragraph 5 hereof mentioned (*c*).

(2.) An account of the profits made by the plaintiff in selling or disposing of any hoes or shovels not of the plaintiff's manufacture, sold under the device in paragraph 6 hereof mentioned, or as "dagger" hoes or shovels, or bearing square labels arranged and coloured as in paragraph 8 hereof mentioned.

(3.) Delivery up to the plaintiff by the defendant upon oath of all hoes and shovels not of the plaintiff's manufacture, in the defendant's possession or under his control, marked with the device, or bearing the said labels, and of all price lists, copies of invoices, and other documents, and of all advertisement-blocks in the defendant's possession or under his control, bearing the word "dagger," for erasure or cancellation of the devices, labels, and words, or for destruction.

(4.) Costs.

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3. Defence

(In answer to the above Statement of Claim No. 2).

Traverses of the allegations in the statement of claim.

1. The defendant admits that the plaintiff is registered as the proprietor of the alleged trade-mark, No. 1234 in class 13, but he denies that the said mark is a trade-mark, and that the plaintiff is properly registered as the proprietor of the same. The said mark was not used by the plaintiff or by his predecessors in business as a trade-mark before the 13th of August, 1875.

2. The defendant denies that the said mark and that the word "dagger" is, or at any material time has been, used as a trade-mark for hoes or shovels, and that the plaintiff's hoes or shovels are known as "dagger" hoes or shovels, and that "dagger" hoes or shovels mean, or are understood to mean, hoes or shovels made or sold by the plaintiff, and that hoes and shovels sold in the market and bearing labels arranged and coloured as stated in paragraph 5 of the statement of claim are known to purchasers or intending purchasers as, or are bought as or for, the goods of the plaintiff.

Devices and word common to the trade.

3. The devices of a circle or an oval and a triangle, and the word "dagger," and the device of a dagger, are, and each of them is, common to the trade in hoes and shovels. The word "dagger" and the device of a dagger are commonly employed in the hardware trade to indicate a particular pattern of hoe

(*c*) See other forms of injunction, *post*, p. 748.

or shovel, namely, a hoe or shovel having an unusually narrow blade.

Get-up used for a long time by the defendant.

4. The business of the defendant as a manufacturer of hoes and shovels has been established since the year 1860, and the said business is much larger than that of the plaintiff. The defendant and his predecessors in the said business have for many years, and since the year 1870 at least (as the plaintiff has since the year last mentioned been well aware), used upon the hoes and shovels manufactured and sold by them a number of small square labels coloured red and green, and arranged in the form of a circle.

Acquiescence and waiver.

5. If the use by the defendant of the said square labels as aforesaid was at any time an infringement of any right of the plaintiff (which the defendant denies), the plaintiff has acquiesced in the same, and has long since forfeited any claim to interfere with such use.

Get-up of defendant's goods is not deceptive.

6. The said square labels arranged and coloured as aforesaid are not an imitation of the plaintiff's triangular labels, but are, and are well known to dealers in and purchasers of hoes and shovels to be, distinct from the same, and to indicate the goods of the defendant.

Denial of infringement.

7. The defendant denies that he has infringed the plaintiff's alleged trade-mark, or imitated the get-up of the plaintiff's goods. He admits that he has sold hoes and shovels, as he lawfully might, bearing some of the common marks aforesaid, namely, the devices of an oval, a square, and a dagger. Save as herein expressly admitted, he denies each of the allegations in paragraphs 6, 7, 8, and 9 of the statement of claim.

Denial of passing off and of profits.

8. The defendant denies that he has sold or passed off, or caused to be sold or passed off, any goods not of the plaintiff's manufacture as or for the plaintiff's goods, and that (if he has done so, which he denies) he has made any profits thereby.

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4. Statement of Claim (*d*).

("Common Law Trade-Mark.")

1. The plaintiffs have for many years been manufacturers of belting for driving machinery, and have extensively advertised, and sold the belting made by them under the styles of "Camel," "Camel Brand," and "Camel Hair." In consequence thereof, belting called "Camel," "Camel Brand," or "Camel Hair," has become to be known in all parts of the world where belting is used as belting of the plaintiffs' manufacture, as the defendants well know.

2. The defendants have lately commenced the business of

(*d*) *Reddaway & Co.* v. *Bentham Hemp Spinning Co.*, 9 R. P. C. 503. This and the following pleading are taken from the report, and are probably somewhat abbreviated from the forms actually used. And see *Reddaway* v. *Banham*, 13 R. P. C. 218.

belting manufacturers, and in order to obtain for themselves the reputation acquired by the plaintiffs, and to pass off their belting as that of the plaintiffs, and to deceive purchasers thereof, have adopted the words "Camel," "Camel Brand," and "Camel Hair," so used by the plaintiffs as aforesaid, and have sold belting under the same designation, and have advertised for sale belting manufactured by them as "Camel," "Camel Brand," and "Camel Hair Belting."

3. The use of the words "Camel," "Camel Brand," and "Camel Hair," by the defendants as aforesaid, is calculated to deceive purchasers of belting into the belief that they were buying belting of the plaintiffs' manufacture, and many persons have been so deceived (*e*).

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5. Defence

(In answer to the above-printed Statement of Claim, No. 4).

1. The defendants deny that belting called "Camel," "Camel Brand," and "Camel Hair Belting" has become to be known in all parts of the world where belting is used as belting of the plaintiffs' manufacture; and, if it has, they deny that the defendants were aware of the fact.

2. The defendants and their predecessors have long carried on the business of hemp spinning, and some time ago commenced the manufacture of various kinds of belting in connection with and as a branch of their said business.

3. Amongst other materials used by the defendants in the manufacture of belting was yarn made of camels' hair; and the defendants have, as they lawfully may, described and sold the said belting as the "Bentham Solid Woven Camel-Hair Belting." The defendants have applied to the said belting manufactured and sold by them their distinctive trade-mark.

4. Save as aforesaid, the defendants deny that they have sold or advertised their belting manufactured by them as "Camel," "Camel Brand," and "Camel Hair."

5. The defendants deny that the use of the words "Camel," "Camel Brand," and "Camel Hair" would be calculated to deceive persons into the belief that they were buying goods of the plaintiffs' manufacture. The plaintiffs have no prescriptive or distinctive right to the use of the said words.

6. The defendants deny that the use of the words "Camel Hair," as used by them, was calculated to deceive purchasers of belting manufactured by the defendants into the belief that they were buying belting of plaintiffs' manufacture. The defendants deny that any persons have been so deceived.

(The defendants also denied that the plaintiffs had been damnified, and alleged that their competition with the plaintiffs was fair trade competition.)

(*e*) For forms of claim, see pp. 744 and 748 *et seq.*

No. 10.

FORMS OF ORDERS IN TRADE-MARK CASES AND CASES ANALOGOUS THERETO (*a*).

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1. Morison *v.* Mout (*Morison's Universal Medicine*) 748
2. Farina *v.* Silverlock (*Eau de Cologne*) 749
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9. Read *v.* Richardson (*Dog's Head Beer*) 752
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11. Melachrino *v.* The Melachrino, &c. Co. (*Melachrino Cigarettes*) 753
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16. Wilkinson *v.* Griffith (*Red Medal Polish*) 755
17. Paine *v.* Daniels (*John Bull Beer*) 755
18. Powell's Trade-Mark (*Yorkshire Relish*) 755
19. Powell *v.* Birmingham Vinegar Brewery Co. (*Yorkshire Relish—interlocutory injunction*) 756
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21. Grezier and Doyle *v.* Antran (*Chartreuse*) 756
22. Royal Baking Powder Co.'s Trade-Marks 758
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24. Kynoch and Co.'s Trade-Mark (*Kynite*) 759
25. Pinet *v.* Maison Louis Pinet, Ld. (*Pinet's Boots*) 759
26. Eastman, &c. Co., Ld. *v.* John Griffiths Cycle Corporation, Ld. (*Kodak*) 759
27. Valentine Meat Juice Co. *v.* Valentine Extract Co., Ld. (*Valentine's Extract of Meat*) 760
28. Cash *v.* Cash (*Cash's Frillings, &c.*) 761

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1. Morison *v.* Moat (*b*), 20 L. J. Ch. 529 (1851), Turner, V.-C.

Trade Secret.

Injunction against use of name of plaintiff's goods;

An injunction to restrain the defendant, his agents, servants, and workmen, from selling, or causing or procuring to be sold, under the title or designation of "*Morison's Universal Medicine*,"

(*a*) The forms are, in most instances, taken from the reports cited; in some cases they give only the substance of the orders actually drawn up. For fuller forms and the formal parts of orders, see Seton, 5th ed., Vol. I., p. 534 *et seq.* A large number of orders have been collected by Mr. Sebastian, and are printed in his book, 3rd ed., p. 510; 4th ed., p. 514.

(*b*) The Lords Justices required the plaintiffs to give an undertaking as to damages; 21 L. J. Ch. 248.

any medicine made or manufactured by him, the said defendant, or by or under his order or direction; and also to restrain the defendant, his agents, servants and workmen, from making or compounding any medicines according to the secret in the said bill mentioned, and from in any manner using the secret of compounding the said medicines or any part thereof.

against use of trade secret.

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2. FARINA *v.* SILVERLOCK, 24 L. J. Ch. 632 (1855). WOOD, V.-C.

Trade-Mark.

To restrain the defendant from printing or selling any labels similar to those in use by the plaintiff, or containing copies of his signature, or address, or flourish, seal or stamps, or other marks invented and used by the plaintiff, or marks merely colourably differing therefrom, intended to represent that Eau de Cologne prepared by other parties was Eau de Cologne prepared by the plaintiff.

Injunction against printing or selling labels; or passing off.

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3. SEIXO *v.* PROVEZENDE, L. R. 1 Ch. 194 (1865), Cranworth, L.C.

Trade-Mark and Passing off.

An injunction to restrain the defendants from affixing, or causing to be affixed, to any casks of wine shipped to their orders, the brand or mark of a crown and the word *Seixo*, or any other combination of marks or words so contrived, as by colourable imitation or otherwise, to represent the marks or brands of the plaintiff, and from employing any marks or words which should be so contrived as to represent, or induce the belief, that such wines were Crown *Seixo*, or the produce of the Quinta *do Seixo*, or otherwise using the word *Seixo without clearly distinguishing* (*a*) the same from the wines produced by the Quinta *do Seixo*.

Injunction against use of trade-mark; or of trade-name of the plaintiff's goods.

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4. WOTHERSPOON *v.* CURRIE, L. R. 5 H. L. p. 523 (1872).

Trade-Name of Goods, Passing off.

Injunction restraining the respondent, his servants and agents, from using the word "Glenfield" in or upon any labels affixed to packets of starch manufactured by or for him, and from in any other way representing the starch manufactured by or for him to be "Glenfield Starch," and from selling or causing the same to

Injunction against use of name;

(*a*) This is the proper form where the right to use is not absolutely barred. See No. 6, and *Reddaway* v. *Banham*, (1896) A. C. 199, 13 R. P. C. 218. Cf. No. 21.

and passing off.

be sold as "Glenfield Starch," and from doing any act or thing to induce the belief that starch manufactured by or for him, the respondent, is "Glenfield Starch" or starch manufactured by the appellants.

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5. Ford *v.* Foster, L. R. 7 Ch. p. 634 (1872), L. JJ.

Trade-Mark.

Injunction against use of trade-mark.

To restrain the defendants from applying the mark or title "*Eureka*" to any shirts manufactured by them, or to any shirts sold by them, unless manufactured by the plaintiffs, and from selling any shirts already marked with the mark and title "*Eureka*," unless such mark or title has been applied with the sanction of the plaintiff; and from issuing any boxes or packages on which the mark or title of "*Eureka*" shall be applied to shirts not of the plaintiff's manufacture; and from affixing or using any label or card or other mark containing the word "*Eureka*" to or upon any shirts not of the plaintiff's manufacture (there was also an order for an account limited to the period since the filing of the bill).

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6. Orr-Ewing & Co. *v.* Johnston & Co., 13 C. D. p. 450 (1880), Fry, J., and C. A. (*c*).

Trade-Mark and Trade-Name.

Injunction against use of an infringing mark;

or any similar mark without distinguishing, &c.

To restrain the defendants, Robert Johnston & Co., their servants, workmen, and agents, from affixing or causing to be affixed to any Turkey red yarn not dyed by the plaintiffs, Archibald Orr-Ewing & Co., the ticket marked B, and from using two elephants on any tickets used on Turkey red yarn, without clearly distinguishing such tickets from the plaintiffs' ticket marked A, *and from employing any mark or words which would be calculated to cause any Turkey red yarn not dyed by the plaintiffs to be known in Bombay as "Bhé Hathi" yarn, or to* (*c*) (or so as to) represent or induce the belief that any of the said yarn was dyed by the plaintiffs; with an order for an account of profits and costs.

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7. Massam *v.* Thorley's Cattle Food Company, 14 C. D. p. 762 (1880), C. A.

Trade-Name and Passing off.

Injunction against passing off;

An injunction to restrain the defendant company, their servants, workmen, agents and travellers, and representatives

(*c*) The words in italics were struck out by the House of Lords. 7 App. Cas. p. 234.

respectively, from selling, exporting, or shipping, or causing, or procuring, or allowing to be sold, shipped, or exported, and from in any manner representing, or causing, or procuring to be represented, any goods manufactured by the defendant company as the manufacture or goods of the late *Joseph Thorley*, or of the plaintiffs, his trustees and successors in business; and also from in any manner representing, or causing, or procuring to be represented, or doing anything which shall lead to the belief that the defendant company have been or are carrying on the business of the late *Joseph Thorley*, or are the successors in business of the late *Joseph Thorley*; and also from affixing or permitting, or causing to be affixed to any goods or articles manufactured or bought, or procured, or sold, or shipped, or exported by the defendant company, or otherwise using or employing, or permitting to be used or employed, any labels, wrappers, or marks used by the late *Joseph Thorley* and the plaintiffs, his trustees and successors in business, or so contrived and prepared as to represent or lead to the belief that the goods or articles manufactured, or sold, or shipped, or exported by the defendant company are the goods or manufacture of the late *Joseph Thorley*, or of the plaintiffs; and also from employing, using, or circulating, or causing to be employed, used, or circulated, any circulars, pamphlets, notices, or advertisements of the late *Joseph Thorley* or of the plaintiffs, or which shall in any manner represent or lead to the belief that the defendant company have been or are carrying on the business of the late *Joseph Thorley*, or that they are his successors in business.

against pretence that defendants' business is the plaintiff's;

against imitation of marks and get-up.

Circulars and advertisement.

(The Court refused to prohibit the defendants using the name Thorley in a way not calculated to mislead the public.)

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8. Hendriks *v.* Montagu, 17 C. D. p. 638 (1881), C. A.

Company's Trade-Name.

"An injunction to restrain the defendants from applying to the Registrar of Joint Stock Companies in *England* for registration, under the Companies Acts, of any company to be incorporated under the name of the *Universe Life Assurance Association*, or any other name likely to mislead or deceive the public into the belief that the company, being incorporated as aforesaid, is the same as the *Universal Life Assurance Society*, from issuing or publishing advertisements, circulars, or prospectuses, representing that a company is to be incorporated pursuant to the *Companies Act*, 1862, under the name of the *Universe Life Assurance Association, Limited*, or any other such name as aforesaid; and from carrying on or commencing any business under the name of the *Universe Life Assurance Association, Limited*, or any such other name as aforesaid."

Injunction against registration of company with name like plaintiff's name;

against advertising company with name like plaintiff's name;

or carrying on business under such name.

9. READ *v.* RICHARDSON, 45 L. T. N. S. p. 60 (1881), C. A.

Trade-Mark.

Undertaking as to damages.

Interim injunction against use of trade-marks on goods for exportation.

Costs.

The plaintiffs by their counsel undertaking to abide by any order this Court may make as to damages, in case this Court shall hereafter be of opinion that the defendants have sustained any by reason of this order which the plaintiffs ought to pay, this Court doth order that the defendants, E. Richardson & Co., their servants and agents, be restrained from using the figure of a dog's head upon any labels, tickets, or wrappers affixed or applied to bottles of beer or stout sold for exportation, or exported by the defendants to any of the Australian colonies or New Zealand, and from selling for exportation, or exporting, any bottles of beer or stout having affixed or applied thereto any such label, ticket, or wrapper, until judgment in this action, or further order: and it is ordered that the plaintiffs' costs of this motion be their costs in the action.

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10. LEVER *v.* GOODWIN, 4 R. P. C. p. 503 (1886), Chitty, J., and C. A. (*a*).

Trade-Mark and Passing off.

Trade-mark action dismissed.

Injunction against use of particular wrapper; against passing off.

Account.

Payment of amount found due.

Costs.

"This Court doth order that this action, so far as the same claims protection in respect of the trade-mark, No. 39,714, stand dismissed out of the said Court. And it is ordered, that the defendants, Goodwin Bros., their agents and servants, be restrained from selling, offering for sale, or disposing of any soap, not being manufactured for or by the plaintiffs, in the wrapper, *or* of the form of any one of the three exhibits admitted in this action to have been issued by the defendants, and marked J.S.S.1, J.S.S.4, and B.B.1, or in any wrapper or in any form calculated or intended to pass off, or to enable others to pass off, such soap as or for the goods of the plaintiffs. And it is ordered that the following account be taken, that is to say, an account of the profits made by the defendants in selling or disposing of soap, made by or for the defendants, in any wrapper such as that contained in the exhibits marked J.S.S.1, J.S.S.4, and B.B.1, and in the form of those exhibits. And it is ordered that the defendants, Goodwin Bros., do within fourteen days after the date of the chief clerk's certificate, to be made pursuant to this order, pay to the plaintiffs, Lever & Co., the amount which, upon taking such account, shall be certified to be payable by the defendants to the plaintiffs. And it is ordered that it be referred to the taxing master to tax the costs of the plaintiffs of this

(*a*) Compare the form of the order in *Payton* v. *Snelling, Lampard & Co., Ld.*, 16 R. P. C. 290. (An appeal by the defendants in that case was allowed, 17 R. P. C. 48, and the plaintiffs' appeal to the House of Lords was dismissed, 17 R. P. C. 628.)

action, up to and including the trial, except so far as the same have been incurred by their claim for protection in respect of the trade-mark aforesaid. And it is ordered that it be referred to the taxing master to tax the costs of the defendants of the action, so far as the same have been incurred by the plaintiffs setting up the said claim for protection in respect of the said trade-mark, and the costs of the plaintiffs, when so taxed, are to be set off against the said costs of the defendants, when taxed, and the taxing master is to certify to whom, after such set-off, the balance is due. And it is ordered that the party from whom such balance shall be certified to be due do pay the amount thereof to the other party. And the question of the costs of this action incurred subsequent to the trial are reserved, and either of the parties are to be at liberty to apply as they may be advised." Costs of account reserved.

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11. MELACHRINO *v.* THE MELACHRINO EGYPTIAN CIGARETTE CO., 4 R. P. C. 225 (1887), Chitty, J.

Trade-Mark and Trade-Name.

An injunction to restrain the defendant *Poulides*, his agents and servants, from carrying on at No. 10, Pall Mall, the business carried on by him there under the name of *The Melachrino Egyptian Cigarette Co.*, or of *Melachrino & Co.*, and to restrain the defendants respectively, and their respective agents and servants, until judgment or further order, from selling or offering for sale cigarettes not of the plaintiffs' manufacture or merchandise, in boxes or packages having affixed thereto or connected therewith the labels, exhibits A11 and A12, or any other label being a colourable imitation of the plaintiffs' label. Interim injunction against use of name for a particular business; and use of particular labels.

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12. THE APOLLINARIS CO. *v.* HERRFELDT, 4 R. P. C. 488 (1887), C. A.

Trade-Marks.

That the defendants, Messrs. Herrfeldt and Campbell, their servants, agents, and workmen, be restrained, until judgment in this action or further order, from using the word "*Apollinis*," or any other word only colourably differing from the word "Apollinaris," upon any labels or corks used by them in the course of their trade in any mineral water, and also from offering for sale, or selling, or otherwise disposing of any mineral water in bottles bearing the word "*Apollinis*." Interim injunction against use of infringing word; and sale of marked goods.

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13. JAY *v.* LADLER, 6 R. P. C. 138, 140 (1888), Kekewich, J.

Trade-Mark and Passing off.

Injunction against infringement by circulars or advertisements; against the use of a particular device.

To restrain the defendant from infringing the plaintiff's trade-mark by issuing, publishing, or circulating, or causing to be issued, published, or circulated, any circular, advertisement, or notice containing or bearing the trade-mark in the pleadings mentioned, or any colourable imitation thereof, in connection with sealskin mantles and sealskin coats, or otherwise using the said trade-mark in that connection (and also from using the device of a lady and a bear so as to deceive the public).

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14. MONTGOMERY *v.* THOMPSON, 41 C. D. 47 (1889), Chitty, J., and C. A. (*d*).

Trade Name, Passing off.

Interim injunction against the use of the plaintiffs' trade-name; and against passing off.

An injunction restraining the defendant until judgment or further order from carrying on the business of a brewer at *Stone*, under the title of "*Stone Brewery*," or "*Montgomery's Stone Brewery*," or under any other title so as to represent that the defendant's brewery is the brewery of the plaintiffs, and from selling or causing to be sold any ale or beer not of the plaintiffs' manufacture, under the term "*Stone Ale*" or "*Stone Ales*," or in any way so as to induce the belief that such ale or beer is of the plaintiffs' manufacture.

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15. BURLAND'S TRADE-MARK, 42 Ch. D. 274, 6 R. P. C. 482 (1889), Chitty, J.

Order for Disclaimer.

Entry of disclaimer on the Register.

This Court doth order that the Register of Trade-Marks be rectified by entering thereon a disclaimer of any right of Frederick Adolphus Burland to the exclusive use of the word "Washerine" in the Trade-Mark, No. 77,935, and due notice of the said rectification is to be given to the Comptroller of Patents, Designs, and Trade-Marks.

(*d*) The injunction was made perpetual, and was upheld by the House of Lords; (1891) A. C. 217.

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16. WILKINSON *v.* GRIFFITH BROS. & Co., 8 R. P. C. 376 (1891), Romer, J.

Trade-Name and Passing off.

An injunction restraining the defendants, their agents and servants, from selling, or offering for sale, any French polish not of the plaintiffs' manufacture with the label complained of upon it, or so labelled or marked as to induce the public to believe that it is of the plaintiffs' manufacture. An inquiry as to the amount of damages suffered by the plaintiffs by the wrongful acts of the defendants. The defendants to pay the costs of the action up to and including the trial. The subsequent costs to be reserved, with liberty to apply. The costs which the defendants are ordered to pay to include the costs of the counterclaim which was not insisted upon.

Injunction against the use of a particular label.

Inquiry as to damages.

Costs.

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17. PAINE & Co. *v.* DANIELLS & SONS' BREWERIES, (1893) 2 Ch. 581, C. A.

Trade-Mark and Passing off.

Restrain the defendants, their servants and agents, from using the label marked "F." in the labels referred to in the plaintiffs' interrogatories, and from otherwise infringing the plaintiffs' registered trade-marks aforesaid, and from doing any act calculated to pass off ale or beer made by the defendants as ale or beer made by the plaintiffs.

Injunction against use of trade-mark;

and against passing off.

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18. POWELL'S TRADE-MARK, (1393) 2 Ch. 388, 10 R. P. C. 63, Chitty, J. (*e*).

Trade-Mark Expunged.

This Court doth order that the Register of Trade-Marks kept under the authority of the above-mentioned Act be rectified by expunging therefrom the above-mentioned trade-mark, No. 37,030. And it is ordered that the said William Powell do pay to the said Birmingham Vinegar Brewery Co., Ld., and to the Comptroller-General of Patents, Designs, and Trade-Marks their costs of this application, to be taxed by the taxing master.

And it is ordered that an office copy of this order be forthwith left with the Comptroller-General of Patents, Designs, and Trade-Marks at the Patent Office.

Removal of mark from Register.

(*e*) Affirmed by the Court of Appeal, (1893) 2 Ch. 388, 10 R. P. C. 195, and by the House of Lords, (1894) A. C. 8, 11 R. P. C. 4.

19. POWELL *v.* BIRMINGHAM VINEGAR BREWERY COMPANY, LD., (1894) 3 Ch. 449, 11 R. P. C. 563, Stirling, J. and C. A.

Interlocutory Injunction. Trade-Name of Goods.

Interim injunction against use of trade-name of plaintiff's goods.

An injunction to restrain the defendants until trial or further order from using the words *Yorkshire Relish* as descriptive of or in connection with any sauce or relish manufactured by them, or sauce or relish not being of the plaintiff's manufacture sold, or offered for sale, by them without clearly distinguishing such sauce or relish from the sauce or relish of the plaintiff.

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20. POWELL *v.* BIRMINGHAM VINEGAR BREWERY COMPANY, LD., (1896) 2 Ch. 54; 12 R. P. C. 496, Stirling, J. (*f*).

Trade-Name of Goods.

Injunction against use of trade-name of plaintiff's goods.

This Court doth order that the defendants, The Birmingham Vinegar Brewery Company, Ld., their servants and agents, be perpetually restrained by injunction from using the words *Yorkshire Relish* as descriptive of or in connection with any sauce or relish manufactured by them, or sauce or relish (not being of the plaintiff's manufacture) sold, or offered for sale, by them without clearly distinguishing such sauce or relish from the sauce or relish of the plaintiff. And it is ordered that the following account be taken at the risk of the plaintiff: an account of all profits made by the defendants by the sale of any sauce or relish (not manufactured by the plaintiff) in bottles having labels with the words *Yorkshire Relish* thereon. And it is ordered that in case the defendants shall on or before 12th November, 1895, serve a notice of appeal from this order, the restraint hereby imposed is, so far as regards the label secondly issued by the defendants, to be suspended until after such appeal shall have been heard or otherwise disposed of. (The defendants were ordered to pay the costs of the action.)

Account of profits.

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21. GREZIER AND DOYLE *v.* AUTRAN, 13 R. P. C. 13 (1896), Chitty, J.

Trade-Name of Goods and Passing off.

Injunction against use of name on goods not made by plaintiff at particular place.

(1) An injunction to restrain the defendant Hippolyte Autran, his servants and agents, until further order from selling, or offering or advertising for sale, within the United Kingdom, under the name of "*Liqueur de Chartreuse*," or "*Chartreuse*," or under any other description of which the name "Chartreuse" forms part, any liqueur which has not been, or shall not be, manufactured

(*f*) Affirmed on appeal, (1896) 2 Ch. 54, 13 R. P. C. 235, and by the House of Lords, (1897) A. C. 710; 14 R. P. C. 720.

by the plaintiff, Gabriel Alfred Grezier, or his assignor, Louis Garnier, at the Monastery of La Grande Chartreuse, in France, or elsewhere in the district or region known as La Grande Chartreuse, in France, hereinafter referred to as the "Monastery Liqueur," save and except the following liqueur, that is to say, liqueur which has been or shall be manufactured at one distillery or establishment at Voiron, in France, by Henri Meunier, the father, or by Henri Meunier, the son, or by other the persons, if any, for the time being entitled, according to the law of France, as set forth in the judgment of the Civil Court of Grenoble, dated the 2nd of March, 1895, to the benefit of the agreement dated the 9th of July, 1842. (2) An injunction to further restrain the defendant Hippolyte Autran, his servants and agents, until further order from selling, or offering or advertising for sale, within the United Kingdom, the said excepted liqueur under the name of "*Chartreuse*" simply, and from selling, or offering or advertising for sale, within the United Kingdom, under the name of "*Liqueur de Chartreuse*," or any other description of which the name "*Chartreuse*" forms part, the said excepted liqueur, without clearly distinguishing the same from the Monastery liqueur; and further, on any sale, or offer or advertisement for sale, of the said excepted liqueur, from making any mention of or reference to the recipe of Don Niviere, given to Charles Meunier, the grandfather, in 1813, intended or calculated to induce to the belief that the said excepted liqueur has been or is made according to such recipe. (3) An injunction to restrain the defendant Hippolyte Autran, his servants and agents, until further order from selling, or offering or advertising for sale, within the United Kingdom, under the name of "*Elixir Vegetal de la Grande Chartreuse*," or under any other description of which the name "*Chartreuse*" forms part, any liquid for medicinal use which has not been or shall not be manufactured by the plaintiff, Gabriel Alfred Grezier, or his assignor, Louis Garnier, at the Monastery of La Grande Chartreuse, in France, or elsewhere in the district or region known as La Grande Chartreuse, in France, hereinafter referred to as "Monastery Elixir," save and except the "Elixir Vegetal," which has been or shall be manufactured at one distillery or establishment at Voiron, in France, by Henri Meunier, the father, or by Henri Meunier, the son, or by other persons, if any, for the time being entitled, according to the law of France, as set forth in the said judgment of the Civil Court at Grenoble, dated the 2nd of March, 1895, to the benefit of the said agreement dated the 9th of July, 1842. (4) An injunction to further restrain the defendant Hippolyte Autran, his servants and agents, until further order from selling, or offering or advertising for sale, within the United Kingdom the said excepted elixir under the name of "*Elixir Vegetal de la Grande Chartreuse*," or under any other name of which the name "*Chartreuse*" forms part, first, without clearly distinguishing the same from the Monastery elixir, and secondly, without stating in English whenever mention

Exception.

Injunction against selling excepted goods under name without distinguishing;

and from referring to recipe.

Similar injunctions and exception as to another name;

and from referring to recipe without a particular statement.

or reference is made to the said recipe, that part of Article 4 of the said agreement, dated the 9th of July, 1842, in which it is formally declared that the processes of Henri Meunier, the father, as to the manufacture of the said excepted elixir, have no connection with those at the Monastery of La Grande Chartreuse aforesaid. And the parties were to be at liberty to apply to extend or vary the terms of the said injunctions, having regard to the result of any further proceedings in France relating to the said agreement dated the 9th of July, 1842.

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22. Royal Baking Powder Company's Trade-Marks, 14 R. P. C. 425 (1897), Romer, J. (*g*).

Trade-Marks Expunged.

Order expunging marks.

This Court doth order that the Register of Trade-Marks be rectified by expunging therefrom Trade-Marks Nos. 66,683 and 66,684, both in Class No. 42. And it is ordered that notice of this order be given to the Comptroller-General of Patents, Designs, and Trade-Marks by serving a copy of this order upon the said Comptroller, or by leaving the same with a clerk at the office of the said Comptroller, and at the same time producing the duplicate of this order passed and entered.

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23. Saxlehner *v.* Apollinaris Company, 14 R. P. C. 657 (1897).

Trade-Name of Goods.

Injunction to restrain use of word without clearly distinguishing.

An injunction to restrain the defendants, their officers, &c., from selling or offering, or exposing or advertising for sale, in the United Kingdom, any Hungarian bitter water, not being "Hunyadi Janos" water derived from the plaintiff's spring near Buda Pesth, in the Kingdom of Hungary, under or with or by means of any name or description of which the name "Hunyadi" forms part, without clearly distinguishing the same from the water derived from the said spring. Delivery up or destruction of all labels and other documents, and also capsules in the possession or power of the defendants, or under their control, which exhibit the name "Hunyadi" in connection with Hungarian bitter water without clearly distinguishing the same from water derived from the said spring. (An account of profits, limited as agreed, was also ordered, and a special order was made as to costs.)

(*g*) See 18 R. P. C. 97.

24. Kynoch & Co.'s Trade Mark, 14 R. P. C. 905 (1897), Kekewich, J.

Order to proceed with Registration.

Upon motion this day made unto this Court for the above-named applicants, Messrs. G. Kynoch & Co., Ld., being an appeal from the Comptroller-General to register the word *Kynite* in Class 20 in respect of all goods included in that class, which appeal has been referred to the Court by the Board of Trade, and upon, &c., this Court doth order that the Comptroller-General do proceed with the registration of the said trade-mark.

Order to proceed with registration.

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25. F. Pinet et Cie. *v.* Maison Louis Pinet, Ld.; and Same *v.* Maison Pinet, Ld., 15 R. P. C. 73 (1898), North, J.

Trade-Name.

Upon the two several motions for injunction this day made unto this Court by counsel for the plaintiffs in the respective actions, and upon, &c.; and the plaintiffs and defendants in both actions by their counsel consenting that the hearing of the said motions should be treated as motions for judgment in the respective actions, and the plaintiffs by their counsel waiving any claim for damages. The Court doth order that the defendant, Frederick William Shepherd, the liquidator thereof, be perpetually restrained from transferring, selling, or dealing with any right to the name *Pinet*, or any title or description including that name in connection with the manufacture or sale of boots or shoes. And it is ordered that the defendants, Maison Louis Pinet, Ld., Frederick Westwood Potter, William Alfred Phillips, Arthur Joshua Eastmead, and Louis Marius Pinet, and Maison Pinet, Ld., Frederick William Shepherd, and Walter Kelsey, be perpetually restrained from using the said name *Pinet*, or any such title or description as aforesaid, in such connection as aforesaid, and from doing any other act or thing conferring, or purporting to confer, either directly or indirectly, upon any other person or persons any right to use the said name or other such title or description as aforesaid, in such connection as aforesaid, and from selling or offering for sale any boots or shoes not of the plaintiff's manufacture under the name of "*Pinet's* Special Boots and Shoes," or "*Pinet's* Boots and Shoes."

Injunction restraining liquidator from selling name.

Injunction restraining other defendants from using name in connection with certain goods or conferring use of it on others;

and from selling goods under certain names.

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26. Eastman Photographic Materials Company, Ld. *v.* John Griffiths Cycle Corporation, Ld., and Kodak Cycle Company, Ld., 15 R. P. C. 112 (1898), Romer, J.

Trade-Name and Passing off.

An injunction restraining the defendant companies, or either of them, from carrying on business under the name "*Kodak Cycle Company, Ld.*," or under any name comprising the word

Injunction restraining carrying on business under name;

or representing that defendant's business is connected with plaintiff's;

or selling goods under name.

"*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, Ld. An injunction restraining the defendant companies, and each of them, from selling, or offering to sell, any of their cycles or goods as "*Kodak*." The defendants to pay the costs, including the costs of the Comptroller (*h*).

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27. Valentine Meat Juice Company *v.* Valentine Extract Company, Ld., 17 R. P. C. 688 (1900), C. A.

Trade-Name and Passing off.

Injunction restraining certain defendants from carrying on certain business under name;

and from selling goods under name;

and another defendant from doing so without distinguishing;

and all defendants from representing connection with plaintiffs or passing off.

"This Court doth order that the defendants, the Valentine Extract Company, Ld., and Herbert Hughes, and each of them, their servants and agents, be perpetually restrained from carrying on business as manufacturers or vendors of any preparation of extract of meat or meat juice under any name or title of which the name '*Valentine*' or '*Valentine's*' forms part, and from selling, or offering, or exposing, or advertising for sale, or procuring to be sold any such preparation as aforesaid not being of the plaintiff's manufacture under any name or description of which the name '*Valentine*,' or '*Valentine's*,' or '*Valtine*' forms part. And it is ordered that the defendant, Charles Richard Valentine, his servants and agents, be perpetually restrained from carrying on any such business as aforesaid, under any such name or title as aforesaid, without clearly distinguishing such business from the business of the plaintiffs, and from selling, or offering, or exposing, or advertising for sale, or procuring to be sold, any such preparation as aforesaid, under any such name or description as aforesaid, without clearly distinguishing such preparation from goods of the plaintiffs. And doth order that the defendants, the Valentine Extract Company, Ld., Charles Richard Valentine, and Herbert Hughes, and each of them, their servants and agents, be perpetually restrained from in any manner representing or acting so as to be calculated to lead to the belief that the defendant, Charles Richard Valentine, is or ever has been interested in or connected with the business of the plaintiffs, and from passing off, or enabling or assisting others to pass off, any such preparation as aforesaid not being of the plaintiff's manufacture, as or for the plaintiff's goods." (The order directed a delivery up of infringing labels and boxes and an inquiry as to profits, and that the costs of the action and the appeal be paid by the defendants.)

(*h*) There was also an order to expunge the first defendant company's mark "*Kodak*."

28. J. & J. Cash, Ld. *v.* Cash, 18 R. P. C. 191 (1901), Kekewich, J.(*i*).

Trade-Name.

An injunction to restrain the defendant, *Joseph Cash*, from carrying on business of a manufacturer or seller of frillings or woven names or initials under the name of Joseph Cash & Company, or under the name of "*Cash*," and from carrying on any such business under any name or in any manner so as to mislead or deceive the public into the belief that the business of the defendant, or the frillings or woven names or initials manufactured or sold by him, are the business of or goods manufactured by the plaintiffs, or that the defendant is carrying on the business formerly carried on at Coventry by Messrs. J. & J. Cash, the vendors to and predecessors in business of the plaintiffs; an injunction to restrain the defendant from making over his business in frillings or woven names or initials to, or acting as managing director of, any limited or other company formed to carry on business in frillings or woven names or initials, and having a name which is calculated or likely to mislead or deceive the public into the belief that the business, frillings, or woven names or initials of such company are the business, frillings, or woven names or initials of the plaintiffs, or that such company is carrying on the business formerly carried on at Coventry by the said Messrs. J. & J. Cash, and from otherwise assisting any such company to so mislead or deceive the public. (An injunction against soliciting was also granted with the costs of the action, and, the defendant alleging that an interlocutory injunction which had been granted was wider than that granted at the trial, he was to be at liberty to apply for an inquiry as to damages sustained by reason of the interim order (*k*).)

Injunction restraining defendant from carrying on business in certain goods under his own name;

or so as to mislead;

and from transferring his business to company having name calculated to mislead.

(*i*) The defendant has appealed from the order.

(*k*) There were special reasons for not granting the inquiry at the trial. See the report.

No. 11.

ORDERS IN COUNCIL APPLYING THE PROVISIONS OF SECT. 103 OF THE PATENTS, ETC. ACT OF 1883 TO BRITISH POSSESSIONS AND FOREIGN STATES.

COLONIAL ARRANGEMENTS.

Colony.	Date of Order in Council.	Statutory Rules and Orders.
Queensland	17 Sept., 1885.....	Vol. 5, p. 141.
New Zealand	8 Feb., 1890	1890, p. 887.
Tasmania	30 April, 1894	1894, p. 54, No. 123.
Western Australia	11 May, 1895	1895, p. 587, No. 245.

INTERNATIONAL ARRANGEMENTS (*a*).

Foreign State.	Date of Order in Council.	Statutory Rules and Orders.
Belgium	26 June, 1884	Vol. 5, p. 142.
Brazil	26 June, 1884	Vol. 5, p. 142.
Denmark (including the Faroë Islands)	20 Nov., 1894	1894, p. 56, No. 542.
Dominican Republic	21 Oct., 1890	1890, p. 887.
Ecuador	16 May, 1893	1893, p. 65.
France	26 June, 1884.....	Vol. 5, p. 142.
Greece	15 Oct., 1894	1894, p. 57, No. 234.
Italy	26 June, 1884	Vol. 5, p. 142.
Japan	7 Oct., 1899	1899, p. 964, No. 759.
Mexico	28 May, 1889	Vol. 5, p. 146.
Netherlands	26 June, 1884	Vol. 5, p. 142.
Netherlands (East Indian Colonies)	17 Nov., 1888	Vol. 5, p. 145.
Netherlands (Curaçao and Surinam	17 May, 1890	1890, p. 886.
Paraguay	24 Sept., 1886.....	Vol. 5, p. 144.
Portugal	26 June, 1884	Vol. 5, p. 142.
Roumania	5 Aug., 1892	1892, p. 650.
Servia	26 June, 1884	Vol. 5, p. 142.
Spain	26 June, 1884	Vol. 5, p. 142.
Sweden and Norway	9 July, 1885	Vol. 5, p. 143.
Switzerland	26 June, 1884.....	Vol. 5, p. 142.
Tunis	26 June, 1884	Vol. 5, p. 142.
United States	12 July, 1887	Vol. 5, p. 145.
Uruguay	24 Sept., 1886.....	Vol. 5, p. 144.

(*a*) **As to Guatemala, Salvador, and Ecuador, see p. 771.**

Places under British Jurisdiction.

Penalties on British subjects committing offences against the Patents, &c. Acts, 1883 to 1888 (*b*).

Places.	Date of Order in Council.	Statutory Rules and Orders.
Africa— (*a*) *Continent and adjacent Islands* (excluding certain of the territories to which the Order noted *infra*, under (*b*), and recent Orders dealing with Rhodesia and Nigeria apply)	15 Oct. 1889, Art. 55..	Vol. 3, pp. 259, 273.
(*b*) *East Africa*	7 July, 1897, Art. 17..	1897, pp. 134, 141, No. 575.
Brunei	22 Nov., 1890, Art. 40..	1890, p. 677.
China and Corea.....	2 Feb., 1899.....	1899, p. 639, No. 82.
Egypt	8 Aug., 1899, Art. 57..	1899, pp. 643, 662, No. 595 (*c*).
Morocco	28 Nov., 1889, Art. 112	Vol. 3, p. 524.
Ottoman Empire (and see Egypt, *supra*)	8 Aug., 1899, Art. 57..	1899, pp. 643, 662, No. 595.
Persia	13 Dec., 1889, Art. 292.	Vol. 3, pp. 698, 766.
Persian Coast and Islands	13 Dec., 1889, Art. 50..	Vol. 3, pp. 796, 815.
Siam	28 Nov., 1889, Art. 40..	Vol. 3, pp. 813, 831.
Somaliland	7 Oct., 1899, Art. 12 ..	1899, pp. 705, 711, No. 758.
Turkey. See Ottoman Empire	.. ..	.. ..
Zanzibar	7 July, 1897, Art. 17..	1897, pp. 159, 165, No. 576.

(*b*) Orders in Council issued under 41 & 42 Vict. c. 67, now replaced by 53 & 54 Vict. c. 37.

(*c*) This Order (the Ottoman Order in Council, 1899) is (Art. 12) suspended as regards matters within the jurisdiction of the Egyptian Courts established with his Majesty's concurrence, and the limits of the Order as respects Egypt do not extend to any place south of the 22nd parallel of north latitude.

No. 12.

THE INTERNATIONAL CONVENTION (*a*).

International Convention between the Governments of Belgium, Brazil, Spain, France, Guatemala,* Italy, Netherlands, Portugal, Salvador,* Servia, and Switzerland, for the Protection of Industrial Property.

Signed at Paris, March 20, 1883.

[*Ratifications exchanged at Paris, June* 6, 1884.]

(Translation.)

Art. I.—The Governments of Belgium, Brazil, Spain, France, Guatemala,* Italy, Holland, Portugal, Salvador,* Servia, and Switzerland constitute themselves into a Union for the Protection of Industrial Property.

Art. II.—The subjects or citizens of each of the Contracting States shall, in all the other States of the Union, as regards patents, industrial designs or models, trade-marks and trade-names, enjoy the advantages that their respective laws now grant, or shall hereafter grant, to their own subjects or citizens.

Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided they observe the formalities and conditions

* Salvador withdrew from this Convention by notice dated September 6, 1886; Guatemala by notice dated November 27, 1894, taking effect on November 8, 1895.

(*a*) Further articles were agreed upon at the Conference at Rome in 1886 (see Parliamentary Paper, C.—4837), but were never ratified. The articles printed below, p. 771, were agreed upon at the Conference at Madrid in 1889, and they have been duly ratified by Great Britain, Spain, France, Switzerland, and Tunis. The articles printed below, p. 773, were not ratified by Great Britain. There are numerous other treaties and arrangements existing between this country and foreign States for the protection of the trade-marks of each other's subjects. See Parliamentary Papers (1888), Commercial, No. 12, and (1872) C.—633; and *ante*, p. 545, *n.* (*b*).

imposed on subjects or citizens by the internal legislation of each State.

Similar provisions to those of this Article and of Art. III. were to be found in particular treaties between individual States; but, owing to differences in municipal law, they were insufficient to provide for the protection of trade-marks. Thus, in France, Italy, and other countries, no right arises to the applicant for the registration of a trade-mark from the mere registration if another has previously held the same mark for goods of the same kind. In Germany, Sweden, Norway, &c., the mark belongs to the first applicant. "It has thus happened that unscrupulous competitors in countries where the latter system exists have hastened to register in their own names the new names registered in its own country by a well-known house, so that they were placed in a position to compete unfairly with the house by means of its own marks, and even to have its goods seized for infringement of trade-mark." (*Trans. Int. Ass. Prot. Ind. Prop.*, vol. i., 1897, p. 186.) It was impossible to compel these countries to alter the basis of their legislation. Hence Art. IV. gave persons interested the necessary time to register their marks in all the States of the Union before another could anticipate them. See note to Art. IV.

ART. III. Subjects or citizens of States not forming part of the Union, who are domiciled, or have industrial or commercial establishments in the territory of any of the States of the Union, shall be assimilated to the subjects or citizens of the Contracting States.

See note to Art. II., *supra*.

ART. IV. Any person who has duly applied for a patent, industrial design or model, or trade-mark in one of the Contracting States, shall enjoy, as regards registration in the other States, and reserving the rights of third parties, a right of priority during the periods hereinafter stated.

In some foreign countries registration is equivalent to ownership, notwithstanding prior user or prior registration elsewhere. Hence the provision in the Convention as to priority.

Consequently, subsequent registration in any of the other States of the Union before expiry of these periods shall not be invalidated through any acts accomplished in the interval, either, for instance, by another registration, by publication of the invention, or by the working of it by a third party, by the sale of copies of the design or model, or by use of the trade-mark.

The above-mentioned terms of priority shall be six months for patents and three months for industrial designs and models and trade-marks. A month longer is allowed for countries beyond sea.

See note to Art. II. Art. IV. provides a period of three months (with an additional month for countries beyond sea), during which the mark may be registered in all the Contracting States, and the efficacy of the registration cannot be affected by acts which have been accomplished in the interval, and in particular by another

registration or the use of the mark. "In other words, an application made during the period of priority has the same result as if it had been made on the day of the first application in the country of origin. In this way a temporary security is provided for applicants for the registration of new marks in those countries where by law the mark belongs to the first applicant." (*Trans. Int. Ass. Prot. Ind. Prop.*, vol. i., 1897, p. 187.)

ART. V. The introduction by the patentee into the country where the patent has been granted of objects manufactured in any of the States of the Union shall not entail forfeiture.

Nevertheless, the patentee shall remain bound to work his patent in conformity with the laws of the country into which he introduces the patented objects.

Forfeiture for importation and compulsory working are unknown to English law.

ART. VI. Every trade-mark duly registered in the country of origin shall be admitted for registration, and protected in the form originally registered in all the other countries of the Union.

That country shall be deemed the country of origin where the applicant has his chief seat of business.

If this chief seat of business is not situated in one of the countries of the Union, the country to which the applicant belongs shall be deemed the country of origin.

Registration may be refused if the object for which it is solicited is considered contrary to morality or public order.

See also note to Art. 4 of the Final Protocol, *post*, p. 769.

ART. VII. The nature of the goods on which the trade-mark is to be used can, in no case, be an obstacle to the registration of the trade-mark.

This provision relates to the case where the mark is intended for goods whose sale in the country is either forbidden or permitted only after official investigation. Medical remedies are here principally contemplated. This article, by permitting the registration of marks for such goods, allows the owner of a mark to take care at any rate that no other can obtain the use of the same mark for other similar goods, which might afterwards be opposed to the original mark, when the goods in question can be introduced into commerce. (*Trans. Int. Ass. Prot. Ind. Prop.*, vol. i., 1897, p. 188.)

ART. VIII. A trade-name shall be protected in all the countries of the Union, without necessity of registration, whether it form part or not of a trade-mark.

In France it had been decided by the Cour de Cassation, in *Beissel's case* (*Annales de la Propriété Industrielle*, 1880, p. 113), that a mark in becoming public property carried with it the trade-name which formed part of it. Hence Art. VIII.

ART. IX. All goods illegally bearing a trade-mark or trade-name may be seized on importation into those States of the Union where this mark or name has a right to legal protection.

Arts. IX. and X. are applied in English law by the provisions of the M. M. A. 1887, which go much further than, and therefore

satisfy, the provisions of the Convention. This article was a great benefit to the States which made liberal provision in regard to the device of marks. But this benefit gradually diminished owing to the tendency of all the States of the Union to adopt a broader conception of marks.

The seizure shall be effected at the request of either the proper public department or of the interested party, pursuant to the internal legislation of each country.

ART. X. The provisions of the preceding Article shall apply to all goods falsely bearing the name of any locality as indication of the place of origin, when such indication is associated with a trade-name of a fictitious character or assumed with a fraudulent intention.

Any manufacturer of, or trader in, such goods, established in the locality falsely designated as the place of origin, shall be deemed an interested party.

See note to Art. IX.

ART. XI. The high contracting parties agree to grant temporary protection to patentable inventions, to industrial designs or models, and trade-marks, for articles exhibited at official or officially recognized international exhibitions.

This article is carried out as regards patents and designs by sects. 39 and 57 of the Patents and Trade-Marks Act, 1883. No analogous provision was required as regards trade-marks, as the right to a trade-mark in England is acquired not by priority of registration, but by priority of user. A doubt has arisen under this article whether temporary protection ought to be granted by every State of the Union merely for the exhibitions which take place in its territory, or whether it should be extended to exhibitions in the other Contracting States. The Brussels Conference (*La Propriété Industrielle*, 1898, p. 2) interpreted the article in the latter sense; and see Patents Act, 1886, s. 3.

ART. XII. Each of the high contracting parties agrees to establish a special government department for industrial property, and a central office for communication to the public of patents, industrial designs or models, and trade-marks.

ART. XIII. An international office shall be organized under the name of "Bureau International de l'Union pour la Protection de la Propriété Industrielle" (International Office of the Union for the Protection of Industrial Property).

This office, the expense of which shall be defrayed by the governments of all the Contracting States, shall be placed under the high authority of the central administration of the Swiss Confederation, and shall work under its supervision. Its functions shall be determined by agreement between the States of the Union.

ART. XIV. The present Convention shall be submitted to periodical revisions, with a view to introducing improvements calculated to perfect the system of the Union.

To this end conferences shall be successively held in one of the Contracting States by delegates of the said States. The next meeting shall take place in 1885 at Rome.

ART. XV. It is agreed that the high contracting parties respectively reserve to themselves the right to make separately, as between themselves, special arrangements for the protection of industrial property, in so far as such arrangements do not contravene the provisions of the present Convention.

ART. XVI. States which have not taken part in the present Convention shall be permitted to adhere to it at their request.

Such adhesion shall be notified officially through the diplomatic channel to the government of the Swiss Confederation, and by the latter to all the others. It shall imply complete accession to all the clauses, and admission to all the advantages stipulated by the present Convention.

ART. XVII.—The execution of the reciprocal engagements contained in the present Convention is subordinated, in so far as necessary, to the observance of the formalities and rules established by the constitutional laws of those of the high contracting parties who are bound to procure the application of the same, which they engage to do with as little delay as possible.

ART. XVIII.—The present Convention shall come into operation one month after the exchange of ratifications, and shall remain in force for an unlimited time, till the expiry of one year from the date of its denunciation. This denunciation shall be addressed to the government commissioned to receive adhesions. It shall only affect the denouncing State, the Convention remaining in operation as regards the other contracting parties.

[*Here follow the Signatures.*]

Final Protocol.

On proceeding to the signature of the Convention concluded this day between the governments of Belgium, Brazil, Spain, France, Guatemala, Italy, the Netherlands, Portugal, Salvador, Servia, and Switzerland, for the protection of industrial property, the undersigned plenipotentiaries have agreed as follows:—

1. The words "industrial property" are to be understood in their broadest sense; they are not to apply simply to industrial products properly so called, but also to agricultural products (wines, corn, fruits, cattle, &c.), and to mineral products employed in commerce (mineral waters, &c.).

2. Under the word "patents" are comprised the various kinds of industrial patents recognized by the legislation of each of the Contracting States, such as importation patents, improvement patents, &c.

3. The last paragraph of Article II. does not affect the legislation of each of the Contracting States as regards the procedure to be followed before the tribunals, and the competence of those tribunals.

4. Paragraph 1 of Article VI. is to be understood as meaning that no trade-mark shall be excluded from protection in any State of the Union from the fact alone that it does not satisfy, in regard to the signs composing it (*b*), the conditions of the legislation of that State; provided that on this point it comply with the legislation of the country of origin, and that it had been properly registered in said country of origin. With this exception, which relates only to the form of the mark (*b*), and under reserve of the provisions of the other Articles of the Convention, the internal legislation of each State remains in force.

To avoid misconstruction, it is agreed that the use of public armorial bearings and decorations may be considered as being contrary to public order in the sense of the last paragraph of Article VI. (*c*).

5. The organization of the special department for industrial property mentioned in Article XII. shall comprise, so far as possible, the publication in each State of a periodical official paper.

6. The common expenses of the International Office, instituted by virtue of Article XIII., are in no case to exceed for a single year a total sum representing an average of 2,000fr. for each Contracting State.

To determine the part which each State should contribute to this total of expenses, the Contracting States, and those which may afterwards join the Union, shall be divided into six classes, each contributing in the proportion of a certain number of units, namely:—

1st class	.. ..	25 units.
2nd ,,	.. ..	20 ,,
3rd ,,	.. ..	15 ,,
4th ,,	.. ..	10 ,,
5th ,,	.. ..	5 ,,
6th ,,	.. ..	3 ,,

(*b*) The expressions "in regard to the signs composing it" and "only to the form of the mark" were, no doubt, used because special attention was directed to name-marks, which at that time were not considered as marks in a certain number of States. At present the majority of States do recognise names as marks, but with all kinds of restrictions which (as in the case of Great Britain, where descriptive words are not registrable) tend to destroy the effect of the concession. (*Trans. Int. Ass. Prot. Ind. Prop.*, Vol. 1 (1897), p. 144.)

(*c*) The object of clause 4 has been suggested to be to protect word-marks in countries where the local law did not admit them. (*Trans. Int. Ass. Prot. Ind. Prop.*, Vol. 1 (1897), p 141.) On the other hand, the view has been put forward (*ib.*) that, under the last paragraph of this clause, States may refuse, as "contrary to public order," marks which, whilst apparently mere fancy names, consist of a new name of the product, or words descriptive of it, and those which are more or less likely to lead to mistakes. (*Sed quære!*)

These coefficients will be multiplied by the number of States in each class, and the sum of the result thus obtained will supply the number of units by which the total expense has to be divided. The quotient will give the amount of the unit of expense.

The Contracting States are classed as follows, with regard to the division of expense :—

1st class	..	France, Italy.
2nd ,,	..	Spain.
3rd ,,	..	Belgium, Brazil, Portugal, Switzerland.
4th ,,	..	Holland.
5th ,,	..	Servia.
6th ,,	..	Guatemala, Salvador.

The Swiss Government will superintend the expenses of the International Office, advance the necessary funds, and render an annual account, which will be communicated to all the other Administrations.

The International Office will centralise information of every kind relating to the protection of industrial property, and will bring it together in the form of a general statistical statement, which will be distributed to all the Administrations. It will interest itself in all matters of common utility to the Union, and will edit, with the help of the documents supplied to it by the various Administrations, a periodical paper in the French language dealing with questions regarding the object of the Union.

The numbers of this paper, as well as all the documents published by the International Office, will be circulated among the Administrations of the States of the Union in the proportion of the number of contributing units as mentioned above. Such further copies as may be desired, either by the said Administrations or by societies or private persons, will be paid for separately.

The International Office shall at all times hold itself at the service of members of the Union, in order to supply them with any special information they may need on questions relating to the international system of industrial property.

The Administration of the country in which the next Conference is to be held will make preparation for the transactions of that Conference, with the assistance of the International Office.

The Director of the International Office will be present at the meetings of the Conferences, and will take part in the discussions, but without the privilege of voting.

He will furnish an annual report upon his administration of the office, which shall be communicated to all the members of the Union.

The official language of the International Office will be French.

7. The present final protocol, which shall be ratified together with the Convention concluded this day, shall be considered as

forming an integral part of, and shall have the same force, validity, and duration as, the said Convention.

[*Here follow the signatures.*]

Accessions and Withdrawals (*d*).

Denmark (including the Faroe Islands) acceded October 1, 1894.

Dominican Republic acceded December 8, 1884.

Ecuador acceded December 21, 1883, but withdrew February 27, 1886 (*d*).

Greece, declaration October 15, 1894.

Guatemala withdrew by notice dated November 27, 1894, taking effect November 8, 1895.

Japan acceded by notice dated April 15, 1899, taking effect July 15, 1899.

Salvador, a signatory party, withdrew September 6, 1886.

Sweden acceded June 18, 1885.

United States acceded May 30, 1887.

Arrangement between Great Britain, [illegible]n, France, Switzerland, and Tunis, for the [illegible]revention of False Indications of Origin of Goods (*e*).

Signed at Madrid, April 14, 1891.

[*Ratifications exchanged at Madrid, June* 15, 1892.]

(Translation.)

The undersigned Plenipotentiaries of the States hereinafter enumerated,

In view of Article XV. of the International Convention of the 20th March, 1883, for the protection of industrial property,

Have mutually concluded the following arrangement, subject to ratification :—

Art. I. All goods bearing a false indication of origin, in which one of the Contracting States, or a place situated therein, shall be directly or indirectly indicated as being the country or place of origin, shall be seized on importation into any of the said States.

(*d*) See the list printed at p. 762.
(*e*) Parliamentary Paper, Treaty Series, No. 13 (1892).

The seizure may also take place either in the State where the false indication of origin has been applied, or in that into which the goods bearing the false indication may have been imported.

If the law of any State does not permit seizure on importation, such seizure shall be replaced by prohibition of importation.

If the law of any State does not permit seizure in the interior, such seizure shall be replaced by the remedies assured in such case to natives by the law of such State.

ART. II. The seizure shall take place at the request either of the proper Government Department, or of an interested party, whether individual or society, in conformity with the domestic law of each State.

The authorities are not bound to effect the seizure of goods in transit.

ART. III. The present stipulations are not intended to prevent the vendor from indicating his name or address upon goods coming from a country other than that where the sale takes place; but in such case the address or the name must be accompanied by a clear indication in legible characters of the country or place of manufacture or production.

ART. IV. The tribunals of each country will decide what appellations, on account of their generic character, do not fall within the provisions of the present arrangement, regional appellations concerning the origin of products of the vine being, however, not comprised in the reserve provided for by the present article.

It has been suggested that, instead of the courts of law being left to deal with the question *pro re natâ*, either the Contracting States or the competent authorities in every country should be required to determine beforehand what local names in their territory are to be considered as generic. (*Trans. Int. Ass. Prot. Ind. Prop.*, Vol. 1 (1897).) There would, however, be great difficulty in carrying out either suggestion. In some cases the law of the country might not permit the Executive to trespass in this way on the domain of the Courts. Names that ought to find a place in the generic lists would be omitted. Who would decide as to translated names and names of countries?—as in the case of "Russia leather," which in German (*Russisches leder*) means leather from Russia, while in England and in France (*cuir de Russie*) it means a peculiar kind of leather called in Germany *Juchtenleder*. (*Ib.* pp. 179, 180, and n. 120.)

ART. V. States which are parties to the Union for the Protection of Industrial Property, and who have not adhered to the present arrangement, shall be allowed to accede on demand in the manner prescribed by Article XVI. of the Convention of the 20th March, 1883, for the Protection of Industrial Property.

ART. VI. The present arrangement shall be ratified, and the ratifications shall be exchanged at Madrid within six months at the latest.

It shall come into force one month after the exchange of ratifications, and have the same force and duration as the Convention of the 20th March, 1883.

In witness whereof the plenipotentiaries of the States hereinafter enumerated have signed the present arrangement at Madrid, 14th April, 1891.

[Signed on behalf of Brazil, Spain, France and Tunis, Great Britain, Guatemala, Portugal, and Switzerland, but Brazil, Guatemala, and Portugal did not ratify.]

ARRANGEMENT RELATING TO THE INTERNATIONAL REGISTRATION OF TRADE-MARKS (*f*).

ART. I. The subjects or citizens of each of the Contracting States may ensure in all the other States the protection of their trade-marks accepted for registration in the country of origin by applying for the said marks at the International Office at Berne, through the agency of the Administration of the said country of origin.

ART. II. The subjects or citizens of States which have not adhered to the present Arrangement who satisfy the conditions of Article III. of the Convention shall be assimilated to the subjects or citizens of the Contracting States.

ART. III. The International Office shall immediately register marks applied for, in accordance with Article I. It shall notify such registration to the Contracting States. The marks registered shall be published in a supplement to the journal of the International Office, by means of a drawing or a description in the French language provided by the applicant.

With a view to provide the necessary publicity in the various States for marks so registered, each Administration shall receive gratis from the International Office such a number of copies of the said publication as it shall think fit to demand.

ART. IV. From the date of registration so made at the International Office, the protection in each of the Contracting States shall be the same as if the mark had been directly registered there.

(*f*) This translation is by Mr. J. F. Iselin (Trans. Int. Ass. Prot. Ind. Prop., Vol. 1 (1897), p. 111). The restricted Union includes the following States:—Belgium, Brazil, France, Italy, the Netherlands, Portugal, Spain, Switzerland, and Tunis. It applies also to the respective colonies of the Contracting States mentioned as forming part of the General Union of 1883. Great Britain did not sign, see above, p. 648.

ART. V. In the countries where their law authorises them to do so, the Administrations to which the International Office gives notice of the registration of a mark shall have power to declare that protection cannot be granted to such mark in their territory. They shall exercise such power within a year of the notice prescribed by Article III.

Such a declaration so notified to the International Office shall be transmitted by it without delay to the Administration of the country of origin and to the owner of the mark. The person interested shall have the same remedies as if the mark had been directly registered by him in the country where the protection is refused.

ART. VI. The protection resulting from registration at the International Office shall last for twenty years from such registration, but cannot be invoked in favour of a mark which no longer enjoys legal protection in its country of origin.

ART. VII. Registration may always be renewed in accordance with the provisions of Articles I. and III.

Six months before the expiry of the period of protection, the International Office shall give official notice to the Administration of the country of origin and to the owner of the mark.

ART. VIII. The Administration of the country of origin shall fix at its pleasure, and shall raise for its own profit, a fee which it may demand from the owner of the mark for which international registration is applied for.

To this fee shall be added an international duty of 100 francs, the annual produce of which shall be divided equally amongst the Contracting States, after deducting the costs occasioned by the execution of this Arrangement.

ART. IX. The Administration of the country of origin shall give notice to the International Office of the annulments, erasures, disclaimers, transfers, and other changes which shall take place in the ownership of the mark.

The International Office shall register these changes, give notice of them to the Contracting Administrations, and immediately publish them in its journal.

ART. X. The Administrations shall regulate by agreement the details relating to the execution of the present Agreement.

ART. XI. The States of the Union for the Protection of Industrial Property which have not taken part in the present Arrangement shall be permited to adhere to it upon their demand, and in the form prescribed by Article XVI. of the Convention of the 20th March, 1883, for the Protection of Industrial Property.

As soon as the International Office shall be informed that a State has adhered to the present Arrangement, it shall send to the Administration of that State, in accordance with Article III., a

general notice of the marks which at that time enjoy international protection.

ART. XII. The present Arrangement shall be ratified, and the ratifications shall be exchanged at Madrid within six months at the latest. It shall come into force one month after the exchange of ratifications (*g*), and shall have the same force and duration as the Convention of the 20th March, 1883.

Final Protocol.

Upon proceeding to the signature of the Arrangement relating to the International Registration of Trade Marks, concluded this day, the Plenipotentiaries of the States which have adhered to the said Arrangement have agreed as follows:—Doubts having arisen as to the scope of Article V., it is understood that the power of refusal which this Article leaves to the Administrations does not affect the provisions of Article VI. of the Convention of the 20th March, 1883, or of paragraph 4 of the accompanying Final Protocol, these provisions being applicable to marks registered at the International Bureau, as they are, and shall still continue to be applicable to those directly registered in any of the Contracting States. The present Protocol shall have the same force and duration as the Arrangement to which it relates.

(*g*) This exchange of ratifications took place on June 15th, 1892.

No. 13.

FOREIGN AND COLONIAL TRADE-MARK LAWS (*a*).

1. Principal Foreign Laws.

AUSTRIA-HUNGARY.

The Law of December 7th, 1858, which for thirty-two years regulated the protection to property in trade-marks in Austria-Hungary, gave way in 1890 to a new law, which was published in Vienna on January 6th, and in Buda-Pesth on April 6th of that year.

The law in question is the same for both halves of the Dual Monarchy, and came into force three months after the date of its publication in Austria and Hungary respectively.

This law, subject to certain modifications hereinafter mentioned, still regulates all questions as to trade-marks in Austria-Hungary, and contains full particulars as to procedure, forms, and fees for registration.

Sect. 4, para. 32, of the law enacts that, with reference to the protection of marks, as also of names, firms, arms, or business descriptions of foreign establishments or undertakings, the conventions or treaties concluded with the respective foreign States are decisive.

The subjects of His Britannic Majesty, therefore, by virtue of Article VI. of the treaty concluded between Great Britain and Austria on December 5th, 1876, enjoy in Austria-Hungary the same protection as native subjects with regard to rights of ownership over trade-marks, and other distinctive marks of goods, or their packages, as well as over patterns and designs for manufactures.

British subjects, however, in order that they may enjoy the benefit of protection, must obtain the registration of their trade-marks both at Vienna and Buda-Pesth, and, to this end, must deposit four specimens of such marks in the Chambers of Commerce at each capital, whereas under the law of 1858 only two copies were required.

It should be further noted that under the old law it was only necessary for an applicant for registration to prove that his

(*a*) This summary has been prepared from the following Blue Books:—*Reports relative to Legislation in Foreign Countries*, 1879 (C. 2284, 2420); *Reports from Her Majesty's Representatives Abroad on Trade-Marks Laws and Regulations*, 1900 (Cd. 104). See also *Summaries of Foreign and Colonial Laws as to Merchandise Marks*, pp. 850 *et seq.* (Cd. 358).

trade-mark had been registered in the United Kingdom in order to effect its registration in Austria-Hungary. Now, however, the law enacts that the mere fact of a mark being registered abroad does not necessarily imply that it is qualified for registration by the Austrian and Hungarian authorities, foreigners being called upon to satisfy the same requirements for registration as any native of the Dual Monarchy.

By virtue of an enactment, dated July 30th, 1895, the following amendments and additions to the Law of 1890 were made. These modifications of the law are still in force:—

Amendment. 1. The stipulations of sect. 3, No. 2, of the Law of 1890, enacting that those marks of goods which consist only of words are excluded from registration, are restricted to those words which contain exclusively statements as to place, time, and manner of production, and as to quality, price, designation, quantity, and weight.

Addition. 2.—(1) It is enacted, with reference to sect. 2 of the Law of 1890, that the sole right to a mark consisting of words is not restricted only to the deposited forms of a mark in words, but also extends to the use of those forms of execution by which the protected word or words are rendered in other characters, colours, or sizes, wholly or in part.

(2) It is enacted, with reference to sect. 21, sect (*e*), of the Law of 1890, that a mark can be annulled when it is found that the same has a striking resemblance to a mark previously granted upon a similar class of goods, the Minister of Commerce to give his decision in the matter after he has heard the owner of the trade-mark, and, if necessary, called in the evidence of experts.

(3) It is enacted, with reference to sect. 21 of the Law of 1890, that the actual user of a non-registered mark can bring an action for annulment against the owner, or his legal successor, of a registered mark, if, at the time of registration of the contested mark, or one strikingly similar, the said mark was known in commercial circles as the mark of his goods. Such an action for annulment shall be considered inadmissible when the mark in question has been registered with the consent of the plaintiff, or when the firm or other undertaking which has registered the mark has used the mark unregistered for the same period as the plaintiff, or even longer.

The complaint must be lodged with the Ministry of Commerce within two years of the registration of the mark, the annulment to come into force from the date of the filing of the action, where such action is successful.

The successful plaintiff is entitled to register the annulled mark in his own name as soon as the annulment has been declared valid.

This enactment is only applicable to those marks which have been registered since August 2nd, 1895.

(4) In those cases where a party is non-resident in Austria-

Hungary, including Bosnia and Herzegovina, and has no settled abode, the said party will only be able to establish his claims under the Law of 1890, or the supplementary enactment of 1895, by nominating an attorney resident within the territory in question. The name of the said attorney may, but need not necessarily, be entered in the register of marks. Where such name has not been entered, judgment may be given in any action brought for annulment of a mark without having the evidence of the non-resident owner.

(5) The Minister of Commerce has the right, according to his own free judgment, to determine in all disputes occurring subsequent to August 2, 1895, the proportion of the costs of the proceedings and of the legal representatives to be borne by the parties in question. Any legal decision concerning costs can be enforced by legal distraint.

(6) In those cases where marks have been annulled consequent upon a delay in the re-registration, or upon an action at the instance of the legitimate claimant, the same or strikingly similar marks for the same or a similar class of goods cannot be registered in favour of another or of the previous owner, or his legal successor, until two years after the legal annulment.

The foregoing supplementary enactment to the Law of 1890 came into force on February 2, 1896.

Brazil.

All matters relating to the registration and protection of trade-marks in Brazil are at present regulated by the Law of October 14, 1887.

In its main provisions this law is very similar to the decree of October 23, 1875, a French translation of which was published in Parliamentary Blue Book, "Commercial, No. 25, 1879." Contrary, however, to the British Act, while no prohibition appears of the importation of goods bearing the name or trade-mark of a Brazilian dealer, an endeavour has been made (Law of December 16, 1896), "with the view of protecting national industry, and in order to give greater publicity to its products, to prohibit, under penalty of a fine of from 1,000 to 5,000 milreis (about 30*l.* to 150*l.*), the printing or importation of labels and marks of foreign products, or in a foreign language, to be affixed to Brazilian products, and to prohibit the sale of products of Brazilian origin to which such labels have been affixed."

As regards registration of trade-marks, the following modifications appear in the Law of 1887:—

The manufacturer or his special delegate is required to present three fac-similes of a trade-mark for registration, instead of two as formerly; after registration two of these are returned to him.

An explanation or description of the trade-mark must accompany the fac-simile, with a declaration of the branch of trade or commerce for which the mark is destined.

The application and the print or sketch of the mark must be on thick paper 33 × 22 centims. in dimension, with a margin for binding. This paper must not be folded, nor must other parts be attached to it. Each sheet must be stamped, dated, and signed.

Within thirty days after the date of registration the applicant is required to publish in the official *Gazette* the certificate of registration, with an explanation of the distinguishing features of the mark.

Within sixty days from the same date he must also deposit a copy of the *Gazette* containing this publication at the office of the Commercial Tribunal of Rio.

Trade-marks composed of arms, national or foreign medals, or emblems are prohibited; also a trading name to which the applicant is not entitled; also the partial or entire imitation of a mark already registered for goods of the same description.

As regards the system of official fees for registration of trade-marks, it appears to be impossible to give precise information, as the system of registration fees in Brazil is so complicated and variable.

In the first place the power of attorney (*pouvoir*) and the certificate of registration of the country of origin must be taken to the stamp office to be stamped, the value of such stamp varying according to the dimensions of the paper and the number of sheets. The next step is to present these two documents at the Ministry of Foreign Affairs, where a fee of 550 reis (about 4½*d.* at present rate of exchange) has to be paid for each. These two documents must then be translated by a sworn translator on stamped paper; the price charged for these two translations is very variable. This done, a form of application, with a 300-reis stamp (about 2½*d.*) affixed, and a description in triplicate of the trade-mark with a 900-reis stamp (about 7¼*d.*) affixed, must be deposited at the Junta Commercial, together with a fee of 2 milreis (about 1*s.* 4*d.*).

The stamps required for the certificate of deposit amount to 6$600 reis (about 3*s.* 11*d.*); the publication of the certificate of registration in the official *Gazette* costs 200 reis (about 1⅘*d.*) per line.

Lastly, it is required to furnish a copy of the official *Gazette* (100 reis = about ⅓*d.*), stamped with a 1$200-reis stamp (about 9½*d.*), together with a stamped petition (100 reis = about ⅓*d.*) accompanied by a fee of 2 milreis (about 1*s.* 4*d.*).

Denmark.

The Danish Trade-Mark Law of April 11, 1890, replaced the old one of July 2, 1880. The reason for making a new law was that Sweden and Norway were to get a uniform law (there was already a law in Sweden, but none in Norway), and the two countries invited Denmark to join and have similar rules as to protection and reciprocity. In Sweden and Norway there were

a good many timber and iron firms, who used as marks single letters ("A," "B," "BB," "BC," &c.).

Such letter combinations could be registered by the owners within six months from the date of the coming into force of the law. After the expiration of the six months they could not be registered (sect. 14, paragraph 7).

On September 28, 1894, Denmark joined the International Convention for the protection of trade-marks of March 20, 1883, and to which almost all civilised States have adhered.

On December 19, 1898, an amendment was passed for the purpose of enabling traders to register words or figures, but the law prescribes that to make registration possible these words or figures should not contain any indication as to the origin, kind, use, quality, or price of the goods.

France.

(Law of June 23, 1857.)

Part I.—The Ownership of Trade-Marks.

Art. I.—(Sect. 1.) Trade-marks are optional. Nevertheless, decrees in the form of administration orders may, by way of exception, declare trade-marks compulsory for certain specified articles.

The following are considered trade-marks:—Names of a distinctive character, appellations, emblems, imprints, stamps, seals, vignettes, reliefs, letters, numbers, wrappers, and every other sign serving to distinguish the products of a manufacture or the articles of a trade.

Art. II. No person can assert his exclusive ownership of a trade-mark, unless two copies of the pattern of the mark have been deposited (registered) at the Tribunal of Commerce of his domicil (*b*).

Art. III. This deposit (registration) is effective for a period of fifteen years only. The ownership of the mark may, however, be secured for a further term of fifteen years by means of a fresh deposit (registration).

Art. IV. A fixed fee of one franc is charged for entering the minute of deposit of each mark, and making a copy thereof, exclusive of stamp and registration fees.

Part II.—Provisions Relating to Foreigners.

Art. V. Foreigners who have industrial or commercial establishments in France enjoy the protection of the present law for the products thereof, provided they comply with the formalities herein prescribed (*c*).

(*b*) This article has been amended by the Law of 3rd May, 1890 (see *infra*, p. 781).

(*c*) Compare Art. III. of the International Convention of 1883 (p. 765).

ART. VI.—(Sect. 1.) Foreigners and Frenchmen whose houses or places of manufacture are situate out of France also enjoy the protection of the present law for the products thereof, if, in the countries where such houses or factories are situate, diplomatic conventions have stipulated reciprocity for French trade-marks.

Sect. 2. Foreign marks in this case shall be registered at the Tribunal of Commerce of the Department of the Seine.

The Law of the 23rd June, 1857, is still in force, with the exception of Article II., which has been amended by the Law of the 3rd May, 1890.

A Presidential Decree of the 27th February, 1891, regulates the working of the provisions of the Law of 1857 in its amended form, and annuls the Imperial Decree of the 23rd June, 1857.

Under Article II. thus modified the applicant for a trade-mark must, in order to claim exclusive rights over that trade-mark, deposit at the "Tribunal de Commerce" of his place of domicile, or, in the case of a foreigner, at the "Tribunal de Commerce du Département de la Seine": **Procedure.**

1. Copies in triplicate (instead of in duplicate, as heretofore) of his trade-mark; and
2. The plate (or die) of that trade-mark.

This plate must not exceed 12 centim. in length; it must be of metal, and of such a kind as is usually employed for printing purposes, 23 millim. in thickness, and must be inclosed in a solid wooden box.

It is returned to the interested party after the official publication of the trade-mark in the "Bulletin Officiel de la Propriété Industrielle et Commerciale."

The delay between the time of application for the registration of a trade-mark and its publication is usually about forty-five days.

A fee of 1 fr. is charged for each *procès-verbal* of deposit besides the stamp and registration fees, which amount together to about 8 fr. 38 c. (see annexed table):— **Fees.**

(A.) *Dépôt de la Marque de Fabrique et délivrance de l'Expédition.*

	Fr.	c.
1. Timbre de la minute du procès-verbal. (Décret du 18 Juin, 1880, Article XII. s. 3)	0	60
2. Enregistrement de la minute du procès-verbal ..	5	63
3. Rédaction du procès-verbal y compris le coût de l'expédition. (Décret du 27 Février, 1891, Article XII. Décret du 18 Juin, 1880, Articles VIII. et X.)	1	00
4. Mention sur le répertoire et remboursement du timbre. (Décret du 18 Juin, 1880, Articles X. et XII.)	0	35
5. Timbre de l'expédition	1	80

If more than one trade-mark is deposited by the same person, an additional fee of 1 fr. is charged for each trade-mark, the other stamp and registration fees of 8 fr. 38 c. being sufficient to cover the registration of any number of trade-marks.

The *procès-verbal* of deposit should be renewed every fifteen years.

Any person wishing to have an extract from the Trade-marks Register must pay a fee of 1 fr. for each trade-mark, together with stamp and registration fees, amounting together to 4 fr. 8 c. or 4 fr. 68 c., as the case may be (see annexed table):—

(B.) *Délivrance du Certificat d'Identité de la Marque de Fabrique.*

	Fr.	c.
1. Timbre du certificat .....60 c. ou	1	20
2. Enregistrement de la Minute	1	88
3. Délivrance du certificat. (Décret du 18 Juin, 1880, Article VIII., s. 8)	1	00
4. Mention sur le répertoire et remboursement du timbre. (Décret du 18 Juin, 1880, Articles X. et XII.)	0	35
5. Légalisation. (Décret du 18 Juin, 1880, Article X., s. 1)	0	25

Germany.

The 1874 law on trade-marks and its defects.

The first uniform Law on trade-marks for the Empire of Germany was that of November 30th, 1874, which, however, proved to be defective, and was replaced twenty years later by the present Law of May 12th, 1894 (supplemented by "regulations to carry the same into effect").

The present Law extended legal protection to trade-marks which did not fall within the limits of the old Law. The 1874 Law had this peculiarity, that it was uniform in its application to all parts of the Empire, but each Federated State was allowed to retain its separate offices for the registration, cancellation, &c. of trade-marks, and each Commercial Court in each Federated State still continued to have its separate register of trade-marks, though all the registered marks were published in the *Imperial Gazette* (*Reichsanzeiger*), but without any central reference index.

The inconveniences occasioned by this state of things, which may be described as a want of centralisation, together with the non-examination of applications for trade-marks, the exclusion of the registration of "word marks," and the fact that marks could only be protected by such traders or merchants as were inscribed on the official Commercial Registers ("Handelsregister"), brought about changes that were urgently needed in the interests of the public.

The 1894 law on trade-marks: position of foreigners.

The Trade-Marks Law of 1894 is characterised by the fact that any person whatsoever can acquire protection for a trade-mark, and that all foreigners in Germany are placed on an exactly equal footing with Germans in the eye of the law, so long as they have a domicile ("Niederlassung") within the Empire (*i.e.*, a place of business or a residence which involves the payment of German taxes). Failing this domicile in Germany, protection for a trade-mark is made strictly dependent upon the reciprocity of trade-mark rights in the country of the foreign applicant; therefore, in order that a foreigner may obtain the benefit of the German Trade-Mark Law, there must have been previously published in the *Imperial Gazette* (*Reichs-anzeiger*) a notice stating that German trade-marks are granted legal protection, in the country or State in which the foreign applicant's domicile is located, to the same extent as the national trade-marks of that country. (Sect. 23 of Law.)

If that reciprocity is accorded, the nationality of the applicant is immaterial. Such notifications have been published for Austria-Hungary, Belgium, Brazil, Bulgaria, Denmark, France, Greece, the United Kingdom, Guatemala, Italy, Japan, Luxembourg, the Netherlands, Mexico, Roumania, Russia, Sweden and Norway, Switzerland, Servia, Venezuela, and the United States.

As such a notice has been published as regards the United Kingdom, the only other condition to be fulfilled by a British applicant (not having a domicile in Germany) for the registration of a foreign trade-mark is that he produce proof that he has applied for and has secured protection for the mark in the United Kingdom by registration there (sect. 23 of Law). His application, however, for a similar registration in Germany does not follow as a matter of course. The German Trade-Marks Office (a branch of the Patent Office) first examines his application to see if it conforms to the requirements of the 1894 Act in every particular; and registration in the German Empire may be refused on various grounds, such as the previous registration of the same mark by another applicant, or the too great similarity of the mark to some other mark already registered for a German or foreign trader.

Germany is not a member of the "Union for the Protection of Industrial Property."

It may here be mentioned that the German Empire has not yet adhered to the "International Union for the Protection of Industrial Property," founded in 1883; so that in Germany there is no question of international registration of trade-marks, as is the case in some of those countries which have joined the Union.

British trade-marks may be appropriated by other persons if not registered in Germany.

As in Germany non-registered marks can be used by anyone, notwithstanding the fact that such marks are the property of British firms or individuals in Great Britain and are there registered for them, it may happen that German or other firms or persons in the German Empire have already adopted certain British marks, in which case there is not much hope of redress for such British firms or persons as have neglected to register their marks in due time in Germany. Moreover, the previous

use of a registered British mark for a lengthened period in the German Empire would not entitle the owner to any rights or priority in the matter of registration, as against a German or any foreigner who had already applied for its registration as his own trade-mark. The actual date of the application for registration is determinative. No registration of such a British trade-mark by a German or other foreigner would be cancelled in favour of the British owner, even if previous use and consequent material ownership of the said mark over a lengthened period in Germany were proved, save under exceptional circumstances (under the provisions of sect. 9 of Trade-Marks Law). It is therefore most important that all British exporters of goods, going both to the German Empire and to all other important neutral markets abroad, should, if they have not already done so, effect immediately a proper registration of their trade-marks. Otherwise they may suffer unnecessary injury all over the world, merely because they have not taken the trouble to effect a proper registration in Germany, as well as in the United Kingdom, for their trade-marks.

Fees for registration and renewal.

The actual procedure to be followed in order to obtain registration of a British trade-mark is to be found in the "Regulations for Applications for the Registration of Trade-Marks." The preliminary fee is 1*l.* 10*s.*, of which 1*l.* will be returned if the application for registration is not accepted. A further 10*s.* is payable for each application for the renewal of a mark on the expiration of the first ten years (sect. 2 of Law). There are no other fees or expenses whatever. In Germany there are forty-two classes of trade-marks, and the initial fee of 1*l.* 10*s.* covers the registration of the mark for all these classes of goods if noted in the complete list of goods to which the mark is to be applied accompanying the application.

Conditions of the renewal of registration.

The registration of a trade-mark expires *ipso facto* after ten years from the date of registration or from the date of renewal. It can also be cancelled if the registration ought to have been refused in the first instance. Notice of cancellation on account of failure to renew is given to the proprietor of the mark by the Trade-Mark Branch of the Patent Office. If 10*s.* fine besides the renewal fee of 10*s.*, or 1*l.* altogether, be paid within one month of the delivery of the notice, then the renewal will be considered to have been properly made on the day of the expiration of the former registration (sect. 8 of Law). But, even after this time, the expired mark can nevertheless be again registered afresh by an entirely new application. In this case, however, the application has no priority whatever on account of its previous registration, and such re-registration may meantime have been barred by the fact that some other firm or person has registered the same mark or one nearly resembling it.

Testamentary and contract transfer of

The rights in trade-marks can be transferred to other persons by contract, or they can pass over by a testamentary enactment, but only together with the business to which the trade-mark

belongs. Such transfers are officially registered (sect. 7 of Law). trade-mark rights.

Anyone can petition for the cancellation of a mark on the following grounds (sect. 9 of Law):— Grounds for cancellation of a mark.

1. If the mark has been entered in the Trade-Marks Register in his name for the same or similar goods on the basis of a prior application, or in pursuance of the Trade-Marks Act of November 30th, 1874.

2. If the business to which the mark belongs is no longer carried on by the registered proprietor.

3. If there are any circumstances that show that the mark used is misleading and is calculated to deceive.

These provisions are valuable where the British owner of a trade-mark wishes to try to remove the registration and to prevent the use of his mark in Germany by some other person. It is only under the provisions of sect. 9 that he might possibly obtain redress.

Sect. 17 of the Law is important, and reads thus:—

"Foreign products which wrongfully bear the name and locality of a German firm, or which wrongfully bear a registered trade-mark, on entering Germany as imports or for transit through the country are liable to seizure and confiscation if the injured party fi! s a petition to that effect and gives security. The seizure is effected by the Custom House authorities, and the confiscation is decided according to the Penal Code (sect. 459 of Code)." Penalties for wrongfully using German trade-marks.

Actions in the Courts in trade-mark matters are provided for in sect. 21.

A most important provision is found in sect. 22; but the important rights conferred by it have not as yet been made use of by the Federal Council. It is as follows:— Powers of Federal Council as to compelling imported goods to bear a mark showing their origin.

"If German goods must bear a certain mark or sign on being imported into, or for transit through, a foreign country to show that they are of German origin, or if such goods are not so favourably treated at the Custom House in respect of trade-marks as the goods of other countries, then the Federal Council is empowered to subject goods imported into Germany from such other countries, or for transit through Germany, to the same obligations, and to order that, in the case of violation of this regulation, the goods shall be seized and confiscated. The seizure is effected by the Custom House authorities, and the confiscation will be decided by the verdict of the Department of Administration (sect. 459 of the Regulations of the Criminal Law)."

It is, therefore, to be noticed that the above regulation might be applied to British goods entering Germany whenever, in Great Britain, German goods imported there, or for transit merely, are obliged to bear a mark showing that they are of German origin, or whenever German imports do not, in the matter of trade-marks, receive most-favoured-nation treatment at the British Custom House. Liability of British imports to bear a mark showing their origin.

Definition of what may be registered as a trade-mark.

Any kind of sign can become a trade-mark, either on the article itself or on its covering when packed, if it affords a clear and distinguishing mark. Picture and figurative designs, as also "word marks" and fancy names, can be used as trade-marks; but they cannot consist of numerals, of letters, or of words which only give particulars of the time, place, or manner of production, or of words indicating considerations of quality, price, quantity, and weight, or words which refer to the nature of the goods. In the registration of "word marks" it is important to state in the application whether protection is wanted only for it as a design or for its sound, or for both; for the Trade-Marks Office, in its examination, investigates this point.

As to use of coats-of-arms.

The use of German or foreign State coats-of-arms, as well as of the arms of German municipalities or corporations, in order to unduly enhance the market value of goods, is forbidden under a penalty of a fine of 250*l.*, or by imprisonment not exceeding six months (sect. 16 of Law).

Definition of "freemarks."

The Trade-Mark Office in Berlin publishes a list of so called "Free Marks" ("Freizeichen"). Those consist of marks that are generally used by the public to indicate certain trades, such as crossed hammers for the coal trade, and an anchor for some marine trades, which cannot be acquired by anyone as a private trade-mark. Additions are often made to this list, and applications for the registration of trade-marks are refused if it is found that the mark applied for resembles too closely a listed "Free Mark."

German colonies and protectorates.

The German Trade-Marks Law was also put into force for the German Colonies and Protectorates on October 1, 1894.

Special agreements.

Special agreements, dealing with trade-marks, &c., exist with Austria-Hungary (December 6, 1891), with Italy (January 18, 1892), with Switzerland (April 13, 1892), and with Servia (August 21, 1892).

Trade-mark relations between the United Kingdom and Germany.

The relations, in trade-mark matters, between the United Kingdom and the German Empire were formerly governed by Art. VI. of the Treaty of Commerce of May 30, 1865 (extended to the whole German Empire by the Declaration of April 14, 1875), which expired on July 30, 1898. Since that date our rights in Germany with regard to trade-marks are regulated by the German law.

Protection of German trade-marks in China.

The German Government has concluded agreements with France in 1898, with Holland in 1899, and with Belgium also during the present year regarding the protection of German trade-marks in China. Under these several agreements German Consular officers in China will take legal proceedings against any German subjects residing in China who may imitate French, Dutch, or Belgian trade-marks registered in the German Empire. The representatives of the French, Dutch, and Belgian Governments in China are likewise bound to act similarly in the case of French, Dutch, and Belgian subjects.

Italy.

No change has taken place in internal Italian legislation with regard to trade-marks since the report presented to Parliament in 1879.

Legislative effect has, however, been given with regard to foreign trade-marks to the requirements of the Paris Convention of 1883, and the similar requirements of the Italo-German Convention of 1892. These modifications in the existing Law only affect the period of delay conceded to the proprietors of foreign trade-marks during which the priority of a trade-mark registered abroad may be made valid in Italy. Special regulations issued in 1898 determine the formalities necessary to obtain the notification on the certificate of registration of the right of priority of a trade-mark claimed under the above-mentioned Conventions.

Further, a Law of November 19th, 1894, puts in force the provisions of the Madrid Convention of 1891 for the international registration of trade-marks, and affords protection in this country, without the fulfilment of the formalities required by the Law of Italy, to trade-marks registered in the countries adhering to the Union, and fulfilling the conditions contemplated by that instrument.

Japan.

The present Japanese Law relating to trade-marks is one of a series of Laws which came into force on July 1st, 1899.

According to this Law, which has superseded the Trade-Mark Regulations contained in the Imperial Ordinance No. 86 of 1888, the protection of property in trade-marks in Japan depends upon registration, but trade-marks which were actually in use before July 1st last would appear to be protected by sub-heading 5 of Article II., unless their registration has meanwhile been obtained by other persons and three years have been allowed to elapse without protest.

The course to be pursued by owners of foreign trade-marks to obtain registration in Japan is laid down in the Law and in the "Detailed Regulations for carrying out the Trade-Marks Law" of July 20th, 1899.

The reference in Article XX. to Articles VI. to X. of the Japanese Patent Law is important, as it makes it obligatory on persons not resident in Japan to appoint a duly qualified agent through whom the application for registration of a trade-mark should be made. The registration may be cancelled if the owner of a trade-mark fails to appoint an agent within six months (Article XI., 2).

In the case of British subjects previous registration of their trade-marks in the United Kingdom does not appear to be necessary, but if it has taken place certified copies of the original certificate of registration and specifications must accompany the application for registration in Japan (Detailed Regulations, Article II.). Article IX. of the Law also gives priority to a

trade-mark registered in a country belonging to the Union for the Protection of Industrial Property, provided that application for its registration in Japan is made within four months.

No limit of time is stated within which persons who have used trade-marks before registration are obliged to register them. Penalties, however, are imposed by Article XVII. on persons who use a trade-mark "to which a deceptive mark, which suggests that it has been registered, is applied."

In order to obtain redress in the event of the infringement of trade-marks which have been registered in Japan, proceedings must be instituted by the injured party either by an application to the Patent Bureau for a trial of the case, or by a criminal action for an infraction of Article XVI. of the present Law.

All documents relating to an application for the registration of a trade-mark, or any other matter connected therewith, must be in Japanese, and all copies of foreign documents must be accompanied by a Japanese translation.

The fee for registration is 3*l.* 2*s.* 6*d.* (30 yen) for each trade-mark and each class of goods for which it is used. The application for registration must bear revenue stamps to the amount of 6*s.* 3*d.* (3 yen). Further payments in connection with trade-marks are enumerated in the list of fees contained in the Imperial Ordinance No. 195.

Mexico.

Art. I. Any sign which may determine the special character of an industrial product for commercial purposes will be considered as a trade-mark.

Art. II. The protection which the present law grants to trade-marks does not protect, for the purposes therein specified, any but the goods manufactured or sold in the country.

Art. III. The form, colour, words, or designs which do not in themselves constitute a specific sign of the speciality of the product will not be considered as trade-marks. In no case shall this sign be of an immoral character.

Art. IV. Any proprietor of a trade-mark, whether Mexican or foreigner, residing in the country may acquire the exclusive right to use it in the Republic, always subject to the requirements of the present law.

The Mexicans and foreigners who reside outside of the country will be allowed to register the trade-marks belonging to them, when they have an industrial or mercantile establishment or agency within its boundaries, for the purpose of selling their products, always excepting any stipulation to the contrary contained in treaties that refer to foreigners.

Art. V. In order to acquire the exclusive ownership of a trade-mark the interested party will apply, either himself or through his representative, to the Department of Fomento,

stating that he reserves his rights, and transmitting the following documents:—

1. The power of attorney executed by the interested party unless he presents it in person.

2. Two copies of the trade-mark or a representation thereof in drawing or engraving.

3. Should the trade-mark be in bas-relief or raised on the goods, or should it present any other speciality, two separate leaves will also be presented showing those peculiarities, either by means of one or more figures in detail, or by means of an explanatory statement.

4. The written contract of commission, duly attested, by virtue of which an agency has been established, in the case referred to in the second part of the preceding article.

ART. VI. The petition must set forth the name of the factory, its situation, the residence of the proprietor, and the character of the trade or industry in which the petitioner desires to utilise the trade-mark.

ART. VII. No trade-mark belonging to a foreigner who is not a resident of the Republic can be registered therein unless it has been previously registered in the country of its origin in due legal form.

ART. VIII. The first person who may legally make use of the trade-mark is the only one who will be allowed to acquire its ownership. In case of any dispute arising between two claimants to the mark, the ownership will be conceded to the first possessor, or, should it be impossible to prove this, to the first petitioner.

ART. IX. The exclusive ownership of a trade-mark cannot be exercised except by virtue of a declaration from the Department of Fomento that the interested party has reserved his rights after having fulfilled all the legal requirements.

ART. X. The declaration referred to in the preceding article will be made without any previous examination, under the exclusive responsibility of the petitioner, and without prejudice to the rights of any third party.

The Department of Fomento will have the petition of the interested party published, and in case of any opposition presented within the ninety days following such publication the trade-mark will not be registered until the judicial authorities decide in whose favour it is to be registered.

ART. XI. The trade-marks can only be transferred together with the establishments for whose manufacture or trade they are to be employed for purposes of distinction; but the transfer shall not be subject to any special formality, and will remain in accordance with the provisions of common law.

ART. XII. The duration of the ownership over trade-marks is indefinite, but it will be considered abandoned through the closing of the establishment or factory which has used it, or the non-production for one year.

ART. XIII. The trade-marks which are deposited will be preserved in the Department of Fomento, where every person so desiring will be allowed to examine the register during the hours fixed for that purpose by that Department, and certified copies of the registry will be issued at the expense of the person who may require them.

ART. XIV. The ownership of any trade-mark which may have been obtained in contravention of the preceding provisions will be judicially declared null and void on *ex parte* petition.

ART. XV. The judge who may have had the matter before him will duly notify the Department of Fomento of any final sentence under which the ownership of a trade-mark is declared null and void.

NETHERLANDS.

Since the publication by the Foreign Office in 1879 of "Reports relative to Legislation in Foreign Countries on the subject of Trade-Marks" a completely new Law has been passed on the subject in the Netherlands, distinct from the draft bill which appeared in the above-mentioned Blue-Book.

The Law now in force on the subject for the Netherlands is dated September 30, 1893.

For the colonial possessions of the Netherlands three other Laws on trade-marks exist, all dated November 9, 1893—*i.e.*, for the Netherlands East Indies in twenty-six articles, and for Surinam and Curaçao in twenty-five articles each. All three are practically identical, with the exception of that regulating trade-marks in the Netherlands Indies, which has one additional article. It has, therefore, merely been necessary to have one of these Laws translated for the purposes of this report; for, if Article XII. of the Law for the Netherlands Indies be omitted, the rest of that Law and the twenty-five articles of the other two are the same; they are, therefore, applicable, not only to the Netherlands East Indies, but also to Surinam and Curaçao.

The Trade-Marks Law of September 30, 1893, for the Netherlands came into force on December 1, 1893, and it completely superseded the former Law of May 25, 1880, and the subsequent amendments of the Law of July 22, 1885. The three Laws for the various colonies came into force on January 1, 1884.

Trade-marks in the Netherlands are now entirely controlled by the Industrial Property Office at The Hague, which was established there on December 1, 1893, from which date applications for the registration of trade-marks had to be directed to that office instead of to the registrars of the local Courts as had previously been the case.

The Netherlands (including Dutch colonies) have joined the International Convention for the Protection of Industrial Property, concluded at Paris on March 20, 1883, which was approved by the Law of April 23, 1884. Trade-marks can, therefore, obtain in the Netherlands international registration (including Dutch colonies). There are thus two distinct forms of registration possible at The Hague Bureau :—

(*a*) Merely for the Netherlands.
(*b*) For international registration—*i.e.*, for Holland, France, Spain, Portugal, Switzerland, Belgium, Italy, Brazil, and Tunis, as well as for the colonies of the first four countries, and in Netherlands India, Surinam, and Curaçao.

The regulations to be followed to secure this international registration are to be found in Part B of "The Regulations for Registration," issued by the Industrial Property Office at The Hague. Part A of those regulations contain the rules for registration in Holland only. In the first case, the fee is about 4*l* 11*s*. 8*d*.; in the second case, 16*s*. 8*d*.

With regard to the course of procedure to be followed by owners of British trade-marks to obtain protection for their marks, it is to be observed that no difference whatever is made between natives and foreigners in such applications; but the foreigner must choose a "domicile" in order to be able to follow the ordinary procedure for the registration of a trade-mark. The Industrial Property Office at The Hague states that this merely means a "trade domicile," which is constituted by merely giving an address in Holland, such as a lawyer's address, or the name of an hotel at which the applicant for a trade-mark might be residing. The actual steps to be taken by a British applicant, either for registration in Holland only or for international registration, are to be found in "The Regulations for Registration."

The previous registration of British trade-marks in the United Kingdom is not required. In applications for international registration, sect. 3 of Article III. of "The Law on Trade-Marks for the Netherlands" says:—

"The person who, within the period fixed by Article IV. of the International Convention of Paris has sent in a mark to the Office for Industrial Property, which, with due observance of Article VI. of the said Convention, he has deposited according to the regulations of one of the States that is a party to that Convention, shall be considered to have already made use of the mark in the Netherlands."

A similar provision is found in the Laws on trade-marks for the Dutch colonies.

There is no limit of time within which persons who have used trade-marks before registration in the Netherlands are obliged to register their trade-marks in order to secure the benefit of the Dutch Laws on trade-marks.

The steps to be taken by the owners of trade-marks used in

the Netherlands, to obtain redress in the event of infringement, are the following:—

(*a*) By a prosecution, founded upon Article 337 of the Penal Law. This is effected by denouncing (to the justice of the local Court of the place of the occurrence) the infringement.

(*b*) By means of a civil law suit, founded upon—

1. Article X. of the Dutch Law on Trade-Marks. This is effected by petitioning the Court of Justice at The Hague to cancel the registration of a trade-mark which is similar or nearly similar to a mark which has already been made use of by some other person for the same kind of merchandise.

2. Article 1,401 of the Dutch Civil Law, in order to obtain indemnification.

The consequence of neglect on the part of British subjects to observe the regulations as to trade-marks entails possible adoption of those marks by Dutchmen or by other foreigners. It is most advisable to register marks, which are then protected by the Office for Industrial Property, which will prevent similar or nearly similar marks from being registered.

With regard to fees, there is only the one payment of 10fl. (16*s.* 8*d.*) for registration ("Dépôt-Taxe"); and no fees have to be paid subsequently for final registration nor for the renewal of registration in the Netherlands (see Article XIX. of Law on Trade-Marks for the Netherlands). There are, however, some small expenses in addition, for the law as to stamping has to be complied with, under which the stamp dues depend on the size of the paper used. And there is also a fixed duty of 1·10fl. (about 1*s.* 10*d.*) to be paid under the Law on Registration.

Russia.

The question of trade-marks in Russia is regulated by the Law of February 26th (March 9th), 1896, and the following are its main provisions:—

Trade-marks may be adopted and used by all persons engaged in trade and manufacturing industries; such adoption, however, is not compulsory.

No trade-marks may be used with designs and inscriptions contrary to public morality, nor such as may fraudulently mislead and deceive a purchaser; also are prohibited trade-marks showing medals, &c. of distinction on which the year of award is not indicated. Marks exhibiting such honorary awards may, moreover, be exhibited only on goods and articles of the class for which the award was made.

The exclusive use of a trade-mark is secured by application to the Department of Trade and Manufactures, which, on approval of the mark, issues a certificate of registration.

Application for more than one trade-mark can be made by a single applicant for distinguishing goods differing in kind and variety.

Exclusive right to a trade-mark cannot be secured if it does

not differ distinctly from one already registered in the name of another person for goods of a kindred nature.

The registration of trade-marks may be effected, according to the desire of applicants, for terms ranging from one to ten years. On the expiration of the term of registration the same may be renewed for a further period.

A trade-mark registered in any one colour and in one size may be used in other colours and sizes.

A trade-mark is registered in the name of the first person applying for its registration.

The registration of a trade-mark does not deprive any other person of the right during three years after such registration of contesting at law the validity of the same.

The transfer of a trade-mark to another person or firm is allowed under certain conditions, and subject to the sanction of the Department of Trade and Manufactures.

The exclusive right of using a particular trade-mark ceases at the request of the person to whom such right was granted, or on the close of the manufacturing or other business in which it was used. It also lapses on the non-renewal of the registration or non-notification to the Department of Trade and Manufactures of the transfer of a business, &c., within six months of such transfer; moreover, the exclusive right of using a trade-mark expires when a Court of law shall declare such right to be non-existent.

The fee payable to the Government for registering or renewing a trade-mark is 3 roubles for the first year of duration of the certificate of registration, and 1 rouble for each succeeding year.

All applications for the registration of a trade-mark must have affixed on each sheet of the same a Russian revenue stamp of the value of 80 copecks.

Fraudulent use and counterfeit of trade-marks are punishable by imprisonment from four to eight months.

A dealer found in possession of goods bearing fraudulent trade-marks is liable to the same punishment.

Persons selling or found in possession of goods bearing prohibited trade-marks are liable to a fine not exceeding 100 roubles for the first offence, and for the second and succeeding offences in a sum not exceeding 200 roubles on each occasion.

Sweden and Norway.

With the exception of stamps set on iron goods, no legislation existed in Sweden until the year 1885 protecting trade-marks, other than the very incomplete regulations which were to be found in the general Penal Law. The affixing of stamps on iron and steel goods has, on the other hand, been from time immemorial and continues to be obligatory in Sweden on the Swedish manufacturers. Up to the year 1885 the control and registration of the iron stamps belonged to the Director-General

of the Mining Department, now the Commercial Department of the Royal Board of Trade.

In the year 1877 a committee sat for the purpose of drawing up a bill regarding patents and protection for patterns and models as well as trade-marks. The proposals made by this committee led, however, as far as concerned the protection of trade-marks, to no result.

In the year 1881, however, committees met simultaneously in Sweden, Norway, and Denmark with the object, among others, of drawing up a bill concerning the protection of trade-marks as nearly as possible in the same form for the three countries.

When these committees met together for united work in 1882, they laid on the table bills respecting the protection of trade-marks which were in all essentials similar. After some slight amendments the Swedish bill was passed in the 1884 session of the Riksdag, and the Law on the protection of trade-marks now in force was promulgated on July 5th of the same year and came into force on January 1st, 1885.

The provisions of this Law have since been modified, partly by a Law of March 5th, 1897, which provided protection to certain so-called "word-marks," and partly by Decrees which were issued later.

The Decrees which are at present in force are (1) the Royal Proclamation of December 31st, 1895, relating to the character of the documents which are to be presented on the registration of trade-marks; (2) the Royal Proclamation of June 25th, 1897, relating to a change in the wording of paragraph 2 of the above-mentioned Royal Proclamation; and (3) the Royal Proclamation of November 18th, 1898, relating to the register of trade-marks.

Paragraph 3 of the Law on trade-marks relates to the formalities required for registration and the costs attached thereto. It runs as follows:—

Anyone who wishes to have a trade-mark registered shall hand into the registration authority, or send in a prepaid letter, a written application containing a clear description of the mark and a full statement of the name, business, and postal address of the applicant or firm, and also in cases where the right to the trade-mark embraces only certain kinds of wares, a statement of these kinds. The application must be accompanied by (1) a drawing upon good stout paper of the mark, in triplicate, not more than 10 centims. long and 15 centims. broad; (2) two stamps such as are used in printing the mark (*clichés*), of the same size as the drawing; (3) a fee of 40 kroner for registration and publication.

There are no fixed forms of publication, but more detailed information as to what the application should contain will be found in the above-mentioned Royal Proclamation of June 25th, 1897.

Beyond the above-mentioned fee of 40 kroner, the applicant has nothing more to pay for registration. The protection of a

registered trade-mark ceases, however, when an application for its renewal is not made, the first time, within ten years of the day of registration, and subsequently, within ten years from the previous day of renewal. A person wishing to renew his registration must hand or send in (in the way stated in paragraph 3 of the Law on trade-marks) a written application to that effect, accompanied by one copy of such drawing as is there prescribed, and also a registration fee of 10 kroner.

To insure mutual protection of trade-marks between Sweden and foreign States, the King has come to an understanding with certain States, and also, by an Act of Adhesion on behalf of Sweden on June 26th, 1885, has become a party to the Convention for the International Protection of Industrial Property, concluded at Paris on March 20th, 1883. His Majesty, by a Royal Proclamation of June 26th, 1885, in regard to States belonging to the Union founded through the above-mentioned convention, has also decreed, among other things, that protection of trade-marks, according to the Law of July 5th, 1884, belongs to those persons who, in a foreign State forming one of the Union, carry on manufactures or trades, agricultural, mining, or other business; and also to those who are the subjects of such a State, or have a fixed residence there but carry on their business in another State.

Besides the documents which, as above stated, must accompany an application for registration, such applications from foreigners must also be accompanied by an attestation, consisting of an extract from the proper register of trade-marks, that the applicant has fulfilled the conditions which in the foreign State are required in order to insure protection of the trade-mark.

Switzerland.

The Law of December 19th, 1879, respecting the registration and protection of trade-marks, was superseded by that of September 26th, 1890.

The formalities required by the latter for the registration of a trade-mark are the following:—

An application must be made to the Bureau Fédéral de la Propriété Intellectuelle in French, German, or Italian, in the prescribed form, in duplicate, with a designation of the goods for which it is to be used.

Further, an exact reproduction, in duplicate, of the trade-mark, with the date of deposit, signed by the owner, or his representative, must be sent in, together with a stereotype of the same.

In the case of firms or individuals whose industry is carried on in Switzerland, an official attestation is required as regards their entry in the commercial register, or, in default of such entry, respecting the domicile of the depositor.

In the case of firms or individuals established in other countries

which accord reciprocity of treatment, an official attestation certifying the registration of the trade-mark in question in the country of origin is required.

The right of the depositor to any honorary distinctions mentioned on the trade-mark must be duly established, and it must be shown that a power of attorney has been conferred on the representative who acts for the owner if the latter does not appear personally in the business.

All papers in connection with the application for registration must be in the same language, or a translation furnished at the same time.

The fee for registration is 20 fr. At the expiration of twenty years it is necessary to renew the registration within six months for a fresh term of twenty years, the registration fee being, as before, 20 fr.

A trade-mark which is not made use of during three consecutive years is regarded as having lapsed.

In the case of refusal on the part of the Bureau Fédéral to register the trade-mark, appeal can be made to the competent department; if the decision of the former is upheld, final appeal can be made to the Conseil Fédéral.

A registered trade-mark can only be transferred with the industry the products of which it served to identify. Such transfer is subject to a fee of 20 fr., in addition to the same formalities as were required for the original registration, and is valid for a period of twenty years.

Any change or modification in the designation of the firm must be duly registered, the registration being gratuitous when such modification does not consist of a change of partners, or involve an alteration in the trade-mark. If, on the other hand, the change or modification affects the trade-mark, a tax of 10 fr. is levied, the publication of the trade-mark, as modified, being necessary.

An extension of the use of a registered trade-mark beyond the original limits specified at the time of registration involves formalities identical with those previously required, the fee for such extension being 20 fr., and a fresh period of twenty years commencing from that date.

A restriction, on the other hand, as regards its employment may be simply notified by letter, no tax attaching to such notification.

The cancelling of a registered trade-mark can take place—

By a written renunciation of the same from the owner.

On the expiration of the period of twenty years for which protection was originally granted, if a renewal of the term has not been formally made.

By decision of the competent Federal Department: or, in virtue of a legal sentence justifying the demand for such a step.

The owners of trade-marks applied to products at an exhibition from countries which have no convention with Switzerland

on the subject can enjoy temporary protection for a period not exceeding two years, on the payment of a fee of 10 fr. for registration.

Their application must be accompanied by a stereotype of the trade-mark.

The United States.

Rules governing the Registration of Trade-marks under the Act of March 3rd, 1881.

Who may Register a Trade-mark.

17. A trade-mark may be registered by any person, firm, or corporation domiciled in the United States or located in any foreign country which, by Treaty, Convention, or Law, affords similar privileges to citizens of the United States, and who is entitled to the exclusive use of any trade-mark and uses the same in commerce with foreign nations or with Indian tribes.

Also, by any citizen or resident of this country wishing the protection of his trade-mark in any foreign country the laws of which require registration in the United States as a condition precedent upon the payment of the fee required by law and other due proceedings had.

18. Owners of trade-marks for which protection has been sought by registering them in the Patent Office under the Act of the 8th July, 1870 (declared unconstitutional by the Supreme Court of the United States, 16 O.G., 999), may register the same for the same goods, without fee. With each application of this character a specific reference to the date and number of the former certificate is required.

19. Applicants whose cases were filed under the Act of 1870, either prior to or since the decision of the Supreme Court declaring it unconstitutional, which are now pending before the office, must prepare their applications in conformity with the present Law and Rules. On the receipt of such an application, referring to the date of the one formerly filed, all fees paid thereon will be duly applied. Those who have paid only 10 dollars as a first fee are advised that the Law does not provide for a division of the legal fee of 25 dollars, and that the remainder of the entire fee is required before the application can be examined.

20. No trade-mark will be registered unless it shall be made to appear that the same is used as such by the applicant in commerce between the United States and some foreign nation or Indian tribe, or is within the provisions of a Treaty, Convention, or Declaration with a foreign Power, or which is merely the name of the applicant, or which is identical with a known or registered trade-mark owned by another and appropriated to the same class of merchandise, or which so nearly resembles some other person's lawful trade-mark as to be likely to cause confusion in the mind of the public or to deceive purchasers, or which is merely descriptive in its nature.

The Application.

21. An application for the registration of a trade-mark must be made to the Commissioner of Patents, and must be signed by the owner of the trade-mark.

22. A complete application comprises—

(a) A brief letter of advice requesting registration, signed by the applicant.

(b) A statement or specification which, in addition to the requirements of sect. 1 of the Statute, must also discriminate between the essential and non-essential features of the trade-mark, and if the applicant be a corporation it must set forth under the laws of what State or nation incorporated.

(c) A declaration or oath complying with sect. 2 of the Statute.

(d) A fac-simile or drawing of the mark.

(e) A fee of 25 dollars.

23. The letter of advice, the statement, and the declaration must be in the English language, and written on one side of the paper only.

24. Pending applications are preserved in secrecy, and no information will be given without authority of the applicant respecting the filing of an application for the registration of a trade-mark by any person, or the subject-matter thereof, unless it shall, in the opinion of the Commissioner, be necessary to the proper conduct of business before the office.

Declaration or Oath.

25. The declaration or oath may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any Minister, Chargé d'Affaires, Consul, or Commercial Agent holding commission under the Government of the United States, or before any notary public of the foreign country in which the applicant may be, who is authorized by the laws of said country to administer oaths, the oath being attested in all cases, in this and other countries, by the proper official seal of the officer before whom the oath or affirmation is made. When the person before whom the oath or affirmation is made is not provided with a seal, his official character shall be established by competent evidence, as by a certificate from a clerk of a Court of Record or other proper officer having a seal.

26. The declaration cannot be amended. If that filed with the application is faulty or defective, a substitute declaration must be filed.

Fac-simile or Drawing.

27. If for any reason a drawing does not constitute a satisfactory fac-simile of the trade-mark, two copies of the trade-

mark as actually used must be deposited in addition to the required drawing, to be preserved in the office for reference.

28.—(1.) The drawing must be made upon pure white paper of a thickness corresponding to three-sheet Bristol board. The surface of the paper must be calendered and smooth. India ink alone must be used, to secure perfectly black and solid lines.

(2.) The size of a sheet on which a drawing is made must be exactly 10 by 15 inches. One inch from its edges a single marginal line is to be drawn, leaving the "sight" precisely 8 by 13 inches. Within this margin all work and signatures must be included. One of the shorter sides of the sheet is regarded as its top, and, measuring downwardly from the marginal line, a space of not less than 1¼ inches is to be left blank for the heading of title, name, number, and date.

(3.) All drawings must be made with the pen only. Every line and letter, signatures included, must be absolutely black. This direction applies to all lines, however fine, and to shading. All lines must be clean, sharp, and solid, and they must not be too fine or crowded. Surface shading, when used, should be open.

(4.) The signature of the proprietor of the trade-mark must be placed at the lower right-hand corner of the sheet and the signatures of the witnesses at the lower left-hand corner, all within the marginal line, but in no instance should they encroach upon the drawing.

(5.) When the view is longer than the width of the sheet, the sheet should be turned on its side, and the heading will be placed at the right and the signatures at the left, occupying the same space and position as in an upright view, and being horizontal when the sheet is held in an upright position.

(6.) Drawings should be rolled for transmission to the office—not folded.

An agent's or attorney's stamp, or advertisement, or written address will not be permitted upon the face of a drawing, within or without the marginal line.

29. The office, at the request of applicants, will furnish the drawings at cost.

Examination of Applications.

30. All applications for registration are considered in the first instance by the trade-mark examiner. Whenever on examination of an application registration is refused for any reason whatever, the applicant will be notified thereof. The reasons for such rejection will be stated, and such information and references will be given as may be useful in aiding the applicant to judge of the propriety of prosecuting his application.

31. The examination of an application and the action thereon will be directed throughout to the merits; but in each letter the examiner shall state or refer to all his objections.

Amendments.

32. The statement may be amended to correct informalities or to avoid objections made by the office, or for other reasons arising in the course of examination; but no amendments will be admitted unless warranted by something in the statement or fac-simile as originally filed.

33. In every amendment the exact word or words to be stricken out or inserted in the statement must be specified, and the precise point indicated where the erasure or insertion is to be made. All such amendments must be on sheets of paper separate from the papers previously filed, and written on but one side of the paper.

Erasures, additions, insertions, or mutilations of the papers and records must not be made by the applicant.

34. When an amendatory clause is amended, it must be wholly re-written, so that no interlineation or erasure shall appear in the clause, as finally amended, when the application is passed to issue. If the number or nature of the amendments shall render it otherwise difficult to consider the case, or to arrange the papers for printing or copying, the examiner may require the entire statement to be re-written.

35. Amendments will not be permitted after the notice of allowance of an application, and the examiner will exercise jurisdiction over such an application only by special authority from the Commissioner.

Amendments not affecting the merits may be made after the allowance of an application, if the case has not been printed, on the recommendation of the examiner, approved by the Commissioner, without withdrawing the case from issue.

36. After the completion of the application the office will not return the papers for any purpose whatever. If the applicant has not preserved copies of the papers which he wishes to amend, the office will furnish them on the usual terms.

Interferences.

37. In case of conflicting applications for registration, or in any dispute as to the right to use which may arise between an applicant and a prior registrant, the office will declare an interference, in order that the parties may have an opportunity to prove priority of use, and the proceedings on such interference will follow, as nearly as practicable, the practice in interferences upon applications for patents.

Appeals or Petitions.

38. From an adverse decision of the examiner of trade-marks upon an applicant's right to register a trade-mark, or upon any interlocutory matter, or from a decision of the examiner of interferences, the case will be reviewed by the Commissioner, on petition or appeal, without fee.

Issue, Date, and Duration of Certificate.

39. When the requirements of the Law and the Rules have been complied with, and the office has adjudged a trade-mark lawfully registrable, a certificate will be issued by the Commissioner, under seal of the Interior Department, to the effect that applicant has complied with the Law, and that he is entitled to the protection of his trade-mark in such case made and provided. Attached to the certificate will be a fac-simile of the trade-mark and a printed copy of the statement and declaration.

40. Before a trade-mark certificate will be delivered, the applicant must furnish a revenue stamp to the value of 10 cents, to be affixed thereto and cancelled as required by the "Act to provide Ways and Means to meet War Expenditures, and for other purposes," approved on the 13th June, 1898.

41. The weekly issue closes on Thursday, and the certificates of registration of that issue bear date as of the third Tuesday thereafter.

42. A certificate of registry shall remain in force for thirty years from its date, except in cases where the trade-mark is claimed for and applied to articles not manufactured in this country, and in which it receives protection under the Laws of a foreign country for a shorter period, in which case it shall cease to have any force in this country by virtue of this Act at the time that such trade-mark ceases to be exclusive property elsewhere.

At any time during the six months prior to the expiration of the term of thirty years such registration may be renewed on the same terms and for a like period.

Assignments.

43. The right to the use of any trade-mark is assignable by an instrument in writing, and provision is made for recording such instrument in the Patent Office. But no such instrument or conveyance will be recorded unless it is in the English language, and unless an application for the registration of a trade-mark shall have first been filed in the Patent Office, and such instrument must identify the application by serial number and date of filing, or, where the mark has been registered, by its certificate number and the date thereof. No particular form of instrument is prescribed.

Copies and Publications.

44. After a trade-mark has been registered, printed copies of the statement and declaration in each case, with a fac-simile of the trade-mark, can be furnished by the office upon the payment of the fee.

45. An order for a copy of an assignment must give the liber and page of the record, as well as the name of the proprietor;

otherwise an extra charge will be made for the time consumed in making any search for such assignment.

46. The "Official Gazette" of the Patent Office will contain a list of all trade-marks registered, with the name and address of the registrant in each case, an illustration of the trade-mark, a brief statement of its essential features, and the particular description of goods to which it is applied.

Fees.

	Dol.	c.
47. On filing an application for registration of a trade-mark	25	00
For abstracts of title—		
For the certificate of search	1	00
For each brief from the digests of assignments	0	20
For copies of matter in any foreign language, for every 100 words or fraction thereof	0	10
For translation, for every 100 words or fraction thereof	0	50
For recording every assignment, agreement, power of attorney, or other paper, of 300 words or less	1	00
For recording every assignment, agreement, power of attorney, or other paper, of more than 300 words and less than 1,000 words	2	00
For recording every assignment, agreement, power of attorney, or other paper, of more than 1,000 words	3	00
For assistance to attorneys and others in the examination of records, one hour or less	0	50
Each additional hour or fraction thereof	0	50
For single printed copy of statement, declaration, and *fac*-simile	0	05
If certified, for the certificate, additional	0	25

48. The person ordering any such certificate as specified in Rule 47 must furnish a revenue stamp to the value of 10 cents, to be affixed to the certificate and cancelled as provided for by the "Act to provide Ways and Means to meet War Expenditures, and for other purposes," approved on the 13th June, 1898.

49. Money required for office fees may be paid to the Commissioner, or to the Treasurer, or any of the Assistant Treasurers of the United States, or to any of the depositaries, national banks, or receivers of public money designated by the Secretary of the Treasury for that purpose, who shall give the depositor a receipt or certificate of deposit therefor, which shall be transmitted to the Patent Office. When this cannot be done without inconvenience, the money may be remitted by mail, and in every such case the letter should state the exact amount inclosed. All money orders should be made payable to the "Commissioner of Patents."

50. All money sent by mail, either to or from the Patent Office, will be at the risk of the sender. All payments to the office must be made in specie, Treasury notes, national bank notes, certificates of deposit, post office money orders, postal notes, or certified cheques.

Repayment of Money.

51. Money paid by actual mistake, such as a payment in excess, or when not required by Law, or by neglect or misinformation on the part of the office, will be refunded; but a mere change of purpose after the payment of money, as when a party desires to withdraw his application for the registration of a trade-mark, will not entitle a party to demand such a return.

2. Colonial Laws.

It has not been thought necessary to increase the size of the book by a summary of the provisions of the trade-marks laws of the colonies, as these follow very closely the lines of Imperial legislation on the subject. The Hong Kong Ordinance of 1898 (No. 14 of 1898) is a recent and typical instance (*a*).

(*a*) See p. 850, as to Merchandise Marks.

No. 14.

TREATY WITH THE UNITED STATES.

The Government of Her Majesty the Queen of the United Kingdom of Great Britain and Ireland, and the Government of the United States of America, with a view to the reciprocal protection of the marks of manufacture and trade in the two countries, have agreed as follows:—

The subjects and citizens of each of the Contracting Parties shall have, in the dominions and possessions of the other, the same rights as belong to native subjects or citizens, or as are now granted or may hereafter be granted to the subjects and citizens of the most favoured nation in everything relating to property in trade-marks and trade-labels.

It is understood that any person who desires to obtain the aforesaid protection must fulfil the formalities required by the laws of the respective countries.

In witness whereof the undersigned have signed the present declaration, and have affixed thereto the seal of their arms.

Done at London, the 24th day of October, 1877.

DERBY.
EDWARD PIERREPONT.

No. 15.

MERCHANDISE MARKS ACT, 1887 (*a*).

(50 & 51 Vict. c. 28.)

ARRANGEMENT OF SECTIONS.

SECT.
1. Short title.
2. Offences as to trade-marks and trade descriptions.
3. Definitions.
4. Forging trade-mark.
5. Applying marks and descriptions.
6. Exemption of certain persons employed in ordinary course of business.
7. Application of Act to watches.
8. Mark on watch case.
9. Trade-mark, how described in pleading.
10. Rules as to evidence.
11. Punishment of accessories.
12. Search warrant.
13. Extension of 22 & 23 Vict. c. 17, to offences under this Act.
14. Costs of defence or prosecution.
15. Limitation of prosecution.
16. Prohibition on importation.
17. Implied warranty on sale of marked goods.
18. Provisions of Act as to false description not to apply in certain cases.
19. Savings.
20. False representation as to Royal Warrant.
21. Application of Act to Scotland.
22. Application of Act to Ireland.
23. Repeal of 25 & 26 Vict. c. 88.

An Act to consolidate and amend the Law relating to Fraudulent Marks on Merchandise. [23rd August, 1887.]

BE it enacted by the Queen's most excellent Majesty, by and with the advice and consent of the lords spiritual and temporal, and commons, in this present parliament assembled, and by the authority of the same, as follows:

1. This Act may be cited as the Merchandise Marks Act, 1887. Short title.

2.—(1.) Every person who— Offences as to trade-marks and trade descriptions.

(a) forges any trade-mark (pp. 560 to 566); or
(b) falsely applies to goods any trade-mark or any mark so nearly resembling a trade-mark as to be calculated to deceive (pp. 567 to 569); or

(*a*) See Book II., p. 554.

(c) makes any die, block, machine, or other instrument for the purpose of forging, or of being used for forging, a trade-mark (pp. 560 to 566); or

(d) applies any false trade description to goods (pp. 569 to 596); or

(e) disposes of or has in his possession any die, block, machine, or other instrument for the purpose of forging a trade-mark (pp. 560 to 566); or

(f) causes any of the things above in this section mentioned to be done (p. 596),

shall, subject to the provisions of this Act, and unless he proves that he acted without intent to defraud (pp. 601 to 604), be guilty of an offence against this Act.

(2.) Every person who sells, or exposes for, or has in his possession for, sale, or any purpose of trade or manufacture, any goods or things to which any forged trade-mark or false trade description is applied, or to which any trade-mark or mark so nearly resembling a trade-mark as to be calculated to deceive is falsely applied, as the case may be, shall, unless he 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;

be guilty of an offence against this Act (pp. 607 to 610).

(3.) Every person guilty of an offence against this Act shall be liable (p. 611)—

(i.) on conviction on indictment, to imprisonment, with or without hard labour, for a term not exceeding two years, or to fine, or to both imprisonment and fine; and

(ii.) on summary conviction to imprisonment, with or without hard labour, for a term not exceeding four months, or to a fine not exceeding twenty pounds, and in the case of a second or subsequent conviction to imprisonment, with or without hard labour, for a term not exceeding six months, or to a fine not exceeding fifty pounds; and

(iii.) in any case, to forfeit to her Majesty every chattel, article, instrument, or thing by means of or in relation to which the offence has been committed.

(4.) The Court before whom any person is convicted under this section may order any forfeited articles to be destroyed or otherwise disposed of as the Court thinks fit (p. 611).

(5.) If any person feels aggrieved by any conviction made by a court of summary jurisdiction, he may appeal therefrom to a court of quarter sessions (p. 617).

(6.) Any offence for which a person is under this Act liable to punishment on summary conviction may be prosecuted, and any articles liable to be forfeited under this Act by a court of summary jurisdiction may be forfeited, in manner provided by the Summary Jurisdiction Acts: Provided that a person charged with an offence under this section before a court of summary jurisdiction shall, on appearing before the court, and before the charge is gone into, be informed of his right to be tried on indictment, and if he requires be so tried accordingly (p. 612). 42 & 43 Vict. c. 49.

3.—(1.) For the purposes of this Act—

Definitions.

The expression "trade-mark" means a trade-mark registered in the Register of trade-marks kept under the Patents, Designs, and Trade-Marks Act, 1883, and includes any trade-mark which, either with or without registration, is protected by law in any British possession or foreign state to which the provisions of the one hundred and third section of the Patents, Designs, and Trade-Marks Act, 1883, are, under Order in Council, for the time being applicable (p. 560): 46 & 47 Vict. c. 57.

The expression "trade description" means any description, statement, or other indication, direct or indirect,

(a) as to the number, quantity, measure, gauge, or weight, of any goods, or

(b) as to the place or country in which any goods were made or produced, or

(c) as to the mode of manufacturing or producing any goods, or

(d) as to the material of which any goods are composed, or

(e) as to any goods being the subject of an existing patent, privilege, or copyright,

and the use of any figure, word, or mark which, according to the custom of the trade, is commonly taken to be an indication of any of the above matters, shall be deemed to be a trade description within the meaning of this Act (pp. 570 to 584):

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 (pp. 584 to 588):

The expression "goods" means anything which is the subject of trade, manufacture, or merchandise (p. 567):

The expressions "person," "manufacturer, dealer, or trader," and "proprietor" include any body of persons corporate or unincorporate (p. 558):

The expression "name" includes any abbreviation of a name (p. 592).

(2.) 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 (p. 588).

(3.) The provisions of this Act respecting the application of a false trade description to goods, or respecting goods to which a false trade description is applied, shall extend to the application to goods of any false name or initials of a person, and to goods with the false name or initials of a person applied, in like manner as if such name or initials were a trade description, and for the purpose of this enactment the expression false name or initials means as applied to any goods, any name or initials of a person which—

(a) are not a trade-mark, or part of a trade-mark, and
(b) are identical with, or a colourable imitation of the name or initials of a person carrying on business in connection with goods of the same description, and not having authorised the use of such name or initials, and
(c) are either those of a fictitious person or of some person not *bonâ fide* carrying on business in connection with such goods (pp. 590 to 594).

Forging trade-mark.

4. 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 (p. 563).

Applying marks and descriptions.

5.—(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 covering, 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 (p. 567).

(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 (p. 568).

(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 (p. 569).

Exemption of certain persons employed in ordinary course of business.

6. Where a defendant is charged with making any die, block, machine, or other instrument for the purpose of forging, or being used for forging, a trade-mark, or with falsely applying to goods any trade-mark or any mark so nearly resembling a trade-mark as to be calculated to deceive, or with applying to goods any false trade description, or causing any of the things in this section mentioned to be done, and proves—

(a) That in the ordinary course of his business he is employed on behalf of other persons, to make dies, blocks, machines, or other instruments for making, or being used in making, trade-marks, or as the case may be, to apply marks or descriptions to goods, and that in the case which is the subject of the charge he was so employed by some person resident in the United Kingdom, and was not interested in the goods by way of profit or commission dependent on the sale of such goods; and

(b) That he took reasonable precautions against committing the offence charged; and

(c) That 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

(d) That he gave to the prosecutor all the information in his power with respect to the persons on whose behalf the trade-mark, mark, or description was applied—

he shall be discharged from the prosecution, but shall be liable

to pay the costs incurred by the prosecutor, unless he has given due notice to him that he will rely on the above defence (pp. 597 to 600).

Application of Act to watches.

7. Where a watch case has thereon any words or marks which constitute, or are by common repute considered as constituting, a description of the country in which the watch was made, and the watch bears no description of the country where it was made, those words or marks shall *prima facie* be deemed to be a description of that country within the meaning of this Act, and the provisions of this Act with respect to goods to which a false trade description has been applied, and with respect to selling or exposing for, or having in possession for sale, or any purpose of trade or manufacture, goods with a false trade description, shall apply accordingly, and for the purposes of this section the expression "watch" means all that portion of a watch which is not the watch case (p. 620).

Mark on watch case.

8.—(1.) Every person who after the date fixed by Order in Council sends or brings a watch case, whether imported or not, to any assay office in the United Kingdom for the purpose of being assayed, stamped, or marked, shall make a declaration declaring in what country or place the case was made. If it appears by such declaration that the watch case was made in some country or place out of the United Kingdom, the assay office shall place on the case such a mark (differing from the mark placed by the office on a watch case made in the United Kingdom), and in such a mode as may be from time to time directed by Order in Council (pp. 622, 837).

(2.) The declaration may be made before an officer of an assay office, appointed in that behalf by the office (which officer is hereby authorized to administer such a declaration), or before a justice of the peace, or a commissioner having power to administer oaths in the Supreme Court of Judicature in England or Ireland, or in the Court of Session in Scotland, and shall be in such form as may be from time to time directed by Order in Council (p. 838).

(3.) Every person who makes a false declaration for the purposes of this section shall be liable, on conviction on indictment, to the penalties of perjury, and on summary conviction to a fine not exceeding twenty pounds for each offence (p. 640).

Trade-mark, how described in pleading.

9. In any indictment, pleading, proceeding, or document, in which any trade-mark or forged trade-mark is intended to be mentioned, it shall be sufficient, without further description and without any copy or fac-simile, to state that trade-mark or forged trade-mark to be a trade-mark or forged trade-mark (p. 563).

Rules as to evidence.

10. In any prosecution for an offence against this Act,—

(1.) A defendant, and his wife or her husband, as the case

may be, may, if the defendant thinks fit, be called as a witness, and, if called, shall be sworn and examined, and may be cross-examined and re-examined in like manner as any other witness (p. 605).

(2.) In the case of imported goods, evidence of the port of shipment shall be *prima facie* evidence of the place or country in which the goods were made or produced (p. 576).

Punishment of accessories.

11. Any person who, being within the United Kingdom, procures, counsels, aids, abets, or is accessory to the commission, without the United Kingdom, of any act which, if committed in the United Kingdom, would under this Act be a misdemeanour, shall be guilty of that misdemeanour as a principal, and be liable to be indicted, proceeded against, tried, and convicted in any county or place in the United Kingdom in which he may be, as if the misdemeanour had been there committed (p. 600).

Search warrant.

12.—(1.) Where, upon information of an offence against this Act, a justice has issued either a summons requiring the defendant charged by such information to appear to answer to the same, or a warrant for the arrest of such defendant, and either the said justice on or after issuing the summons or warrant, or any other justice, is satisfied by information on oath that there is reasonable cause to suspect that any goods or things by means of or in relation to which such offence has been committed are in any house or premises of the defendant, or otherwise in his possession or under his control in any place, such justice may issue a warrant under his hand by virtue of which it shall be lawful for any constable named or referred to in the warrant, to enter such house, premises, or place at any reasonable time by day, and to search there for and seize and take away those goods or things; and any goods or things seized under any such warrant shall be brought before a court of summary jurisdiction for the purpose of its being determined whether the same are or are not liable to forfeiture under this Act.

(2.) If the owner of any goods or things which, if the owner thereof had been convicted, would be liable to forfeiture under this Act, is unknown or cannot be found, an information or complaint may be laid for the purpose only of enforcing such forfeiture, and a court of summary jurisdiction may cause notice to be advertised stating that, unless cause is shown to the contrary at the time and place named in the notice, such goods or things will be forfeited, and at such time and place the Court, unless the owner or any person on his behalf, or other person interested in the goods or things, shows cause to the contrary, may order such goods or things or any of them to be forfeited.

(3.) Any goods or things forfeited under this section, or under any other provision of this Act, may be destroyed or otherwise

disposed of, in such manner as the Court by which the same are forfeited may direct, and the Court may, out of any proceeds which may be realized by the disposition of such goods (all trade-marks and trade descriptions being first obliterated), award to any innocent party any loss he may have innocently sustained in dealing with such goods (pp. 618 to 620).

Extension of 22 & 23 Vict. c. 17, to offences under this Act.

13. The Act of the session of the twenty-second and twenty-third years of the reign of her present Majesty, chapter seventeen, intituled, "An Act to prevent vexatious indictments for certain misdemeanours," shall apply to any offence punishable on indictment under this Act, in like manner as if such offence were one of the offences specified in section one of that Act, but this section shall not apply to Scotland (p. 615).

Costs of defence or prosecution.

14. On any prosecution under this Act the Court may order costs to be paid to the defendant by the prosecutor, or to the prosecutor by the defendant, having regard to the information given by and the conduct of the defendant and prosecutor respectively (p. 616).

Limitation of prosecution.

15. No prosecution for an offence against this Act shall be commenced after the expiration of three years next after the commission of the offence, or one year next after the first discovery thereof by the prosecutor, whichever expiration first happens (p. 615).

Prohibition on importation.

16. Whereas it is expedient to make further provision for prohibiting the importation of goods which, if sold, would be liable to forfeiture under this Act; be it therefore enacted as follows (pp. 624 to 638):

(1.) All such goods, and also all goods of foreign manufacture, bearing any name or trade-mark being or purporting to be the name or trade-mark of any manufacturer, dealer, or trader in the United Kingdom, unless such name or trade-mark is accompanied by a definite indication of the country in which the goods were made or produced, are hereby prohibited to be imported into the United Kingdom, and, subject to the provisions of this section, shall be included among goods prohibited to be imported as if they were specified in section forty-two of the Customs Consolidation Act, 1876 (pp. 627 *et seq.*).

39 & 40 Vict. c. 36.

(2.) Before detaining any such goods, or taking any further proceedings with a view to the forfeiture thereof under the law relating to the Customs, the Commissioners of Customs may require the regulations under this section, whether as to information, security, conditions, or other matters, to be complied with, and may satisfy themselves in accordance with those regulations that the goods are such as are prohibited by this section to be imported (p. 635).

(3.) The Commissioners of Customs may from time to time

make, revoke and vary, regulations, either general or special, respecting the detention and forfeiture of goods the importation of which is prohibited by this section, and the conditions, if any, to be fulfilled before such detention and forfeiture, and may by such regulations determine the information, notices, and security to be given, and the evidence requisite for any of the purposes of this section, and the mode of verification of such evidence (p. 635).

(4.) Where there is on any goods a name which is identical with or a colourable imitation of the name of a place in the United Kingdom, that name, unless accompanied by the name of the country in which such place is situate, shall be treated for the purposes of this section as if it were the name of a place in the United Kingdom (p. 578).

(5.) Such regulations may apply to all goods the importation of which is prohibited by this section, or different regulations may be made respecting different classes of such goods or of offences in relation to such goods.

(6.) The Commissioners of Customs, in making and in administering the regulations, and generally in the administration of this section, whether in the exercise of any discretion or opinion, or otherwise, shall act under the control of the Commissioners of her Majesty's Treasury.

(7.) The regulations may provide for the informant reimbursing the Commissioners of Customs all expenses and damages incurred in respect of any detention made on his information, and of any proceedings consequent on such detention.

(8.) All regulations under this section shall be published in the "London Gazette" and in the "Board of Trade Journal."

(9.) This section shall have effect as if it were part of the Customs Consolidation Act, 1876, and shall accordingly apply to the Isle of Man as if it were part of the United Kingdom.

(10.) Section two of the Revenue Act, 1883, shall be repealed as from a day fixed by regulations under this section, not being later than the first day of January one thousand eight hundred and eighty-eight, without prejudice to anything done or suffered thereunder. 46 & 47 Vict. c. 55.

Implied warranty on sale of marked goods.

17. On the sale or in the contract for the sale of any goods to which a trade-mark, or mark, or trade description has been applied, the vendor shall be deemed to warrant that the mark is a genuine trade-mark and not forged or falsely applied, or that the trade description is not a false trade description within the meaning of this Act, unless the contrary is expressed in some writing signed by or on behalf of the vendor and delivered

at the time of the sale or contract to and accepted by the vendee (p. 520).

Provisions of Act as to false description not to apply in certain cases.

18. Where, at the passing of this Act, a trade description is lawfully and generally applied to goods of a particular class, or manufactured by a particular method, to indicate the particular class or method of manufacture of such goods, the provisions of this Act with respect to false trade descriptions shall not apply to such trade description when so applied: Provided that where such trade description includes the name of a place or country, and is calculated to mislead as to the place or country where the goods to which it is applied were actually made or produced, and the goods are not actually made or produced in that place or country, this section shall not apply unless there is added to the trade description, immediately before or after the name of that place or country, in an equally conspicuous manner, with that name, the name of the place or country in which the goods were actually made or produced, with a statement that they were made or produced there (p. 594).

Savings.

19.—(1.) This Act shall not exempt any person from any action, suit, or other proceeding which might, but for the provisions of this Act, be brought against him.

(2.) Nothing in this Act shall entitle any person to refuse to make a complete discovery, or to answer any question or interrogatory in any action, but such discovery or answer shall not be admissible in evidence against such person in any prosecution for an offence against this Act.

(3) Nothing in this Act shall be construed so as to render liable to any prosecution or punishment any servant of a master resident in the United Kingdom who *bonâ fide* acts in obedience to the instructions of such master, and, on demand made by or on behalf of the prosecutor, has given full information as to his master (p. 618).

False representation as to royal warrant.

20. Any person who falsely represents that any goods are made by a person holding a royal warrant, or for the service of her Majesty, or any of the Royal Family, or any government department, shall be liable, on summary conviction, to a penalty not exceeding twenty pounds (p. 641).

Application of Act to Scotland.

21. In the application of this Act to Scotland the following modifications shall be made:—

The expression "Summary Jurisdiction Acts" means the Summary Procedure Act, 1864, and any Acts amending the same.

The expression "justice" means sheriff.

The expression "Court of Summary Jurisdiction" means the Sheriff Court, and all jurisdiction necessary for the purpose of this Act is hereby conferred on sheriffs.

Application of Act to Ireland.

22. In the application of this Act to Ireland, the following modifications shall be made:—

The expression "Summary Jurisdiction Acts" means, so far

as respects the police district of Dublin metropolis, the Acts regulating the powers and duties of justices of the peace of such district, and as regards the rest of Ireland means the Petty Sessions (Ireland) Act, 1851, and any Act amending the same. 14 & 15 Vict. c. 93.

The expression "Court of Summary Jurisdiction" means justices acting under those Acts.

Repeal of 25 & 26 Vict. c. 88.

23. The Merchandise Marks Act, 1862, is hereby repealed, and any unrepealed enactment referring to any enactment so repealed shall be construed to apply to the corresponding provision of this Act; provided that this repeal shall not affect—

(a) any penalty, forfeiture, or punishment incurred in respect of any offence committed against any enactment hereby repealed; nor

(b) the institution or continuance of any proceeding or other remedy under any enactment so repealed for the recovery of any penalty incurred, or for the punishment of any offence committed, before the commencement of this Act; nor

(c) any right, privilege, liability, or obligation acquired, accrued, or incurred under any enactment hereby repealed.

No. 16.

MERCHANDISE MARKS ACT, 1891.

(54 Vict. c. 15.)

An Act to amend the Merchandise Marks Act, 1887.

[11th May, 1891.]

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

Customs entry to be trade description. 50 & 51 Vict. c. 28.

1. The customs entry relating to imported goods shall, for the purposes of the Merchandise Marks Act, 1887, be deemed to be a trade description applied to the goods (p. 583).

Official prosecutions.

2.—(1.) The Board of Trade may, with the concurrence of the Lord Chancellor, make regulations providing that in cases appearing to the Board to affect the general interests of the country, or of a section of the community, or of a trade, the prosecution of offences under the Merchandise Marks Act, 1887, shall be undertaken by the Board of Trade, and prescribing the conditions on which such prosecutions are to be so undertaken. The expenses of prosecutions so undertaken shall be paid out of moneys provided by Parliament.

(2.) All regulations made under this section shall be laid before Parliament within three weeks after they are made if Parliament is then sitting, and if Parliament is not then sitting, within three weeks after the beginning of the next session of Parliament, and shall be judicially noticed, and shall have effect as if enacted by this Act, and shall be published under the authority of Her Majesty's Stationery Office.

(3.) Nothing in this Act shall affect the power of any person or authority to undertake prosecutions otherwise than under the said regulations (pp. 612, 840).

Short title.

3. This Act may be cited as the Merchandise Marks Act, 1891, and the Merchandise Marks Act, 1887, and this Act may be cited together as the Merchandise Marks Act, 1887 and 1891.

No. 17.

MERCHANDISE MARKS (PROSECUTION) ACT, 1894.

An Act for enabling the Board of Agriculture to undertake Prosecutions in certain cases under the Merchandise Marks Act, 1887. [20th July, 1894.]

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

Power of Board of Agriculture to prosecute in certain cases. 54 & 55 Vict. c. 28.

1. The powers exerciseable by the Board of Trade under the Merchandise Marks Act, 1891, with respect to the prosecution of offences under the Merchandise Marks Act, 1887, may in cases which appear to the Board of Agriculture to relate to agricultural or horticultural produce be exercised by that Board, and in such cases the former Act shall apply as if the Board of Agriculture were referred to therein instead of the Board of Trade (p. 613 and pp. 841 to 843).

Extent of Act.

2. This Act shall not extend to Ireland.

Short title.

3. This Act may be cited as the Merchandise Marks (Prosecutions) Act, 1894, and shall be read with the Merchandise Marks Acts, 1887 and 1891.

No. 18.

GENERAL ORDERS ON THE MERCHANDISE MARKS ACT, 1887.

PAGE
A. Consolidated Instructions (with the Customs Regulations) 818
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C. Order in Council as to marks on watch case 837
D. Sardines à l'huile 839

A.—General Order 15/1900.

Custom House, London,
26th February, 1900.

Consolidated Instructions.

The following consolidation of the General Orders and other instructions on the subject of the Merchandise Marks Act of 1887, is issued for the information and guidance of the officers.

1. The regulations made by the Board under sect. 16 of the Merchandise Marks Act, 1887, will be found on page 18 (p. 830).

Goods without marks.

2. Goods imported into the United Kingdom which do not bear any marks whatever, either on the goods themselves or on the coverings containing them, are not subject in any way to the Act, and therefore need not bear any statement or indication, such as "Made abroad," "Made in Germany," &c.

3. Although the Act draws no special distinction, except as regards the requirement of qualification in certain cases under sect. 16, between goods prohibited on account of marks suggesting British origin and goods prohibited on other grounds, for the purposes of customs administration it is convenient to deal with them separately. The goods, therefore, prohibited under the Act to which the attention of officers is called may be classed under two heads:

(A) Goods with marks which suggest British origin and require, in order to legalize their importation, some counteracting qualification (paragraph 4).

(B) Goods with marks prohibited on other grounds (paragraph 19).

It is to be noted that by sect. 1 of the Merchandise Marks Act, 1891 (54 Vict. c. 15), the customs entry relating to imported

goods shall, for the purposes of the Merchandise Marks Act, 1887, be deemed to be a trade description applied to the goods.

(A) Goods with Marks suggesting British Origin.

4. Goods falling under (A) may be again subdivided :—

(a) Goods, whether manufactured or raw, having applied to them any description, figures, words, or marks, or arrangement or combination thereof, which by being or including, either expressly or by reference, the name of *a place in* or *a part* of the United Kingdom (*e.g.*, "Irish" = "of Ireland"), or in any other way, constitute a statement or other indication, direct or indirect, that the goods were made or produced in the United Kingdom.

(b) Goods of foreign manufacture bearing any name or mark which is, or purports to be, the name or trade-mark of a manufacturer, dealer, or trader in the United Kingdom.

(c) Goods, whether manufactured or raw, having applied to them a generally used trade description, which in indicating a particular class of goods or method of manufacture, includes expressly the name of a place in, or a part of, the United Kingdom, and is thereby calculated to mislead as to the place of the manufacture or production of the goods. This class, though in fact only a case of (a), is dealt with specially by the Act (sect. 18).

5. (A) (b) relates to manufactured goods, and not to entirely raw goods, and the word "purports" is to be understood as referring to any name or names reasonably suggesting a British manufacturer, dealer, or trader, whether the name is or is not known to the officer; or as referring to a trade-mark, not being merely matter of decoration or ornament, which reasonably suggests itself as British by containing English wording, or other representation specially designed to convey, and, in fact, conveying, an impression of British manufacture.

Places indicating method of manufacture.

6. As to (c) that the words "trade description which in indicating a particular class of goods or method of manufacture, includes the name of a place in or a part of the United Kingdom, and is thereby calculated to mislead" (*see* 4 (c)) mean such terms as Kidderminster Carpets, "Balbriggan" on Hosiery, or "Shetland" on Shawls, and the like, which, although they might be held to be merely phrases descriptive of method of manufacture, are yet calculated to mislead as to place of origin. Where, however, such a description has become associated with a particular class of goods in a manner practically to preclude any probability of deception, as "Portland Cement" and "Bath Chaps," the description need not be accompanied by a statement of the country of actual production. This applies also to the

case of colonial names describing, for instance, classes of wool, &c., where, although the names are British, the circumstances preclude mistake.

7. All such goods as above specified are to be detained and reported to the Board unless they are qualified as follows:—

As to (a), by a definite indication of make or production out of the United Kingdom.

As to (b), by a definite indication of the country in which the goods were made.

As to (c), by the name of the country in which the goods were actually made or produced, with a statement that they were made or produced there.

When "made in" not required.

8. With regard to (a), "Made abroad" will be generally sufficient. With regard to (b), the name of the country is a sufficient indication, without the words "made in," if the name or trade-mark only appears. Where there is an address, as "John Smith, Sheffield," then the qualification must be "Made in Germany," or similar wording; "Germany" alone would not counteract "Sheffield"; (c) requires the full statement "Made in Germany."

Actual place of origin.

9. Officers are not expected to decide whether goods were actually made or produced in the country from which in the qualification they are stated to come; the name of *some* foreign country, or of some place in a foreign country is sufficient.

Place-name alike in United Kingdom and abroad.

10. If the goods bear the name of a place identical with, or a colourable imitation of, the name of a place in the United Kingdom, the name should be accompanied by the name of the country in which the place is situated. Thus Boston, in Massachusetts, should be accompanied by the name "United States," or by the initials "U.S.A.," or even by the abridgment "Mass."

English language on goods.

11. The use of the English language applied as a description to goods imported from non-English speaking countries is not, simply *as* language and where not involving the name of any place in, or part of, the United Kingdom, a "direct," and, as a rule, is not to be regarded as an "indirect," indication of British origin. Where, however, there is good ground for considering that the use of the language was specially designed to convey, and does in fact convey, an impression of such origin, then the language will be a description within (a) of paragraph 4.

Initials.

Initials.

12. "Initials" under the Act, though not treated as names generally, are to be so treated in certain cases, of which the following are all of which the officers need take cognizance:—

(i.) Where the initials are followed by affixes distinctly suggesting a British firm as "& Co." from countries where that affix is not used, which includes all the continental countries except Germany, and "Brothers" or "Bros." or the like, which applies to all non-

English speaking countries. This holds as to all goods whether manufactured or raw; but in respect of baskets and the like, holding raw fruit, eggs, &c., and sent to and from the Continent, the rule, when the baskets, &c., will not meet the eyes of retail buyers, is not strictly applied.

(ii.) Where, in respect of manufactured goods, the name or mark of a manufacturer, dealer, or trader in the United Kingdom is prohibited, on foreign goods, even his own property, without a definite qualification, the initials will fall within the prohibition if they are easily recognizable as those of persons or firms so well-known as to make the initials practically equivalent to the name itself; and also, where they are the initials of known consignees of the goods who will bring them into consumption in the same "coverings." Where the consignees are not known, and no special fact calls attention to the goods, they may, as regards initials, be passed.

Packing Cases and Coverings.

Cases and coverings.

13. Goods will not be liable to detention when the name of a port or place of destination is applied to mere packing cases or outer wrappers in which goods are clearly not intended to be sold or exposed for sale, or if exposed for sale, then in an export market. Address marks, when they are merely and manifestly such, for purposes of carriage only, are not marks within the Act.

14. "Coverings" such as boxes, capsules, bottles, &c., are to be judged with discrimination as to whether the marks, if any, on them, refer to them, or to the goods they are to cover. If the marks on them refer, as is rarely the case, distinctly to the coverings, the case should be reserved for the Board. If the marks, such as Royal Arms, or the like, refer to the goods to be covered, and it is shown to the satisfaction of the officer that they will be British goods, or goods as to which British marks are not objectionable, and do not refer to the coverings themselves, then the coverings may be regarded as not contrary to the Act.

15. This principle will apply to coverings (such as ornamental boxes for tobacco, tea, or confectionery), with names on them of firms who have ordered the coverings for their own goods, or where such firms, though not having actually ordered the coverings themselves, consent in writing to their importation for such goods.

Grain Sacks.

Grain sacks.

16. The name and address of a merchant in this country upon grain sacks, are to be regarded as an indication that the grain is of British origin, and will require the addition of a statement of

the country of production. In the case of grain imported in bulk and transferred *after due entry and clearance* into sacks on board the importing ship, such marking of the sacks need not be qualified with a statement of the foreign origin of the grain.

Samples, &c.

Samples.

17. Samples or patterns, readily distinguished as such, and valueless in themselves, are not to be treated as under the Act so far as British origin is concerned.

Goods not Produced in United Kingdom.

Non-products of United Kingdom.

18. Goods not produced in the United Kingdom, such as wine, tea, and other produce not grown in this country, such as linseed, rapeseed, &c., are also treated as not under the Act, so far as British origin is concerned. This is applied further to some special forms of manufacture which, by shape, make, or colour, cannot be mistaken for the manufacture here of the same article, as, for instance, Dutch cheese of the kind well-known to be made in Holland, bearing the initials of British dealers.

(B) Goods Prohibited on other grounds.

19. Goods prohibited on grounds other than marking suggestive of British origin are those which, whether manufactured or raw, have applied to them a false trade description

(a) As to the place or country in which they were made or produced;

(b) As to trade-marks or names so as to constitute forgery;

(c) As to number, quantity, measure, gauge or weight, and mode of manufacture or material;

(d) As to being the subject of any existing patent, privilege, or copyright.

Marks as between foreign countries.

20. As to (a), this relates, of course (British origin having been dealt with above), to questions between two foreign countries; that is to say, to goods with marks indicating make or production in a place or country which is not that in which the goods were made or produced. The Act does not specify particularly what is to be the qualification here; but if the mark indicates, expressly, or by reference, a place or country not that, in reality, of the make or production of the goods, there must be a definite qualification to the effect that the goods were not made or produced in the place or country indicated; *or*, a definite indication of the place or country in which the goods were made or produced.

Mark including place-name.

21. A mark which, though not naming, *includes* the name of a place or country, is to be held as naming such place or country. For instance, a wine, the produce of Germany, and described as "Port" or "Sherry" (which words include the names of the places Oporto and Xeres), should have that de-

scription accompanied by the statement "produced in Germany," or should be described as "German Port" or "Australian Sherry," &c. Such a mark as "Lancashire Swedish" on Swedish iron, where the qualifying word follows the misleading name, may be admitted. As in marks suggesting British origin, exception to this rule is made in cases where the name of a place in a trade description is indicative merely of the character of the goods, and is not calculated to mislead as to the country of origin. The description "Brussels Carpet" is an exception of this kind.

Port of shipment evidence of origin.

22. For judging between two foreign countries the Act provides that, in the absence of proof to the contrary, the port of shipment of goods shall be *prima facie* evidence of the place or country in which the goods were made or produced; and this rule the officers can, generally, act upon. Where, however, the port of shipment is merely an ordinary trading route from some inland country, as Rotterdam or Antwerp with respect to Germany, or Hamburg with respect to Austria, the officers may, if they have no reason to doubt the good faith of the importer, accept the statement that the goods are the make or produce of the inland country.

Foreign language not of country of origin.

23. The use of language of one foreign country on goods of another must not be viewed more strictly than its use in cases indicating British origin, dealt with in paragraph 11. The use of a certain language is allowed freely to *all* countries when, by custom, that language is usually applied to such goods: *e.g.*, Spanish on tobacco and cigars, when the recognized words are applied only to colour, shape, size, and the like; or French on sardines, when confined to the words "Sardines à l'huile," without any additional French description.

Forging trade-mark.

24. The forging of a trade-mark (par. 19 (b)) is the application to goods of any figure, words, or marks, or arrangement or combination thereof, reasonably calculated to lead persons to believe that the goods are the manufacture or the merchandise of some person other than the person whose manufacture or merchandise they really are; and this includes the name or initials of a person. The figures, words, or marks applied need not be an actual trade-mark, or actual name or initials, provided they are a colourable *imitation of the mark, name*, or initials of a person carrying on business in connection with goods of the same description, and are used without his authority.

Registration.

Registration.

25. As to goods under all the three heads, (b), (c), and (d), of paragraph 19, the difficulty of detection by officers, without special information, and more particular examination than is ordinarily bestowed for revenue purposes, is greater than in the case of goods falling under (a), but as regards the forging of trade-marks (b), as above explained, while it would not be possible for officers to enter into the examination of all names and marks so as to detect fraud of this kind, the Board have, nevertheless, felt that a manufacturer, dealer, or trader who has reason to

believe that his name or trade-mark is one not unlikely to be imitated, so as to constitute a forgery, is entitled to ask that, without the requirement of information beforehand, goods so marked shall be stopped; and to meet this the Board have established the following system.

Detention on account of registration.

26. They have established a system of registration of name or marks so that a manufacturer, dealer, or trader, may register his name or mark at such port or ports as he desires. In respect of names or marks so registered, it will be the duty of the officers, at the particular port or ports, to prevent the delivery of goods to which such names or marks or imitations of them as above explained may be applied, unless the delivery is authorized by the registered proprietor.

27. When goods are thus detained on account of names or marks which have been registered in this Department, care is to be taken in every case that, in addition to the usual notice of seizure required under section 207 of the Customs Consolidation Act, information of the detention, and of the cause of such detention, shall be at once given in writing to the person who has so registered his name or mark, or to the representative appointed by him to authorize delivery of the goods, who is to be informed that unless immediate attention is given to the matter the goods will be released. If, at the end of forty-eight hours, the collector (or other principal officer concerned) does not receive a reply he will release the goods; but collectors will observe that the limit to the time of detention here laid down does not apply in cases where the marks are such as to render the goods liable to detention irrespective of the question of registration. In any case of detention under this system of registration the Board, if they see fit, may order security to be given if prolongation of the detention is requested, and the matter is, at all, one of doubt.

Registering foreign marks; and agency.

28. Any manufacturer, dealer, or trader, whether British or foreign, may register his name or mark; but officers may refuse registration to any name or mark which they consider to be of a character too indefinite or indistinct to recognise, referring to the Board in any case of doubt. An applicant for registration must prove his proprietorship of the name or mark by declaration (see Form C. in the Appendix); and if, in order to avoid delay, he desires to do so, he may appoint an agent to give authority for delivery of his goods.

Registered marks on goods imported by owner.

29. It must, however, be distinctly understood that the use by any manufacturer, dealer, or trader in the United Kingdom of even his *own* name on foreign goods, and the use by any manufacturer, dealer, or trader, on like goods, of words, figures, or marks of any kind stating or indicating, directly or indirectly, make or production in the United Kingdom, are prohibited unless such goods are properly qualified by the required definite indication of origin. It must, therefore, be clearly explained to every person registering a name or mark which involves any such statement or indication, as will probably often be the case,

that, while the name or mark will be guarded by such registration, it will not be rendered admissible unless duly qualified, as the law may require, in every case.

30. Goods bearing a mark registered in this Department may be delivered by the officers without reference to the Board on receipt by them of the authority of the proprietor of the mark, or of his duly appointed agent, provided the mark be properly qualified, as in this Order shown. Release when qualified.

General.

British Returned Goods.

31. British goods returned bearing the name, brand, or mark of any British manufacturer may be admitted upon proof of their origin being furnished. This may be done by Bill of Store; or by a declaration by the importer that the goods are, to his knowledge, British goods returned, and were originally manufactured in this country; or by and with the consent in writing of the proprietor of such name, brand, or mark, or his legal representative (42 & 43 Vict. c. 21, s. 6). British returned goods.

32. The declaration by the importer as to the British origin of the goods may be in the usual form as an ordinary customs document, but if the officer sees reason to doubt it, he should refer the papers to the Board; and he should, in no case, require a statutory declaration, under the Act as to such declarations, without the Board's order.

33. On any other point British goods returned will not be dealt with except on information.

Goods for Private Use.

31. Dutiable.—Tobacco, including cigars, not exceeding 20 lb., wine not exceeding twelve gallons, and spirits not exceeding one-half that quantity, in any one consignment, may be admitted free of the Act, on the officer being satisfied that the goods are for private use. Private use.

35. Non-dutiable.—Such goods sent as presents, or for personal use, and not in any process of sale or purchase, are similarly free of the Act, and this especially includes articles not new, and which are manifestly private property, such as clothing, or other personal effects, and old, used, and damaged articles sent for repairs, imported by, or consigned to, persons whose names are on them. This applies also to presents to corporate bodies or public institutions.

Goods in Transit.

36. Under the Transhipment Regulations, transhipment and transit goods are not to be specially examined for the purpose of scrutinizing marks *in the absence of information* (General Transhipment goods.

Order $\frac{1}{1\,8\,0\,8}$); nor are such goods to be detained under the Merchandise Marks Act unless they infringe its provisions in one or other of the following ways:—

(a) By reason of their bearing marks which raise a clear and direct claim to British origin; or

(b) By reason of their bearing the name or trade-mark of a manufacturer, dealer, or trader in the United Kingdom, without qualification; or

(c) By reason of their bearing a trade-mark specially registered at the customs.

When the marks on a package, or on goods found therein, contravene the Merchandise Marks Act, all the packages of the same mark on the entry are to be examined, the packages with other marks being treated as if on a separate entry.

This direction also applies to goods entered for home consumption, but intended to be forthwith re-shipped for exportation, on production of satisfactory evidence (such as Bills of Lading, Invoices, &c.), of the final destination abroad of the goods; but they are subject to examination under G.O. $\frac{1}{1\,8\,0\,8}$, as laid down in G.O. $\frac{1}{1\,8\,0\,5}$, par (8).

Marks not descriptive but part of the Goods.

Marks where part of goods.

37. Wording or marking, whatever may be its character, if it is not a description "applied" to goods, but part of the goods themselves, as, for instance, the regulating words on a thermometer, the titles of books, christian names on handkerchiefs, such words as "a present from Margate" on china, and the like, are not amenable to the Act.

Goods imported for advertising purposes only, and not for sale, although bearing the name, or name and address of a British trader, provided he is not a maker of, or dealer in, such articles, may be delivered upon a written statement to that effect from the person whose name is on the goods.

Reports of Detention.

Detained goods to be reported at once; monthly and quarterly.

38. Report (on Form 294) is to be made immediately of all cases of detention of goods, stating briefly the number of packages detained, the port from which they come, the marks and numbers of the packages, the description and value of the goods, and the objectionable marking, whether by means of labels or on the goods themselves, on account of which they are detained. Reference should be made to any previous cases of the importation of illegally marked goods consigned to the same merchants or coming from the same consignor.

A monthly return is to continue to be made to the Board, being forwarded to the solicitor on Forms 401 and 402.

A quarterly return is to be made to the Board (Div. IV.) on Form No. 398, for which purposes the present form of record at the various stations is to be maintained.

When report dispensed with.

39. Immediate reports of detentions of goods may be dispensed with when such detentions are made in consequence of the absence of evidence that the marks on the goods are correct, provided that the officers have reason to believe that such evidence will be forthcoming within a reasonable time. On production of the evidence, the officers, if satisfied therewith, will deliver the goods. This direction will include British returned goods bearing marks which would be open to objection on goods of foreign origin; also goods bearing marks indicative of origin in some country other than that from which the goods are imported, when such marks are believed to be authentic.

All marks to be reported.

40. The whole of the marks found on the detained goods should be reported, including the marks on cartons, cases, &c., containing the goods and not merely the actual mark for which the detention has been made.

Qualifying Words to be conspicuous, &c.

Qualification to be conspicuous.

41. The officers are to take care that, in all cases where the Board allow qualifying words to be added before the delivery of goods, such words are applied in characters clear, conspicuous, and as indelible as the marks requiring qualification, and in close proximity to those marks.

Seizures and Unclaimed Goods.

Seizures. Full examination.

42. In all cases in which goods are ordered to be retained as seizures, a *full examination* of the contents of all the packages should be made as soon as the order for seizure is given, and any discrepancy between the marks originally reported and those found on the goods should be communicated to the Board forthwith.

But if an importer should express a wish not to have *all* his packages opened, officers may forego this upon a consent in writing from him, or his agents, that the whole consignment shall be taken as having marks applied to them similar to those on the goods in the packages already opened.

Goods in London not claimed within two months.

43. Goods which have been placed under detention on account of illegal marks, and in respect of which no applications have been made by the importers for, or no steps taken to carry out the conditions imposed by the Board on their release, are to be removed to the Queen's Warehouse, within two months from the date of the Board's order for their detention, without special directions in each case, if the officers see no circumstances which call for exceptional treatment. They are to be entered in the Monthly Seizure Account.

Patent or Copyright on Goods.

Goods for sale: patent or copyright.

44. In order that there may be no risk of goods protected by

patent or copyright in the United Kingdom being offered for sale by this Department, in submitting accounts of seizures under the Act, particular attention should be called in column 8 to any goods included for disposal marked "Patent," or "Copyright," or which the officers have any reason to suppose are patented, or the subject of copyright, in this country.

Watch Cases and Watches.

Watch cases and watches.

45. A special provision as to watch cases and watches is made by sect. 7 of the Act. It provides that, as regards watches, any mark on the case is to be deemed to extend to the watch. If, therefore, a watch case is made in this country, with any statement or indication of origin such as, for instance, a British hall-mark, and having been exported, is returned with a foreign movement, then, in the absence of a counter description on the watch itself, the mark on the case will apply to the watch.

General Order [illegible], which goes fully into this subject, is not affected by this Consolidating Order (*a*).

Procedure on Information.

Detentions on information.

46. It must be borne in mind that information, in itself, even though given, is not a mandate to the Crown to detain; and no detention should on account of it be made where it is clear that the law would be against it. Officers may sometimes see at once that a consignment to which the information points does not infringe the law, and they will then not detain the goods. But they are authorized to make, when necessary, a fuller examination than ordinarily takes place.

Deposit or bond.

47. In any other case the officer will detain the goods, and require (if it is not already given) immediate security, as in Regulation 4 (p. 20) (*b*). The sufficiency of the sureties named in the notice of information must be tested in the usual way. Regulation 7 (p. 20) (*b*) shows when the security will be delivered up.

No security, no detention.

Whenever security is not duly given, there will be no further detention.

Information as to origin.

48. Information will not generally touch the point of origin. Whenever it does do so, and affects the interests of "British Possessions" or "Foreign States," if the name complained of is found to be applied to the goods, and is the name of a country, or of a place in a country, not the country of the port of shipment, the officer may, in the absence of proof of make or produce at the place or in the country named on them, be satisfied that the alleged infringement clearly exists. This is in accordance with the principle in paragraph 22.

Forged marks in certain States and British Possessions.

49. Whenever an information relates to a forged trade-mark alleged to be one recognised in a British Possession or foreign State, information will not be good unless it relates to a Possession or State to which sect. 103 of the Patents, Designs,

(*a*) Printed p. 837.
(*b*) Page 833, below.

and Trade Marks Act, 1883, has been applied by Orders in Council, viz. :—

British Possessions ..	..	New Zealand. Queensland. Tasmania. Western Australia.
Foreign States in Europe ..	..	Belgium. Denmark, including Faroë Islands. Franco. Greece. Italy. The Netherlands. Norway. Portugal, including Azores and Madeira. Roumania. Servia. Spain. Sweden. Switzerland.
In N. and S. America and the W. Indies ..	..	Brazil. Ecuador. Mexico. Paraguay. San Domingo. Surinam and Curaçao. The United States of America. Uruguay.
In Africa ..	..	Tunis.
In Asia	..	Japan. Netherlands East India Colonies.

Definitions.

50. The officers will note the meanings given by the Act to the following expressions, viz. :— Definitions.

"Goods" "Trade Mark" *"Trade Description" "False Trade Description" "Person" "Manufacturer" "Dealer" or "Trader" "Proprietor" "Name" "Name or initials"	Sect. 3, and *54 Vict. c. 15, s. 1.
"Applied" "Falsely applied" "Coverings"	Sect. 5, (1), (2), and (3).

51. The following General Orders are hereby cancelled:—

Nos. 81 and 99 of 1887.
Nos. 10, 14, 26, 33, 39, 44, 121, 122, 125 and 147 of 1888.
No. 7 of 1889.
Nos. 1 and 8 of 1890.
Nos. 50 and 68 of 1893.
No. 4 of 1894.
Nos. 4, 28, 34 and 82 of 1895.
Nos. 4 and 9 of 1896.
No. 63 of 1897.

The following Circular Letters are also cancelled:—

Nos. 1, 4, 5, 8, 33 and 36 of 1889.
No. 6 of 1890.
Nos. 9 and 20 of 1891.
No. 13 of 1892.

The following London Port Orders are also cancelled:—

Nos. 9, 18, 21, 61, 70, 72, 74 and 76 of 1888.
Nos. 23, 48 and 52 of 1889.
Nos. 2 and 6 of 1890.
Nos. 12 and 58 of 1893.
No. 19 of 1894.
No. 13 of 1895.
No. 4 of 1898.

The following General Orders on the subject are not affected, viz.:—

1887, 1888 (with directions as to examining London Port Order No. 1888), and 1891.

By order of the Board,
JOHN COURROUX.

Regulations made by the Commissioners of Customs under Section 16 of the Merchandise Marks Act, 1887.

Whereas by the Merchandise Marks Act, 1887 (hereinafter called "the Act"),

After various provisions against the sale, or exposure for sale, or possession for sale, trade or manufacture, of goods with forged trade-marks or false trade descriptions, or trade-marks falsely applied to them;

And after defining (amongst other things) the expression "trade-mark" in manner therein set forth, with reference to "The Patents, Designs, and Trade Marks Acts, 1883," and the law of indicated British Possessions and Foreign States;

And after defining the expression "trade description" as any description, statement or other indication, direct or indirect, as to number, quantity, measure, gauge, or weight of goods,

as to place or country in which any goods were made or produced, as to the mode of manufacturing or producing any goods, or as to the material of which any goods are composed, or as to any goods being the subject of any existing patent, privilege, or copyright;

And after defining the expressions "false trade description," "goods," "apply," and "falsely apply";

It is provided by section 16 that,

(i.) All such goods as above mentioned, and

(ii.) All goods of foreign manufacture, bearing any name or trade-mark, being or purporting to be, the name or trade-mark of any manufacturer, dealer, or trader, in the United Kingdom, unless such name or mark be accompanied by definite indication of the country in which such goods were made or produced,

shall be prohibited to be imported, and, subject to the provisions of the said section, shall be included among goods prohibited to be imported, as if they were specified in section 42 of "The Customs Consolidation Act, 1876."

And whereas by section 18 of the Act, after authorizing the continued use of trade descriptions lawfully and generally applied to goods of the particular class, or manufactured by a particular method, to indicate such class or method, it is provided that, where such trade description includes the name of a place or country calculated to mislead as to where the goods were actually made or produced, such goods not having been actually made or produced there, the said reciting section should not apply (and, consequently, goods so marked would be prohibited), unless there be added to the trade description, immediately before or after the name of the place or country, in an equally conspicuous manner with that name, the name of the place or country in which the goods were actually made or produced, with a statement that they were made or produced there.

And whereas it is also provided by the said section 16 that the Commissioners of Customs (hereinafter called "the commissioners"), may, from time to time, make, revoke and vary regulations, either general or special, respecting the detention and forfeiture of goods the importation of which is prohibited as hereinbefore mentioned, and the conditions, if any, to be fulfilled before such detention and forfeiture, and may by such regulations determine the information, notices, and security to be given, and the evidence requisite for any of the purposes of the said section, and the mode of verification of such evidence.

And it is further provided by the said last-mentioned section:—

That before detaining goods or taking proceedings with a view to the forfeiture thereof under the law relating to the customs, the commissioners may require that such regulations as aforesaid shall be complied with, and satisfy themselves as to the liability of the goods to forfeiture.

That such regulations may apply to all goods, the importation of which is prohibited by the said section, or different regulations may be made respecting different classes of such goods.

And also that the regulations may provide for the informant reimbursing the commissioners all expenses and damages incurred in respect of any detention made on his information, and of any proceedings consequent on such detention.

And it is also provided by the said section that section 2 of the Revenue Act, 1883, shall be repealed from a day to be fixed by regulations under the said reciting section, such day not being later than the 1st day of January, 1888, without prejudice to anything done or suffered thereunder.

And whereas section 2 of the Revenue Act, 1883, is the law under, and by virtue of which, goods of foreign manufacture infringing the proprietary rights of British subjects in names, addresses, and trade-marks, or bearing or having upon them, under certain conditions, the name of a place in or a part of the United Kingdom, are, at the present time, detected and stopped by officers of customs acting on their own observation and responsibility, under directions laid down by the commissioners, and without the requirement of previous information, security, or other conditions.

Now, therefore, the commissioners under and by virtue of the hereinbefore recited power in that behalf, hereby make and require to be complied with the following regulations, viz. :—

1. Goods prohibited to be imported as hereinbefore recited, having applied to them forged trade-marks, false trade descriptions, or marks, names, or descriptions otherwise illegal, which, upon examination, are detected by the officers of customs, are to be detained by them without the requirement of previous information.

2. In giving information with a view to detention an informant must fulfil the following conditions, viz. :—

(i.) He must give to the collector or superintendent or the chief officer of customs of the port (or sub-port) of expected importation, notice in writing, stating,
the number of packages expected, as far as he is able to state the same,
the description of the goods by marks or other particulars sufficient for their identification,
the name or other sufficient indication of the importing ship,
the manner in which the goods infringe the Act,
the expected day of the arrival of the ship.

(ii.) He must deposit with the collector or other officer as aforesaid a sum sufficient, in the opinion of that officer, to cover any additional expense which may be incurred in the examination required by reason of his notice.

3. If, upon arrival and examination of the goods, the officer of customs is satisfied that there is no ground for their detention,

they will be delivered. If he is not so satisfied, he will decide either to detain the goods as in a case of detention upon ordinary examination, or to require security from the informant for reimbursing the commissioners or their officers all expenses and damages incurred in respect of the detention made on his information and of any proceedings consequent thereon.

4. The security thus required must be an immediate *ad valorem* deposit of ten pounds per cent. on the value of the goods, as fixed by the officer from the quantities or value shown by the entry; and also, subsequently, a bond to be completed within four days in double the value of the goods, with two approved sureties. The *ad valorem* deposit will be returned upon completion of the bond, and will not be required if, as an alternative where time permits, the informant prefers to give a like bond before examination upon estimated value of the goods declared to by him under statutory declaration. If the security is not duly given as above required, there will be no further detention of the goods.

5. In the above regulations the words "officer of customs" mean an officer acting under general or special direction of the commissioners, and the words "value of the goods" mean value irrespective of duty.

6. The "notice" and "bond" required as above shall be in the forms contained in the schedule to these regulations, or in such other forms as the commissioners may from time to time order and direct.

7. The security taken under these regulations will be given up at the times following, that is to say:—

Where given before examination, and if no detention, forthwith.

Where given on detention:—

If the forfeiture is completed, either by lapse of time or ultimate condemnation by a Court of Justice, then on such completion of forfeiture.

If the forfeiture is not completed, then

If the goods are released by the Commissioners, and no action or suit has been commenced against them, or any of their officers, in respect of the detention, then at the expiration of three months from the time of detention; or, if the goods are released for failure of proceedings taken for the forfeiture and condemnation thereof upon information under section 207 of "The Customs Consolidation Act, 1876," and no action or suit has been commenced against the commissioners, or any of their officers, in respect of the detention, then at the expiration of three months from the trial of such information.

If within such periods as aforesaid any such action or suit as aforesaid has been commenced, then upon the ultimate conclusion of such action or suit, and the fulfilment of the purpose for which the security was given.

8. These regulations apply to transhipment and transit goods

as well as to goods landed to be warehoused, or for home consumption.

9. The 1st day of January, 1888, is, by these "regulations," fixed as the day from which section 2 of the "Revenue Act, 1883," shall be repealed, subject to the terms of the recited Act; and these regulations will take effect from the date of such repeal.

CHARLES DU CANE
H. MURRAY
HORACE SEYMOUR
} Commissioners of H. M. Customs.

Custom House, London,
1*st December*, 1887.

SCHEDULE.

A.—(NOTICE.)

The Merchandise Marks Act, 1887.

To the Collector, Superintendent, or Chief Officer of Customs at the Port * of .

I hereby give you notice that the undermentioned goods, that is to say,† are about to be imported into your port on or about the day of next in the ‡ from .

That such goods are liable to detention and forfeiture being § .

That Mr. of and Mr. of are prepared to become my sureties in such bond as may be required upon detention of the goods.

And I request that the said goods may be detained and dealt with accordingly.

Dated this day of , 188 .

A. B.
[*or* Agent for] .

NOTE.—Mr. refers to his bankers [*or* solicitors], and Mr. to his bankers [*or* solicitors] as to his sufficiency for the penalty of the bond.

B.—(BOND.)

The Merchandise Marks Act, 1887.

KNOW ALL MEN BY THESE PRESENTS, THAT WE A. B. and are held and firmly bound unto Our Sovereign Lady Victoria, by the Grace of God, of the United Kingdom of Great Britain and Ireland, Queen,

* Or Sub-Port.

† Describe the goods, number of packages, marks used, and any other particulars necessary for their identification.

‡ Describe the ship, and give name or indication.

§ State how the goods infringe the Act, and if the infringement is one as to a forged trade-mark protected in a British possession or foreign state, state the possession or state; or, if the infringement is one as to place or country of origin, state the name of the place or country falsely used.

Defender of the Faith, in the sum of pounds to be paid to our said Lady the Queen, her heirs or successors. For which payment well and truly to be made we bind ourselves, jointly and severally, our heirs, executors, and administrators, firmly by these presents. Sealed with our seals. Dated this day of in the year of our Lord one thousand eight hundred and .

Whereas the above-named A. B. has by a notice dated the day of informed the collector of customs at that the undermentioned goods, that is to say, were about to be imported into the port of contrary to section 16 of the Merchandise Marks Act, 1887, and requested that the said goods should be detained and dealt with accordingly. And whereas the said goods duly arrived in the said port on the day of last, and are now detained pursuant to the said notice.

Now the condition of this obligation is such that if the said A. B. his executors or administrators, shall well and effectually indemnify, save harmless, and keep indemnified, her Majesty, her heirs and successors, and all her and their officers of customs, and their executors or administrators, from and against all loss or damage, payment or payments, and all costs and expenses which her said Majesty, her heirs or successors, and her and their officers of customs, their executors or administrators, shall or may sustain or incur by reason or on account of any detention of the said goods following upon the information contained in such notice and any proceedings consequent upon such detention, then this obligation shall be void, or otherwise shall be and remain in full force and virtue.

Signed, sealed, and delivered.

O.—Merchandise Marks Act, 1887.

(50 & 51 Vict. c. 28.)

Declaration on Registration under Paragraph 28 of General Order .

Port of .

I* , hereby declare that † , ‡ the proprietor , of § , viz., , which ‖ expect to be applied to goods imported, from time to time, at this port; and that ‖ have appointed Mr. ¶ of , to be** agent, to give authority for the delivery of such goods.

I make this solemn declaration conscientiously believing the same to be true, and by virtue of the Statutory Declaration Act, 1835.

(Signed) .

Declared this day of , 18 , at ,

Before me ,

A commissioner to administer oaths, &c.

N.B.—Registration in pursuance of this declaration is subject to the provisions of the Act which forbid the importation, by a registered proprietor, even of his own goods which bear, in name or mark, any statement or indication, direct or indirect, of make or produce in the United Kingdom unless qualified as the Act requires.

* Full name and address of declarant.

† "I," or "I and my partners, trading as Messrs. ," or "such and such a company, of which I am the representative official," or "so and so, of such and such a place abroad, whom I represent in this country."

‡ "Is" or "are."

§ "The following name as a trade description," or "the following trade-mark," or "the following name as a trade description and trade-mark."

‖ "I" or "we."

¶ This portion as to appointment of agent may be erased, where such appointment is not desired.

** "My" or "our."

B.—General Order 9/1888.

Custom House, London,
18th January, 1888.

Sir,

In accordance with paragraph 33 of General Order 99/1887, I now transmit to you the directions of the Board, to enable you to deal with watch cases and watches, under the Merchandise Marks Act; the latter term, watches, meaning, as provided by section 7 of the Act, "all that portion of a watch which is not the watch case."

Your attention has already, by G. O. 81/1887, been called to the position in which watch cases, under this section, stand in relation to watches; and the consequent importance of the assay mark on watch cases, which mark, by virtue of section 3 (1) of the Act, would be deemed a trade description as to place or country of origin.

You will note, in addition, that by section 8 (1) of the Act, provision is made for preventing foreign-made watch cases from obtaining the mark placed on a watch case made in the United Kingdom; and it is enacted that a different mark shall be placed on foreign watch cases of such pattern, and in such mode as directed by Order in Council.

An Order in Council to this effect, dated the 28th of November last, was published in the "London Gazette" of 9th December last, and a copy of this order, together with sheets 1 and 2 of Appendix to Schedule II. therein referred to, which contain diagrams of the required new marks, are sent to you herewith.

You will carefully study these sheets, and note how the marks apply variously to the different assay offices in the United Kingdom.

The directions to be observed by you in applying this new law will relate to—

(a) Watch cases with assay marks imported alone.
(b) Like watch cases imported with the watches, that is to say watches of foreign manufacture in them.

(a) *Watch Cases with Assay Marks imported alone.*

If the cases are wholly unmarked, or are duly marked in accordance with the Order in Council, or with a foreign assay mark, and there is not, in addition, any wording on any part of the case proper, or on the dome, indicating make or produce in the United Kingdom, the goods may be delivered. If, on the other hand, there is any such wording, the goods must be detained and the matter referred to the Board.

If the cases are marked with a British Hall Mark as placed on watch cases made in the United Kingdom, you will detain the goods unless they are entered as "British goods brought back," in which case they may be admitted under the usual regulations.

(b) *Watch Cases imported with the Watches in them.*

If the cases are wholly unmarked, or are marked either
In accordance with the Order in Council, or
With a foreign assay mark, or
With a British assay mark as placed on a watch case made in the United Kingdom, and with an equally conspicuous statement either above or below the assay mark, that the watch is of foreign make;

And if there is no wording either as an addition on the case or done, or upon the watch itself, whether on the dial or the plate, or any part of the works, indicating make or produce in the United Kingdom, then the goods may be delivered.

If, on the other hand, there is any such wording, the goods must be detained and the matter referred to the Board.

If the cases are marked with a British assay mark as placed on a watch case made in the United Kingdom, and with no statement of foreign make on the cases, as required above, you will detain them as a seizure, unless there is upon the dial of each watch and also on the top "plate" (where the watch is of that construction) or on the bottom "plate" (where the watch is of that construction) visibly, between the "bridges," an indelible and definite indication of the place or country in which the watches were made. Such an indication will be considered definite, if it is, or contains only the name of the place or country of origin; if in addition, it contains the name of a place in, or a part of the United Kingdom, as, for instance, "Geneva and London," or if there is anywhere on the watch an indication by figures, words, or otherwise, that the watch might be the make or produce of the United Kingdom, then, in addition to the name of place or country of origin, there must be a distinct statement that the watches were there made.

I am, Sir, your obedient Servant,
E. Goodwyn.

The Collector at

C.—Order in Council as to Assay Marks on Watch Cases (*b*).

At the Court at Windsor, the 28th day of November, 1887.

Present—The Queen's Most Excellent Majesty in Council.

Whereas by the Merchandise Marks Act, 1887, 50 & 51 Vict. c. 28, it is, amongst other things, provided that—

(1.) Every person who, after the date fixed by Order in Council sends or brings a watch case, whether imported or not, to any assay office in the United Kingdom for the purpose of being assayed, stamped, or marked, shall

(*b*) London Gazette, 9 Dec., 1887, p. 6862.

make a declaration declaring in what country or place the case was made. If it appears by such declaration that the watch case was made in some country or place out of the United Kingdom, the assay office shall place on the case such a mark (differing from the mark placed by the office on a watch case made in the United Kingdom) and in such a mode as may be from time to time directed by Order in Council.

(2.) The declaration may be made before an officer of an assay office appointed in that behalf by the office (which officer is hereby authorized to administer such a declaration) or before a justice of the peace or a commissioner having power to administer oaths in the Supreme Court of Judicature in England or Ireland or in the Court of Session in Scotland, and shall be in such form as may be from time to time directed by Order in Council.

(3.) Every person who makes a false declaration for the purposes of this section shall be liable on conviction or indictment to the penalties of perjury, and, on summary conviction, to a fine not exceeding twenty pounds for each offence.

Now, therefore, her Majesty, by and with the advice of her Privy Council, and in exercise of the powers vested in her by the above-recited provisions of the said Act, is pleased to order and declare, and doth hereby order and declare, that where it appears by such declaration that such watch cases have been made in some country or place out of the United Kingdom, then the following authorities, that is to say:—

The Wardens and Commonalty of the Mystery of Goldsmiths of the City of London;

The Guardians of the Standard of Wrought Plate, Birmingham;

The Company of Goldsmiths of the City of Chester;

The Guardians of the Standard of Wrought Plate, Sheffield;

The Incorporation of Goldsmiths of the City of Edinburgh;

The Goldsmiths' Company of the City of Glasgow;

The Fraternity or Company of Goldsmiths of the City of Dublin;

shall respectively cause to be placed on such watch cases the marks more particularly described and delineated in Schedule II. hereunto annexed, and no other mark or marks, and such marks are hereby authorized accordingly.

And it is hereby further ordered and declared that the declaration to be made shall be in the form set forth in Schedule I. hereunto annexed.

This order shall come into operation on the first day of January, one thousand eight hundred and eighty-eight.

C. L. Peel.

SCHEDULE I.

Form of Declaration.

I* do hereby declare that the [watch case] *or* [watch cases] [brought] *or* [sent] by me this day to the Assay Office at in number and in a parcel marked [was] [were] made in †.

Declared at this day of , 18 .

Before me ‡.

Officer of the aforesaid Assay Office appointed in that behalf *or*, Justice of the Peace for *or*, Commissioner having power to administer oaths in the Supreme Court of Judicature in England.

[Supreme Court of Judicature in Ireland].

[Court of Session in Scotland].

* Here insert name and address of declarant.

† Signature of declarant.

‡ Signature and title of person before whom the declaration is made.

SCHEDULE II. (*c*).

On a foreign gold case:—

Within a shield of the form of a cross, and of the size shown in Figure I. of the Appendix hereto, the word "Foreign," over which a hall mark particular to each office shown in Figure III. and the carat value of the gold, and under which the decimal equivalent of the carat value of the gold together with the variable annual date letter.

On a foreign silver case:—

Within a shield of the form of a regular octagon and of the size shown in Figure II. of the Appendix hereto, the word "Foreign," over which a hall mark particular to each office shown in Figure III. and under which the variable annual date letter.

The particular hall mark above referred to for each of the seven assay offices at which foreign cases may be stamped is shown in Figure V. of the Appendix hereto (*c*).

D.—By Board's Order on No. 37366/1888.

Sardine Trade.

Sardines from Spain and Portugal imported into this country, *marked with names of French places or in the French language*, but without the qualification required by the Merchandise Marks Act, 1887, may be delivered, up to the 30th of June, 1889 (inclusive). After that date, sardines which are not imported from France will not be admitted to this country unless duly qualified, when they bear upon them the names of places in France or descriptions in the French language other than the trade description "sardines à l'huile," which will be admissible on sardines from whatever part of the world they may be imported.

By order,

(Signed) E. Goodwyn.

Custom House, London,
18th December, 1888.

(*c*) The figures referred to are shown in the London Gazette, 9 Dec., 1887, p. 6862.

No. 19.

REGULATIONS made by the Board of Trade with the Concurrence of the Lord Chancellor under Section 2 of the Merchandise Marks Act, 1891, with regard to the Prosecution of Offences under the Merchandise Marks Act, 1887 (*a*).

1. The prosecution of offences under the Merchandise Marks Act, 1887, shall, subject to the condition hereinafter prescribed, be undertaken by the Board of Trade in cases which appear to the Board to affect the general interests of the country, or of a section of the community, or of a trade.

2. Every application to the Board to undertake a prosecution shall be accompanied by the following documents:

(a) A statement showing the nature and circumstances of the case, and sufficient to enable the Board to form an opinion whether the case affects the general interests of the country, or of a section of the community, or of a trade.

(b) A statement showing the facts which, if the Board undertake the prosecution, will be capable of proof, and setting out the proofs and names of the witnesses available to prove such facts.

The Board may require the above statements to be supplemented, or additional evidence to be furnished.

3. If, on the evidence, the Board is of opinion that there is no reasonable prospect of a conviction being obtained, the Board will not, unless it thinks fit, undertake the prosecution.

4. If the Board is of opinion that the prosecution would be better or more properly conducted under some other Act of Parliament other than the said Act, the Board will not undertake the prosecution.

5. The Board may, before undertaking a prosecution, require the applicant to give security for costs on such terms and in such manner as it thinks proper.

6. For the purpose of carrying these regulations into effect, the Board may, from time to time, prescribe the use of such forms and give such directions as it may deem expedient.

M. E. Hicks-Beach,
President of the Board of Trade.

21st May, 1892.

I concur,
Halsbury, C.

(*a*) Statutory Rules and Orders, 1892, p. 973.

REGULATIONS made by the Board of Agriculture, with the concurrence of the Lord Chancellor, pursuant to Section 1 of the Merchandise Marks (Prosecutions) Act, 1894, with regard to the Prosecution of Offences under the Merchandise Marks Act, 1887, relating to Agricultural or Horticultural Produce.

1. The Board of Agriculture shall, where it appears to them from the statements hereinafter mentioned that there is a reasonable prospect of a conviction being obtained, and subject to the other conditions in the next following regulation prescribed, undertake the prosecution of offences under the Merchandise Marks Act, 1887, in cases which appear to the Board to relate to agricultural or horticultural produce and to affect the general interests of the country, or of a section of the community, or of a trade.

2. (i.) Every application to the Board to undertake a prosecution shall be accompanied by the following documents:—

(a) A statement showing the nature and circumstances of the case, and sufficient to enable the Board to form an opinion whether the case relates to agricultural or horticultural produce and affects the general interests of the country, or of a section of the community, or of a trade.

(b) A statement of the facts capable of proof, with the names and addresses of the witnesses available to prove such facts.

(ii.) The Board may require the above statements to be supplemented or additional evidence to be furnished.

3. For the purpose of carrying the foregoing regulations into effect, the Board may, from time to time, prescribe the use of such forms and give such directions as they may deem expedient.

T. H. Elliott,
Secretary to the Board of Agriculture.

27th October, 1894.

I concur,
Herschell, C.

Merchandise Marks (Prosecutions) Act, 1894.

BOARD OF AGRICULTURE,
4, WHITEHALL PLACE,
LONDON, S.W.,
1st February, 1895.

SIR,

I am directed by the Board of Agriculture to say that they think it may be useful that they should communicate to you the following information as to the effect of the Merchandise Marks (Prosecutions) Act, 1894, and as to the procedure to be adopted on applications for prosecutions thereunder.

The Act referred to enabled the Board, with the concurrence of the Lord Chancellor, to make regulations providing that in cases appearing to the Board to relate to agricultural or horticultural produce, and to affect the general interests of the country, or of a section of the community, or of a trade, the prosecution of offences under the Merchandise Marks Act, 1887, should be undertaken by the Board, under such conditions as they might prescribe, and the Board have accordingly, with the concurrence of the Lord Chancellor, made regulations in the following form :—

[The regulations referred to are set out *ante* at p. 841.]

The Merchandise Marks Act, 1887, provided, *inter alia*, that every person who applies any false trade description to goods shall, subject to the provisions of the Act, and unless he proves that he acted without intent to defraud, be guilty of an offence under the Act, and although various other offences of an analogous character are specified in the Act of 1887, the Board apprehend that the provision above cited is that to which it will most frequently be necessary to resort in order to check the malpractices of which complaint has been so generally made amongst British agriculturists.

It is important to observe that the expression "goods" in the Act of 1887 is defined to mean "anything which is the subject of trade, manufacture, or merchandise"; that the expression "trade description" is defined by the Act to mean "any description, statement, or other indication, direct or indirect, (*a*) as to the number, quantity, measure, gauge, or weight of any goods, or (*b*) as to the place or country in which any goods were made or produced, or (*c*) as to the mode of manufacturing or producing any goods, or (*d*) as to the material of which any goods are composed, or (*e*) as to any goods being the subject of an existing patent, privilege, or copyright;" that the use of any figure, word, or mark which, according to the custom of the trade, is commonly taken to be an indication of any of the above

matters, is to be deemed to be a trade description within the meaning of the Act; and, lastly, that the expression "false trade description" is defined to mean "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 that the fact that a trade description is a trade-mark, or part of a trade-mark, is not to prevent such trade description from being a false trade description within the meaning of the Act.

The Board have little doubt that the law as it now stands should be sufficient to enable cases in which fraudulent misrepresentations of the place of origin are applied to agricultural produce to be dealt with as they deserve, and, so far as the Board are concerned, they will be very willing to exercise the new powers which Parliament has conferred upon them with a view to the removal of the sense of grievance which undoubtedly exists on the part of many agriculturists in respect to what they consider and, in the opinion of the Board, very legitimately so, as competition unfair in character.

The Board have certainly no wish that the Act passed last session under their auspices should remain a dead letter so long as any legitimate ground for complaint on the part of home producers remains, but it is beyond the power of the Board to be of assistance in this matter unless agriculturists themselves are able and willing, either individually or through the instrumentality of their various organisations, to co-operate with the Board by bringing under their notice specific cases in which there is *prima facie* ground for believing that an offence under the Act of 1887 has been committed.

The Board would be glad, therefore, if you would take steps to bring this matter under the notice of your fellow members at an early opportunity, with a view to its being considered whether any, and if so, what, action can be taken by them in the direction indicated in the preceding paragraph. Applications which may be made to the Board to undertake prosecutions for offences under the Act of 1887 should comply fully with the requirements of the regulations above set out, and it is desirable that they should be made as soon as possible after the alleged offence has been committed.

I am, Sir,
Your obedient Servant,

T. H. ELLIOTT,
Secretary.

No. 20.

FORMS OF INDICTMENT AND INFORMATION.

Form of Indictment (*a*).

Middlesex } The jurors for our Lord the King upon their
to wit. } oath present that C. D. before and on the day of was the proprietor of a certain trade-mark duly registered in the Register of trade-marks kept under the Patents, Designs and Trade-Marks Act, 1883, and in the said Register numbered ( ) (*b*); and that A. B. on the day of , the said C. D. then being the proprietor of the said trade-mark as aforesaid, unlawfully, and with intent to defraud, did apply the said trade mark to certain goods, to wit [*describing them*], without the assent of the said C. D., contrary to the Merchandise Marks Act, 1887 [*or* the statute in that case made and provided];

Second Count.]—And the jurors aforesaid, upon their oath aforesaid, do further present that C. D., before and on the day of , was the proprietor of a certain trade-mark duly registered in the register of trade-marks kept under the Patents, Designs, and Trade-Marks Act, 1883, and in the said register numbered ( ) (*b*), and that A. B., on the day of , the said C. D. then being the proprietor of the said trade-mark as aforesaid, unlawfully, and with intent to defraud, and without the assent of the said C. D., did apply to certain goods, to wit [*describing them*], a certain mark, to wit [*describing it*], so nearly resembling the said trade-mark as to be calculated to deceive, contrary to the Merchandise Marks Act, 1887 [*or as above*].

Information for an Offence against the Merchandise Marks Act, 1887 (*c*).

In the County of , Petty Sessional Division of .

The information of C. D. [*address and description*], who, upon oath, states that A. B. [*address and description*] on the day of did [*here state the offence, as below*].

Taken before me, J. P.,
Justice of the Peace for the county of aforesaid.

(*a*) It is not necessary to aver that the defendant elected to be tried by jury. See *R.* v. *Chambers*, 65 L. J. M. C. 214; 18 Cox, C. C. 401 (1896), Lord Russell of Killowen, C. J., Pollock, B., Hawkins, Grantham and Lawrance, JJ., C. C. R.

(*b*) If the date of the offence charged is more than one year before that of the presentation of the indictment, add, "and that the said C. D. first discovered the commission of the offence herein charged after the of ." See sect. 15.

(*c*) Summary Jurisdiction Rules, 1886, r. 31; the information must be for one offence only, Summary Jurisdiction Act, 1848, s. 10. Informations are not usually in writing or upon oath in summary cases.

Statement of Offences (*d*).

Unlawfully and with intent to defraud did forge a certain trade-mark duly registered in the Register kept under the Patents, Designs and Trade-Marks Act, 1883, and therein numbered , of which trade-mark one C. D. was then the proprietor, within the meaning of the Merchandise Marks Act, 1887, contrary to the said Act.

Unlawfully and with intent to defraud did falsely apply to certain goods, to wit [*describing them*], a certain trade-mark duly registered [*as above*], of which [*as above*], within the meaning of the Merchandise Marks Act, 1887, contrary to the said Act.

Unlawfully and with intent to defraud did apply to certain goods, to wit, gelatine (on the day of , sold by the said A. B. to), a false trade description as to the materials of which such goods were composed, by which description the said goods were falsely indicated to be isinglass (*e*), contrary, &c.

Unlawfully and with intent to defraud did sell [*or* did expose for sale] certain goods, to wit, gelatine (on the day of , sold by the said A. B. to), to which had been applied a false trade description as to the materials of which such goods were composed, whereby the goods were falsely indicated to be isinglass (*e*), contrary, &c.

Unlawfully and with intent to defraud did apply a false trade description, whereby the said goods were falsely described to be subject to an existing patent (*e*), contrary, &c.

Unlawfully did sell [*or* did expose for sale] certain goods, to wit [*describing them*], to which a false trade description had been applied (*e*), contrary, &c.

At the parish of Saint Michael in the said city, on the 16th of January, 1890, unlawfully did apply a certain false trade description, namely, the word "barrel," to certain goods, to wit, to a certain cask of beer, false as to the measure [*or* gauge] thereof, contrary to the provisions of the Merchandise Marks Act, 1887 (*f*).

On the 7th and 11th of February, 1889, at Purfleet, in the parish of , and the county of , unlawfully did apply [*or* cause to be applied] a false trade description, to wit, the letters, figures, and words "Gunpowder, Chilworth Gunpowder Company, R.L.G.4," to certain goods, viz., gunpowder, contrary to the statute 50 & 51 Vict. c. 28, s. 2 (*g*).

(*d*) See note (*c*).
(*e*) See *Gridley* v. *Swinborne*, 52 J. P. 791.
(*f*) *Budd* v. *Lucas*, 55 J.P. 550.
(*g*) *Starey* v. *Chilworth Gunpowder Co.*, 54 J. P. 436.

No. 21.

STATUTES REQUIRING PARTICULAR CLASSES OF GOODS TO BE MARKED IN A SPECIFIED MANNER (*a*) IN ENGLAND (*b*).

ANCHORS AND CHAIN CABLES.]—Manufacturer to place his name or initials and the number and weight of the anchor on every anchor (57 & 58 Vict. c. 60, s. 543); contract for sale of chain cable or anchor exceeding in weight 168 lbs. to imply a warranty of testing and stamping (62 & 63 Vict. c. 23, s. 2 (1)); no chain cable or anchor of greater weight than 168 lbs. to be sold unless tested and stamped according to the Anchor and Chain Cables Act, 1899 (62 & 63 Vict. c. 23, s. 1 (1)).

BREAD.]—Penalty for making or exposing for sale any bread made wholly or partially of peas, beans, potatoes (not including potato-yeast), or any sort of corn or grain other than wheat, unless it be marked with a Roman M. The Act applies only beyond ten miles from the Royal Exchange, London. 6 & 7 Will. 4, c. 37, s. 10. But the same provision is made for the excepted area by 3 Geo. 4, c. cvi.

BUTTER.]—Imitations of butter to be sold only as "margarine." *See* "Margarine."

BUTTONS (metal).]—Penalties for marking, ordering, or exposing for sale any words or marks denoting quality on metal buttons, or any words or marks on the undersides thereof, unless the buttons be silver-plated or gold-gilt; only the marks, gilt, plated, double or treble gilt to be marked; penalties for falsely marking buttons; Act not to extend to buttons of gold, silver, tin, pewter, lead, tin and lead, tinned iron, Bath metal, white metal, any of these metals inlaid with steel, or buttons plated on shells. 36 Geo. 3, c. 60.

CARDS.]—Playing cards (except toy cards) to be sold in stamped wrappers. 25 & 26 Vict. c. 22, ss. 1, 2, 28, 36; 27 & 28 Vict. c. 56, s. 6. So as to foreign cards. 16 & 17 Vict. c. 107, ss. 114—116; 39 & 40 Vict. c. 36, s. 286.

CHAIN CABLES.]—*See* "Anchors."

(*a*) A more detailed summary of all or most of these statutes will be found in Mr. Safford's "Law of Merchandise Marks," Appendix D., and in Mr. Sebastian's "Trade-Marks." I am indebted to the former book for the suggestion of many of the classes of goods referred to, and to the Official Index to Statutes for reference to the statutes mentioned under the different heads. Statutes (as the Copyright Acts, for example) which require marks to be put upon particular goods in order to secure some right or privilege (as copyright in designs, for instance) are not here included. They would naturally be sought for in works devoted to the law regarding the rights or privileges in question.

(*b*) The Scotch and Irish statutes are given by Mr. Safford.

CHICORY AND COFFEE.]—Imitations of coffee and coffee mixtures not to be sold, except in packets containing one or more quarters of a pound, each packet bearing a label showing the amount of duty, and a label showing the constituents of the mixture. 45 & 46 Vict. c. 41, s. 6.

CLOCKS.]—Bearing marks implying manufacture in the United Kingdom not to be imported. 39 & 40 Vict. c. 36, s. 42.

CUTLERY.]—*See* above, p. 641, and Sheffield marks, p. 101.

GOLD.]—*See* "Plate."

GUNPOWDER.]—If sold in quantities greater than 1lb., to be packed in closed packages and labelled "Gunpowder." 38 & 39 Vict. c. 17, s. 32.

HOPS.]—Bags to be marked with the name of the owner, the parish and county where they were grown, and the date, number, and weight; penalty for false marking. 54 Geo. 3, c. 123, s. 1; 29 & 30 Vict, c. 37, s. 2. Implied warranty that the marks are genuine. 29 & 30 Vict. c. 37, s. 18.

LINEN.]—Penalties for affixing counterfeit marks to linen. 17 Geo. 2, c. 30; 18 Geo. 2, c. 24. English linen for exportation to be marked with name and place of abode of the maker and of the exporter, the year and number and length. 18 Geo. 2, c. 24, s. 2.

MARGARINE.]—All imitations of butter to be sold, and marked, when exposed for sale, as "margarine." 50 & 51 Vict. c. 29, ss. 3—7. Penalties for dealing in, selling, or exposing for sale any margarine contrary to the Act. *Ibid.* s. 7. *See* also the Sale of Food and Drugs Act, 1899 (62 & 63 Vict. c. 51).

MEDALS (Exhibition).]—Penalties for false representations as to grants of medals or certificates of the Exhibitions of 1851 or 1862. 26 & 27 Vict. c. 119.

PLATE (*bb*).]—The rules regulating the marking and standards of fineness required and allowed in respect of gold and silver goods are contained in the statutes referred to below (*c*). They require to be marked on the goods the first letters of the christian and surnames of the worker (12 Geo. 2, c. 26, s. 5), and the *assay mark* of the town where the goods were made, or (if they were not made in an assay town) marked (2 Hen. 6, c. 17, London; 12 & 13 Will. 3, c. 4, York (*d*), Exeter, Bristol (*e*), Chester, and Norwich (*d*); 1 Anne, c. 3, Newcastle-on-Tyne; 13 Geo. 3, c. 52, Sheffield; 5 Geo. 4, c. lii. s. 1, *local*, Birmingham), the variable or date mark to show the year of marking (12 & 13 Will. 3, c. 4, s. 3; 12 Geo. 2, c. 26, s. 5). And, in addition, on gold wares of twenty-two or eighteen carats fineness, the *standard* and *quality* marks of a crown and 22 (7 & 8 Vict. c. 22, s. 15), or a crown and 18 (38 Geo. 3, c. 69, s. 2) respectively; and on silver wares of 11 ozs. 10 dwts. and 11 ozs. 2 dwts. fineness, the standard

(*bb*) See Encyclopædia Britannica, "Plate."

(*c*) These statutes are summarized by Mr. Sebastian, 4th ed., p. 614, and Mr. Safford, p. 204.

(*d*) The marks for these towns are now discontinued.

(*e*) Bristol never exercised its right to mark: Sebastian, 4th ed., p. 614.

marks of Britannia and a lion *passant* respectively (6 Geo. 1, c. 11, s. 41; 12 Geo. 2, c. 26), and a *duty* mark (*f*) of the king's head. (24 Geo. 3, sess. 2, c. 53, s. 5.)

Before 1854, gold wares were required to be of either twenty-two or eighteen carats fineness (38 Geo. 3, c. 69); but her Majesty was authorized, under an Act of that year (17 & 18 Vict. c. 96), by Order in Council, to allow any standard for gold plate not being less than one-third part of the whole in fine gold, and to approve any instrument for stamping or marking the wares, setting forth in figures the actual fineness thereof according to the standard declared. The new inferior standard gold wares were declared not to be liable to duty. Under this Act, the nine, twelve, and fifteen carat gold standards have been authorized.

Silver wares must all be of either the 11 ozs. 10 dwts. or 11 ozs. 2 dwts. of silver to the pound troy standard. (6 Geo. 1, c. 11.)

The following wares are exempted from marking:—chains, necklace beads, lockets, filigree work, shirt buckles or brooches, stamped medals, or spouts to china, stone, or earthenware tea-pots, or any of them, of any weight; tippings, swages, or mounts, or any of them, not exceeding 10 dwts. of silver each, except only necks and collars for castors, cruets, or glasses, appertaining to any sort of stands or frames; silver goods not weighing 5 dwts., except necks, collars, and tops for castors, cruets, or glasses appertaining to any sort of stands or frames, buttons to be affixed or set on any wearing apparel, solid sleeve buttons, and solid studs, not having a bissiled edge soldered on, wrought seals, blank seals, bottle tickets, shoe clasps, patch boxes, salt spoons, salt shovels, salt ladles, tea-spoons, tea-strainers, caddy ladles, buckles (shirt buckles or brooches before mentioned excepted), and pieces to garnish cabinets, or knife cases, or tea-chests, or bridles, or stands, or frames. (30 Geo. 3, c. 31.) Gold wedding rings are to be marked as gold plate. (18 & 19 Vict. c. 60, s. 1.)

Imported foreign plate, except ornamental plate, made before 1800 (5 & 6 Vict. c. 56, s. 6), is to be marked as English plate (5 & 6 Vict. c. 47, s. 59), and with the figure F. on an oval shield. (39 & 40 Vict. c. 35.)

Penalties for counterfeiting assay marks and connected offences are provided by 7 & 8 Vict. c. 22.

The importation of clocks and watches, or any other article of metal impressed with any mark or stamp, representing or in imitation of any legal British assay mark or stamp, or purporting by any mark or appearance to be of the manufacture of the United Kingdom, is forbidden (39 & 40 Vict. c 36, s. 42).

Watch cases of foreign manufacture brought for assay to any assay office in the United Kingdom are to be marked as directed by the Order in Council of the 28th of November, 1887 (p. 837),

(*f*) The duty on plate is now abolished: 53 Vict. c. 8, s. 10.

made under the Merchandise Marks Act, 1887, s. 8, that is to say, with the word "foreign," and a shield which is cross-shaped for gold and octagon-shaped for silver (p. 622).

PLATED GOODS.]—Makers of plated goods in Sheffield, or within 100 miles thereof, are authorized to strike on their goods their surnames, or the names of their firm, with a mark (not being an imitation of an assay-mark) which is approved by the guardians of the assay office and registered (24 Geo. 3, sess. 2, c. 20, ss. 2 and 3).

SILVER.]—*See* "Plate."

STORES (PUBLIC).]—The marks enumerated below to denote that stores to which they are affixed are his Majesty's property; the marks not to be applied by unauthorized persons (*a*); obliterating the marks with intent to conceal his Majesty's property in the stores is a felony; regimental necessaries, &c., issued to soldiers, militiamen, or volunteers are excepted from the Act (38 & 39 Vict. c. 25; 44 & 45 Vict. c. 58, s. 156).

Stores.	Marks.
Hempen cordage and wire rope	White, black, or coloured worsted threads laid up with the yarns and wire respectively.
Canvas, fearnought, hammocks, and seamen's bags.	A blue line in a serpentine form.
Bunting	A double tape in the warp.
Candles	Blue or red cotton threads in each wick, or wicks of red cotton.
Timber or metal. Any stores not before enumerated, whether similar to the above or not.	The name of her Majesty (Queen Victoria), her predecessors, her heirs or successors, or of any public department or any branch thereof, or the broad arrow, or a crown, or her Majesty's arms, whether such broad arrow, crown, or arms be alone or be in combination with any such name as aforesaid, or with any letters denoting any such name.

TOBACCO.]—Cavendish and negro-head tobacco to be delivered for home consumption in separate packets not exceeding 1 lb. or less than 1 oz. in weight, and wrapped in a wrapper and label approved by the Commissioners of Customs; not to be sold, or had in possession, except wrapped and labelled as aforesaid; penalties for forging labels (26 & 27 Vict. c. 7, ss. 3—8).

WEIGHTS AND MEASURES.]—To be marked with proper indicating marks: see the Acts 41 & 42 Vict. c. 49; 52 & 53 Vict. c. 21.

YARN.]—Penalty for reeling short lengths of yarn, 17 Geo. 3, c. 11 (ss. 17—19, 24, in part repealed by the S. L. Rev. Act, 1861; ss. 12, 22, repealed in part; ss. 20, 23, repealed by 47 & 48 Vict. c. 43, s. 4; and s. 24 by 56 & 57 Vict. c. 61, s. 2).

(*a*) See 28 & 29 Vict. c. 89, s. 45 (Greenwich Hospital Mark), and 38 & 39 Vict. c. 25, s. 17.

No. 22.

COLONIAL AND FOREIGN LAWS AS TO MERCHANDISE MARKS.

I.—The Colonies.

[See as to places where exterritorial jurisdiction is regulated under the *Foreign Jurisdiction Acts*, p. 763.]

AUSTRALIA—NEW SOUTH WALES (No. 9 of 1865).]—The statute is called "The Trade-Marks Act, 1865," and only a few of its provisions deal with the criminal law of false marking. Forging a trade-mark or falsely applying any trade-mark to any chattel or article with intent to defraud (sect. 8), and applying a forged trade-mark to any vessel, case, wrapper, &c., in or with which any article is sold or intended to be sold (sect. 9), are misdemeanours. Penalties are attached to selling articles with forged or false trade-marks (sect. 10), marking any false indication of quantity, &c., upon an article with intent to defraud (sect. 13), selling or exposing for sale articles with false statements of quantities, &c. (sect. 14); but it is not an offence to apply names or words known to be used for indicating particular classes of manufactures (sect. 15). As to procedure, see sects. 16—24.

QUEENSLAND.]—There is no special statutory law as to merchandise marks. The Acts No. 13 of 1884, No. 5 of 1886, and No. 8 of 1890, which are closely modelled on the Imperial Acts, deal with trade-marks.

SOUTH AUSTRALIA (No. 551 of 1892).]—Sects. 45—62 deal with merchandise marks, and are practically a transcript of the M. M. A. 1887.

VICTORIA (54 Vict. No. 1146).]—The provisions as to forgery, &c., of trade-marks and false trade descriptions (sects. 12, 13, 14) are substantially identical with those of the M. M. A. 1887. In case of charges of marking dies, blocks, &c., there is an exemption of persons employed in work of the kind in the ordinary course of business (sect. 16). Watch-cases are expressly dealt with in sect. 17. As to procedure, see sects. 18—25. The Customs regulations are contained in sect. 26. There is an implied warranty on the sale of marked goods that the mark is genuine, and that any trade description applied to the goods is not false (sect. 27). There is an exemption similar to that in the M. M. A. 1887 of conventional descriptions from the provisions of the Act as to false trade descriptions (sect. 28). Similar provisions occur in nearly all the colonial Acts relating to merchandise marks. (No. 6 of 1888.)

WESTERN AUSTRALIA.]—Practically a transcript of the M. M. A. 1887.

BAHAMA ISLANDS.]—There is no special statutory law as to merchandise marks.

BARBADOS (No. 28 of 1888—89; No. 7 of 1896).]—The Act is closely modelled on the M. M. A. 1887. There are provisions similar to those noted under "Victoria," *supra*, as to watch-cases (No. 28 of 1888-9, s. 7), Customs regulations (sect. 13), implied warranty on the sale of marked goods (sect. 14), and conventional descriptions (sect. 15). No. 7 of 1896 deals with the registration of marks; it is amended on a point of detail by No. 16 of 1897.

BERMUDA (No. 17 of 1889).]—The Act is closely modelled on the M. M. A. 1887.

BRITISH GUIANA (No. 2 of 1888).]—Practically a transcript of the M. M. A. 1887.

BRITISH HONDURAS (No. 3 of 1888).]—Practically a transcript of the M. M. A. 1887.

BRITISH INDIA (No. 4 of 1889).]—Closely modelled on the M. M. A. 1887. Piece goods, such as are ordinarily sold by length or by the piece, which have been manufactured in premises which are a factory under the Indian Factories Act, 1881, are not to be removed from those premises without having conspicuously stamped in English numerals on each piece the length thereof in standard yards, or in standard yards and a fraction of such a yard, according to the real length of the piece (sect. 12 (1)). The penalty for contravention of this provision, besides forfeiture of the piece, is a maximum fine of 1,000 rupees (sect. 12 (2)) (*a*).

BRITISH NEW GUINEA.]—No statutory law as to merchandise marks exists.

BRITISH NORTH BORNEO.]—No statutory law as to merchandise marks exists.

CANADA (51 Vict. c. 41; Crim. Code, 1892, Pt. 33, ss. 443—455).]—Closely modelled on the M. M. A. 1887. There are special provisions as to the fraudulent marking of bottles (51 Vict. c. 41, s. 7, and Crim. Code, 1892, s. 449); words or marks on watch-cases (sect. 11, and Crim. Code, 1892, s. 444); prohibiting the importation of specified goods (sect. 22, and Crim. Code, 1892, s. 452); and as to implied warranty on sale of marked goods (sect. 18).

CAPE OF GOOD HOPE (No. 12 of 1888; No. 14 of 1889).]—Practically a transcript of the M. M. A. 1887.

CEYLON (No. 13 of 1888, and No. 14 of 1892).]—Practically a transcript of the M. M. A. 1887. No. 14 of 1892 enacts provisions as to piece goods similar to those noted *supra* under BRITISH INDIA.

CYPRUS (No. 12 of 1892).]—Practically a transcript of the M. M. A. 1887.

FALKLAND ISLANDS (No. 1 of 1889; No. 14 of 1889).]—Practically a transcript of the M. M. A. 1887.

(*a*) See further, on Indian Marks, p. 863.

FIJI ISLANDS (No. 12 of 1889; No. 2 of 1890).]—Practically a transcript of the M. M. A. 1887.

GAMBIA (No. 11 of 1888).]—Practically a transcript of the M. M. A. 1887.

GIBRALTAR (No. 4 of 1888).]—Practically a transcript of the M. M. A. 1887.

GOLD COAST COLONY (No. 4 of 1888; No. 16 of 1888).]—Practically a transcript of the M. M. A. 1887. Sect. 308 (8) of the Criminal Code (No. 12 of 1892) applies the provisions of that Code as to forgery to the forgery of trade-marks. Folded woven goods are partly exempted from the provisions of No. 4 of 1888. (No. 2 of 1894, s. 16.)

GRENADA (No. 9 of 1889).]—Practically a transcript of the M. M. A. 1887.

HONG KONG (No. 15 of 1890).]—Practically a transcript of the M. M. A. 1887. And see Regulations made by Governor in Council, 13th July, 1891 (*Gazette*, 1st August, 1891).

ISLE OF MAN.]—Merchandise Marks Act, 1898, closely modelled on the M. M. A. 1887. Sect. 17 imposes penalties on any person who falsely represents that any goods are made by a person holding a royal warrant, or for the service of her Majesty or of any of the Royal Family, or any Government department.

JAMAICA (Nos. 18 and 22 of 1888).]—Practically a transcript of the M. M. A. 1887.

LABUAN (No. 3 of 1891).]—Practically a transcript of the M. M. A. 1887.

LAGOS (No. 8 of 1888, and No. 13 of 1889).]—Practically a transcript of the M. M. A. 1887. Folded woven goods are partly exempted from No. 8 of 1888. (No. 5 of 1893, s. 17.)

LEEWARD ISLANDS (No. 34 of 1887; No. 10 of 1890).]—No. 34 of 1887 is practically a transcript of the M. M. A. 1887. No. 10 of 1890 prohibits the importation of goods unless marked with the name of the country in which they were made (sect. 1 (1)), and provides that goods marked with the name or imitation of the name of a place in the United Kingdom, or the colony, or any British possession, unless the name of the country is given, are to be treated as if such place were in British territory (sect. 1 (4)).

MAURITIUS (No. 13 of 1888; No. 6 of 1896).]—No. 13 of 1888 is practically a transcript of the M. M. A. 1887. No. 6 of 1896 deals with a minor point of evidence on Customs prosecutions.

NATAL (No. 22 of 1888; No. 11 of 1889).]—Practically a transcript of the M. M. A. 1887.

NEW ZEALAND (No. 12 of 1889).—Sects. 89—105 deal with merchandise marks and are practically a transcript of the M. M. A. 1887.

NEWFOUNDLAND (c. 31 of 1888).]—Practically a transcript of the M. M. A. 1887. C. 12 of 1891 is a minor amending Act.

St. Lucia (No. 106, Laws of St. Lucia (1888)).]—Practically a transcript of the M. M. A. 1887. And see the Crim. Code, 1888 (No. 101, Laws of St. Lucia), ss. 112, 113.

St. Vincent (No. 8 of 1885).]—Practically a transcript of the M. M. A. 1887.

Sierra Leone (Nos. 7 and 12 of 1889).]—Practically a transcript of the M. M. A. 1887. Folded woven goods are partly exempted from the operation of these Ordinances (No. 1 of 1894, s. 15).

Straits Settlements (No. 3 of 1888).]—Practically a transcript of the M. M. A. 1887.

Tasmania (No. 6 of 1893).]—Sects. 90—105, deal with merchandise marks and are practically a transcript of the M. M. A. 1887.

Trinidad and Tobago (No. 7 of 1888).]—Practically a transcript of the M. M. A. 1887.

II. Foreign Law.

Provisions as to False Marking (*a*).

Austria-Hungary (Law of 1890).

Sect. 23. Whoever introduces into commerce goods for sale, well knowing that the same are illegally provided with a mark in which another person possesses the sole right, or whoever designedly imitates a mark, shall be guilty of a misdemeanour and be fined with a sum not less than 500 florins, and not exceeding 2,000 florins, or be punished with imprisonment for a term of from three months to one year, to which may be also added a fine of a sum not exceeding 2,000 florins.

Besides this, the application of the more rigid stipulations of the general penal code, especially those referring to the crime of fraud, is not excluded (sect. 197, &c.).

Sect. 24. The provision of sect. 23 is also applied against any person who introduces into commerce goods, well knowing that the same have been illegally marked with the name, the firm, the arms, or the business description of the undertaking of a producer or a trader, and also against the person who designedly manufactures the said marks for this purpose.

Sect. 25. The punishment of the acts mentioned in sects. 23 and 24 is also imposed in cases where the mark, the name, the firm, the arms, or the business description of the undertaking are reproduced with such slight alterations that the difference

(*a*) This summary is condensed from the *Reports from Her Majesty's Representatives Abroad on Trade-Marks Laws and Regulations*, Part 1900.

can only be distinguished by the purchaser of those goods with more than ordinary attention.

Sect. 26. The procedure and decision of the transgressions described in sects. 23 and 24 belong to the common Courts of law.

Prosecution only takes place at the application of the injured party.

Sect. 27. At the demand of the injured party it must be decreed that the tools and apparatus which have been exclusively or especially used for the imitation or illegal denotations be made unserviceable, that the stock then in hand of imitated marks and illegally manufactured descriptions be destroyed, and that the illegally fixed marks and descriptions on goods in the possession of the convicted person be removed therefrom, and from the wrappers, even if this would lead to the destruction of the goods.

The verdict may be published by the injured party at the expense of the convicted person, and must contain, in accordance with the suggestions of the injured party, stipulations how and when this publication is to take place.

In place of the compensation due to the injured party, according to common law, the Criminal Court may decree that, in addition to the punishment, the convicted must pay to the injured party a sum not exceeding 5,000 florins. All persons condemned to pay a fine are liable jointly and separately for the payment of the same. The stipulations of this paragraph are also to be put into practice if the punishment takes place in accordance with a more rigid stipulation of the penal code.

Sect. 28. The injured party is entitled to demand the seizure, or at least the taking in safe custody, of the articles mentioned in sect. 27, para. 1, as also that the necessary measures be carried out to prevent a repetition of the criminal act, even before the judgment is pronounced.

The Criminal Court must at once decide with reference to this demand, and may decree the seizure or the custody of the articles in question, against security to be found by the injured party.

Sect. 29. In case the injured party demands the adjudgment of damages in civil law for one of the offences mentioned in sects. 23 and 24, the judge has to decide with reference to the existence as also to the extent of the injury, according to his unbiassed judgment, taking all the facts disclosed into consideration.

Sect. 30. The Minister of Commerce decides as to the sole right vested in a mark, as to the priority and transfer of the same, and also whether a registered mark may be used by a third person for a different kind of goods (sect. 7).

Should it appear during the criminal proceedings in one of the cases mentioned in sect. 23, that the decision depends on a preliminary question, which, according to the first part, is to be

settled by the Minister of Commerce, the Criminal Court is bound to apply to the said Minister for such decision, to forward to him all the required documents, and to await his decision.

Sect. 31. Infringements of the stipulations mentioned in sect. 6 are to be punished by the political authorities in accordance with the stipulations of the Trade Law, whereby always the seizure of the goods is to be decreed.

France.

(Law of 23rd June, 1857.)

Art. VII., Sect. 1. The following persons are liable to a fine of from 50 francs to 3,000 francs, and to imprisonment for from three months to three years, or to one of such penalties only :—

1. Those who have counterfeited or made use of a counterfeit mark ;
2. Those who have fraudulently affixed to their goods, or the articles in which they trade, a mark belonging to others ;
3. Those who have knowingly sold or displayed for sale one or more articles bearing a counterfeit mark, or to which a mark has been fraudulently affixed.

Art. VIII. The following are liable to a fine of from 50 francs to 2,000 francs and to imprisonment for from one month to one year, or to one of such penalties only :—

1. Those who, without having counterfeited a mark, have fraudulently imitated it in a way calculated to deceive a purchaser, or who have made use of a mark fraudulently imitated;
2. Those who have made use of a mark having characteristics (*indications*) apt to deceive a purchaser as to the nature of the goods ;
3. Those who have knowingly sold or exposed for sale one or more articles bearing a mark fraudulently imitated, or having characteristics (*indications*) apt to deceive a purchaser in relation to the nature of the goods.

Art. IX. The following are liable to a fine of from 50 francs to 1,000 francs, or to imprisonment for from a fortnight to six months, or to one of such penalties only :—

1. Those who have not affixed to their goods a mark which is compulsory ;
2. Those who have sold or offered for sale articles not bearing a mark compulsory for such articles ;
3. Those who have infringed the provisions of the decrees issued pursuant to Article 1 of the present law.

Art. X. The penalties provided by the present law cannot be cumulated.

The highest penalty only is inflicted for all acts done before the commencement of proceedings.

ART. XI. The penalties inflicted by Articles 7, 8, and 9 may be doubled in case of a fresh offence. A sentence for any offence under this Act delivered within the next preceding five years makes the accused an old offender for the purposes of this Act.

ART. XII. Article 463 of the Penal Code is applicable to offences provided for in the present Act.

ART. XIII., Sect. 1. Offenders, moreover, may be deprived of the right of voting at the elections for Tribunals and Chambers of Commerce, for the Consultative Chambers of Arts and Manufactures, and for the *Conseils de Prud'hommes*, for a period not exceeding ten years.

Sect. 2. The Court may order the publication of the sentence in such places as it may deem fit, as well as its insertion wholly or partially in such newspapers as it may appoint at the expense of the person against whom such sentence is delivered.

ART. XIV., Sect. 1. The Court may even on acquittal order the confiscation of goods bearing marks contrary to the provisions of Articles 7 and 8, as well as of the instruments and tools which have been specially employed for the commission of the offence.

Sect. 2. The Court may order delivery of the confiscated objects to the owner of the infringed mark, irrespectively of further damages where such owner is entitled to them.

Sect. 3. It shall in every case order the destruction of marks found to be an infringement of the provisions of Articles 7 and 8.

ART. XV., Sect. 1. In the case provided for by the first two paragraphs of Article 9, the Court shall order that marks be affixed to articles for which they are obligatory by law.

Sect. 2. The Court may order the confiscation of such articles where the defendant has been convicted within the next preceding five years of an offence provided against in the first two paragraphs of Article 9.

ART. XIX., Sect. 1. All foreign articles bearing either the trade-mark or the name of a manufacturer residing in France, or the name or place of a French manufactory, are prohibited from entering or passing through France, or being warehoused there, and may be seized wherever found, either by the Customs authorities or at the instance of the Public Procurator or of the person whose rights are infringed.

Sect. 2. Where the seizure is made at the instance of the Customs authorities, a minute of the seizure shall at once be transmitted to the Public Procurator.

Sect. 4. The provisions of Article 14 are applicable to goods seized pursuant to the present article.

ART. XX. All the provisions of the present Act are applicable to wines, alcohols, and other drinks, to cattle, grain, flour, and generally to all agricultural products.

ART. XXII., Sect. 1. The present Act shall not come into force until six months after its promulgation.

Sect. 2. An administrative order shall specify the formalities to be observed in regard to registration, and publication of trade-marks, and any other measures requisite for the enforcement of the law.

ART. XXIII. Subject to the provisions of this Act previous enactments shall remain in force.

(Law of November 26, 1873.)

ACT *to Establish a Stamp or Special Mark to be Affixed to Trade and Merchandise Marks.*

ART. I. On written application by the owner of a trade-mark registered in accordance with the Act of June 23, 1857, whether the said trade mark be marked upon labels, bands, or envelopes of paper, or upon plaques of metal, the Government shall apply a special stamp or puncheon for the purpose of guaranteeing the authenticity of such trade-mark. The puncheon may be applied to the trade-mark forming part of the article itself, if the authorities think it fit to receive such application.

ART. II. A fee, varying from one centime to one franc, shall be paid to the State for every affixing of the stamp. The fee shall be not less than five centimes and not exceed five francs for every application of the puncheon to the articles themselves.

ART. III., Sect. 1. The amount of the fees payable to the Treasury shall be proportionate to the value of the articles to which the labels are to be attached, whether in paper or in metal, and to the difficulty of applying the puncheon to the marks affixed to the articles themselves.

Sect. 2. An administrative order shall determine such proportion; it shall also specify the metals to which the puncheon may be applied, the conditions to be complied with for obtaining the application of a stamp or puncheon, the place where such application shall be effected, and other measures for carrying out the present Act.

ART. IV. The sale by the owner of the trade-mark of the articles protected thereby at a higher price than that corresponding to the proportion of the stamp or puncheon shall be punishable for each offence by a penalty of 100 francs to 5,000 francs. Such offences shall be published in every place open to the public by the officials authorized to report offences relating to

stamps and indirect taxes, and by post-office and custom-house officials in case of exportation. These officials shall receive one-fourth of the penalty recovered. The offences shall be reported and the prosecution shall take place:—(1) as in stamp matters where the stamp has been affixed to labels, bands, or wrappers in paper; (2) as in matters of indirect taxes, where a stamp has been applied by puncheon.

ART. V. French consuls abroad are qualified (*auront qualité*) to draw up reports concerning the fraudulent use of trade-marks, and to forward the same to the competent authorities.

ART. VI. Any person who shall counterfeit or forge the stamps or puncheons instituted by this Act, and who shall make use of counterfeit or forged stamps or puncheons, shall be punished according to the provisions of Article 140 of the Penal Code, irrespectively of civil damages. Any other fraudulent use of such stamps or puncheons, or of labels, bands, wrappers, or plaques, stamped therewith, shall be punished according to the provisions of Article 142 of the said Code. Article 463 of the Penal Code is applicable thereto.

ART. VII. The stamp or puncheon of the State applied to a trade-mark shall form an integral part of the said mark. If the State should fail to prosecute, in France or abroad, the counterfeiting or forgery of such stamp or puncheon, the owner of the mark may himself prosecute.

ART. VIII. The present Act shall be applicable in the French Colonies and in Algeria.

ART. IX. The provisions of other laws in force relating to trade names, merchandise and trade-marks, designs and models shall be applicable in favour of foreigners, if the laws of their country or international treaties insure the same protection to Frenchmen.

(Law of November 26, 1873.)

ART. IX. The provisions of other laws in force relating to trade names and merchandise marks (*nom commercial*), . . . shall be applicable in favour of foreigners, if in their country the laws (*la législation*) or international treaties insure the same protection to Frenchmen.

(Law of July 28, 1824.)

Merchandise Marks and Trade Names.

ART. I., Sect. 1. Any person who shall affix or by adding, shortening, or any other alteration, shall cause to appear on manufactured goods the name of any manufacturer but their real manufacturer, or the name of any manufactory but that at which the goods were manufactured, or the name of any place

but that of manufacture, will be liable to the penalties prescribed by Article 423 of the Penal Code, and to damages where a right to them exists.

Sect. 2. Every merchant, commission agent, or tradesman will be liable to prosecution who knowingly exhibits for sale or sells goods marked with pretended or altered names.

Art. II. The above-mentioned offence will consequently cease, in spite of Article 17 of the law of April 12, 1803 (22 Germinal, year XI), to be assimilated to the counterfeiting of special marks provided for by Articles 142 and 143 of the Penal Code.

Germany.

(*Law of May 12th*, 1894.)

Sect. 14. Any person who knowingly, or through gross negligence, wrongfully applies to goods, their packings or coverings, advertisements, price lists, business letters, circulars, or the like, the name or firm of another party or a trade-mark registered according to the provisions of this Act, or puts goods so marked on the market, or offers same for sale, is bound to indemnify the injured party.

If he has knowingly made use of the mark he will be further punished by a fine of 150 to 5,000 marks (7*l.* 10*s.* to 250*l.*), or by imprisonment not exceeding six months. The prosecution is only instituted on petition. The petition can be withdrawn.

Sect. 15. Any person who, for the purpose of fraudulent trading, applies to goods or their packings or coverings, or advertisements, price lists, business letters, circulars, invoices, or the like, a design used in the trades concerned for distinguishing another person's similar goods, without the permission of such person; or any person who, for the same purpose, puts on to the market or offers for sale goods so marked is bound to indemnify the injured party, and will be punished by a fine of 100 to 3,000 marks (5*l.* to 150*l.*), or by imprisonment not exceeding three months. The prosecution is only instituted on petition. The petition can be withdrawn.

Sect. 16. Any person who wrongfully applies to goods or their wrappers or packings, or to advertisements, price lists, business letters, circulars, bills, or the like, a State coat-of-arms, or the name or coat-of-arms of a district, of a municipal or corporate body, for the purpose of creating confusion as regards the nature and value of the goods; or any person who offers goods bearing such mark for sale, will be punished by a fine of 150 to 5,000 marks (7*l.* 10*s.* to 250*l.*), or by imprisonment not exceeding six months.

The employment of names which, according to trade custom, serve to designate certain products on the market without being

destined to show their origin, is not subject to these prescriptions.

Sect. 17. Foreign products which wrongfully bear the name and locality of a German firm, or which wrongfully bear a registered trade-mark, on entering Germany as imports or for transit through the country, are liable to seizure and confiscation, if the injured party files a petition to that effect, and gives security. The seizure is effected by the Custom-house authorities, and the confiscation is decided according to the Penal Code of the Department of Administration (sect. 459 of the Criminal Code).

Sect. 18. In lieu of all damages arising according to the present Act, an amercement not exceeding 10,000 marks (500*l.*), in addition to the penalty, may be adjudged to the injured party if he so demands.

The condemned are liable for this amercement as joint debtors.

Such acknowledged amercement precludes all further rights to claim damages.

Sect. 19. If verdict is given on the basis of sects. 14, 15, 16, and 18, the sentence must provide that the illegal mark on the goods found in the possession of the condemned party be removed, or, when it is not possible to remove the mark in any other way, that the goods bearing such mark be destroyed.

If verdict is given in the criminal procedure in the instance of sects. 14 and 15, the injured party shall have the right to publish the sentence at the expense of the condemned party. The kind of publication and the term for making same is to be fixed in the verdict.

Sect. 20. The application of the prescriptions of this Act is not excluded from taking effect in the case of variations in the reproduction of foreign names, firms, designs, coats-of-arms, and other designations for goods, if, in spite of such variations, there is any danger of confusion arising in the trade.

Sect. 22. If German goods must bear a certain mark or signification on being imported into, or for transit through, a foreign country, to show that they are of German origin, or if such goods are not so favourably treated at the Custom-house in respect of trade-marks as the goods of other countries, the Federal Council is empowered to subject goods imported into Germany from such foreign countries, or for transit through the country, to the same obligations; and to order that, in case of violation of this regulation, the goods shall be seized and confiscated. The seizure is effected by the Custom-house authorities, and the confiscation will be decided by verdict of the Department of Administration. (Sect. 459 of the Regulations of the Criminal Law.)

United States.

(Law of 1881.)

Sect. 7. That registration of a trade-mark shall be *primâ facie* evidence of ownership. Any person who shall reproduce, counterfeit, copy, or colourably imitate any trade-mark registered under this Act and affix the same to merchandise of substantially the same descriptive properties as those described in the registration shall be liable to an action on the case for damages for the wrongful use of said trade-mark at the suit of the owner thereof; and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of such trade-mark used in foreign commerce or commerce with Indian tribes, as aforesaid, and to recover compensation therefor in any Court having jurisdiction over the person guilty of such wrongful act; and Courts of the United States shall have original and appellate jurisdiction in such cases without regard to the amount in controversy.

Sect. 8. That no action or suit shall be maintained under the provisions of this Act in any case where the trade-mark is used in any unlawful business or upon any article injurious in itself, or which mark has been used with the design of deceiving the public in the purchase of merchandise, or under any certificate of registry fraudulently obtained.

Sect. 9. That any person who shall procure the registry of a trade-mark, or of himself as the owner of a trade-mark, or an entry respecting a trade-mark, in the office of the Commissioner of Patents, by a false or fraudulent representation or declaration, orally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence thereof to the injured party, to be recovered in an action on the case.

Sect. 10. That nothing in this Act shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trade-mark might have had if the provisions of this Act had not been passed.

Circular to Customs Officers.

1897.—*Department Circular No.* 116. *Division of Customs.*

Treasury Department, Office of the Secretary,
Washington, D.C., August 3rd, 1897.

To Officers of the Customs and others:

The attention of officers of the Customs and others is invited to the following provision of sect. 11 of the Act of the 24th July, 1897:

"Sect. 11. That no article of imported merchandise which shall copy or simulate the name or trade-mark of any domestic manufacture or manufacturer, or which shall bear a name or

mark which is calculated to induce the public to believe that the article is manufactured in the United States, shall be admitted to entry at any Custom-house of the United States. And in order to aid the officers of the Customs in enforcing this prohibition, any domestic manufacturer who has adopted trade-marks may require his name and residence and a description of his trade-marks to be recorded in books which shall be kept for that purpose in the Department of the Treasury, under such regulations as the Secretary of the Treasury shall prescribe, and may furnish to the Department fac-similes of such trade-marks; and thereupon the Secretary of the Treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of the Customs."

Applications for the recording of names or trade-marks in this Department will state the name and residence of the domestic manufacturer, and furnish a description of the mark and the names of the ports to which the fac-similes should be sent. No such name or trade-mark will be received unless accompanied by the proper proof of ownership and proof that the owner is a domestic manufacturer, which must consist of the affidavit of the owner or one of the owners, certified by a notary public, or other officer entitled to administer oaths, and having a seal.

On the receipt by a Customs officer of any such fac-similes, with information from the Department that they have been recorded therein, he will properly record and file them, and will exercise care to prevent the entry at the Custom-house of any article of foreign manufacture copying or simulating such mark.

No fees are charged for recording trade-marks in the Department and Custom-houses.

A sufficient number of fac-similes should be forwarded to enable the Department to send one copy to each port named in the application with ten additional copies for the files of the Department.

Especial attention is invited to the provision in said section prohibiting the entry of articles "which shall bear a name or mark which is calculated to induce the public to believe that the article is manufactured in the United States," and collectors and other officers of the Customs are instructed to use due diligence to prevent violations of this provision.

No. 23.

TRADE MARKS (INDIA).

The extract from a letter of the Government of India of 28th January, 1891, and copy of a notification dated 13th November, 1891 (which are printed below), state the Indian law and executive orders now in force for the protection of trade-marks and descriptions. Though there is no law requiring the registration of trade-marks in India, they can be, and sometimes are, registered under Act III. of 1877 ("The Indian Registration Act").

The use of a false trade-mark is an offence punishable in India under Section 480 of the Indian Penal Code, and protection of trade-marks and descriptions is also provided by the Merchandise Marks Act, 1889 (*a*).

Extract of Letter from Government of India, No. 25 (Statistics and Commerce), dated 28th January, 1891.

Trade-marks are defined by sect. 3 of the Indian Merchandise Marks Act (amending the Indian Penal Code, sect. 478) to include those which are registered in England and those which, whether with or without registration, are protected in any British possession or foreign State to which the British law is by Order in Council made applicable. There is no law requiring the registration of trade-marks in this country, nor is it the usual practice to register them here. No condition is required precedent to action by either the Customs authorities or the Criminal Courts; the former can act either on their own motion or on information, the latter only on information and formal complaint; but to ensure seizure and detention the information must be followed by satisfactory proof of fraud.

Notification (Home Department), dated 13th November, 1891.

In the exercise of the power conferred by sect. 16 of the Indian Merchandise Marks Act, IV. of 1889, and in supersession of all existing orders on the subject, the Governor General in Council is pleased to direct that Criminal Courts, in giving effect to the provisions of the Act in respect of trade descriptions of

(*a*) From information supplied to the author by the courtesy of the India Office.

quantity, measure, or weight of the goods specified hereunder, shall observe the following instructions :—

I. A trade description of length stamped on *grey*, *white* or *coloured cotton piece goods* shall not be deemed to be false in a material respect unless,—

(a) where a single length is stamped, the description exceeds the actual length by more than—

4 inches in pieces stamped as 10 yards long and under;
5 inches in pieces stamped as above 10 yards and up to 23 yards long;
7 inches in pieces stamped as above 23 yards and up to 36 yards long;
9 inches in pieces stamped as above 36 yards and up to 47 yards long;
18 inches in pieces stamped as above 47 yards long;

provided that the average length of the goods in question shall not be less than the stamped length;

(b) where a maximum and minimum length are stamped, the described maximum length is greater than the actual length by more than—

9 inches in piece goods under 35 yards long;
18 inches in piece goods 35 yards and up to 47 yards long;
36 inches in piece goods above 47 yards long;

provided that no such piece shall measure less than the minimum stamped length.

II. A trade description of width stamped on *grey*, *white*, or *coloured cotton piece goods* shall not be deemed to be false in a material respect unless the description exceeds the actual width by—

half an inch, in pieces stamped as 40 inches or less in width;
three quarters of an inch, in pieces stamped as over 40 inches or under 59 inches in width;
one inch, in pieces stamped as 59 inches or more in width;

provided that the average width of the goods in question shall not be less than the stamped width.

III. A trade description of count or number, length or weight, applied to *grey* or *bleached cotton yarn* shall not be deemed to be false in a material respect unless—

(a) the described count or number is greater or less than the actual count or number by more than 5 per cent., provided that the average count of the whole of the yarn in question is not greater or less than the described count; or
(b) the average length of the whole number of hanks in a bundle is less than 840 yards; or
(c) in a bundle of yarn of any count under 50, described as being 10 pounds in weight, the number of knots of 20 hanks each is not half of, the number of knots of

10 hanks each is not the same as, and the number of knots of 5 hanks is not double, the described count or number of the yarn; or

(d) in a bundle of yarn of any count under 50, described as being 5 pounds in weight, the number of knots of 20 hanks each is not a quarter of the described count or number of the yarn; or

(e) in a bundle of yarn of any count from 50 upwards, the number of knots of 20 hanks each is not half, or the number of knots of 40 hanks each is not a quarter, when the described weight is 10 pounds, and is not a quarter or an eighth, as the case may be, when the described weight is 5 pounds, of the count or number of the yarn; or

(f) in the case of *bleached yarn*, the described weight exceeds the actual weight by more than,—

7½ per cent. in counts from 1 to 8:
5 per cent. in counts from above 8 to 18;
4 per cent. in counts from above 18 to 30;
2½ per cent. in counts from above 30 to 80.

IV. A trade description of count or number applied to a bundle of *dyed cotton yarn* shall be accepted as indicating length only, the hank being taken to measure 840 yards, and it shall be deemed to be false in a material respect if the average length of the hanks in a bundle is less than 819 yards.

V. A trade description of length applied to *thread of any kind* (of cotton, wool, flax, or silk) shall not be deemed to be false in a material respect unless it exceeds the actual length by more than one per cent.

VI. The dimensions of goods on which their length or width is stamped shall be determined by measurement in imperial yards of 36 inches.

C. J. LYALL,
Secretary to the Government of India.

Instructions (Executive) for the guidance of Customs Officers in the administration of the India Merchandise Marks Act, IV. of 1889.

1. Labels or tickets applied to boxes, cartons, parcels or other packages, which are manifestly intended only for the purpose of identifying articles for the convenience of dealers and shopkeepers, and are not specially intended to attract the eye of the purchaser, should not be treated as trade descriptions. *Examples:*—On bundles of hosiery, "hose, brown merino, size 10;" on shoes, "enamelled leather, men's, No. 6;" on hats, "brown felt, hard, No. 7."

NOTE.—This rule does not apply to a mark or description on the goods themselves, or to a description of quality, or one containing the name of a place, country, manufacturer or trader, or to a trade-mark.

2. Goods manufactured on the Continent of Europe should be detained if the manufacturer's name and the trade description are expressed in English, unless the name and description are accompanied by the name of the country of manufacture.

3. Customs officers should detain, on their own motion and without requiring information, any goods produced or manufactured beyond the limits of the United Kingdom or of British India which are marked with British or British Indian names or trademarks, or so described as to indicate that the goods were produced or made in the United Kingdom or British India, unless such description is accompanied with the name, in conspicuous letters, of the country of manufacture.

A description in such cases which indicates a particular class or method of manufacture, and includes the name of a place in or a part of the United Kingdom, and is thereby likely or calculated to mislead, includes such terms as "Kidderminster carpets," "Windsor soap," "Balbriggan" on hosiery, "Shetland" on shawls and the like; for though these terms may be held to be merely indicative of methods of manufacture, they are likely to mislead as to the place of origin.

4. A report on the proceedings of the Collector should be submitted annually to the Local Government, for transmission to the Government of India. The report should show the number of cases in which (1) detention was ordered; (2) detention was followed by confiscation; (3) detention was followed by release with or without a fine; (4) detention was ordered on information received; (5) detention was ordered without information. Under the first head should be specified the section of the Act under which action was taken.

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NOTE.—*A collection of words and names of marks occurring in trade-marks considered in the decided cases has been inserted in the Index, with the names of the cases in which they occur, in order to facilitate reference to cases of which the names have been forgotten.*

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THE END.

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