May, 1906.

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THE
TRADE MARKS ACT, 1905.

[7 EDW. VII. CH. 15.]

WITH NOTES, CROSS REFERENCES, AND A COMMENTARY, AND THE RULES, FORMS, FEES, AND CLASSIFICATION OF GOODS UNDER THE ACT.

BY

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LONDON:
SWEET & MAXWELL, LIMITED,
3, CHANCERY LANE, W.C.
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OCT 17 1922

PREFACE.

In this book the new Act is compared throughout with its predecessor, and the alterations which it affects are noted. These are summarised in the Introductory Chapter. Comparative tables of sections, appendices, and a commentary as full as seemed likely to be useful until the more important sections shall have received judicial interpretation are added. The references to "Kerly on Trade Marks" (2nd edit.), and the addition of the later cases relating to registration of trade marks will, it is hoped, serve as a supplement to that work and bring it up to date.

The fact that the new rules were not published until the end of March has postponed the publication of this work to a later date than was originally contemplated.

D. M. KERLY.
F. G. UNDERHAY.

Easter, 1906.

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TRADE MARKS ACT, 1905.

[5 EDW. VII., CH. 15.]

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7.	Inspection of and extract from register	§ 88.

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117.	General definitions	Cf. §§ 3, 4.

[1] And see Interpretation Act, 1889, sec. 38, *post*, p. 226.

THE TRADE MARKS ACT, 1905.

INTRODUCTION.

THE new Act is the outcome of repeated attempts during recent years to amend the law of trade marks, so far as that depends upon registration, and in particular to extend the scope of the classes of trade marks which can be entered upon the register. The Bill upon which the Act was founded was drafted and introduced into the House of Commons by Lord Justice Fletcher Moulton, then Mr. J. Fletcher Moulton, K.C., in accord with the London Chamber of Commerce, and was referred to a select committee.[1] The committee, after hearing a good deal of expert and trade evidence, reported the Bill to the House of Commons with sundry amendments,[2] of which the insertion of the Manchester clause,[3] in deference to representations from the Manchester Chamber of Commerce, was perhaps the most striking.[4] Some further amendments of a detailed character were made in the House of Lords, and the Act passed on August 11th, 1905. In order to allow time for the new rules to be made its operation was postponed, except as to one or two subordinate matters,[5] until April 1st, 1906.[6]

Earlier legislation.

The Act is the fourth[7] English statute dealing with the civil law of trade marks. The first, that of 1875,[8] set up the register and

[1] Mr. Blake, Mr. Butcher, K.C., Mr. Cripps, K.C., Mr. Eve, K.C., Mr. Fison, Mr. Fletcher Moulton, K.C., Sir Walter Palmer, Sir Charles Renshaw, and Mr. Tillett.

[2] See the report of the committee and the evidence before it, No. 231 of 1905.

[3] Sec. 64, post, pp. 11 and 111.

[4] The committee also struck out the proposed rules, which formed part of the Bill, leaving the rules to be drawn up by the Board of Trade after the Act was passed: sec. 60. And they decided to leave the sections of the old Act dealing with international and colonial arrangements unrepealed: sec. 65.

[5] See sec. 64 (10).

[6] Sec. 2.

[7] *I.e.*, disregarding the small amending Acts of 1876 and 1877, pp. **688—690**. See Chap. I., pp. **1—16**.

[8] Passed August 13th, 1875, p. **684**. Marks used before this date, "old marks," still have certain privileges as to registration: see sec. 9, post, p. 23.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

introduced the principle that the registration of a trade mark is evidence, *prima facie* or conclusive, of the proprietor's right to the exclusive use of the trade mark in connection with the goods for which it is registered.[1] The Act also defined a trade mark for the purposes of the Act, and by the definition[2] limited registrable trade marks to what turned out to be a comparatively small proportion of the trade marks which were then in use, or subsequently came into use, in the country.

The Patents, Designs, and Trade Marks Act, 1883.

The Act of 1875 was repealed by the Patents, Designs, and Trade Marks Act of 1883.[3] This dealt with the three very different subjects, patents, designs, and trade marks, as one group, and in many instances by sections applying without distinction to them all. It no longer purported to define a trade mark for the purposes of the Act, but substituted for the original definition the rule that a registrable trade mark must consist of or contain at least one of certain enumerated essential particulars.[4] The new section was, however, read, and even constantly referred to, as if it had contained a definition, and the "essential particulars" were treated as if they were the trade marks actually registered, instead of being, as was clearly the intention of the Act, merely qualifying conditions of the registration of the mark.

The Act of 1883 failed to give satisfaction to the commercial community, and it was, after consideration by a departmental committee of the Board of Trade, presided over by the late Lord Herschell,[5] amended by the Act of 1888. This Act, among other changes of minor importance, amended the list of the "essential particulars," some or one of which must be present in a trade mark to entitle it to registration.

Defects of the repealed Acts.

Notwithstanding the amendments introduced by the two later Acts just referred to, and also by the more liberal construction put upon those Acts after the decision of the *Solio* case[6] in the House of Lords, the law remained in a condition which was very unsatisfactory to the commercial community, and especially on three points, namely, that large numbers of perfectly good and often valuable trade marks were not registrable;[7] that when trade marks were admitted to

[1] By sec. 3.
[2] By sec. 10.
[3] P. **645** *et seq.*, and post, p. 149.
[4] By sec. 64, p. **649**.
[5] 1887, see p. **10**.
[6] In 1898, pp. **11**, **171**.
[7] According to the last report of the Comptroller-General, the total number of trade marks registered since January 1st, 1876, to the end of 1904, was 110,775, of which about one-fifth had been allowed to lapse.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

registration, it frequently happened that "disclaimers" were insisted upon in the Office which hampered the owner of the marks in getting protection abroad; and that there was no effective statute of limitations to objections brought against registered trade marks, so that they were open to attack, and were sometimes removed from the register, after having been registered and used for many years. Lord Justice Fletcher Moulton's Bill was intended, so far as is possible, to remove, and the new Act is directed to remove, or at least to mitigate, all of these objections. The Act also effects an important formal change by separating trade marks from patents and designs, and providing a detailed and nearly complete[1] code of the law relating to registered trade marks. It is now proposed to deal in this Introduction with these four main points, in the first place, and afterwards to refer shortly to some of the minor alterations.

A separate code for trade-marks.

1. The new Act separates trade marks from patents and designs except as regards secs. 103 and 104 of the Act of 1883, which deal with the matters to which the International Convention relates and which were left untouched in order to avoid the necessity for issuing fresh Orders in Council, and also because the Conventions with foreign powers invariably deal with all these topics together.[2]

Some objection was taken before the committee to the separation of trade marks from patents and designs, inasmuch as they are all administered in the same Office,[3] and on the ground that it is a reversal of the policy of the Act of 1883. The alteration appears, however, to be a beneficial one, for the three subjects have nothing in common such as to offer any advantage in coupling them together. It is true that letters patent, copyright in a design, and the registration of a trade mark alike confer a monopoly, as do also literary and artistic copyright, but the resemblance is purely superficial. On the other hand the idea that the registration of a trade mark confers a valuable privilege analogous to that which an inventor receives as consideration for the disclosure of his invention to the public, is a mistaken notion which has not been without effect in inclining some Judges to place a narrow construction upon the Registration Acts, and this idea was unquestionably fostered by the inclusion of trade marks in a Patents and Designs Act. The truth is that the registration of a trade mark is rather the recognition of a fact than the grant of a

[1] The international and colonial sections and sec. 106 of the old Act are left unrepealed: see sec. 65, post, p. 117.

[2] See an address on the Act delivered to the Chartered Institute of Patent Agents by Lord Justice Fletcher Moulton, Proc. 1906.

[3] See Chap. III., p. 56.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

privilege. It is because the trade mark does distinguish and identify the goods of the proprietor, or will do so when it comes into use, and because its use for other goods would be deceptive, that registration is desirable, both to afford the proprietor a ready means of preventing such deception, and as notice to other traders. The object of the Acts is, so far as possible, to provide a record of every trade mark in use, and, so far as any such trade mark is kept off the register, this object fails to be attained.[1]

The Act has been drafted with great care, and for the first time it puts the law relating to registered trade marks into a logical and orderly form.

Greater freedom given in the choice of registrable trade marks.

2. The chief objection to the old Acts was that, as already stated, the classes of marks which could be registered other than "old marks," *i.e.*, trade marks in use before August 13th, 1875, were so narrow that a large number of the trade marks in actual use, many of which were perfectly distinctive and of great value, could not be registered. These marks were nevertheless fully protected under the civil law as "common law trade" marks, by means of what is called a "passing-off action,"[2] provided that the owner could prove, as he generally could prove, that the use of the trade mark, or a mark nearly resembling it, by another trader was likely to cause the goods of the latter to be "passed off" as those of the owner of the trade mark. They were also to a considerable extent protected under the criminal law.[3] But the owner of an unregistered mark lost the benefit of the statutory title which registration confers, and was put to the expense of calling evidence to establish the fact that the trade mark was known to indicate his goods. In the case of a trade extending to foreign countries he was still further injured by the refusal of registration, since in most European countries, and particularly in Germany, registration was refused to an English trader in respect of a trade mark not registered in England, while the very same mark might be registered against him, and the right to the exclusive use of it claimed by another trader.[4]

The new Act endeavours to meet this grievance by greatly enlarging

[1] "It often seems to me that our Courts "have at times considered it as a triumph "if they kept a mark off the register, "even though it was a mark un- "doubtedly used and recognised. Every "mark that they so kept off the register "was an instance of the failure of trade "mark legislation": Lord Justice Fletcher Moulton's address, ante, p. 3, n. [2].

[2] See Chap. XVI., p. **446**.

[3] See Merchandise Marks Act, 1887, sec. 3 (2) and (3), pp. **588**, **589**.

[4] Possibly by his own agent.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

the area of registration.[1] The intention of the promoters of the Bill was to render it possible to register "everything that is effectively a trade mark,"[1] but it is probably too sanguine a view to suppose that quite so wide an interpretation will be put upon the Act by the Courts. In any case the old remedies for the protection of unregistered trade marks are allowed to remain unaffected.[2]

The machinery adopted to carry out this important object is contained in the three definitions of "mark," "trade mark," and "registrable trade mark," in sec. 3,[3] the new and enlarged category of essential particulars which qualify a trade mark for registration embodied in sec. 9,[4] and the recognition for the first time in sec. 10[5] of colour as a distinctive element in a trade mark tendered for registration.

All of these sections are fully discussed and annotated in the following pages, and it is only necessary here to refer shortly to the provisions of sec. 9.

Word marks.

A distinction is drawn between word marks and other marks. Word marks are regarded in most trades with peculiar favour. They also offer peculiar difficulties, because it is impossible to allow a single trader to monopolise the use of ordinary descriptive words of which his competitors may reasonably desire to make use. In the Manchester cotton piece and cotton yarn trades, which are largely concerned with non-European nations, wholly ignorant of English words and letters, they are, however, on the contrary, treated as non-distinctive and valueless, and the Act for the first time recognises this.[6] In its first four sub-sections sec. 9 enumerates four classes of word marks as qualifying "essential particulars,"[7] namely, names of companies, persons, or firms represented in a special or particular manner, signatures of the applicants or their predecessors in business, invented words, and words having no direct reference to the character or quality of the goods and not being, according to their ordinary signification, geographical words or surnames.

Word mark admitted in special cases

So far no very material alteration is made, but the Act adds by

[1] Lord Justice Fletcher Moulton's address, ante, p. 3, n. [2].

[2] Sec. 45, post, p. 94.

[3] Post, p. 13.

[4] Post, p. 23.

[5] Post, p. 37.

[6] Sec. 64, post, pp. 11 and 111. The Registrar of Trade Marks, Mr. Ralph Griffin, proposed to the committee to follow the plan of admitting any distinctive mark in general terms and adding definite exceptions, one of which was "a word or words which are "commonly employed in the trade, or "which are reasonably required for use "in the trade": see his suggested definition clause, Appendix, p. 219.

[7] Compare the rules of France, Germany, Switzerland, Denmark, and the United States, Appendix, post, p. 220.

sub-sec. (5)[1] the very important provision that the Board of Trade or the Court may order a particular distinctive word mark to be registered, though it does not fall within any of these classes. Further the tribunal may, in the case of a trade mark in actual use, take into consideration the extent to which such use has rendered it distinctive. This will apply to a word mark which, on the face of the matter and apart from actual experience, would not have been expected to be, or would not have been, a distinctive mark. Under this special provision such word marks as "Bright Yellow" for whisky, "Matterhorn" for cigarettes, and "Red, White and Blue" for coffee, could all probably be accepted by the Board of Trade or the Court, at any rate, if it were shown that they had come by use to distinguish the goods of particular traders, although the first might be said to have a direct reference to the colour of the goods, the second is in its ordinary signification a geographical name, and the third describes the get-up of a well-known brand.

How far sub-sec. (5) will be made use of, it is, as yet, impossible to foresee, but the object of the draftsman is plain. It was intended to afford a remedy for all exceptional cases where the strict limitation of the four general word-mark classes just enumerated would cause injustice or hardship.

Other marks. All marks, or combinations of marks, other than word marks, are also dealt with by sub-sec. (5), which admits them to registration subject to no other condition than that they must be "distinctive," that is to say, adapted to distinguish the goods of the proprietor of the trade mark from the goods of other persons.[2] Except by the recognition of colour as an element of distinctiveness, already referred to, and the alteration with regard to "disclaimers" which is mentioned below,[3] no material change is made with regard to these marks.

A minor but important amendment is made by the provision of sec. 36 that no trade mark on the register at the commencement of the Act which is a registrable trade mark under the Act shall be removed on the ground that it was not registrable under the Acts in force at the date of its registration. This gets rid of the absurdity of compelling the Court to remove a trade mark by reason of some objection based upon a repealed Act, where the owner is entitled to re-register it at once under the existing Act.

Trade marks to be registered as 3. Under the old Acts a practice had grown up by which, when a

[1] See post, p. 32. The provision is put in the negative form in the sub-section, but the effect is as here stated.

[2] Post, p. 32.

[3] Post, pp. 7 and 54.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

trade mark was registered, the exclusive right to everything composing, or appearing upon it, other than such of the enumerated essential particulars as it contained, and excepting the name of the applicant or of his place of business, was stated by a note on the register to be disclaimed. actually used, and generally without disclaimer.

For example, if a mark consisted of a number of devices with some words referring to the goods, the applicant was usually required to state that the essential particulars of his trade mark consisted of the combination of devices, and that he disclaimed everything else. This had several inconvenient consequences. In particular, as there was authority[1] for saying that by the disclaimer he lost his common law right to protect any particular part of the mark to which it referred, although it was, or had become, distinctive of his goods, the disclaimer was almost an invitation to an unscrupulous competitor to use it. Further, when certificates of registration were given for use abroad the disclaimers were included, and, not being understood in other countries, they were not infrequently the cause of trouble. In the proceedings before the committee, a hope was expressed that, for the future, no reference to disclaimers will be put upon certificates intended for use abroad, and it is probable that this course will be adopted.

The only provision for disclaimers in the new Act is contained in sec. 15,[2] which enacts that if a trade mark contains parts not separately registered as distinct trade marks, which may be done under sec. 25, or if it contains matter common to the trade, or of a non-distinctive character, the proprietor *may* be required to disclaim any right to the exclusive use of any part of the trade mark, or any part of such common or non-distinctive matter, or to make such other disclaimer as is needful for the purpose of defining his rights under the registration. But no disclaimer is to affect any rights of the proprietor other than such rights as arise out of the registration of the trade mark.

This section recognises that the owner of a trade mark will, in general, be entitled to the exclusive use of even the parts of a complex mark which are not themselves of a distinctive character in *combination* with the rest of the trade mark, and that no disclaimer will therefore, as a general rule, be required. But it gives the authorities a discretion to insist upon a disclaimer wherever the special circumstances of the case require it.

[1] Post, p. 58. [2] Post, p. 54.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

The need for any disclaimer at all will, however, be now rarely felt, because the new Act very properly contains general provisions for the protection of the public and rival traders against unwarrantable claims founded upon the registration of a mark. It is provided by sec. 41[1] that nothing in the Act shall entitle the proprietor of a registered trade mark to interfere with or restrain the user by any person of a similar trade mark upon or in connection with goods for which he has continuously used it from a date anterior to the use of the mark by the proprietor, or to object, upon such earlier user being proved, to such person being also registered as a proprietor of the mark.[2] And it is further provided by sec. 44[3] that no registration under the Act shall interfere with the *bonâ fide* use by a person of his own name or place of business, or of any *bonâ fide* description of his goods.

Registration to be conclusive after seven years.

4. In spite of the emphatic language of the repealed Acts that "registration . . . 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,"[4] the proprietor's title was held to be open to attack after any interval, because the old sec. 76 concluded with the words "subject to the provisions of this Act," and one such provision was the section enabling the Court to rectify the register. The result was that, though registration after five years was conclusive while it lasted, it could be put an end to by a successful motion to rectify. And in point of fact, although the Courts have of recent years[5] shown a strong inclination to uphold old registered trade marks, such marks were not infrequently removed from the register as not complying with the Acts. A trade mark owner was never safe from attack. The new Act endeavours to carry into effect the intention to make the registration conclusive after a lapse of time, so far as regards its original validity, which the framers of the earlier Acts certainly entertained but failed to secure. The section in question is sec. 41, and it applies upon applications to rectify as well as in all other legal proceedings. The period of limitation has been extended to seven years from the date of registration or of the passing of the Act, whichever is later.

The policy of making the register conclusive involves, however, some very serious difficulties, and it has been found necessary to meet these by making some exceptions to the general principle.

First, the lapse of time is only conclusive as to the original

[1] See the section, post, p. 88.
[2] See sec. 21, post, p. 65.
[3] Post, p. 93.
[4] Act of 1883, s. 76; Act of 1875, s. 3.
[5] See the notes to sec. 41, post, p. 88.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

validity of the registration. This was the matter most desired, because it will bar any question as to whether the registered mark was, or was not. qualified for registration under sec. 9.[1] But it will still be open to an objector to show that the mark is no longer a good one, for instance, because it has been abandoned, or become removable for non-user,[2] or (possibly) because it has become a mere descriptive word.[3] Secondly, inasmuch as it would be grossly inequitable to bar a trader from using a mark which he had used long and continuously, because some other trader had subsequently adopted and registered that mark or a similar one, in such a case the right of the earlier user is preserved, although he is not entitled, after the seven years, to attack the registered proprietor.[4] Thirdly, the section does not apply where the original registration was obtained by fraud, or where the use of the registered mark would be deceptive or improper, or the mark itself is a scandalous design.[5]

Registration obtained by fraud.

The extent to which the new section carries into effect the hopes of its promoters appears to depend upon the latitude of the construction put by the Courts upon the exception of fraud. It may be restricted to such obvious cases as where the agent of a foreign manufacturer secretly registers his employer's mark as his own,[6] or it may, on the other hand, receive so wide a construction as to render the section almost as useless as the old sec. 76.

Need to watch the register.

Unless the event last suggested happens, which is very improbable, the new "statute of limitations" for objections will make it urgently necessary for manufacturers and merchants to keep a close watch upon the advertised applications for registration. If they neglect this they may find that either their own marks, or marks very closely resembling them, or names or devices which are, or ought to be, common to the trade, have been registered by some particular trader and that it is too late to object.

Minor changes.

5. Besides the main alterations referred to, a number of minor changes have been made.

Associated trade marks.

The use by one trader of a trade mark with variations which do not substantially affect its identity is recognised, and the registration of the several variations is admitted, subject to a provision that the whole group shall be registered as "associated," and shall be transmissible only as a whole.[7] This provision is directed to prevent two

[1] Ante, p. 5, and post, p. 23.
[2] See sec. 37, post, p. 83.
[3] Post, p. 90.
[4] Post, p. 88.
[5] See sec. 11, post, p. 38.
[6] Post, p. 90.
[7] Secs. 24—27, post, p. 69.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

trade marks, which are too nearly alike to be used by different traders without confusion, from getting into different hands.

Registration of identical marks.

A wider discretion is allowed to the Courts in registering the same or nearly identical marks for different owners where there has been honest concurrent user of the marks by both.[1]

Additional powers of amendment and correction for the registrar.

Some amendments in procedure have also been made which should be found useful. The registrar is now authorised to make amendments upon applications,[2] and also corrections and amendments of the register and of registered marks,[3] in numerous cases where it was previously necessary to apply to the Court.

Costs.

Costs can now be granted upon an opposition to the registration of a mark in respect of the proceedings before the registrar and before the Board of Trade,[4] and a party giving notice of opposition or appeal who neither resides nor carries on business in the United Kingdom can be ordered to give security for costs.[5]

The costs incurred by the registrar in any proceedings before the Court under the Act are to be in the discretion of the Court, instead of being borne in all cases by the unsuccessful party. But, as was the case before the Act, the registrar cannot be ordered to pay any costs.

Appeal to be heard on the same materials.

Where there is an appeal from a decision of the registrar it is to be heard upon the same materials as were before him, and he is to take no further ground of objection without the leave of the tribunal.[6] This provision is to enable an applicant to be advised whether to appeal or not without running the risk of being met by fresh objections. And there is a corresponding provision limiting oppositions to a registration, on appeal, to grounds of which notice has been given.[7]

Appeal to the Board of Trade or the Court.

Upon an appeal from the registrar, allowing or refusing the registration of a mark, the appeal may be made direct to the Court[8] instead of, as according to the old practice, to the Board of Trade. There is still an option to appeal to the Board, but if that course is selected the appellant cannot appeal further.[9] The Board can, instead of hearing an appeal, themselves refer it to the Court if they please.[9] Parties frequently do prefer the Board of Trade as a tribunal, both because the expense of a hearing before the Board is much less than

[1] Secs. 19—21, post, p. 61.
[2] Sec. 12 (6), post, p. 46.
[3] Secs. 32 and 34, post, p. 74.
[4] Sec. 14 (10), post, p. 49.
[5] Sec. 14 (11).
[6] Sec. 12 (5).
[7] Sec. 14 (8).
[8] Sec. 12 (3), sec. 14 (5).
[9] Sec. 59, post, p. 103.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

that of a hearing in Court, and because the proceedings before the Board are strictly private. The last consideration is often important. The applicant for registration of a mark, which he has in actual use, will usually be very unwilling to risk the advertisement of a failure to obtain registration.

Standardisation marks.

A minor but not unimportant improvement is introduced by the admission to registration, for the first time, of marks which are known to be warranties or indications of some material circumstance concerning the goods to which they are attached, such as Lloyd's Register mark (L R) on shipbuilding materials, and the stamps which some trade associations put upon goods manufactured under the superintendence of their officials, or in accordance with their rules. Such marks are not, of course, trade marks, because they do not indicate the origin of the goods and are not connected with the goodwill of any business. They are, however, when registered, to be deemed to be trade marks, and proceedings can now be taken for their protection from piracy, both by an action for an injunction, and by a prosecution under the Merchandise Marks Act, 1887.[1]

The Sheffield register.

The Act brings the old clauses[2] dealing with the Sheffield Register up to date, and substitutes an appeal from any decision of the Cutler's Company direct to the Court for the old appeal to the Comptroller.[3]

The Manchester clauses.

It also makes special provision for the trade marks of the great industry in cotton piece goods and yarn which is identified with Manchester. A branch of the Trade Marks Registry of the Patent Office for the registration of marks in the cotton classes has long been maintained at Manchester.[4] The new Act gives the practice established in connection with that branch statutory recognition.[5] One peculiarity of that practice, to which great importance is attached, is that a record is kept of all applications to register trade marks from the first introduction of the register in 1875 onwards, and the marks applied for, both those which were refused as well as those which were registered, can be inspected by any member of the public. The Act preserves this right of inspection,[6]

Words and line headings in the cotton clauses.

The representations to the committee of the Manchester Chamber of Commerce and of witnesses from Manchester secured the inclusion in the Act of the rules—(a) that in respect of cotton piece goods

[1] See p. **560**.
Sec. 81, Chap. VI., p. **101**, and post, p. 155.

[2] Sec. 63, post, p. 107.

[3] See Chap. VII., p. **112**. The address is "The Keeper of Cotton Marks, Manchester Trade Marks Branch, 48, Royal Exchange, Manchester."

[4] See sec. 64, post, p. 111.

[5] Sec. 64 (11).

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

and cotton yarn no mark consisting of a word or words alone should be registered, and that no word or words should be deemed to be distinctive; (b) that in respect of cotton piece goods no mark consisting of a "line heading"[1] alone should be registered, and no "line heading" should be deemed distinctive; and (c) that no registration of a cotton mark should give any exclusive right to the use of any word, letter, numeral, line heading, or contraction thereof.[2]

The witnesses explained that word-marks to many of the purchasers of Manchester goods in non-European countries are only indistinct devices, and that the number of line headings had become too great to admit of the possibility of distinctive identity for any of them. These headings, being essentially colour marks, could not be registered under the old Acts, but, now that colour is allowed as a distinctive feature,[3] they might have been registered had not sec. 64 (10) prohibited it.

International arrangements.

The international and colonial arrangements under the convention of 1883[4] and its amendments are left unchanged.

Rules have been made by the Board of Trade under the Act of 1905, which came into operation at the commencement of the Act, April 1st, 1906.[5]

[1] The coloured marking woven or stamped across the end of a piece of cotton goods: see p. 150.

[2] Sec. 64 (10), p. 112.

[3] Sec. 10, post, p. 37.

[4] Page 764.

[5] Trade Mark Rules, 1906. The Schedules contain the list of fees, the forms and the classification of goods. Appendix III., post, p. 167.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

TRADE MARKS ACT, 1905.

(5 Edw. VII. c. 15.)

An Act to consolidate and amend the Law relating to Trade Marks. A.D. 1905.

[11th August, 1905.]

Be it enacted by the King'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 Trade Marks Act, 1905. Short title.

2. This Act shall, save as otherwise expressly provided, come into operation on the first day of April one thousand nine hundred and six. Commencement of Act.

Notes.

The commencement of the Act was by an amendment made in the House of Lords postponed to April 1st, 1906. This was presumably done in order to allow time for the preparation of new rules or classification; but the existing rules, tables of fees, and classification of goods were continued in force until superseded by rules, tables of fees, or classification made under this Act (sec. 73). The new Rules under this Act will be found in Appendix III.[1] The schedules to the Rules contain the fees, the forms, and the classification of goods.

"Save as otherwise expressly provided." It is so provided as to the matters to which sec. 64, sub-sec. (10), relates. That sub-section, which prohibits words alone and line-headings alone from being deemed to be distinctive in respect of cotton goods, and makes other provisions relating to cotton marks, takes effect from the passing of the Act (August 11th, 1905).

Part I.

Definitions.

3. In and for the purposes of this Act (unless the context otherwise requires) :— Definitions.

A "mark" shall include a device, brand, heading, label, ticket,

[1] Post, p. 167.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

name, signature, word, letter, numeral, or any combination thereof:

A "trade mark" shall mean a mark used or proposed to be used upon or in connexion with goods for the purpose of indicating that they are the goods of the proprietor of such trade mark by virtue of manufacture, selection, certification, dealing with, or offering for sale:

A "registrable trade mark" shall mean a trade mark which is capable of registration under the provisions of this Act:

"The register" shall mean the register of trade marks kept under the provisions of this Act:

A "registered trade mark" shall mean a trade mark which is actually upon the register:

"Prescribed" shall mean, in relation to proceedings before the Court, prescribed by rules of court, and in other cases, prescribed by this Act or the rules thereunder:

"The Court" shall mean (subject to the provisions for Scotland, Ireland, and the Isle of Man) His Majesty's High Court of Justice in England.

Notes.

The definition of a trade mark, Chap. II., p. **23.**

"The register," see secs. 4—7, and Chap. III., p. **56.**

"Prescribed," "the Court," see below, p. 17, and pp. **88, 285,** and sec. 117 of the Act of 1883.[1] The Rules under this Act are printed in Appendix III. (post, p. 167).

"Mark."

"MARK."—This is used in the next definition, and in the important section 9 (sub-sec. (5)), which indicates the nature of a "mark" which is registrable under the Act. It is here defined so as to comprise any symbol which can receive a permanent form. The particular "marks"—device, p. **141**; brand, p. **147**; heading, p. **149**; label, p. **150**; and ticket, p. **156**—were specially mentioned in sec. 64 (1) (c) of the Act of 1883. Certain names, signatures, and words were also covered by that section, but letters or numerals did not fall within any of the definitions of essential particulars under the older Acts. Under the Act of 1875 it was held that neither a collection of English letters nor a single letter constituted a device.[2]

[1] Post, p. 166.

[2] *Ex p. Stephens*, 3 C. D. 659; *Mitchell's Tm.*, 7 C. D. 36.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

"COMBINATION."—This is a valuable element in the definition, because it will enable a trader to register together, and as one mark, a number of separate trade marks. In the Manchester trade it is customary to use five or more such marks in combination. "Combination."

"TRADE MARK."—The earlier Acts contained no definition of a trade mark, and the present definition is somewhat wider in scope than that generally adopted by the Courts in the application of the Acts. Compare the definition given and fully discussed in Chap. II., p. **23**, namely, "A trade mark is a symbol which is applied or attached "to goods offered for sale in the market so as to distinguish them "from similar goods, and to identify them with a particular trader, "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 (or which has been properly registered under the Acts "as the trade mark of a particular trader)." "Trade Mark."

It will be observed that the present definition extends to marks proposed to be used. Such marks were registrable under the old Acts,[1] provided there was a real intention to use the mark at the time when it was registered.[2] The provision of sec. 75 of the Act of 1883, as amended by the Act of 1888, that application for registration of a trade mark should be deemed equivalent to public use of it, becomes unnecessary and is omitted. Objection was taken before the committee to the insertion of this definition in the Act, on the ground that it would widely extend the operation of the criminal law embodied in the Merchandise Marks Act, but it was pointed out that no such result would follow, because "trade mark" in that Act means a trade mark registered under the present Act, now substituted for the Act of 1883.[3] See pp. **560** to **561**. It must be remembered that the use of a spurious trade mark, so as to deceive, was already punishable, as being the "application of a false trade "description" under "Lord Herschell's clause" (sec. 3 (3)), and sec. 3 (2) (p. **588**) of the Merchandise Marks Act.

The definition extends to marks used, or proposed to be used, in connection with goods, as well as to marks used upon them. This is new; see p. **28**. Substantially it brings trade names of goods under the definition of trade marks, and admits them to registration. In connection with goods.

[1] Pages **54**, **304**; *Hudson's Tms.*, 32 C. D. 311; 3 R. P. C. 155; [1886] C. A.

[2] *Batt & Co.'s Tms.*, [1898] 2 Ch. 432; 15 R. P. C. 262, 534, in H. of L. (*sub nom. Batt & Co.* v. *Dunnett*) [1899] A. C. 428; 16 R. P. C. 411.

[3] See sec. 6, and Interpretation Act, sec. 38, post, p. **226**.

Hitherto it has been held that some physical connection between the goods and the mark, so that the mark goes with the goods into the market, is essential to use as a trade mark.[1] Use of a mark as a mere advertisement or hoarding placard has not been considered use as a trade mark. And it was to some extent an open question whether under the old Acts there could be an infringement of a registered trade mark by the use of a mark which was not marked upon the defendant's goods, although used in connection with them and as a mark of origin (see p. **369**[2]); but probably, if the matter had been argued out, such a use would have been held to fall within sec. 76 of the Act of 1883 and to be an infringement. The question did not arise for decision, because the use in question could almost always be stopped by an action for "passing off,"[3] and an action for infringement is usually combined with such an action. The present definition and the language of sec. 39,[4] which corresponds with it, make it probable that the improper use of a registered mark, or one too nearly resembling it, in connection, even if not in physical connection, with spurious goods for the purpose described, will be held to be an infringement. This is an important amendment, as it will no longer be necessary for the proprietor of the trade mark in such a case to resort to a passing-off action.[5]

The essence of a trade mark or trade name has always been that it is "an indication of origin." The proprietor of the mark may be only one of a series of persons who have handled the goods. The purpose of the mark is to indicate that he has a connection with the goods that they have "passed through his hands," whether he be manufacturer, merchant, or selector. See p. **52**. The present Act expressly authorises the registration as trade marks of standardisation and other marks belonging to associations which do not trade at all,[6] and the word "certification" in the definition seems specially appropriate

[1] *Powell's Tm.*, [1893] 2 Ch. 388; [1894] A. C. 8.

[2] See also *Price's Patent Candle Co., Ltd.* v. *Joyes' Sanitary Compound Co., Ltd.*, 19 R. P. C. 17, [1901] C. A.; *Montgomerie* v. *Young*, 20 R. P. C. 781, 21 R. P. C. 285 [1904] Scotch. In *Kodak, Ltd.* v. *London Stereoscopic, etc., Co., Ltd.*, 20 R. P. C. 337 (1903), Eady, J., it was admitted by the defendants that the use of the plaintiff company's trade marks as the names of goods in invoicing them was an infringement; and under the Merchandise Marks Act a description in an invoice sent with goods has been held to be "applied to goods" within sec. 5 (1) (d): *Budd* v. *Lucas*, [1891] 1 Q. B. 408, Pollock and Charles, JJ.

[3] See Chap. XVI. and sec. 45, post, p. 94.

[4] Post, p. 85.

[5] See ante, p. 4.

[6] Sec. 62, post, p. 106.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

to such trade marks. Subject to that special exception, however, proprietors of trade marks must deal in the goods to which the marks they seek to register relate.

"Registrable Trade Mark."

"REGISTRABLE TRADE MARK."—This is a trade mark which complies with sec. 9,[1] and is not obnoxious to secs. 11[2] or 19.[3] Compare also sec. 36. The mark must be a "trade mark;" that is to say, it must conform to the last definition.

"THE REGISTER."—See secs. 4—7, and Chap. III., p. **56**. A register of Sheffield marks is kept at Sheffield (see sec. 63[4]), and a duplicate of the part of the register containing cotton marks for all goods in classes 23, 24, and 25 (except such as may be prescribed), called the Manchester Register, is kept at Manchester (see sec. 64[5]).

"The Court."

"The Court," pp. **88** and **285**. The definition is the same as in the Act of 1883 (sec. 117), but, in addition to the provisions for Scotland and Ireland and the Isle of Man contained in secs. 69 and 70,[6] it must be read also with sec. 71 with respect to the Lancashire Palatine Court in relation to trade marks the registration of which is applied for in the Manchester branch. Sec. 71 is a re-enactment of sec. 112A of the Act of 1883, introduced into that Act by sec. 26 of the Act of 1888. The question of the jurisdiction of the Scotch and Irish Courts as to rectification of the register is somewhat doubtful. The Irish Courts have held that they have no jurisdiction to rectify,[7] but it has been held by the Scotch Courts that they have jurisdiction to make a declaration that an entry in the register is invalid, and that thereupon sec. 111, sub-sec. (2), of the Act of 1883[8] became applicable.[9] That sub-section is not, however, reproduced in the present Act, but sub-sec. (4) of sec. 35, which is in general terms without express reference to proceedings in Scotland or Ireland, enacts that any order of the Court rectifying the register shall direct that notice of the rectification shall be served upon the registrar in the prescribed manner, who shall upon the receipt of such notice rectify the register accordingly. The omission in the new

[1] Post, p. 23.
[2] Post, p. 38.
[3] Post, p. 63. See also Rules 11 to 16, post, p. 170.
[4] Post, p. 107.
[5] Post, p. 111.
[6] Post, p. 120.
[7] *Bayer* v. *Connell Bros.*, 14 R. P. C. 275 [1897].
[8] Post, p. 164.
[9] *Dewar & Sons, Ltd.* v. *Dewar*, 17 R. P. C. 341 (1900), followed in *Dawson* v. *Stewart*, 22 R. P. C. 250, and *Reid* v. *Thomson & Co.*, 22 R. P. C. 376, both (1905).

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

Act of sub-sec. (2) of sec. 111 of the Act of 1883 does not strengthen the contention that there is jurisdiction in the Scotch or Irish Courts to order rectification of the register.

The County Court has no jurisdiction to try an action for infringement of trade mark: *Bow* v. *Hart*, 22 R. P. C. 222.

Register of Trade Marks.

Register of trade marks.

4. There shall be kept at the Patent Office for the purposes of this Act a book called the Register of Trade Marks, wherein shall be entered all registered trade marks with the names and addresses of their proprietors, notifications of assignments and transmissions, disclaimers, conditions, limitations, and such other matters relating to such trade marks as may from time to time be prescribed. The register shall be kept under the control and management of the Comptroller-General of Patents, Designs, and Trade Marks, who is in this Act referred to as the registrar.

Notes.

The register, Chap. III., p. **56.**

The first paragraph of this section corresponds to sec. 78 of the Act of 1883; but the words "disclaimers, conditions, limitations," are now introduced.

Disclaimers, see sec. 15.[1]

Conditions, see secs. 12, 13, and 14.[2]

The last sentence of the section corresponds to sec. 82 (3) of the old Act, which is unrepealed, and contains a direction that the comptroller should act under the superintendence and direction of the Board of Trade, which is not repeated here.

The business of the Patent Office in relation to trade marks has in practice been undertaken by the registrar on behalf of the comptroller.

It was originally proposed to make the Registrar of Trade Marks an independent official, but this was altered during the progress of the Bill through Parliament. All that the Act does in the matter is to give the comptroller an additional name for the purposes of the Act.

Provision is now made for the registration of assignments and transmissions and for an appeal from the decision of the registrar by sec. 33,[3] and for removing abandoned marks from the register by

[1] Post, p. 54.

[2] Post, pp. 39—54.

[3] Post, p. 76.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

sec. 37.[1] As to the right of the registered proprietor to assign, see sec. 22 and sec. 38 (1).[2]

"PRESCRIBED."—The date of the registration, the goods in respect of which the mark is registered, all particulars named in this section, the occupation of the proprietor, and such other particulars as the registrar thinks necessary are to be entered (rule 64, post, p. 179).

When a trade mark has been removed from the register, a record of such removal and the cause thereof is to be entered (rule 74, post, p. 180). Notice of a trust is not to be entered (sec. 5). As to addresses, see rules 8 and 9 (post, p. 169).

An application to the Court has been allowed under sec. 87 of the Act of 1883, where the comptroller refused to register an assignment: p. **334**; *Bancroft's Tm.*, 5 R. P. C. 209 (1888), Stirling, J.

5. There shall not be entered in the register any notice of any trust expressed, implied, or constructive, nor shall any such notice be receivable by the registrar. Trust not to be entered on register.

Page **58**.—This corresponds to sec. 85 of the Act of 1883, with the addition "nor shall any such notice be receivable by the registrar." Notes.

By reason of this section, and sec. 38,[3] the registered proprietor can make a good title to any purchaser of the trade mark and of the goodwill of the business concerned (sec. 22), who has no notice of any equitable rights in the trade mark or goodwill existing in any third person.

It was held under sec. 87 of the Act of 1883 in a patent case that a registered assignee who took an assignment with notice of an equitable title in a third person took subject to his rights: *New Ixion Tyre and Cycle Co., Ltd.* v. *Spilsbury*, [1898] 2 Ch. 137, 484; 15 R. P. C. 380, 567 (p. **332**). The right to enforce equities is also preserved by this Act (sec. 38 (2)). It is presumed that the last words of the section would not prevent the registrar from taking notice of pending litigation to enforce an equity. See for the practice of the Patent Office as to notices in the nature of caveats in respect of assignments of patents: *Viola* v. *Sharpe*, 22 R. P. C. 23 (1905).

The corresponding provision in the old Act was not interpreted to forbid the entry of a note upon the register stating the effect of an arrangement or undertaking,[4] although the practice of making such

[1] Post, p. 83.
[2] Post, p. 84.
[3] Post, p. 84.
[4] See the note to sec. 85, p. **663**.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

notes was not approved in *Dewhurst's Tm.*,[1] and the Court there refused to permit registration with a limitation as to the geographical area of user. The matter is now dealt with by the Act itself (sec. 4), which provides for the entry of notifications of the conditions and limitations, if any, to which a registered mark is subject. Compare sec. 12 (2),[2] by which the registrar may accept an application to register absolutely or subject to conditions. Sec. 21[3] expressly mentions "place of "user" as a matter in regard to which a condition or limitation may be imposed in cases falling under that section.

Incorporation of existing register.

6. The register of trade marks existing at the date of the commencement of this Act, and all registers of trade marks kept under previous Acts, which are deemed part of the same book as such register, shall be incorporated with and form part of the register. Subject to the provisions of sections thirty-six and forty-one of this Act the validity of the original entry of any trade mark upon the registers so incorporated shall be determined in accordance with the statutes in force at the date of such entry, and such trade mark shall retain its original date, but for all other purposes it shall be deemed to be a trade mark registered under this Act.

Notes.

This corresponds to secs. 113 and 114 of the old Act, but it introduces an important change of policy. Upon the earlier amendments of the law existing registered trade marks were left to depend for their validity on the statute in force at the date of their registration.[4] Now it is provided that a registered trade mark may be supported *either* under the statute in force at the date of its registration, *or* under the present Act. It gets the advantage of the wider scope of the Act without the necessity for re-registration. This is the effect of sec. 36[5] and the present section. Marks already on the register are also to get the benefit of sec. 41,[6] which makes seven years' registration, after the passing of the Act, conclusive as to validity unless the original registration was obtained by fraud, or the mark offends against sec. 11, *e.g.*, as being deceptive.

[1] [1896] 2 Ch. 137; 13 R. P. C. 288.
[2] Post, p. 39, and see sec. 14 (6).
[3] Post, p. 65.
[4] See the sections above referred to, sec. 27 of the Act of 1888, and *Re Borril Tm.*, [1896] 2 Ch. 600; 13 R. P. C. 382.
[5] Post, p. 82.
[6] Post, p. 88.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

The date of application has, under sec. 75 of the Act of 1883 and under the previous practice, been entered on the register as the date of registration (p. **304**). This practice is continued under sec. 16 of this Act.

Inspection of and extract from register.

7. The register kept under this Act shall at all convenient times be open to the inspection of the public, subject to such regulations as may be prescribed; and certified copies, sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

Sec. 88 of the Act of 1883.

Inspection, searches, and indexes, pp. **60, 61**. Hours of inspection, rule 96 (post, p. 183). Searches, rule 95 (post, p. 183). 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, 10*s*. (post, p. 192).

Under rule 95 an official search can be obtained in any class as to marks on record (not merely registered marks) resembling any mark sent in.

Registrable Trade Marks.

Trade mark must be for particular goods.

8. A trade mark must be registered in respect of particular goods or classes of goods.

Notes.

Sec. 65 of the Act of 1883. Classification of Goods, Chap. V., p. **96**; list of classes, post, pp. 214—218. The registrar has power to determine any doubt as to what class goods belong, rule 5 (post, p. 169).

A trade mark is assignable only in connection with the goodwill of the business concerned in the goods for which it is registered (sec. 22) [1]; but see also the saving clause to that section, and sec. 23 [2] as to the apportionment of marks on dissolution of partnership, and sec. 62 [3] as to standardisation marks.

A trade mark need not be registered for the whole of a register class of goods, and it should not be so registered if it is intended to be used for some only of the goods in the class, for a class necessarily contains several and may contain many "descriptions of goods" within

[1] Post, p. 66.
[2] Post, p. 68.
[3] Post, p. 106.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

the meaning of secs. 19 and 20. It is the practice of the office, when an application is made in the miscellaneous class, class 50, to require particular goods to be specified.

Registration for part of a class, pp. **97, 219**. Sec. 37,[1] which provides for the removal of a trade mark on the ground of non-user, empowers the Court to remove the mark in respect of any of the goods for which it is registered; see the notes to that section.

Apart from removal, a plaintiff would probably not be successful in an infringement action in endeavouring to assert exclusive rights in respect of goods in a class covered by his registration, but in which he had no real interest, at all events where the defendant could raise the question of the validity of the registration in the action. In *Edwards* v. *Dennis*, 30 C. D. 454, at p. 474, Cotton, L.J., said: "In my opinion "it is not the intention of the Act "[that of 1875] "that a man register- "ing a trade mark for the entire class, and yet only using it for one "article in that class, can claim for himself the exclusive right to use "the mark for every article in the class." And in *Hargreave* v. *Freeman*, [1891] 3 Ch. 39; 8 R. P. C. 237, Chitty, J., refused relief in an infringement action to a plaintiff whose mark, though registered for the whole tobacco class, was not applicable, and had not been used for cigars, and who was suing the defendant only in respect of cigars sold by him (p. **98**). Now, by rule 16, where the name or a description of any goods appears on a trade mark, the registrar may refuse to register it for other goods, but he may permit registration in cases where the name or description varies (post, p. 171) An old mark should only be registered for the goods in respect of which it was used, and the application must contain a statement as to user, which the registrar may require to be verified by declaration, rule 20 (post, p. 172); but where an old mark, which had been used before 1875 for sweetened gin, was registered in class 43 for fermented liquors and spirits, including liqueurs, and had, subsequently to registration, been used for sloe gin, Swinfen Eady, J., held that the plaintiffs were entitled to an injunction against a defendant who was using for sloe gin a mark so resembling the plaintiffs' registered mark as to be deceptive: *Board & Son* v. *Huddart*, 21 R. P. C. 149 (1904).

Sec. 26[2] provides for the registration of a series of trade marks for the same description of goods with particular variations.

[1] Post, p. 83. [2] Post, p. 70.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

9. A registrable trade mark must contain or consist of at least one of the following essential particulars [1]:— Registrable trade marks.

(1) The name of a company, individual, or firm represented in a special or particular manner;

(2) The signature of the applicant for registration or some predecessor in his business;

(3) An invented word or invented words;

(4) A word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;

(5) Any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the above paragraphs (1), (2), (3), and (4), shall not, except by order of the Board of Trade or the Court, be deemed a distinctive mark:

Provided always that any special or distinctive word or words, letter, numeral, or combination of letters or numerals used as a trade mark by the applicant or his predecessors in business before the thirteenth day of August one thousand eight hundred and seventy-five, which has continued to be used (either in its original form or with additions or alterations not substantially affecting the identity of the same) down to the date of the application for registration shall be registrable as a trade mark under this Act.

For the purposes of this section "distinctive" shall mean adapted to distinguish the goods of the proprietor of the trade mark from those of other persons.

In determining whether a trade mark is so adapted, the tribunal may, in the case of a trade mark in actual use, take into consideration the extent to which such user has rendered such trade mark in fact distinctive for the goods with respect to which it is registered or proposed to be registered.

[1] See ante, p. 3, and cf. the definitions of registrable trade marks of foreign countries, and those suggested to the committee which are set out in the Appendix, pp. 219–223.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

Notes.

Sec. 64 of the Act of 1883, as amended by sec. 10 of the Act of 1888, corresponds to this section. There were under sec. 64, as so amended, five classes—(a), (b), (c), (d), and (e)—of essential particulars, and the present classes of essential particulars are compared with those in the notes to this section. As to what marks might be registered as trade marks under the repealed section see Chap. VIII., p. **115**, and particularly "essential particulars," p. **122**.

The old section is altered by numerous minor amendments, which are chiefly verbal and are intended to make its language clearer, and in some instances to import into its language the interpretation which had been put upon the old section by the Court. The leading expressions of the old section, such as "invented word," have, however, been carefully preserved. There are also amendments of substance, constituting the most important changes effected by the Act. These are directed to enlarging the classes of essential particulars which qualify a mark for registration. See especially sub-sec. (5) below, p. 32.

The general effect of the changes is, if the object of the promoters of the Act is carried out, to render it possible to register everything which is effectively a trade mark.[1]

The provisions of the old section dealing with "added matter" and "disclaimers" (sec. 64 (2) and (3)) are omitted from the present section; see below, p. 55. The Act contemplates that a trade mark may contain matter other than an essential particular. See the opening words of this section and sec. 15, which relates to disclaimers.[2]

The present section enumerates merely conditions with which a trade mark must comply for registration. It must, besides containing or consisting of at least one of the essential particulars here specified, be a trade mark as defined by sec. 3,[3] and it must not be barred from registration by sec. 11[4] or under sec. 19.[5]

See generally, for a discussion of distinctiveness as an essential element of a trade mark apart from the Acts, Chap. II., p. **34**.

The question whether the present Act applies to applications for registration which are pending on the first day of April, when it comes into force, appears to be almost unimportant, since any former registration can now be supported under the present Act,[6] and the

[1] See Lord Justice Fletcher Moulton's address to the Associate Institute of Patent Agents, Proc. 1906, and the introductory chapter, ante, p. 7. Post, p. 54.

[3] Ante, p. 14.
[4] Post, p. 38.
[5] Post, p. 61.
[6] Sec. 36, post, p. 82.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

Act will cover every mark which might have been registered under the old Acts. See sec. 6.[1] It is possible that the principle of sec. 36 will be applied to pending registrations.[2]

COMPARISON OF ESSENTIAL PARTICULARS WITH THOSE UNDER SEC. 64 OF THE ACT OF 1883 AS AMENDED BY THE ACT OF 1888.

The corresponding sections of the old Acts are printed in italics below for comparison.

Word marks.

Word marks, see p. **156.** These are specially dealt with by sub-secs. (1) to (4). In most trades word marks are regarded as of great value and importance, but this is not the case in the Manchester trade, which is, to a great extent, conducted with foreign buyers who are unacquainted with English words or letters. Hence it has been provided that for cotton piece goods and yarn a word or words alone shall not be registered or deemed to be distinctive.[3] In the sewing cotton trade a different view is taken.

(1) The name of a company, individual, or firm represented in a special or particular manner.

(*a*) *A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner.*

Name marks.

See, as to name marks generally and the decisions on the old section, pp. **124—129.** See also sub-sec. (5) below.

Here the definite article is substituted for the indefinite. It must be *the* name of a company, etc. "Company" is now in the section. It was doubtful whether a company name was within the old section.[4]

It was held that the name of an imaginary character in a novel (*Trilby*) was not within the old section,[5] and that the name must be a mere name in the nominative case.[6] These decisions appear to apply to the present section.

"Represented" is practically equivalent to "printed, impressed, or "woven."

As to alterations in a trade mark, including an alteration in the

[1] Ante, p. 20.

[2] There is no express saving section corresponding to sec. 113 of the Act of 1883, or sec. 27 of the Act of 1888. See, however, the general provisions of sec. 38 of the Interpretation Act, 1889, post, p. 226.

[3] Sec. 64 (10), post, p. 112.

[4] Page **126.**

[5] *Holt & Co.'s Tm.*, 13 R. P. C. 118: [1896] 1 Ch. 711. C. A.

[6] *Pirie* v. *Goodall*, [1892] 1 Ch. 35: 9 R. P. C. 17, C. A. Cf. *Colman's Tm.*, [1894] 2 Ch. 115; 11 R. P. C. 129.

name of the proprietor, see sec. 34 (post, p. 77) and the notes thereto.

"Special or particular manner" does not appear to be capable of any meaning different from that put upon "particular and distinctive "manner" of the old section. These words were construed to exclude ordinary type,[1] capitals,[2] and common ornamental letters.[3] The words may be compared with "special and distinctive words" in the old sec. 64 (3) (ii.), as to which see p. **184**.

The name need not be that of the applicant for registration (cf. the next sub-section), but generally it would be either his name or that of one of his predecessors in business, but it might be the name of some outside person, as, for example, that of the manufacturer or inventor of the goods. Of course, there would be an objection, to which this section would have no application, to the registration of the name of a person without his consent.[4] Rule 15 now expressly provides for consents in the case of names or representations of persons living or recently dead.

Signatures.

(2) The signature of the applicant for registration or some predecessor in his business.

(*b*) *A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark.*

See p. **129**. See also sub-sec. (5) below.

The present sub-section brings in here the signature of a predecessor, which might have been admitted under the old sub-sec. (a). The removal of an express reference to a copy of a signature is unimportant, as the trade mark in use is always a copy.

Under the old Act the comptroller was advised that the sub-section must be construed 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 personal names, and that the sub-section did not include mere descriptive trading styles.[5] Accordingly such names as "The "Excellent Tea Co.," "The London Stout Co.," written in a current

[1] *Carroll's Application*, 16 R. P. C. 82 (1899), Kekewich, J.

[2] *Gianaclis' Tm.*, 6 R. P. C. 467 (1889), North, J.

[3] *Re Price's Patent Candle Co.*, 27 C. D. 681 (1884), Pearson, J.

[4] Cf. the American decisions that it is actionable to use a lady's photograph as a trade mark without her consent.

[5] Trade Marks Journal, January 1st, 1896. See pp. **130, 733.**

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hand, were not accepted as signatures,[1] nor was a sham personal name assumed by a trader to advertise a particular brand of goods, as Macfarlane & Co. for Scotch whisky.[2]

(3) An invented word or invented words. — Invented words.

(d) An invented word or invented words.

Word marks, p. **156**. Invented word, p. **171**. See also sub-sec. (5) below.

Words, except as old marks, could not be registered as trade marks under the Act of 1875. Under sec. 64 of the Act of 1883 in its original form, a "fancy word or words not in common use" constituted an essential particular, but until some time after the Act of 1888 this provision was construed very strictly by the Courts in relation to word marks registered or applied for under the Act of 1883. Recently the decisions have been more favourable; and BOVRIL (for foods) (*Re Tm. Bovril*, [1896] 2 Ch. 600; 13 R. P. C. 382), MAZAWATTEE (for tea) (*Densham's Tm.*, [1895] 2 Ch. 176; 12 R. P. C. 75 and 271), and, lastly, TABLOID (for compressed drugs) (*Burroughs, Wellcome & Co.'s Tm.*, [1904] 1 Ch. 736; 21 R. P. C. 69 and 217), have all been upheld as fancy words. A complete list of the decisions as to fancy words up to 1901 is given at pp. **170** and **171**. The *Tabloid case* is the only decision since 1901. Until the judgment of the House of Lords in the *Solio case* the decisions as to invented words had also been mainly adverse to registration; but in that case it was finally decided that sub-secs. (d) and (e) were disjunctive, and therefore that an invented word need not be a word having no reference to the character or quality of the goods (p. **171**).[3] It was also said in that case that, whilst there must be invention, the quantum of invention is immaterial. All that is necessary is that the word shall be substantially a newly coined word.[4] But a mere misspelling or the addition of a common termination to an ordinary word which leaves the compound a mere obvious variation of the known word without constituting a substantially different word does not constitute an invented word, so that UNEEDA is not an invented word: *Re Tm. Uneeda, National*

[1] Trade Marks Journal, January 1st, 1896. See pp. **130, 733.**

[2] *Macmillan* v. *Ehrmann*, 21 R. P. C. 357 (1904), Buckley, J.

[3] *Eastman Photographic Materials Co., Ltd.'s Application*, [1898] A. C. 571, 15 R. P. C. 476, *Solio* for photographic paper; *Kodak, Ltd.* v. *London Stereoscopic Co., Ltd.*, 20 R. P. C. 337 (1903), Eady, J., at p. 350.

[4] See the case cited in the following note.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

Biscuit Co.'s Application, [1901] 1 Ch. 550, [1902] 1 Ch. 783, 18 R. P. C. 170, 19 R. P. C. 281; nor is ABSORBINE (for an absorbent ointment): *Christy & Co.* v. *Tipper & Son*, [1905] 1 Ch. 1, 21 R. P. C. 97 and 755. As to the date to be considered in reference to the invention of the word, Warrington, J., in a recent case,[1] expressed the opinion, although without deciding the point, that a word in order to come within this clause must be newly invented substantially at the date of the application for registration, but he decided that, at all events, it must be invented for the purpose of being used as a trade mark in respect of the particular goods. As regards the first point Eady, J., in *Re the Trade Marks of Kodak, Ltd.*, 20 R. P. C. 337 (1903), held that, if a word was really a newly invented word when adopted as a trade mark, the mark does not become invalidated because of an interval between its first user and its registration. In that case the word had been used for cameras and films since 1888, and had been registered for cameras in 1888, but not for films until 1891; but the latter registration (as well as the former) was held to be good. The opinion of Warrington, J., does not actually conflict with that of Eady, J., for cameras and films may probably be considered for this purpose as the same description of goods. Mere publication of the word in this country before registration does not prevent a word being an invented word: *Linotype Co.'s Application*, [1900] 2 Ch. 238, 17 R. P. C. 380; nor need the applicant for registration be the inventor (S. C.). See, however, on the last point, the judgment of Kay, L.J., in *Holt & Co.'s Tm.*, [1896] 1 Ch. 711; 13 R. P. C. 118 (p. **177**).

The following words were held to be invented words under the old Act:—

KYNITE, *Kynoch & Co.'s Tm.*, 14 R. P. C. 905 (1897); MAZAWATTEE, *Densham's Tm.*, [1895] 2 Ch. 176, 12 R. P. C. 75, 271; SAVONOL, *J. C. & J. Field, Ltd.* v. *Wagel Syndicate, Ltd.*, 17 R. P. C. 266 (1900); SOLIO, *Eastman Photographic Materials Co.'s Application*, [1898] A. C. 571, 15 R. P. C. 476; TACHYTYPE, *The Linotype Co.'s Application*, [1900] 2 Ch. 238, 17 R. P. C. 380; NEOSTYLE, *Neostyle Manufacturing Co., Ltd., Tm.*, 20 R. P. C. 329 (1903); KODAK, *Kodak, Ltd.* v. *London Stereoscopic Co.*, 20 R. P. C. 337 (1903); VEZET, *Verschure & Zoon's Application*,[2] 22 R. P. C. 568 (1905).

[1] *Hommel* v. *Gebrüder, Bauer & Co.*, 21 R. P. C. 576 (1904), Warrington, J.

[2] Held not, under special circumstances, to be objectionable as being the equivalent in Dutch of the letters V, Z.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

The following were held not to be invented words under the old Act:—

APOLLINARIS, *Apollinaris Co.'s Tm.*, [1891] 2 Ch. 186, 8 R. P. C. 137; EBOLINE,[1] *Sir Titus Salt & Co.'s Application*, [1894] 3 Ch. 166, 11 R. P. C. 517; ELECTROZONE, *British Electrozone Co.'s Application*, 13 R. P. C. 447 (1896); EMOLLIOLORUM, *Talbot's Tm.*, 11 R. P. C. 77, (1894) W. N. 12; FORMALIN,[2] *Formalin Hygienic Co.'s Application*, 17 R. P. C. 486 (1900); PERLE,[3] *Ripley & Son's Application*, 15 R. P. C. 151 (1898); SATININE, *Meyerstein's Tm.*, 43 C. D. 604 (1890); SOMATOSE,[1] *Farbenfabriken, etc., Co.'s Application*, [1894] 1 Ch. 645, 11 R. P. C. 84; TRILBY, *Holt & Co.'s Tm.*, [1896] 1 Ch. 711, 13 R. P. C. 118; UNEEDA, *National Biscuit Co.'s Application*, [1901] 1 Ch. 550, 18 R. P. C. 170; PANORAM, *Kodak, Ltd.* v. *London Stereoscopic Co.*, 20 R. P. C. 337 (1903); BIOSCOPE, *Warwick Trading Co.* v. *Urban*, 21 R. P. C. 240 (1904); HÆMATOGEN,[4] *Hommel* v. *Gebrüder, Bauer & Co.*, 21 R. P. C. 576, 22 R. P. C. 43 (1904); ABSORBINE, *Christy & Co.* v. *Tipper*, 21 R. P. C. 97, 755 (1904).

Words not referring to the character or quality of the goods.

(4) A word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname.

(c) *A word or words having no reference to the character or quality of the goods, and not being a geographical name.*

See pp. **178—184**; see also sub-sec. (5) below.

The qualifications "direct" reference[5] and "according to its ordinary "signification" are new, but they import the construction put upon the old section by the Court,[6] and possibly at the same time in some degree extend the class of words which may be registered. "Not "being according to its ordinary signification a surname," is also new, but the comptroller refused to accept mere surnames as essential particulars under the old Act.[7]

Sub-sec. (3) is intended to deal with new or "invented" words, sub-secs. (1) and (2) with personal names and signatures. The present

[1] Decided before the *Solio case* (ante, p. 27, n. 3), and on grounds not now approved.

[2] Held to be the name of the article. See p. **243**.

[3] Equivalent to "pearl."

[4] On the particular facts.

[5] Substituted in the House of Lords for "obvious reference," the original expression of the Bill, which was much discussed before the committee.

[6] *Eastman Photographic Materials Co.'s Application*, [1898] A. C. 571, 15 R. P. C. 476, *Solio*, and as to geographical names *Magnolia Metal Co.'s Tm.*, [1897] 2 Ch. 371; 14 R. P. C. 265 and 621.

[7] P. **731**; Trade Marks Journal, November 6th, 1889.

sub-section deals with such existing words as are generally admitted as "essential particulars," and to these the first proviso in sub-sec. (5) adds such other words, not falling within any of the classes of registrable words, as, being nevertheless in fact distinctive marks, are specially admitted by order of the Board of Trade or the Court.[1]

The antithesis of the present sub-section is a *descriptive* word, such as the name of the goods themselves or the name or description of some real or alleged characteristic of the goods, as, for instance, their quality or uses. Such descriptive words ought to be open to all the trade and to the public, and no trader ought to be allowed to monopolise them.

See, as to descriptive words generally, pp. **36** *et seq.*, **140, 163** *et seq.*

Apart from the Act, it has always been held that a word which is the name of,[2] or is descriptive of, the goods cannot be a trade mark. It sometimes happens that a word which is *primâ facie* descriptive, or was originally descriptive, acquires a distinctive meaning, and comes by its use in connection with the goods of a particular trader to indicate and distinguish his goods. A word which has acquired a "secondary distinctive meaning" may be a good trade mark apart from the Acts. It could not, however, have been registered under the old Acts, and it could not be registered under the present sub-section, although possibly it might be admitted to registration by special order under sub-sec. (5).

As to secondary distinctive meanings of words *primâ facie* descriptive see pp. **36, 140, 165.**

As to geographical names see pp. **157, 166, 182.**

The following words were held to be words having no reference, etc., within the old sub-sec. (e):—

KYNITE, for explosives, *Kynoch's Tm.*, 14 R. P. C. 905 (1897); MAGNOLIA, for a metal alloy, *Magnolia Metal Co.'s Tms.*, [1897] 2 Ch. 371, 14 R. P. C. 621; MAZAWATTEE, for tea, *Densham's Tm.*, [1895] 2 Ch. 176, 12 R. P. C. 75, 271; SOLIO, for photographic paper, *Eastman Photographic Materials Co.'s Application*, [1898] A. C. 571, 15 R. P. C. 476; TRILBY, for gloves, blouses, etc., *Holt & Co.'s Tm.*, [1896] 1 Ch. 711, 13 R. P. C. 118; KODAK, BROWNIE, and BULLSEYE, for cameras and photographic films, *Kodak, Ltd.* v. *London Stereoscopic*

[1] See post, p. 32.

[2] See *Chesebrough Manufacturing Co.'s Tms.*, 18 R. P. C. 191, 19 R. P. C. 342, [1902] 2 Ch. 1, *Vaseline*, and the cases there cited. *Vaseline* was, however, held to be a good trade mark.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

Co., 20 R. P. C. 337 (1903); QUAKER, for whisky, *Ellis & Co.'s Tm.*, 21 R. P. C. 617 (1904); VEZET, *Verschure & Zoon's Application*, 22 R. P. C. 568 (1905).

The following words were held not to be words within the old sub-sec. (e):—

APOLLINARIS, for natural mineral waters, *Apollinaris Co.'s Tm.*, [1891] 2 Ch. 186, 8 R. P. C. 137; EDGES' FILTERED BLUE, for laundry blue, *Edges' Tm.*, 8 R. P. C. 207 (1891); EMOLLIOLORUM, for harness paste, *Talbot's Tm.*, 11 R. P. C. 77 (1894); JOHN BULL, for fermented liquors and spirits, *Paine's Tm.*, 9 R. P. C. 130 (1892); NECTAR, for tea, coffee, etc., *Harrisons & Crosfield's Application*, 18 R.P.C. 34 (1901); PERLE,[1] for cloth, etc., *Ripley's Application*, 15 R. P. C. 151 (1898); SATININE, for starch and soap, *Meyerstein's Application*, 7 R. P. C. 114 (1890); SOMATOSE,[2] for a pharmaceutical product from meat, *Farbenfabriken Co.'s Application*, [1894] 1 Ch. 645 11 R. P. C. 84; TYPOGRAPH, for metal and certain machinery *Linotype Co.'s Application*, 14 R. P. C. 900 (1897); UNEEDA, for biscuits, *National Biscuit Co.'s Application*, [1901] 1 Ch. 550, [1902] 1 Ch. 783, 18 R. P. C. 170, 19 R. P. C. 281; PANORAM, for a panoramic camera, *Kodak, Ltd.* v. *London Stereoscopic Co.*, 20 R. P. C. 337 (1903); ABSORBINE, for a lotion, 21 R. P. C. 97; see also p. 755 (1904); BIOSCOPE,[3] for cinematograph apparatus, 21 R. P. C. 240; HÆMATOGEN, for medicines, *Hommel* v. *Gebrüder, Bauer & Co.*, 21 R. P. C. 576[3]; CENTURY, for machinery, *Printing Machinery Co.'s Application*, 23 R. P. C. 38 (1906).

"Geographical name" in the old sub-sec. (e) was held not to be equivalent to "the name of a place," and a word which happened to be the name of a place might, nevertheless, be admitted to registration, if it was clearly not used or likely to be understood in a geographical sense.[4]

The following words were held to be geographical names within the meaning of the old sub-sec. (e):—

APOLLINARIS, for mineral water, the name of the spring, *Apollinaris Co.'s Tm.*, [1891] 2 Ch. 186, 8 R. P. C. 137; EBOLINE,[5] for

[1] Equivalent to "pearl."

[2] This and the earlier cases were decided before the sub-section was construed by the House of Lords in the *Solio case*. See p. 37, n. 3, post. Several of these words were afterwards registered.

[3] On the facts as to previous use rather than the nature of the word.

[4] See the *Magnolia case*, cited below.

[5] Because of Eboli, a small town in Italy. The decision might have been the other way after the *Magnolia case*.

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silk, *Sir Titus Salt & Co.'s Application*, [1894] 3 Ch. 166, 11 R. P. C. 517.

The following words were held not to be geographical words within the meaning of the old sub-sec. (e):—

MAGNOLIA,[1] for a metal alloy, *Magnolia Metal Co.'s Tms.*, [1897] 2 Ch. 371, 14 R. P. C. 265; MAZAWATTEE, for tea, *Densham's Tm.*, [1895] 2 Ch. 176, 12 R. P. C. 75, 271.

Other distinctive marks.

(5) Any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the above paragraphs (1), (2), (3), and (4), shall not, except by order of the Board of Trade or the Court, be deemed a distinctive mark.

Notes.

This is the sub-section under which all ordinary trade marks other than word marks will fall. It includes the whole of the old sub-sec. (c), for "mark" includes device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof (sec. 3).

Sec. 64 (1) (c) of the Act of 1883: *a distinctive device, mark, brand, heading, label, or ticket*, p. **131.**

This sub-section therefore, coupled with the definition of "mark," adds distinctive names, signatures, words, letters, and numerals to the essential particulars covered by (c) of sec. 64 of the Act of 1883, the scheme of the whole section being to admit as an essential particular any distinctive mark, but with the proviso to the effect that neither names, signatures, nor words are by virtue of (5) only to be deemed distinctive, unless they pass the Board of Trade or the Court. Under the rules an application to register a name, signature, word or words, under this sub-section is to be made on a special form, the ordinary form not being applicable. The registrar notifies the result of a search for similar marks on record, and afterwards the applicant can elect to be heard by the Board of Trade or the Court, rules 35—41 (post, p. 174).

Distinctiveness is an essential element in a trade mark apart from the Acts, Chap. II., p. **34**; distinctive, pp. **132—140**; loss of distinctiveness, p. **339**.

It was under the repealed Acts necessary that the mark should be distinctive apart from colour (pp. **150, 194**), but this is no longer so

[1] The name was taken from the flower, but there are several small towns bearing the name in the United States.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

if the mark is limited as regards colour, so as to be distinctive in the colour or colours in which it is registered (sec. 10).[1] A mark may fail to be distinctive not only by reason of the use of the mark by other persons as a trade mark, but also by reason of its use in advertisements, showcards, etc., or in other ways either physically connected with the goods, or not so connected (p. **139**, and *Louise* v. *Gainsborough*, 20 R. P. C. 61 (1903); and see also *In the Matter of the Anglo-Swiss Condensed Milk Co.'s Tms.*, 20 R. P. C. 509; 21 R. P. C. 261 (1904); and *In the Matter of Verity's Tm.*, 19 R. P. C. 58 (1903)).

Device, p. **141**. A collection of English letters could not, under the Act of 1875, be registered as a device: *Ex p. Stephens*, 3 C. D. 659 (1876), nor a single letter: *Mitchell's Tm.*, 7 C. D. 36 (1877); but "mark," under the Act of 1905, includes "letter," so that a single letter, if distinctive, can be registered. Under the Act of 1888, a device or combination of devices was not required to be verbally described in the statement of essential particulars: *Crompton's Tm.*, [1902] 1 Ch. 758; 19 R. P. C. 265. The form of application under the present Act does not require a statement of essential particulars. See form (post, p. 195). Certain devices, *e.g.*, royal arms or crests, may not appear on registered trade marks, and as to some other devices, *e.g.*, arms of a foreign state or of a city, justification or consent may be required. See rules 11 to 16 (post, p. 170).

Brand, p. **147**. A word mark cannot be registered as a brand: *Piric* v. *Goodall*, [1892] 1 Ch. 35; 9 R. P. C. 17.

Heading, p. **150**. This probably covers line headings in the cotton trades, and as these are essentially colour marks, the Act would facilitate their registration. See sec. 10.[1] But in respect of cotton piece goods no mark consisting of a line heading alone is to be deemed distinctive (sec. 64 (10)).

Label, p. **150**. The question of what constitutes a label, and especially with reference to disclaimers, has caused considerable difficulty. Under the repealed Acts a distinctive label could be registered without disclaimer of words forming part of it, and of which no exclusive use could be claimed (see p. **153**, and the cases there cited, especially *Clement et Cie.'s Tm.*, [1900] 1 Ch. 114; 16 R. P. C. 173 and 611, and p. **208**). The whole matter of disclaimers is put on a new footing by the Act. See sec. 15.[2]

Ticket, p. **156**.

[1] Post, p. 37.

[2] Post, p. 54.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

"Distinction."

"For the purposes of this section 'distinctive' shall mean "adapted to distinguish the goods of the proprietor of the "trade mark from those of other persons.

"In determining whether a trade mark is so adapted, the "tribunal may, in the case of a trade mark in actual use, take "into consideration the extent to which such user has rendered "such trade mark in fact distinctive for the goods with respect "to which it is registered or proposed to be registered."

These provisoes are new. The first merely expresses the meaning which has been put by the Courts on the word "distinctive."

In order to be distinctive, a mark must be different from other marks used upon, or in connection with, similar goods of other traders. In the case of a mark already used, the difference must be such as to distinguish the goods which bear the mark as the goods of the proprietor. As to marks not used before the application to register, their distinctiveness must depend on the capacity to distinguish the mark, having regard to the other marks used in the trade, p. **134**. In *Louise* v. *Gainsborough*, 20 R. P. C. 61 (1903), Farwell, J., after stating that in the case of an old trade mark distinctiveness was a question of historical fact, said, "In the case of a new mark "that cannot, of course, be so, but it means that the word must be "capable of distinguishing the goods of the plaintiff, as goods of his "manufacture or selection, from the goods of all other persons."

Descriptive marks are not distinctive, whether they describe the goods themselves or some characteristic which is attributed to them,[1] but marks which are *primâ facie* descriptive may have become by use in connection with the goods of a particular trader distinctive of such goods, just as words which are *primâ facie* descriptive may sometimes acquire a "secondary distinctive meaning."

As to descriptive marks, see generally pp. **36, 140, 163**, and **178**.

The proviso to the definition of a "distinctive" mark makes it clear that actually distinctive, and not *primâ facie* distinctive, is what is meant, and that the tribunal which has to determine whether a particular mark is distinctive or not may hold it to be distinctive notwithstanding that it is *primâ facie* a descriptive mark, if it has by use acquired a distinctive meaning. This is new, at any rate as regards word marks, since words which had only a "secondary distinctive "meaning" were not capable of being the essential particular of a trade mark under the old Acts.[2]

[1] See ante, p. 30.

[2] See pp. **163—165**.

The definition of "distinctive" so as to comprise words or other marks which have acquired a distinctive signification by actual use, and the provision for the admission of word marks not falling under the earlier sub-section by an order of the Board of Trade or the Court, are intended to open the register to the numerous marks, and particularly word marks, which are in actual use and are valuable "common law" trade marks, but which do not comprise or consist of any of the essential particulars enumerated in the old section or in sub-secs. (1)—(4).

The effect of sub-sec. (5) as regards word marks may be summed up by saying that it enables the Board of Trade or the Court to admit individually marks which by the result of actual user or otherwise are shown to be, as individuals, distinctive marks, although they belong to classes which are to be treated as, in general, not distinctive.[1]

Numerous examples of such trade marks, which may now, it is assumed, be registered, are furnished by the decided cases under the old Acts, *e.g.*, "Stone Ales," *Thompson* v. *Montgomery*, [1891] A. C. 217; 8 R. P. C. 361; and "Yorkshire Relish," *Powell's Tm.*, [1893] 2 Ch. 388; [1894] A. C. 8; 10 R. P. C. 63, 195; 11 R. P. C. 4. Probably such well-known marks as "Black and White" for whisky, and possibly "Camel Hair" for belting,[2] can also now be registered.

Old marks.

"Provided always that any special or distinctive word or "words, letter, numeral, or combination of letters or numerals "used as a trade mark by the applicant or his predecessors in "business before the thirteenth day of August 1875, which has "continued to be used (either in its original form or with additions "or alterations not substantially affecting the identity of the same) "down to the date of the application for registration shall be "registrable as a trade mark under this Act."

Old marks, p. **184**.

The 13th of August, 1875, is the date of the passing of the first Trade Marks Act, which made no provision for word marks except in the case of words used before the date of its passing. Its provisions as to old marks were substantially incorporated in sec. 64 (3) (ii) of the Act of 1883, which was as follows:—

Any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures used as a

[1] See Lord Justice Fletcher Moulton's address, cited ante, p. 3.

[2] See *Reddaway* v. *Banham*, [1896] A. C. 199; 13 R. P. C. 218.

The refcrences to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

trade mark before the 13th day of August, 1875, may be registered as a trade mark under this part of this Act.

"Figure" for which numeral is now substituted was held to mean numeral: Ex p. *Stephens*, 3 C. D. 659 (1876). The new proviso, it will be seen, substitutes "special or distinctive" for "special and "distinctive." As to the meaning of distinctive see above. The provisions of the section as to distinctiveness follow the proviso as to old marks, and apply to distinctiveness in relation to them. The mark must continue to be distinctive at the date of registration: *Wood* v. *Butler*, 32 Ch. D. 247; 3 R. P. C. 81; *Re Bourne's Tms.*, [1903] 1 Ch. 211; 20 R. P. C. 105. The mark must have been used as a trade mark, and not merely as a description of the goods; it must "sell "the goods": *Powell's Tm.*, [1893] 2 Ch. 388; [1894] A.C. 8; 10 R. P. C. 63, 195; 11 R. P. C. 4. And it was held in the same case that the old mark must have been used alone, and not as a part only of the actual trade mark, and must be registered as used. See cases cited p. **191**, also *Crompton & Co.'s Tm.*, [1902] 1 Ch. 758; 19 R. P. C. 265; and *Heddle & Co.'s Application*, 20 R. P. C. 599 (1903). Under the new proviso, minor additions and alterations in use are permitted. "Continued in use," that is to say, substantially continued, perhaps the provisions of sec. 37[1] may be taken as a guide. It is not apparently necessary, as heretofore, in order to defeat the claim for registration of an old mark, that it should have been actually abandoned. Device marks are not within the proviso.[2] Different considerations may apply when comparison has to be made between old marks from those which would apply to new marks: *In the Matter of the Tms. of Bass, Ratcliff & Gretton, Ltd.*, [1902] 2 Ch. 579; 19 R. P. C. 129, 529.[3] As to colour in reference to old marks, see the notes to sec. 10. When it is sought to remove from the register an old mark long registered, the validity of the registration depending on the proof of facts existing at the date of registration, the Court will give the registered owner the benefit of any doubt.[4]

An application to register an old mark must contain a statement of the time during which and by whom it has been used in respect

[1] Post, p. 83.

[2] *Wright, Crossley & Co.'s Application*, [1900] 2 Ch. 218; 17 R. P. C. 386.

[3] In this case a simple diamond was held to be distinctive notwithstanding the existence of more complex trade marks into which a diamond entered.

[4] *Chesebrough Manufacturing Co.'s Tm.*, [1902] 2 Ch. 1; 19 R. P. C. 342; and *Burroughes, Wellcome & Co.'s Tms.* (1904), 21 R. P. C. 217.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

of the goods. The registrar may require a statutory declaration verifying the user claimed, rule 20 (post, p. 172).

The old sec. 64 dealt also with added matter and disclaimers, namely by sub-secs. (2) and (3). Sec. 15[1] of the present Act deals with disclaimers, and the Act contains no express provisions as to added matter, but it certainly contemplates that a trade mark may include matter other than an essential particular. See notes to sec. 15. The proviso to the old sub-sec. (3) that no entry on the register of a person's name affect the right of any owner of the same name to use it or its foreign equivalent is transferred to sec. 44.[2]

Restrictions in the rules.

The rules provide that the registrar may refuse to accept a mark on which certain specified words or devices appear. See rules 11 to 16 (post, p. 170), and notes to sec. 12 (post, p. 43).

Coloured trade marks.

10. A trade mark may be limited in whole or in part to one or more specified colours, and in such case the fact that it is so limited shall be taken into consideration by any tribunal having to decide on the distinctive character of such trade mark. If and so far as a trade mark is registered without limitation of colour, it shall be deemed to be registered for all colours.

Notes.

The earlier part of this is new. The corresponding section was sec. 67, and was as follows :—

Sec. 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.*" See p. 194.

The former rule was that a trade mark to be registrable must be distinctive, apart from colour.[3] In some cases marks were 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 being placed on the register.[4] It was doubtful how far this practice was authorised under the old Acts.[5]

The recognition of colour as a distinctive element is therefore new

[1] Post, p. 54.
[2] Post p. 93.
[3] *Hanson's Tm.*, 37 C. D. 112; 5 R. P. C. 130 (1887), Kay, J., red, white, and blue in three parallel stripes.
[4] See p. 196.
[5] See *Deichurst's Application*, [1896] 2 Ch. 137; 13 R. P. C. 288, *Golden Fan.*

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and important. It is in harmony with the amendments allowing distinctiveness in actual use to be considered (sec. 9).

Subject to any limitation of the registration to particular colours, the proprietor will still have the exclusive right to the use of the mark in any colour. Under the old Act it was held that the registration of a star was an objection to the registration of the words "Red Star "Brand" for the same class of goods,[1] and that a design similar in outline to another design, although the outline was filled up in a totally different manner, might too nearly resemble the latter design, because its distinctive filling up might be obscured by the use of a deep colour in printing.[2]

The section appears to apply to old marks. In a recent case Romer, L.J., reserved his opinion whether, under the existing Acts, colour could enter into the distinctiveness of an old mark. He was not convinced that all consideration of questions of colour should be omitted.[3]

Where a mark is registered without limitation of colour, the registrar may grant a certificate of registration for the purpose of obtaining registration abroad in the colour in which it appears in the register or in any other colour or colours, rule 103 (post, p. 185).

Restriction on registration.

11. **It shall not be lawful to register as a trade mark or part of a trade mark any matter, the use of which would by reason of its being calculated to deceive or otherwise be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.**

This corresponds to sec. 73, which was as follows:—

Sec. 73. "*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, or any scandalous design.*"

The present section is made more general by the substitution of "any matter" for "any words."

As to deceptive marks, see Chap. XIII., pp. **253—261**, and cf. sec. 86 of the old Act, which forbade the registration of a trade

[1] *Société, etc., de l'Etoile Tm.*, [1894] 1 Ch. 61; 2 Ch. 26; 10 R. P. C. 436; 11 R. P. C. 142, Stirling, J., and C. A.

[2] *Worthington's Tm.*, 14 C. D. 8 (1880), C. A.

[3] *Bass' Tms.*, [1902] 2 Ch. 579; 19 R. P. C. 529.

mark, the use of which would, in the Comptroller's opinion, be contrary to law or morality.

The old sec. 73 has in numerous decisions been held not to be confined to something inherently deceptive in the mark itself,[1] and it has in many instances formed the ground of the refusal of registration by reason of the resemblance of the proposed mark to another mark where the express provisions of the old sec. 72 did not apply, *e.g.*, where the other mark was unregistered, or where the mark as a whole did not resemble the other mark sufficiently to be within sec. 72, but contained words similar to words in the other mark.[2]

"Disentitled to protection." These words are not equivalent merely to "not entitled to protection," which was the provision in the Act of 1875. The mere fact of words being descriptive, therefore, would not bring them within the prohibition of this section.[3]

The words "trade mark" occurring in a registered label may be calculated to deceive, if they would lead people to suppose that a part only of the label was registered;[4] but the question whether such words in any particular case are deceptive is one of fact merely.[5] Part of a registered trade mark, which is itself a distinctive trade mark, may now be separately registered under sec. 25.[6]

Registration of Trade Marks.

Application for registration.

12.—(1) Any person claiming to be the proprietor of a trade mark who is desirous of registering the same must apply in writing to the registrar in the prescribed manner.

(2) Subject to the provisions of this Act the registrar may refuse such application, or may accept it absolutely or subject to conditions, amendments, or modifications.

(3) In case of any such refusal or conditional acceptance the

[1] *Eno* v. *Dunn*, 15 App. Cas. 252; 7 R. P. C. 311, is the leading case. See also *Deuhurst's Application*, [1896] 2 Ch. 137; 13 R. P. C. 288.

[2] *E.g.*, *Booth's Distillery Co.'s Application*, 21 R. P. C. 18 (1904), Farwell, J.; and cf. *Ellis' Tms.*, 21 R. P. C. 617 (1904), Farwell. J. (Quaker for spirits).

[3] *Faulder's Tm.*, 18 R. P. C. 37, Kekewich, J., and see *Smokeless Powder Co.'s Tm.*, [1892] 1 Ch. 590; 9 R. P. C. 109. *Faulder's Tm.* was appealed 18 R. P. C. 535, but the Court of Appeal did not decide this point.

[4] *Apollinaris Co's. Tms.*, [1891] 2 Ch. 186; 8 R. P. C. 137. Rule, 11 as first drafted, included the words "trade mark," but these words are not in the rule as promulgated.

[5] *Bass' Tms.*, 19 R. P. C. 529, where the devices on which the words occurred were also separately registered, and the Court held that there was no deception.

[6] Post, p. 70.

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registrar shall, if required by the applicant, state in writing the grounds of his decision and the materials used by him in arriving at the same, and such decision shall be subject to appeal to the Board of Trade or to the Court at the option of the applicant.

(4) An appeal under this section shall be made in the prescribed manner, and on such appeal the Board of Trade or the Court, as the case may be, shall, if required, hear the applicant and the registrar, and shall make an order determining whether, and subject to what conditions, amendments, or modifications, if any, the application is to be accepted.

(5) Appeals under this section shall be heard on the materials so stated by the registrar to have been used by him in arriving at his decision, and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the registrar, other than those stated by him, except by leave of the tribunal hearing the appeal. Where any further grounds of objection are taken the applicant shall be entitled to withdraw his application without payment of costs on giving notice as prescribed.

(6) The registrar or the Board of Trade or the Court, as the case may be, may at any time, whether before or after acceptance, correct any error in or in connection with the application, or may permit the applicant to amend his application upon such terms as they may think fit.

Notes.

Sub-secs. (1)—(5) of the section correspond generally to the old sec. 62, and sub-sec. (6) to the old sec. 91 (a) and (d).

Registration of trade marks.[1]—The Act is permissive, as were all the previous Acts. A trade mark may exist, and very numerous trade marks do exist, apart from the register, many of which for various reasons were, and some of which still are, incapable of registration.[2] The proprietor of an unregistered mark cannot sue for "infringement";[3] but if the effect of the infringement is to pass off the goods of the infringer as his goods, he may sue to restrain its continuance and to recover damages.[4]

[1] See Chap. IV., p. **63**. See Chap. XVI., p. **446**, and common law marks, pp. **450**, **451**.

[3] Sec. 42, post, p. 91.

[4] See sec. 45, post, p. 94.

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An ordinary application for registration comes in the first instance before the registrar, who considers whether the proposed mark, on the face of it, is a registrable mark, and, in particular, whether it contains or consists of one or more of the essential particulars enumerated in sec. 9, whether it is deceptive or such as to be disentitled to protection under sec. 11, and whether it too nearly resembles a mark already on the register for the same goods or description of goods under sec. 19. He may reject the application, and his decision is subject to appeal under the present section. If he allows the application, but not otherwise, it is advertised in the Trade Marks Journal,[1] and any one may then give notice of opposition under sec. 14. If there is no opposition, or the opposition is disallowed either by the registrar or on appeal from him, the mark is entered upon the register. See sec. 16.

Under the rules an application to register a name, signature, or word under paragraph 5 of sec. 9 is to be made on a special form, and after the registrar has notified the result of a search the applicant has one month in which to elect whether he desires to go to the Board of Trade or the Court, rules 35 to 41 (post, p. 174). Application for standardization marks must also be made on a special form, rules 42 to 46 (post, p. 175).

(1) Any person claiming to be the proprietor of a trade mark who is desirous of registering the same must apply in writing to the registrar in the prescribed manner.

(2) Subject to the provisions of this Act the registrar may refuse such application, or may accept it absolutely or subject to conditions, amendments, or modifications.

These sub-sections correspond to the old sec. 62 (1), which was as follows :—

62 (1). "*The comptroller may, on the application of any person claiming to be the proprietor of a trade mark, register the trade mark.*"

Any person.—Person includes a body corporate, although the express provision of the old sec. 117[2] to that effect is not repeated, and the section is repealed. It is a general rule that when used in an Act of Parliament "person" includes any body of persons corporate or incorporate unless the contrary appears.[3] Under the old rules it was interpreted to include a firm or partnership.[4]

[1] Sec. 13 below.
[2] See also rule 41 of 1890.
[3] Interpretation Act, 1889, s. 19, post, p. 225; and see Stroud's Judicial Dic., "person."
[4] Rule 7 of 1890.

An application by a body corporate may be signed by a director or the secretary or other principal officer. Any member of a firm or partnership may sign an application in the name or on behalf of the firm or partnership. An application may be signed by an agent, rule 17 (post, p. 171).

There are a large number of entries upon the register in the assumed or trading names of individual persons or partnerships. How far such entries are justifiable under the Acts may be open to question, at any rate where the name is not the usual and recognised trade name or style of the applicant for registration. Descriptive names assumed for the purposes of trading, such as "The London "Stout Co.," were not accepted as signature marks under the old Act.[1]

As to the death of an applicant before registration, see rule 66 (post, p. 179).

Under the rules of 1890 applications could be made by agents authorised to the satisfaction of the comptroller.[2] Sec. 55 now provides for the recognition of agents.[3] See also rules 2 and 10 (post, pp. 168 and 170).

Proprietor.[4]—This includes a person who has acquired the mark as a trade mark[5] by actual user of it, or by assignment or transmission to him of the goodwill to which it is attached,[6] or has invented or adopted it with the intention[7] of using it either in an existing or newly started business in the goods for which he seeks to register it, or as a standardisation mark.[8]

Prescribed means prescribed by the rules.[9] Part of the procedure to be followed on an application to register[10] was embodied in the old Act[11]; it is now wholly relegated to the rules. As to ordinary applications the rules are 17 to 28 (post, p. 171). As to special applications under paragraph 5 of sec. 9, rules 35 to 41; and as to standardization marks, rules 42 to 46 (see post, pp. 174 to 176).

May refuse.—The registrar has a discretion to refuse to register a

[1] See sec. 9 (2), ante, p. 26, and the official notice of 1895 Journal, No. 925, p. 1038, printed at p. **733**. See also *Macmillan* v. *Ehrmann*, 21 R. P. C. 357 (1904), Buckley, J.

[2] See pp. **68**, **692**, and **726**.

[3] Post, p. 101.

[4] See "Who may apply to register," p. **65**.

[5] See sec. 3, ante, p. 14.

[6] Cf. sec. 22, post, p. 66. This applies to registered marks only.

[7] P. **119**. See *Batts & Co.'s Tm.*, [1898] 2 Ch. 432; 18 R. P. C. 262, 534, Romer, J., and C. A.: [1899] A. C. 428; 16 R. P. C. 411, and sec. 37, post, p. 83.

[8] See. 62.

[9] Sec. 3, ante, p. 14.

[10] See Chap. IV., p. **63**.

[11] Sec. 62 (2), (3), (6), s. 97, 98, 99.

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mark notwithstanding that it complies formally with all the requirements of the Act, but this is a judicial discretion and is subject to appeal,[1] but the Court will not overrule it unless satisfied that it was wrongly exercised.[2]

May accept it absolutely, etc.—This provision is new. The comptroller did in practice for a long period under the old Acts occasionally refuse to register a mark except subject to some condition which was noted on the register.[3] The most frequent condition was, where there was a possibly conflicting mark already registered in the same class, a limitation of the registration to particular goods, but this could be effected by an amendment of the application, and did not entail a special note on the register.[4] The practice of making such notes was considered to be somewhat doubtful.[5] Disclaimers of the exclusive right to a part of the mark as entered on the register, however, were expressly provided for by the old Act,[6] and they were frequently insisted on. An order has also sometimes been made for the entry of a disclaimer on a motion to rectify.[7] Under sec. 15 of the present Act and rule 34 the registrar may require such disclaimer as he may think fit for the purpose of defining the rights of the applicant under the registration.

Under the present Act the registrar may, subject to appeal, insist upon any conditions, amendments[8] or modifications which he thinks right. This will enable him to accept and register a large number of marks which he must otherwise have refused.

The registrar may, by rule 11 (post, p. 170), refuse to accept any application upon which any of the following appear, namely:—(a) The words "patent," "patented," "by royal letters patent," "registered,"[9] "registered design," "copyright," "entered at Stationers' Hall," "to counterfeit this is forgery," or words to like effect; (b) representations of their Majesties or of any member of the royal family. The following are also not to appear on trade marks, the registration of which is applied for:—Representations

[1] See p. **70** *et seq.*, and the reasons for refusal tabulated at p. **69**.

[2] See the recent cases of *Booth's Distillery Co.'s Application*, 21 R. P. C. 18 (1904), Farwell, J.; and *Verschure & Zoon's Application*, 22 R. P. C. 568 (1905), Warrington, J.

[3] See pp. **58**, **99**, **195**, **219**, **282**.

[4] Sec. 91 (d), and see as to an appeal p. **91**.

[5] See *Dewhurst's Tm.*, [1896] 2 Ch. 137; 13 R. P. C. 288, C. A.

[6] Secs. 64 (2) and 74. See Chap. IX., p. **197**.

[7] See p. **282**, and *Faulder's Tm.*, 18 R. P. C. 535, [1901] C. A.

[8] See also sub-sec. (6).

[9] Cf. *Altman's Application*, 21 R. P. C. 753, as to use of "registered" before registration.

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of the royal arms or royal crests, or arms or crests so nearly resembling them so as to lead to mistake, or of British royal crowns, or of the British national flags, or the word "royal," or any other words, letters, or devices calculated to lead persons to think that the applicant has royal patronage or authorisation, rule 12 (post, p. 171). There is an exception in favour of old marks hitherto registrable. There are also restrictions on the registration of foreign arms, and arms of cities, towns, etc., and of the names or representations of living persons, rules 13—15 (post, p. 171).

As to procedure on receipt of application, see rules 29 to 34. Acceptance may be under some circumstances withdrawn by the direction of the Board of Trade, sec. 16 (post, p. 59), and rule 63 (post, p. 179).

(3) In case of any such refusal or conditional acceptance the registrar shall, if required by the applicant, state in writing the grounds of his decision and the materials used by him in arriving at the same, and such decision shall be subject to appeal to the Board of Trade or to the Court at the option of the applicant.

(4) An appeal under this section shall be made in the prescribed manner, and on such appeal the Board of Trade or the Court, as the case may be, shall, if required, hear the applicant and the registrar, and shall make an order determining whether, and subject to what conditions, amendments, or modifications, if any, the application is to be accepted.

(5) Appeals under this section shall be heard on the materials so stated by the registrar to have been used by him in arriving at his decision, and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the registrar, other than those stated by him, except by leave of the tribunal hearing the appeal. Where any further grounds of objection are taken the applicant shall be entitled to withdraw his application without payment of costs on giving notice as prescribed.

Refusal to accept a mark.—The provision requiring the registrar to state in writing the grounds of his decision is new, but accords with the previous practice of the office. The registrar is now also to state the materials used by him in arriving at the decision.[1] The object of the provision is to enable an applicant to

[1] See rule 32 (post, p. 174). The registrar may take into consideration the fact of similar marks having been refused by him, at all events

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obtain advice with regard to an appeal, and sub-sec. (5) has the analogous object of preventing an appellant from being defeated on grounds or materials not raised or acted on by the registrar.

The registrar must give an applicant whose application has been refused the opportunity of being heard if duly required so to do.[1] He may in any case of doubt or difficulty take the directions of the Attorney-General or Solicitor-General.[2] Sub-sec. (3) confers on the applicant the option of appealing from the registrar either to the Board of Trade or the Court, whilst, if the appeal is to the Board of Trade, the Board itself may refer the appeal to the Court,[3] as they could and did, in practice, when asked to do so, under the Act of 1883. The applicant must make his election; if he appeals to the Board he cannot appeal further to the Court afterwards,[3] though he can (probably) make a fresh application. The right of appeal direct to the Court is new. As to procedure, see rules 121 to 127 (post, p. 188). An appeal is to be made within one month from the date of the decision. If to the Court, it is to be by motion.

In the case of rival claims to the same mark or to marks nearly identical, the registrar may refuse to register until the rights of claimants have been determined by the Court or have been settled by agreement in a manner approved by him or (on appeal) by the Board of Trade.[4] The provision, sub-sec. (4), giving the Board of Trade and the Court power to assent to or insist on amendments or modifications as a condition of registration is new and very useful. The Board of Trade or the Court could previously impose conditions,[5] but otherwise had to deal with the case as it was before the registrar, and without the power of taking into consideration any amendment of the application as regards the essential particulars or disclaimers of the exclusive use of added matter which the applicant might offer or the tribunal might suggest.[6] Under the repealed Acts it was held that a note confining the use of the mark to a limited geographical area should not be put on the register.[7]

where it is apprehended that they may be in actual use: *Booth's Distillery Co.'s Tms.*, 21 R. P. C. 18, [1904] Farwell, J.

[1] Sec. 53; cf. sec. 94 of the Act of 1883: also rules 31 and 32 (post, p. 174).

[2] Sect. 56. This has frequently been done under sec. 95 of the Act of 1883 as to questions arising in the office, and involving general practice or a matter of principle. See also the patent case *R. v. Comptroller-General of Patents, Ex p. Tomlinson*, [1894] 1 Q. B. 909; 16 R. P. C. 233. C. A.

[3] Sec. 59, post, p. 103; also rule 125 (post, p. 189).

[4] Sec. 20, post, p. 64.

[5] Old sec. 62 (4) and (5).

[6] See the cases cited at p. 92, note (*e*). See *Faulder's Tm.*, 18 R. P. C. 535, [1901] C. A.

[7] *Dewhurst's Application*, [1896] 2 Ch. 137; 13 R. P. C. 288. C. A.

The provisions of sub-sec. (5) are new, and are intended to prevent the hardship to an applicant, who incurs the expense of an appeal from the registrar, having to meet fresh objections on the appeal.[1] Hitherto the Court has held itself bound to consider all objections taken on appeal to an application.[2] The sub-section reserves to the Court the power of granting leave to the registrar to take a further ground of objection, and, if the objection arises out of new information obtained by the registrar or involves any general principle of importance, the leave will probably be granted.

Costs. The ordinary rule has been that a successful appellant pays the costs of the comptroller,[3] such costs being said by Chitty, J., to be costs incidental to the registration.[4] In some cases, however, a successful appellant has not been ordered to pay the comptroller's costs.[5] The last sentence of sub-sec. (5) now confers on an applicant the right to withdraw his application without payment of costs, where any further grounds of objection are taken on appeal by the registrar, on giving notice as prescribed. See rule 128 (post, p. 189). The withdrawal is to be by notice to the registrar within seven days after the leave referred to is given.[6] Under the repealed Acts there was no jurisdiction to order the comptroller to pay costs.[7] The present Act provides that in all proceedings before the Court under the Act the costs of the registrar shall be in the discretion of the Court, but that the registrar shall not be ordered to pay the costs of any other of the parties.[8]

There is no provision enabling the Board of Trade to give costs against an appellant: cf. sec. 14 (10)[9] below.

(6) The registrar or the Board of Trade or the Court, as the case may be, may at any time, whether before or after

[1] Before the committee the cases of *Player's Tms.*, *Player's Navy Mixture*, and *Denhurst's Tm.* (*Golden Fan*), in which new objections were raised in the appeal by counsel on behalf of the comptroller, were much insisted on as cases of hardship.

[2] *Re Arbenz's Application*, 35 C. D. 248; 4 R. P. C. 143 (1886), Kay, J., and C. A.; *Smiths Co.'s Tm.*, 4 R. P. C. 533 (1887), Kay, J., and other cases cited, p. **93**.

[3] Costs, p. **93**.

[4] *Re Tm. Alpine*, 54 L. J. Ch. 730 (1885).

[5] For instance, *Colman's Tm.*, [1894] 2 Ch. 115; 11 R. P. C. 129, Stirling, J.: cf. *Eastman's Application*, [1898] A. C. at p. 585; 15 R. P. C. at p. 487, H. of L.

[6] Compare the practice in patent actions where the defendant amends his particulars of objection.

[7] *Leaf's Tm.*, 33 C. D. 477; 3 R. P. C. 289 (1886); *Van Duzer's Tm.*, 3 R. P. C. at p. 243, both Bacon, V.-C., and other cases cited, p. **93**.

[8] Sec. 48, post, p. 97.

[9] Post, p. 49.

acceptance, correct any error in or in connection with the application, or may permit the applicant to amend his application upon such terms as they may think fit.

Amendment. This sub-section corresponds to parts of sec. 91 [1] of the repealed Acts; but the present provision is wider, and instead of being limited to particular amendments, is general in scope.[2]

The powers are now extended to the Board of Trade and the Court when an appeal is before either of them, and also so as to be available before or after acceptance.

Under rule 98 (post, p. 184), the registrar has a general power to amend documents and to correct irregularities in procedure.

Advertisement of application.

13. When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions, the registrar shall, as soon as may be after such acceptance, cause the application as accepted to be advertised in the prescribed manner. Such advertisement shall set forth all conditions subject to which the application has been accepted.

Notes.

Advertisement, p. 77. This section corresponds to the old sec. 68. Only verbal alterations are made, but it is now expressly provided that conditions of acceptance are to be advertised. Since the year 1892 the advertisements have included statements of essential particulars and disclaimers. Advertisement is now to be in the journal in such manner as the registrar may direct, rule 47. When no representation of the mark is inserted, there is to be a reference to the place where a specimen of the trade mark is deposited for exhibition.[3]

In view of the provisions of sec. 41[4] making, with certain exceptions, registration conclusive of validity after seven years from the date of registration or of the commencement of the Act, whichever shall last happen, it will in future be much more important that traders should watch the advertisements of marks applied for, in order to see that their rights are in no way interfered with.

In the case of modifications as the result of an opposition, the trade mark is to be re-advertised.[5]

[1] Pp. 78, 665.
[2] Rule 54 of 1890, pp. 78, 701.
[3] Rule 27 of 1890.
[4] Post, p. 88.
[5] Sec. 14 (9), post, p. 49.

Opposition to registration.

14.—(1) Any person may, within the prescribed time from the date of the advertisement of an application for the registration of a trade mark, give notice to the registrar of opposition to such registration.

(2) Such notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

(3) The registrar shall send a copy of such notice to the applicant, and within the prescribed time after the receipt of such notice, the applicant shall send to the registrar, in the prescribed manner, a counter-statement of the grounds on which he relies for his application, and, if he does not do so, he shall be deemed to have abandoned his application.

(4) If the applicant sends such counter-statement, the registrar shall furnish a copy thereof to the persons giving notice of opposition, and shall, after hearing the parties, if so required, and considering the evidence, decide whether, and subject to what conditions, registration is to be permitted.

(5) The decision of the registrar shall be subject to appeal to the Court or, with the consent of the parties, to the Board of Trade.

(6) An appeal under this section shall be made in the prescribed manner, and on such appeal the Board of Trade or the Court, as the case may be, shall, if required, hear the parties and the registrar, and shall make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

(7) On the hearing of any such appeal any party may either in the manner prescribed or by special leave of the tribunal bring forward further material for the consideration of the tribunal.

(8) In proceedings under this section no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the registrar other than those stated by the opponent as herein-above provided except by leave of the tribunal hearing the appeal. Where any further grounds of objection are taken the applicant shall be entitled to withdraw his application without payment of the costs of the opponent on giving notice as prescribed.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

(9) In any appeal under this section, the tribunal may, after hearing the registrar, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity of such trade mark, but in such case the trade mark as so modified shall be advertised in the prescribed manner before being registered.

(10) The registrar, or, in the case of an appeal to the Board of Trade, the Board of Trade, shall have power in proceedings under this section to award to any party such costs as they may consider reasonable, and to direct how and by what parties they are to be paid.

(11) If a party giving notice of opposition or of appeal neither resides nor carries on business in the United Kingdom, the tribunal may require such party to give security for costs of the proceedings before it relative to such opposition or appeal, and in default of such security being duly given may treat the opposition or appeal as abandoned.

Notes.

Opposition to registration, p. 79. This section corresponds to sec. 69 of the Act of 1883.[1] It deals with cases where the mark has passed the registrar and been advertised. Its sub-secs. (5) to (9) correspond to sub-secs. (3) to (5) of sec. 12.

Any person, not merely any person who would be aggrieved by the registration,[2] may oppose the registration on the ground of interference with his rights, or on the ground that for any other reason it ought not to be registered. This section deals with the general right of opposition, and not with the particular grounds. The following are some common grounds of opposition, viz.: (1) that the mark does not contain an essential particular within sec. 9[3]; or (2) that it is calculated to deceive or is otherwise disentitled to protection, and so precluded from registration by sec. 11[4]; or (3) that it is identical with a trade mark registered in respect of the same goods or description of goods and belonging to the opponent, or so nearly resembles such

[1] See also Rule 31 of 1890. An applicant or opponent or agent out of the United Kingdom must give an address for service in the United Kingdom (Rule 9 of 1906, post, p. 169).

[2] Cf. sec. 35. But see *R.* v. *Comptroller-General of Patents, Ex p. Tomlinson*, [1899] 1 Q. B. 909; 16 R. P. C. 233, C. A.

[3] Ante, p. 23.

[4] Ante, p. 38.

a trade mark as to be calculated to deceive[1]; or (4) that its registration would confer on the applicant the right to interfere with any mark or advertisement which the opponent is using; or (5) that the opponent has himself rights in the trade mark applied for;[2]

(1) Any person may, within the prescribed time from the date of the advertisement of an application for the registration of a trade mark, give notice to the registrar of opposition to such registration.

(2) Such notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

(3) The registrar shall send a copy of such notice to the applicant, and within the prescribed time after the receipt of such notice, the applicant shall send to the registrar, in the prescribed manner, a counter-statement of the grounds on which he relies for his application, and, if he does not do so, he shall be deemed to have abandoned his application.

(4) If the applicant sends such counter-statement, the registrar shall furnish a copy thereof to the persons giving notice of opposition, and shall, after hearing the parties, if so required, and considering the evidence, decide whether, and subject to what conditions, registration is to be permitted.

The corresponding parts of sec. 69 of the Act of 1883, as amended by the Act of 1888, were to the same effect, but comprised provisions as to time and procedure, now contained in Rules 51 to 61.[3]

The prescribed time is one month from the date of advertisement, (Rule 51, post, p. 177). The prescribed time for delivery of counter-statement is one month after the receipt of notice of opposition (Rule 53, post, p. 177).

The requirement of sub-sec. (2) that the grounds of opposition shall be stated in the notice of opposition, and the provision of sub-sec. (8) confining the opponent (now extended to the registrar) to the grounds so stated, were formerly contained in the Rules, but have been modified in their incorporation in the Act. See further notes to sub-sec. (8), below.

[1] Sec. 19, post, p. 61.

[2] See further, grounds of opposition, p. 85.

[3] For a table showing the order of procedure in an opposition under the repealed Acts and the Rules of 1890, see p. 82.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

Where the resemblance of the trade mark applied for to a registered trade mark is a ground of opposition, the opponent is required to state the number of the registered mark and the number of the journal in which it has been advertised.[1]

Apparently the abandonment of an opposition would not estop the opponent from applying to remove the mark from the register under sec. 35. See *Arbenz' Application*, 35 C. D. at p. 257; 4 R. P. C. at p. 145 (1887), C. A.

Evidence is to be given by statutory declaration in the absence of directions to the contrary, but power is now for the first time given to the registrar, with the consent of the parties, to take evidence *viva voce* in lieu of, or in addition to, evidence by declaration.[2] The same power is conferred on the Board of Trade on appeal.[3] The statutory declarations may be used before the Court on an appeal to it.[2] As to evidence generally in opposition, see Rules 54 to 57 (post, p. 177).

(5) The decision of the registrar shall be subject to appeal to the Court or, with the consent of the parties, to the Board of Trade.

(6) An appeal under this section shall be made in the prescribed manner, and on such appeal the Board of Trade or the Court, as the case may be, shall, if required, hear the parties and the registrar, and shall make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

(7) On the hearing of any such appeal any party may either in the manner prescribed or by special leave of the tribunal bring forward further material for the consideration of the tribunal.

(8) In proceedings under this section no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the registrar other than those stated by the opponent as herein-above provided except by leave of the tribunal hearing the appeal. Where any further grounds of objection are taken the applicant shall be entitled to withdraw his application without payment of the costs of the opponent on giving notice as prescribed.

(9) In any appeal under this section the tribunal may, after

[1] Rule 52, post, p. 177.
[2] Declarations, Rules 105 and 106, post, p. 185.
[3] Sec. 49, post, p. 98.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

hearing the registrar, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity of such trade mark, but in such case the trade mark as so modified shall be advertised in the prescribed manner before being registered.

Cf. sec. 12, sub-secs. (3), (4) and (5).

Appeal from the comptroller, p. **86.** The corresponding parts of sec. 69 of the repealed Act were, as amended by the Act of 1888 as follows:—

> (3) . . . *But his* [*i.e.*, the comptroller's] *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.*

The appeal may now be, as in the case of appeals from the registrar's refusal of a mark under sec. 12, either to the Court or to the Board of Trade, but unless the parties—that is the applicant and opponent—both agree to the appeal being to the Board of Trade, the appeal is to the Court.

The Board of Trade may itself refer to the Court an appeal to it,[1] but unless it does so, its decision is final. Probably in cases of oppositions it will not now do so,[1] except at the request of the registrar or where some general principle is involved. The appellate tribunal may, as under sec. 12, impose conditions as a term of registration, and may permit modifications of the mark not substantially affecting its identity.

The power given by sub-sec. (9) to allow modification is new,[2] and will be very useful in cases where it is possible to meet an opponent's objection by an alteration of the mark. The power is, however, confined to the tribunal on appeal, and is not expressly conferred on the registrar

[1] See. 59, post, p. 178. In practice under the old Acts the Board always referred repeals on contested oppositions to the Court.

[2] Under the repealed Acts the Courts have held that they had no power on appeal to allow an amendment. See *Player's Application*, [1901] 1 Ch. 382; 18 R. P. C. 65, and the cases cited as to disclaimers, p. **202.**

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

after advertisement. This omission may possibly be covered by sub-sec. (4). The trade mark must, as modified, be re-advertised; this is, of course, to protect persons who might have no objection to the mark, as originally advertised, but might wish to oppose it in its modified form. As to advertisement, see Rule 58.

It will be noticed also that the power contained in sub-sec. (8) of allowing further grounds of opposition to be taken is confined to the tribunal hearing the appeal.

The appeal to the Court was, under the repealed Act, by summons or motion, but usually by motion.[1] It is now to be by motion, the ordinary time allowed being one month (Rule 21, post, p. 172).

For the procedure on appeal to the Board of Trade, see Rules 122 to 127; the prescribed time is within one month from the date of the decision.

As to evidence, see sec. 49, post, p. 176, and sub-sec. (7) of sec. 14.

As to notice to a respondent in Scotland or Ireland, see p. **90**.

The provision in sub-sec. (8) allowing an applicant to withdraw on further grounds of objection without payment of costs is similar to that contained in sec. 12 (5);[2] the time prescribed is within seven days from the giving of the leave (Rule 128, post, p. 189). See further under the notes to sub-secs. (10) and (11).

> (10) The registrar, or in the case of an appeal to the Board of Trade, the Board of Trade shall have power in proceedings under this section to award to any party such costs as they may consider reasonable, and to direct how and by what parties they are to be paid.
>
> (11) If a party giving notice of opposition or of appeal neither resides nor carries on business in the United Kingdom, the tribunal may require such party to give security for costs of the proceedings before it relative to such opposition or appeal, and in default of such security being duly given may treat the opposition or appeal as abandoned.

See also sec. 48; and as to the costs of registrar, see notes to sec. 12, and costs, p. **93**.

The general power to award costs of the proceedings before the registrar or the Board of Trade in the case of an opposition is new where the defendant amends his particulars of objection.

[1] Pp. **89** and **740**.

[2] Ante, p. 40. See also Rule 128. Compare the practice in patent actions

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and will be very useful. These sub-sections, together with the last part of sub-sec. (8), deal with the costs of the parties on an opposition. The only provision as to costs contained in sec. 69 of the Act of 1883, as amended by the Act of 1888, was sub-sec. (5), which was as follows:—

> *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.*[1]

Except as in that sub-section provided, the comptroller had no power to give costs; and where there was an appeal to the Court, the Court could give no costs of the proceedings before the comptroller, except such as are allowed by the taxing master as incident to the application to the Court.[2]

Now sub-sec. (10) gives the registrar, or in the case of an appeal the Board of Trade, power to award costs; and the section would appear to be worded with such generality as (possibly) to allow the Board of Trade on an appeal to deal with the costs of the proceedings before the comptroller as well as before the Board of Trade. The section does not affect the power of the Court as to costs, which are in its discretion[3]; but *query* whether the Court itself has, in view of its previous decision in the *Australian Wine Importers Tm.*,[4] power to deal with the costs before the registrar. It may be that, having regard to the power given to the Board of Trade by sub-sec. (10) and the provision of sub-sec. (5) making an appeal to the Board of Trade or the Court alternative, the Court will hold that it has such power.

As between the parties, probably the general rule of the costs following the event will be adopted in the absence of special circumstances.

Sub-sec. (11), as to security for costs, is new.[5] Under the Act of 1883 every opponent was after counter-statement required to give security for costs,[6] but the sub-section in question was repealed by the Act of 1888 at the suggestion of Lord Herschell's Committee.

Disclaimers.

15. If a trade mark contains parts not separately registered by the proprietor as trade marks, or if it contains matter common

[1] P. 95.
[2] *Australian Wine Importers' Tm.*, 41 C. D. 278; 6 R. P. C. 311 (1889), C. A.
[3] Order 65, r. 1.
[4] Supra, note (2).
[5] As to security before the registrar, see Rule 61, post, p. 178.
[6] Old sec. 69 (3).

to the trade or otherwise of a non-distinctive character, the registrar or the Board of Trade or the Court, in deciding whether such trade mark shall be entered or shall remain upon the register, may require, as a condition of its being upon the register, that the proprietor shall disclaim any right to the exclusive use of any part or parts of such trade mark, or of all or any portion of such matter, to the exclusive use of which they hold him not to be entitled, or that he shall make such other disclaimer as they may consider needful for the purpose of defining his rights under such registration: Provided always that no disclaimer upon the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

Additions and disclaimers, Chap. IX., p. **197.** See also the general provision of sec. 44.[1]

A trade mark "must contain or consist of" at least one of the essential particulars defined in sec. 9, but, as under the repealed Acts, it may contain other matter. Those Acts contained express provisions as to the additions, statements as to essential particulars, and disclaimers, which were as follows:—

64.—(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 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) (i.) *Provided as follows: 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.*[2]

74.—(1) *Nothing in this Act shall be construed to prevent the comptroller entering on the register in the prescribed manner, and*

[1] Post, p. 93.

[2] See now sec. 44, post, p. 93.

subject to the prescribed conditions, as an addition to any trade 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, 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 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 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.

(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.*

These provisions were not wholly consistent, and sec. 74 in particular occasioned considerable difficulty. Sec. 64 (2) dealt with additions of letters and words or figures to essential particulars,[1] and sec. 74 with additions to marks of matter (in the case of new marks words) that was distinctive, that is to say *prima facie* distinctive,[2] but was in fact common, that is open, to the trade.[3] But common

[1] *E.g.*, see the second label in *Clement et Cie.'s Tm.*, [1900] 1 Ch. 114: 16 R. P. C. 173 and 611.

[2] *Burland* v. *Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J.; *Clement et Cie.'s Tm.* (ubi supra): *Faulder's Tm.*, 18 R. P. C. 37 and 535 (1901), Kekewich, J., and C. A.

Burland v. *Broxburn Oil Co.*, supra, and p. 206.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

parts of a distinctive label were not required to be disclaimed, for such parts are not additions to but parts of the trade mark.[1]

The whole matter of disclaimers is by sec. 15 now put on a much simpler and more practical basis. The general intention is plain, that the whole mark as it is used, or intended to be used, shall be registered without sorting out or distinguishing those parts of it which fall within sec. 9, if it happens that some part or parts only do so fall while some other part or parts of the mark do not. It is only in exceptional instances, where the registration of the whole mark without a disclaimer would be likely to cause deception, or to foster or support an unfair claim to a separate part of the mark taken by itself, that a disclaimer of such part is now to be required.[2]

The disclaimer is to be used, as appears from the words of the section, only for the purpose of defining the rights of the proprietor under the registration. Rule 34 gives the registrar power to require an applicant to insert in his application such disclaimer as the registrar may think fit, in order that the public generally may understand what the applicant's rights, if his mark is registered, will be (post, p. 174).

This alteration will be of great value to the owners of trade marks which under the old law could only have been registered subject to disclaimer, especially when the English registration is required as a basis of registration abroad. The trade mark is assumed to be the whole that is registered, and any disclaimer is to be of parts contained in it.

The matter in regard to which an applicant can in particular be required to make a disclaimer is (1) matter common to the trade, (2) matter otherwise of a non-distinctive character, and (3) parts not separately registered by the proprietor as trade marks.

(1) Common to the trade. This probably includes matter open to the trade although *primâ facie* distinctive, as well as matter actually in common use in the trade.[3] What is known as the three-mark

[1] *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.

[2] ". . . In future the office will not regard disclaimers as a thing of course, but "that they will use them exceptionally "where the trade mark, without some "explanatory disclaimer, might lead to a "mistaken notion as to what the rights "granted were." See Lord Justice Fletcher Moulton's address, cited *ante*, p. 3.

[3] Cf. sec. 74 of the Act of 1883, supra, and *Burland* v. *Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482; *Faulder's Tm.*, [1902] 1 Ch. 125; 18 R. P. C. 535. And see p. **206**.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

rule in regard to old marks, namely, that use by more than three persons makes the matter common,[1] will probably be taken as the test of what is in common use in a trade. Practically, if any person in the trade other than the applicant is lawfully using distinctive matter of which the registration would give the applicant the exclusive use, then, in order to protect such other trader, a disclaimer would be necessary.

(2) Matter otherwise of a non-distinctive character, *e.g.*, descriptive matter. It is also provided by sec. 44,[2] that no registration shall interfere with any *bonâ fide* use by any person of any *bonâ fide* description of the character or quality of his goods.

(3) Parts not separately registered by the proprietor as trade marks. Parts of a trade mark—subordinate integers, to adopt the phraseology of the patent law—may now be registered as separate trade marks subject to the special provisions contained in sec. 25.[3]

In the *Apollinaris* case objection was taken to a mark because a particular device forming a part of it, and being itself a distinctive trade mark, had the words "trade mark" printed against it.[4]

Combinations are specially mentioned in the definition of a "mark."[5]

The form of application for registration of a cotton mark contains a statement that no claim of exclusive right is made to any of the letter-press appearing on the mark except in so far as it consists of the applicant's own name and address or the foreign equivalent thereof (post, p. 209; and see sec. 64, sub-sec. (10)).

The effect of a disclaimer of the right to the exclusive use of matter is that the proprietor cannot claim any trade mark rights in such matter, so that no action for infringement lies in respect of the use or imitation of it taken alone.[6] It was held under the repealed Acts that a plaintiff in a passing-over action could not rely in that action on matter which he had disclaimed.[7] It is now expressly provided by this section that no disclaimer shall affect any rights of the proprietor of the mark except such as arise out of registration.

[1] Sec. 74 (3) of Act of 1883, the three-mark rule, p. **207**.

[2] Post, p. 93.

[3] Post, p. 70.

[4] See p. **258**. See, however, *Bass, Ratcliff & Gretton, Ltd.'s Tms.*, [1902] 2 Ch. 579; 19 R. P. C. 529.

[5] Sec. 3, ante, p. 14.

[6] P. **206**.

[7] *Rosenthal* v. *Reynolds* [1892] 2 Ch. 301, 9 R. P. C. 189, North, J. The Scotch Court of Session, however, refused to follow that decision: *Bayer* v. *Baird*, 15 R. P. C. 615 (1898). It is strange that the matter has not called for a decision of the Court of Appeal. See also other cases cited, p. **210**.

This section does not contain any provision such as was contained in sec. 64 (3) (i.) of the Act of 1883, as amended by the Act of 1888, exempting an applicant from disclaiming his own name or the foreign equivalent thereof, or his place of business. Sec. 44 makes any such disclaimer unnecessary, for it provides in general terms, that no registration under this Act shall interfere with any *bonâ fide* use by a person of his own name or place of business or that of any of his predecessors in business.[1]

The section applies to old marks, that is, marks used before August 13th, 1875, as well as to new marks.

Disclaimers may be made on the request of the registered proprietor under sec. 32 (post, p. 74).

16. When an application for registration of a trade mark has been accepted and has not been opposed, and the time for notice of opposition has expired, or having been opposed the opposition has been decided in favour of the applicant, the registrar shall, unless the Board of Trade otherwise direct, register the said trade mark, and the trade mark, when registered, shall be registered as of the date of the application for registration, and such date shall be deemed for the purposes of this Act to be the date of registration. Date of registration.

The imperative direction to the registrar to register when he has accepted the trade mark in default of or on failure of opposition is new. Sometimes, however, in the course of an opposition fresh facts are brought to light which would cause the registrar to refuse registration, and the section, presumably with a view to meet a case of that nature, contains a power for the Board of Trade to direct the registrar not to register. By Rule 63 (post, p. 179) the Board of Trade have given a general direction that where a mark has been accepted by error the registrar may withdraw his acceptance. In other cases the Board will give special directions. The refusal is to be deemed to be a refusal under sec. 12 (2), and an applicant has a corresponding right of being heard and of appealing.[2]

[1] Post, p. 93. This corresponds to the last part of the old sec. 64 (3) (i.).

[2] Rule 63, post, p. 179. See, however, sec. 54, post, p. 100.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

Sec. 75 of the Act of 1883, as amended by the Act of 1888, provided as follows :—

> *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*, 1876,[1] *to have been, the date of registration.*

So far as date is concerned, the section quoted only embodied the previous practice.[2] The first part of sec. 75 is now omitted as unnecessary.[3] The definition of a "trade mark" includes a mark proposed to be used.[4] New and unused marks have always been allowed to be registered. The Acts created a new mode of acquiring a trade mark.[5] Sec. 16 deals only with trade marks registered under this Act. The date of a trade mark registered under any repealed Act is preserved by sec. 6, but with the double advantage of the proprietor being able to support it either under the Act under which it was registered or as being a registerable trade mark under this Act.[6]

Certificate of registration.

17. On the registration of a trade mark the registrar shall issue to the applicant a certificate in the prescribed form of the registration of such trade mark under the hand of the registrar, and sealed with the seal of the Patent Office.

"Prescribed." See Rule 67 (post, p. 179) and Form O, No. 2 (post, p. 200). As to other certificates, see Rules 102 and 104 (post, p. 185).

This section is new in so far as it entitles an applicant to a certificate of registration without fee on the completion of the registration. Objection was taken to it before the committee on the ground that the certificate would be used as a sort of title deed. It will, of course, only show what was entered on the register at its date, and will be no evidence that the person named in it is afterwards the proprietor of the mark. There is a general right under sec. 7 to any person to have a certified copy of any entry in the register on payment of the prescribed fee.[7]

[1] The commencement of the first register. See sec. 7 of the Act of 1875.
[2] P. 656.
[3] As to its construction, see p. 304.
[4] See ante, p. 14.
[5] *Hudson's Tms.*, 32 C. D. 311 : 3 R. P. C. 155 (1886), C. A.
[6] Sec. 36, post, p. 82.
[7] Cf. sec. 88 of the Act of 1883.

The certificate is evidence in all Courts in His Majesty's dominions, and in all proceedings,[1] of the matters stated in it. The fee under the rules of 1906 for certifying office copies is 10*s*.

Non-completion of registration.

18. Where registration of a trade mark is not completed within twelve months from the date of application by reason of default on the part of the applicant, the registrar may, after giving notice of the non-completion to the applicant in writing in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in such notice.

Abandonment of application, pp. **76** and **283**. This section corresponds to sec. 63 of the Act of 1883, as amended by the Act of 1888. There is no substantial alteration. Abandonment is no bar to a subsequent application by the same person and in respect of the same mark.[2]

Under Rule 62 (post, p. 178) the ordinary length of notice to be given is fourteen days. The form is prescribed by the same rule.

Identical marks.

19. Except by order of the Court or in the case of trade marks in use before the thirteenth day of August one thousand eight hundred and seventy-five, no trade mark shall be registered in respect of any goods or description of goods which is identical with one belonging to a different proprietor which is already on the register with respect to such goods or description of goods, or so nearly resembling such a trade mark as to be calculated to deceive.

Duplicate Marks, Chap. X., p. **212**. Mark resembling a registered mark, pp. **220—252**. A registered proprietor acquires no right of exclusive user in the mark as against any other registered proprietor thereof for the same goods except in so far as their respective rights are defined by the Court.[3]

[1] Sec. 50, post, p. 93.

[2] *Jackson* v. *Napper*, 35 C. D. 162; 4 R. P. C. 45 (1886). Stirling, J.

[3] Sec. 39, post, p. 85.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

The section corresponds to sec. 72 of the Act of 1883, which, as amended by the Act of 1888, was as follows:—

(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.*

(2) *Except as aforesaid, the comptroller shall not register with respect to the same goods or description of goods, a trade mark 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.*

"Except by order of the Court", *i.e.*, under the following sections 20 and 21.[1]

"Or in the case of trade marks in use before the 13th day of August "1875." There is no express section in this Act allowing more than one old mark to be registered, but under what is known as the three-mark rule, the proprietors of identical old marks, not more than three in number, have been allowed to register.[2] If more than three persons used the mark in respect of the same description of goods, it was treated as common to the trade. The rule was incorporated in sec. 74 of the Act of 1883 with respect to additions to old marks.[3]

The registrar may now register an "old mark," although there is an identical one on the register, without an order of the Court.

"So nearly resembling." This was the phraseology of the Act of 1883 before amendment. See as to resemblance between marks, Chap. XII.[4]

"Belonging to a different proprietor." The section makes an important change by limiting its operation to marks belonging to different proprietors. It was formerly treated as an objection to the registration of a mark that it was identical with or resembled another mark of the same proprietor already on the register.[5] This case no longer falls under the section, but the tribunal might under secs. 24 or 25[6] require the marks to be registered as associated marks.

[1] Post, p. 61.
[2] P. 215.
[3] P. 656.
[4] Pp. 220-252.
[5] *Player & Son's Application*, [1901] 1 Ch. 382; 18 R. P. C. 65, Cozens-Hardy, J. See secs. 24 and 27, post, pp. 69 and 71.
[6] Post pp. 69 and 70.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

The section deals only with resemblance to registered trade marks, but persons using unregistered trade marks[1] or advertisements[2] which a proposed trade mark nearly resembles may oppose the registration if the use of the proposed trade mark would be deceptive by reason of such resemblance[3] or would interfere with their right to continue to use their marks or advertisements.

Under sec. 31[4] a trade mark which has been removed from the register for non-payment of renewal fees is during one year for the purpose of this section to be deemed a registered trade mark, unless it is shown to the satisfaction of the registrar that there had been no *bonâ fide* trade user of such trade mark during the two years immediately preceding such removal.

The operation of this section is not limited by the register classes. Some of the classes are very wide, comprising goods of widely differing descriptions; on the other hand, goods of the same description are found in different classes. The question whether goods are of the same description for the purposes of this section is one to be considered from the commercial point of view, and in particular it is material to consider whether the goods are usually sold by the same persons.[5] The test was thus stated by Kay, J.: "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."[6]

It is not necessary for the purposes of this section that the proprietor of the registered mark should be in a position to maintain an action to restrain the use of the proposed mark.

The consent of the proprietor of the registered trade mark was held by the Court of appeal under the repealed Acts not to determine the question whether the second mark ought to be registered, and the Court also disapproved of the practice of the entry of a note on the register.[7] The policy of the new Act is to give more elasticity, and to allow in some circumstances the entry of duplicate marks on

[1] P. 138.

[2] Marks used in advertisement, p. 139.

[3] Sec. 11, ante, p. 38.

[4] Post, p. 73.

[5] *Australian Wine Importers' Tm.*, 41 C. D. 278; 6 R. P. C. 311.

[6] In the *Australian Wine Importers' case*, 41 Ch. D., at p. 281. The cases on the subject are collected at pp. 217—219. The more recent cases are *Suter, Hartmann's and Ruhtjen's Tms.*, 19 R. P. C. 42; *Leiner's Application*, 20 R. P. C. 253; *Lake and Elliott's Application*, 20 R. P. C. 605; *Finlay v. Shamrock Co.*, 22 R. P. C. 301.

[7] *Dechnert's Application*, [1896] 2 Ch. 137: 13 R. P. C. 288.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

the register (see especially secs. 20 and 21). No doubt the position of the public, as well as that of the owner of the other mark, must still be considered.

Rival claims to identical marks.

20. Where each of several persons claims to be proprietor of the same trade mark, or of nearly identical trade marks in respect of the same goods or description of goods, and to be registered as such proprietor, the registrar may refuse to register any of them until their rights have been determined by the Court, or have been settled by agreement in a manner approved by him or (on appeal) by the Board of Trade.

Concurrent right, p. **384**. Duplicate marks, p. **212**; and as to the right of persons registered for the same mark and the same goods *inter se*, sec. 39, post, p. 85. Mark resembling a registered mark, p. **220**. See also sec. 19 and the two following sections, 21 and 23.

This section corresponds to sec. 71 of the Act of 1883, which was as follows:—

> *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.*

This section deals particularly with the case of two or more claimants who are not registered, but who are applying for registration of the same or similar marks, whereas sec. 19 deals with an application to register a mark the same as or resembling a trade mark already on the register.

The material alterations of the old sec. 71 are two—first, nearly identical marks are expressly mentioned; and, secondly, the rights of the applicants may be settled by an agreement approved by the registrar or the Board of Trade.

The second change is important, as it seems to contemplate arrangements between persons who have happened to hit upon and bring into use the same mark. The case of honest concurrent user is specially dealt with by the next section,[1] and apparently what may be done by the Court under that section may be done by agreement under this. An agreement by each of two claimants to confine

[1] Cf. sec. 21.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

his use of the mark to a particular market, or to a particular kind of goods or trade, is often made in practice, and it is probable that, in a proper case, both parties might now be registered. There seems to be no reason why one retail trader should not sell "Badger boots" in Manchester, while another sells "Badger boots" in Brighton, and both be registered for the mark, provided that a sufficient space of territory, which neither is to trade in, is maintained between their respective areas.

Under the corresponding section of the Act of 1875 the three-mark rule was adopted in regard to old marks, that is, marks used before August 13th, 1875, and not more than three similar old marks were registered in respect of the same goods.[1] Old marks have also been allowed to be registered, notwithstanding the presence of a similar new mark on the register.[2] But two identical new marks were never ordered to be registered for the same goods[3] under the repealed Acts. For the practice with respect to applications under sec. 71 of the Act of 1883 and the Rules of 1890, see pp. **213**, **699**.

Under rule 29 (post, p. 173), the search to be made by the registrar on application to register includes pending applications. The rules do not seem to provide any special procedure under this section for determining the rights of the applicants.

Concurrent user.

21. In case of honest concurrent use or of other special circumstances which, in the opinion of the Court, make it proper so to do, the Court may permit the registration of the same trade mark, or of nearly identical trade marks, for the same goods or description of goods by more than one proprietor subject to such conditions and limitations, if any, as to mode or place of user or otherwise, as it may think it right to impose.

This section is new. It is the complement of the last section, and provides for special cases which may arise, rendering it expedient for the working of substantial justice between the owners of two trade marks, who cannot come to an agreement under sec. 20, that both should be placed on the register, subject to such conditions and limitations as the Court may impose. It may also apply to cases

[1] The three-mark rule, p. **214**.

[2] *Monson* v. *Bacon*, 26 C. D. 398; *Napper* v. *Jackson*, 35 C. D. 162; 4 R. P. C. 43.

[3] See *Ehrmanns' Tms.*, [1897] 2 Ch. 495; 14 R. P. C. 665; and *Hall and Woodhouse Ld.'s Application*, 19 R. P. C. 58 (1902).

under sec. 19, in which the applicant has enjoyed concurrent user with the proprietor of a registered trade mark. In imposing conditions and limitations the Court will, of course, have regard to the public interest as well as to that of the proprietors of the marks. Except in the case of the goodwill of a business becoming vested in separate persons,[1] or in the case of honest concurrent user, it is not easy to imagine circumstances rendering it proper to register two new identical or nearly identical marks in respect of the same goods.

The section expressly authorises a limitation in respect of place, such as was suggested but disapproved in *Dewhurst's Application*, [1896] 2 Ch. 137; 13 R. P. C. 288. See further, respecting the practice as to concurrent registration under the repealed Acts, the notes to secs. 19 and 21 above.

The power under this section is only to be exercised by the Court; see, however, sec. 20 as to the approval of agreements between rival claimants by the registrar or the Board of Trade.

Assignment.

Assignment and transmission of trade marks.

22. A trade mark when registered shall be assigned and transmitted only in connection with the goodwill of the business concerned in the goods for which it has been registered and shall be determinable with that goodwill. But nothing in this section contained shall be deemed to affect the right of the proprietor of a registered trade mark to assign the right to use the same in any British possession or protectorate or foreign country in connection with any goods for which it is registered together with the goodwill of the business therein in such goods.

Notes.

Assignment and devolution of trade marks, p. **324**. The first sentence of the section is in the same terms as sec. 70 of the Act of 1883, except that "in the goods" has been substituted for the words "in the particular goods or classes of goods." The rest of the section is new. A trade mark must be registered in respect of particular goods or classes of goods.[2]

The rights conferred by registration of a trade mark are limited by the goods for which it is registered.[3] Further, as a trade mark is only assignable with goodwill, if a goodwill exists only

[1] Sec. 23 expressly provides for this case.

[2] See. 8, ante, p. 21.

[3] See sec. 39, post, p. 85.

as to part of the class of goods for which the mark is registered, on any assignment the assignee acquires rights in the trade mark only in respect of that part of the class.[1] Even after seven years' registration, there appears to be no provision in the Act limiting the right of a person to move to rectify the register on such a ground, for sec. 41 only enacts that after seven years the *original* registration shall be taken to be valid.[2]

The goodwill [3] of a business may extend to more than one country, and the new provision contained in the latter part of the section expressly saves the right of the proprietor of a trade mark to assign the trade mark rights in any country, but only in connection with the goodwill therein. It is not easy to see why this proviso was inserted, inasmuch as the registration under the Act is only operative for the United Kingdom and Isle of Man. The divisibility of goodwill is also recognised in sec. 23. The proprietor of a business may sell the goodwill in part of it, limiting the part sold to certain of the goods dealt in, and in that case the rights in respect of the trade marks registered for such goods would pass to the assignee.[4] It is a general rule that trade marks rights pass with goodwill without express mention.[5]

The power to assign a trade mark and to give effectual receipts for any consideration for such assignment is vested in the registered proprietor, subject to any rights appearing from such register to be vested in any other person.[6] The notification and registration of assignments are provided for by secs. 4[7] and 33.[8] Registration of an assignment before the commencement of an action for infringement is not necessary,[9] but it must be effected before judgment in the action can be obtained.[10]

Where the goodwill of a business determines, the trade mark rights incident thereto necessarily determine also, and the section expressly so provides.

As to determination of trade mark rights, see Chap. XIV., p. **338.**

[1] *Edwards* v. *Dennis*, 30 C. D. 454, (1885), C. A.; see also *Hart's Tm.*, [1902] 2 Ch. 621; 19 R. P. C. 569.

[2] See further sec. 41 and notes thereto, post, p. 88.

[3] As to the elements which go to constitute goodwill, see *Inland Revenue Commissioners* v. *Muller & Co.'s Margarine, Ld.*, [1901] A. C. 217, especially the judgment of Lord Lindley.

[4] P. **336.**

[5] P. **325.**

[6] Sec. 38, post, p. 84.

[7] Ante, p. 18.

[8] Post, p. 76.

[9] *Ihlee* v. *Henshaw*, 31 C. D. 323; 3 R. P. C. 15 (1886), North, J.

[10] *Magnolia Metal Co.* v. *Atlas Metal Co.*, 14 R. P. C. 389 (1897), Collins, J.

The rules as to the registration of assignments are rules 76 to 81 (post, p. 180). The request for registration may be either made jointly by the registered proprietor and the assignee or by the assignee.

Apportionment of marks on dissolution of partnership.

23. In any case where from any cause, whether by reason of dissolution of partnership or otherwise, a person ceases to carry on business, and the goodwill of such person does not pass to one successor but is divided, the registrar may (subject to the provisions of this Act as to associated trade marks), on the application of the parties interested, permit an apportionment of the registered trade marks of the person among the persons in fact continuing the business, subject to such conditions and modifications, if any, as he may think necessary in the public interest. Any decision of the registrar under this section shall be subject to appeal to the Board of Trade.

Notes.

This section is new and is designed to meet the hardship which occurred in *Ehrmann's Tms.*,[1] where on the dissolution of a firm it was agreed that one partner should trade as "Ehrmann Frères," and the other as "Ehrmann Brothers," and that new registrations should be made of the old trade marks with consequential alterations, but the new registrations were refused in view of the confusion that might arise. Possibly the scheme proposed in that case would not be allowed under the present section; as the registrar will, no doubt, only give his approval where the proposed apportionment does not conflict with the interests of the public. But where an apportionment does not involve the entry of duplicate marks on the register for the same description of goods, then, notwithstanding that the goodwill in such goods is divided and becomes vested in more than one person, the section contemplates that one of such persons may take some marks and another other marks.

The section applies not only on dissolution of partnership, but in all cases where a person ceases to carry on business and the goodwill becomes divided, *e.g.*, under the provisions of a will.

As to associated trade marks, see secs. 24 to 27.

The only appeal from the registrar is to the Board of Trade,[2] but the Board of Trade may refer the appeal to the Court.[3]

[1] [1897] 2 Ch. 495; 14 R. P. C. 665.
[2] Sec. 54, post, p. 100.
[3] Sec. 59, post, p. 103.

As to rights on the dissolution of partnership, see Chap. XIII. p. 331.

The rules applicable under this section are rules 87 to 89 (post, p. 182). A note of the apportionment and the date of the decision is to be entered on the register.

Associated Trade Marks.

24. If application be made for the registration of a trade mark so closely resembling a trade mark of the applicant already on the register for the same goods or description of goods as to be calculated to deceive or cause confusion if used by a person other than the applicant, the tribunal hearing the application may require as a condition of registration that such trade marks shall be entered on the register as associated trade marks. Associated trade marks.

Notes.

Associated trade marks. This group of sections (24 to 27), except sec. 26 and part of sec. 27, is new. It deals with what are called in the Act "associated trade marks," the feature of which is that, like marks registered in a series under sec. 66 of the Act of 1883, now sec. 26, they can only be assigned or transmitted as a whole, and not separately. They comprise—(1) series of trade marks registered under the old sec. 66 or sec. 26 of this Act; (2) a set of marks constituted by the registered proprietor of a mark or marks subsequently registering other marks or another mark so closely resembling the registered mark or marks that registration by anyone but the proprietor of the latter would not be allowed; and (3) a set of marks constituted by the registration of a trade mark and one or more parts of it. The present section deals with the second class.

A trader sometimes desires to make minor alterations or improvements in a trade mark, or to especially adapt it for certain goods, and to register the mark so altered, but without taking the original trade mark off the register. It was held, under the repealed Acts, that if the new mark is substantially covered by the existing registration it ought not to be registered, because to do so would be to encumber the register.[1] It is, however, often important for a trader who has varied his registered mark in actual use, to register in this country the exact trade mark which he uses in order to obtain registration of it abroad. This section does not in terms authorise the

[1] *Player and Sons' Application*, [1901] 1 Ch. 382; 18 R. P. C. 65, Cozens-Hardy, J.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

registration of a mark closely resembling one of which the applicant is already the registered proprietor, and sec. 26 seems to deal only with the case of concurrent applications, but the tribunal is expressly authorised to require as a condition of registration that the new and old marks should be thenceforth treated as associated trade marks. This meets the difficulty created by *Player's* case.

Where trade marks are registered as associated, a note is to be placed on the register in connection with each mark of the numbers of the other marks, rule 65 (post, p. 179).

Combined trade marks.

25. If the proprietor of a trade mark claims to be entitled to the exclusive use of any portion of such trade mark separately he may apply to register the same as separate trade marks. Each such separate trade mark must satisfy all the conditions, and shall have all the incidents of an independent trade mark, except that when registered it and the trade mark of which it forms a part shall be deemed to be associated trade marks and shall be entered on the register as such, but the user of the whole trade mark shall for the purposes of this Act be deemed to be also a user of such registered trade marks belonging to the same proprietor as it contains.

Notes.

See the last section and the notes thereto, and sec. 27. See also disclaimers, sec. 15.[1]

It often happens that a trade mark, *e.g.*, a label, contains distinctive parts, which the proprietor uses or desires to use separately as trade marks. Compare claims in patent specifications for "subordinate integers." This section provides for the registration as trade marks of the whole mark, and also of such separate parts of it as are themselves qualified as registrable trade marks, the set to be treated as associated trade marks, and therefore only assignable as a whole (sec. 27).[2] The provision that the user of the whole mark is to be deemed also a user of the parts is no doubt specially inserted in view of sec. 37,[3] under which a trade mark can be taken off the register on the ground of non-user.

Series of trade marks.

26. When a person claiming to be the proprietor of several trade marks for the same description of goods which, while

[1] Ante, p. 54.

[2] See post, p. 71.

[3] Post, p. 83.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

resembling each other in the material particulars thereof, yet differ in respect of—

(*a*) statements of the goods for which they are respectively used or proposed to be used; or

(*b*) statements of number, price, quality, or names of places; or

(*c*) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or

(*d*) colour;

seeks to register such trade marks, they may be registered as a series in one registration. All the trade marks in a series of trade marks so registered shall be deemed to be, and shall be registered as, associated trade marks.

Series of marks, p. **100**; associated trade marks, see sec. 24 and the notes thereto, and sec. 27. Notes.

This section, along with the provision of sec. 27, which is imported by the reference to "associated trade marks," corresponds to sec. 66 of the Act of 1883, but sub-secs. (*c*) and (*d*) are new.

Trade marks in a series are now made a special kind of associated trade marks. Under the new section there is added to the respects in which they may differ, non-distinctive matter and colour. Colour may now be regarded in considering the distinctiveness of a trade mark, if the trade mark is limited to one or more specified colours.[1]

It would appear that sec. 24 contemplates differences which are not covered by sec. 26, for instance, differences in distinctive matter.

As to the assignment of a series of trade marks, see sec. 27.

Application for registration of a series of marks is to be made in the manner prescribed by rule 27 (post, p. 173). As to advertisement of a series, see rule 49 (post, p. 176).

27. Associated trade marks shall be assignable or transmissible only as a whole and not separately, but they shall for all other purposes be deemed to have been registered as separate trade marks. Provided that where under the provisions of this Act user of a registered trade mark is required to be proved for any purpose, the tribunal may if and so far as it shall think right

Assignment and user of associated trade marks.

[1] Sec. 10, ante, p. 37.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

accept user of an associated registered trade mark, or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for such user.

Notes.

As regards assignment of associated trade marks as a whole and not separately, this provision corresponds to that of sec. 66 of the Act of 1883, with regard to trade marks of a series.

The proviso respecting user seems to be specially framed with a view to meet any difficulty which might otherwise arise under sec. 37,[1] by which non-user for five years is made a ground for the removal of a trade mark.

The rule laid down by this section is based upon the fact that while the use of closely resembling trade marks for the same description of goods can do no harm while they are used by the same proprietor, and consequently registration of such trade marks is now allowed;[2] if the marks were to be assigned to different proprietors the evils of probable confusion or deception which sec. 19 is intended to prevent would at once arise.

Rules 76 to 81 (post, p. 180), prescribe the procedure as to registration of assignments.

Renewal of Registration.

Duration of registration.

28. The registration of a trade mark shall be for a period of fourteen years, but may be renewed from time to time in accordance with the provisions of this Act.

Notes.

Secs. 28 to 31 inclusive are in substitution of sec. 79[3] of the Act of 1883. Under that Act the registration was perpetual, subject only to liability to removal on non-payment of the prescribed fee at the end of each period of fourteen years. Under the new Act the registration is only for a period of fourteen years, but is renewable from time to time. The position is substantially the same, assuming that the words "conditions as to payment of fees and otherwise" contained in sec. 30 do not entitle the registrar to impose conditions other than payment of fees. See the notes to that section.

Renewal of registration.

29. The registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within

[1] Post, p. 83.

[2] Cf. "belonging to a different proprietor" in sec. 19, ante, p. 61.

[3] P. 349.

the prescribed period, renew the registration of such trade mark for a period of fourteen years from the expiration of the original registration or of the last renewal of registration, as the case may be, which date is herein termed "the expiration of the last "registration."

"The registrar shall." If the application is made in the prescribed manner and within the prescribed period, these words appear to confer on the registered proprietor an absolute right to renewal. See also the notes to the following sec. 30.

"Prescribed." See rule 68 (post, p. 179), the prescribed period is not less than two months nor more than three months before expiration. Renewal is to be advertised in the journal, rule 75 (post, p. 180).

Procedure on expiry of period of registration.

30. At the prescribed time before the expiration of the last registration of a trade mark, the registrar shall send notice in the prescribed manner to the registered proprietor at his registered address of the date at which the existing registration will expire and the conditions as to payment of fees and otherwise upon which a renewal of such registration may be obtained, and if at the expiration of the time prescribed in that behalf such conditions have not been duly complied with, the registrar may remove such trade mark from the register, subject to such conditions (if any) as to its restoration to the register as may be prescribed.

Removal of mark from the register, p. **349.** The time and manner of notice are now left to be prescribed by the rules, which provide for two notices and advertisement in the journal, rules 70 to 74 (post, p. 180).

"The conditions as to payment of fees and otherwise." It is submitted that the words "and otherwise" do not authorise the registrar to impose conditions other than those relating to the time and manner of the application for renewal; for instance, he could not impose a condition that the registered proprietor must disclaim part of what is registered: see secs. 28 and 29.

Status of unrenewed trade mark.

31. Where a trade mark has been removed from the register for nonpayment of the fee for renewal, such trade mark shall nevertheless, for the purpose of any application for registration

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The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

during 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 registrar that there had been no *bonâ fide* trade user of such trade mark during the two years immediately preceding such removal.

This section corresponds to sub-sec. (5) of sec. 79 of the Act of 1883, which, as amended by the Act of 1888, was as follows:—

(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 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.*

Notes.

This section is intended to prevent the registration during the period of one year of a trade mark, in respect of the same goods or description of goods, identical with or so resembling the removed trade mark as to be calculated to deceive. Its main object appears to be the protection of the public. If there has been no *bonâ fide* trade user of the removed trade mark during the two years immediately preceding its removal the section is not to apply. But, of course, if the proprietor is in fact using the removed trade mark, then even after the expiration of the period of one year prescribed by the section, he would have the ordinary right of the owner of an unregistered trade mark to oppose registration of the mark, or a mark closely resembling it, by another person on the ground that the proposed trade mark would be calculated to deceive.[1]

Correction and Rectification of the Register.

Correction of register.

32. The registrar may, on request made in the prescribed manner by the registered proprietor or by some person entitled by law to act in his name,—

(1) Correct any error in the name or address of the registered proprietor of a trade mark; or

[1] See, 11, ante, p. 38, and p. 350.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

(2) Enter any change in the name or address of the person who is registered as proprietor of a trade mark; or

(3) Cancel the entry of a trade mark on the register; or

(4) Strike out any goods or classes of goods from those for which a trade mark is registered; or

(5) Enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of such trade mark.

Any decision of the registrar under this section shall be subject to appeal to the Board of Trade.

Correction and cancellation of entries at the proprietor's request, Notes. p. 295.

This section deals with alterations of entries in the register. Alterations in the registered trade mark itself are dealt with in sec. 34. The section corresponds to those parts of sec. 91 of the Act of 1883 which relate to alterations of entries in the register,[1] namely (*b*) and (*c*), so far as relates to trade marks, but it is much wider. The sub-sections were as follows:—

91. *The comptroller may, on request in writing, accompanied by the prescribed fee—*

(*b*) *Correct any clerical error in the name, style, or address of the registered proprietor of a trade mark.*

(*c*) *Cancel the entry or part of the entry of a trade mark on the register, provided that the applicant accompanied 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.*

Sub-sec. (*b*) only related to errors, and not to changes, of name or address. Changes of address were, however, provided for by rule 48 of 1890.[2] Clause (2) of the new section now expressly authorises the entry of change of the name or address of the registered proprietor.[3] Changes of proprietorship come under sec. 33,

[1] The parts (*a*) and (*d*) of sec. 91, as amended by the Act of 1888, relating to correction and amendment of applications are now replaced by sub-sec. (6) of sec. 12, ante, p. 40.

[2] P. 700.

[3] In *New Ormonde Cycle Co.'s Tm.*, [1896] 2 Ch. 520; 13 R. P. C. 475, North, J., held that on a change of name of a company the comptroller could

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The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

and not under this section. Clauses (3) (4) and (5) deal with cancellations and alterations in the registration, either annulling in whole or in part, or altering without extending, the rights of the registered proprietor arising out of the registration. Where a registered proprietor finds that he cannot support the registration as it stands, it is often expedient for him, especially if threatened with a motion to rectify,[1] to cancel his mark, or, as the present section enables him to do, to apply to confine the registration to part only of the goods for which it is registered, or to enter a disclaimer or memorandum. Non-user in connection with any of the goods for which a trade mark is registered may form a ground for removing the trade mark from the register in respect of such goods.[2]

Disclaimers may be required on the original registration of the trade mark or as a condition of its remaining on the register, *e.g.*, when an application is made to remove it.[3] "Memorandum" seems to contemplate some entry not a disclaimer, *e.g.*, a note better defining the rights covered by the trade mark, or possibly the entry of a condition which might have been required on the application to register.[4]

The rules in regard to matters under this section are rules 82 and 90 to 92 (post, p. 182). An application for a disclaimer or memorandum is to be advertised, rule 92. An application may be made under the section by the trustee in bankruptcy or liquidator (as the case may be) of the registered proprietor, rule 90; but see sec. 33 as to changes of proprietorship. If a mark is removed from the register, a record is to be entered of such removal and of the cause of it, rule 74 (post, p. 180).

There is a right of appeal to the Board of Trade,[5] but there is no right of appeal to the Court, although the Board may refer the appeal to the Court: secs. 54 and 59.

Registration of assignments, &c.

33. Subject to the provisions of this Act where a person becomes entitled to a registered trade mark by assignment, transmission, or other operation of law, the registrar shall, on request made in the prescribed manner, and on proof of title to his

enter the new name on the register, and if he refused the Court had power to make the alteration.

[1] See. 35, post, p. 79.

[2] See sec. 37, post, p. 83.

[3] See. 15, ante, p. 54.

[4] See sec. 12 and 14, ante, pp. 39 and 48.

[5] As to procedure, see rules 122 to 127, post, p. 188.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

satisfaction, cause the name and address of such person to be entered on the register as proprietor of the trade mark. Any decision of the registrar under this section shall be subject to appeal to the Court or, with the consent of the parties, to the Board of Trade.

Devolution and assignment of trade marks, Chap. XIII., p. **324.**
Registration of assignment, p. **331.**

This section corresponds to the first part of sec. 87 of the Act of 1883, which so far as relates to trade marks was in the same terms, except that the present sub-section is introduced by the words "subject to "the provisions of this Act," and the provision for an appeal is new.

"Subject to the provisions of this Act." This refers to the rules that a trade mark is only to be assigned with the goodwill,[1] and to the provisions respecting the assignment of associated trade marks.[2]

As to the power of the registered proprietor to assign and the enforcement of equities, see sec. 38.

Appeal. Compare the option of appeal conferred by sec. 12 (3), and sec. 14 (5). As there is now an express right of appeal from the decision of the registrar, probably an application will not now be allowed under sec. 35 for the purpose of appealing in effect from the registrar's decision, such as existed under sec. 90 of the Act of 1883 in a similar case.

This section relates to changes of proprietorship; as to changes of name and address, see sec. 32.[3]

"On request made in the prescribed manner," see rules 77 to 81 (post, p. 181). The claimant has to leave at the office a request with a case giving full particulars, and subsequently may have to verify these by a statutory declaration.

34. The registered proprietor of any trade mark may apply in the prescribed manner to the registrar for leave to add to or alter such trade mark in any manner not substantially affecting the identity of the same, and the registrar may refuse such leave or may grant the same on such terms as he may think fit, but any such refusal or conditional permission shall be subject to

Alteration of registered trade mark.

[1] Sec. 22, ante, p. 66.
[2] Sec. 27, ante, p. 71.
[3] Ante, p. 74.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

appeal to the Board of Trade. If leave be granted, the trade mark as altered shall be advertised in the prescribed manner.

Notes. Alterations of trade marks, pp. **297**, **300**. This section gives to the registrar a much wider power of altering a registered trade mark than was given to the Court by sec. 92 of the Act of 1883, which confined alterations to non-essential particulars. It was as follows :—

> 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, cause the register to be altered in conformity with the order of leave.*

The new section allows of alterations in the trade mark itself, such for instance as changes of circumstances require or render expedient, *e.g.*, change of a name or address, the addition of the word "limited" on the incorporation of a firm, and so forth; and that notwithstanding that the change of an essential particular[1] is involved. But the addition or alteration must not substantially affect the identity of the trade mark. It is probable that, except to meet such changes of circumstances as are instanced above, leave will only be granted to alter essential particulars in very special cases. Under the repealed Acts it was more difficult to obtain the alteration of a trade mark registered an "old mark," *i.e.*, as used before the 13th of August, 1875, than a new mark;[2] and this may still be the case. The power to allow alterations is, however, in both cases subject to precisely the same limitation which is also embodied in sec. 9.[3] That section allows such an old mark to be registered "either in its original "form or with additions or alterations not substantially affecting the "identity of the same." This corresponds to the words of the present section.

If a proprietor wishes to continue the registration and use of the

[1] Sec. 9, ante, p. 23.
[2] P. **298**.
[3] Ante, p. 35.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

unaltered mark, he can apply to register the altered mark as an associated trade mark.[1]

The rules respecting applications under this section are rules 93 and 94 (post, p. 183).

As to appeals, see secs. 54 and 59.[2] There is no option under this section to appeal to the Court.

The advertisement of the altered trade mark is, of course, for the information and protection of the public: cf. sec. 13. The alteration is to be advertised, and if the Registrar so requires, before leave is given; no procedure as to opposition is, however, provided by the section or rules.

Any member of the public who objects to the registration of the altered mark can apply to rectify under sec. 35, after the entry is made.

35. Subject to the provisions of this Act—

Rectification of register.

(1) The Court may on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, make such order for making, expunging, or varying such entry, as it may think fit:

(2) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of the register:

(3) In case of fraud in the registration or transmission of a registered trade mark, the registrar may himself apply to the Court under the provisions of this section:

(4) Any order of the Court rectifying the register shall direct that notice of the rectification shall be served upon the registrar in the prescribed manner who shall upon receipt of such notice rectify the register accordingly.

Rectification of the register, Chap. XI., p. 262.

Notes.

[1] Sec. 24, ante, p. 69. [2] As to procedure, see Rules 122 to 127, post, p. 188.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

The corresponding section of the Act of 1883, s. 90, has generally been utilised for the purpose of obtaining the removal from the register of a trade mark which is wrongly entered on it or its restriction to particular goods. That section as amended by the Act of 1888 was as follows:—

(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.*

(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.*

Sub-sec. (1) of the new section is substantially the same as before, but the power of rectifying errors or defects in entries is given.

Sub-sec. (3), giving the registrar power to apply in the case of fraud in the registration or transmission of a registered trade-mark, is new. The registrar cannot be ordered to pay costs even if his application fails.[1] This is probably an oversight, but the registrar will presumably only apply in a very clear case.

The power to award damages is omitted; it has never, it is believed, been exercised.[2]

The provisions as to directing issues and as to costs are omitted, being covered by the general powers of the Court in those matters.[3]

One or two changes of great importance affecting the practical working of this section are made by other provisions of this Act. First, the validity of registrations has always, under the former

[1] Sec. 48, post, p. 97. The power was compared before the committee to the intervention of the King's Proctor in collusive divorce cases. Costs may be given against the King's Proctor.

[2] The latest case on the point is *Reid v. Thomson & Co.*, 22 R. P. C. 376 (1905), in Scotland.

[3] As to issues see Orders XXXIII. and XXXVI.; and as to costs, Jud. Act, 1890, s. 5, and Order LXV., r. 1.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

Acts, been judged of as at their date, but now a trade mark on the register is not to be removed if it is a registrable trade mark under this Act.[1] Secondly, although the Court has in certain cases ordered a disclaimer to be entered,[2] it has been doubted whether the Court had jurisdiction to adopt that course on an application to rectify[3]; now, however, the power is expressly conferred on the Court.[4] Thirdly, sec. 41,[5] which, subject to certain exceptions, renders the validity of the original registration of a trade mark not liable to attack after seven years' registration (or seven years after the passing of the Act), applies in proceedings under the present section.

A certificate of validity can now be given in proceedings for rectification of the register.[6] This could only be done formerly under certain special circumstances.[7]

"Person aggrieved." The question is one of *locus standi*. Any person substantially inconvenienced in his business by the registration if it is wrong is a person aggrieved[8]: see pp. **265—270.** But the apprehended injury or damage must be of a legal nature as opposed to a merely sentimental one.[9]

The Court has a discretion under the section, and will in exercising it have regard to the public interest in the purity of the register, and a distinction has, therefore, been made between marks which are bad in themselves and marks which might for some purely extrinsic reason have been opposed.[10]

"The Court." See the definition of that expression in sec. 3,[11] and the notes thereto, especially with regard to the point whether the Scotch or Irish Courts can make an order for rectification of the register under this section. The registrar has the right to appear and be heard, and may be directed by the Court to appear. Unless so directed, he may submit a written statement which is to form part of the evidence.[12]

The registrar is to be served, rule 129 (post, p. 189).

Sub-sec. (4): See rules 129, 130 (post, p. 189).

[1] Sec. 36, post, p. 82.

[2] P. **281.**

[3] *Faulder's Tm.*, 18 R. P. C. 535 (1901).

[4] Sec. 15, ante, p. 54.

[5] Post, p. 88, and see the Introduction, ante, p. 8.

[6] Sec. 46, post, p. 95.

[7] *Field & Co.* v. *Wagel Syndicate*, [1900] 1 Ch. 651; 17 R. P. C. 266.

[8] *Powell's Tm.*, [1893] 2 Ch. 388; [1894] A. C. 8; 10 R. P. C. 195; 11 R. P. C. 4.

[9] *Ellis & Co.'s Tm.*, 21 R. P. C. 617 (1904), *Quaker*, for spirits.

[10] *Paine & Co.* v. *Daniells & Sons Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 71, 217.

[11] Ante, p. 17.

[12] Sec. 47, post, p. 96.

Where a mark is removed, a record of the removal and of the cause of it is to be entered in the register, rule 74 (post, p. 180).

Trade marks registered under previous Acts.

36. No trade mark which is upon the register at the commencement of this Act and which under this Act is a registrable trade mark shall be removed from the register on the ground that it was not registrable under the Acts in force at the date of its registration. But nothing in this section contained shall subject any person to any liability in respect of any act or thing done before the commencement of this Act to which he would not have been subject under the Acts then in force.

Notes.

This section is new, and it alters the general rule applicable under the repealed Acts that the validity of the registration of a trade mark was to be judged as at the date of the registration, that is to say, the date of the application to register,[1] and that the registration, if invalid when judged by that rule, must be annulled, even though it could be at once re-effected. A right is now given to the proprietor to support an old registration by showing that the mark is a registrable trade mark under this Act. Unless he can do so, the validity must be determined in accordance with the statutes in force at the date of the original entry of the trade mark on the register.[2] The mark, if upheld, retains its original date.[3] A "registrable trade mark" is defined by sec. 3[4] to mean a trade mark which is capable of registration under the provisions of this Act, and if a proprietor seeks to avail himself of the option afforded by sec. 36, his trade mark must presumably be so capable of registration at the date when the question of the removal of the trade mark is raised. "Capable of registration" means not only containing an essential particular within sec. 9, but also not obnoxious to sec. 11 or sec. 19. Upon an application for rectification the onus of showing that the entry ought not to have been made is on the applicant where the trade mark in itself appears to be capable of registration,[5] and if this principle is still applied under the present section, the proprietor will be in a more favourable position than if he were applying for registration. In cases in which the proprietor can only support the registration by

[1] *Re Borril Tm.*, [1896] 2 Ch. 600; 13 R. P. C. 382.
[2] Sec. 6, ante, p. 20.
[3] Sec. 6, ante, p. 20.
[4] Ante, p. 13.
[5] P. 279.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

showing that the trade mark is in fact distinctive, under the special case provided for by sec. 9 (5),[1] it may be that the onus of proof will be cast upon him.

If the trade mark would, apart from this section, be removable, the proviso saves all persons from liability in respect of acts or things done before the commencement of the Act. There is no saving as to acts of infringement done after the commencement of the Act and before the decision that the trade mark is a registrable trade mark under this Act.

Non-user of trade mark.

37. A registered trade mark may, on the application to the Court of any person aggrieved, be taken off the register in respect of any of the goods for which it is registered, on the ground that it was registered by the proprietor or a predecessor in title without any *bonâ fide* intention to use the same in connection therewith, or on the ground that there has been no *bonâ fide* user of such trade mark in connection with such goods during the five years immediately preceding the application, unless in either case such non-user is shown to be due to special circumstances in the trade, and not to any intention not to use or to abandon such trade mark in respect of such goods.

Notes.

This section is new, but it was held in *Batt* v. *Dunnett*[2] that a trade mark ought to be removed from the register if the proprietor had no *bonâ fide* intention to use it for the goods for which it was registered, and that such want of intention might be inferred from there being no actual user. The case cited was followed in several others in which trade marks registered in respect of a larger class were limited to the goods for which they were actually used, on a similar ground.[3]

The present section gives statutory effect to this principle. The trade mark may be removed (1) if there was no *bonâ fide* intention to use, and there has been no actual user, or (2) if there has been no

[1] And the last paragraph, ante, p. 34.

[2] [1899] A. C. 428; 16 R. P. C. 411.

[3] *Hart's Tm.*, [1902] 2 Ch. 621; 19 R. P. C. 569; *Suter, &c., Composition Co.'s Tm.*, 19 R. P. C. 42 (1902); *Anglo-Swiss Condensed Milk Co.'s Tms.*, 20 R. P. C. 509; 21 R. P. C. 261 (1904).

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

bonâ fide user during the five years immediately preceding the application, subject to a saving in either case where the non-user is due to special circumstances in the trade.

It will be observed that the Court has an ample discretion to allow the mark to remain or to remove it. Objection was taken to the section before the committee because it was urged that a trader ought to be allowed to register his own name, or a name which he uses, in classes other than those in which he trades, in order to prevent others using the name. In some cases, *e.g.*, where a name has been very widely advertised and is used in a great variety of classes, this might be reasonable. The Court is therefore allowed a discretion.

"Person aggrieved": see sec. 35 and the notes to that section.[1] The procedure is under that section. This section relates to a particular ground for rectification thereunder.

Where a trade mark contains parts separately registered so as to form a series with other associated trade marks, user of the whole is user of all such trade marks,[2] and user of an associated trade mark may be accepted by the tribunal as an equivalent for user of a trade mark with which it is associated.[3]

Effect of Registration.

Powers of registered proprietor.

38. Subject to the provisions of this Act—

(1) The person for the time being entered in the register as proprietor of a trade mark shall, subject to any rights appearing from such register to be vested in any other person, have power to assign the same, and to give effectual receipts for any consideration for such assignment:

(2) Any equities in respect of a trade mark may be enforced in like manner as in respect of any other personal property.

Notes.

As to assignment generally, see sec. 22[4] and Chap. XIII., p. **324.**

Sec. 38 corresponds to the latter part of the old sec. 37, with the alteration next noted.

[1] Ante, p. 79.

[2] Sec. 25, ante, p. 70.

[3] Sec. 27, ante, p. 71.

[4] Ante, p. 64.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

The old section referred to the granting of licences. This is now wholly dropped, no doubt because licences are inapplicable in respect of the rights in a trade mark acquired by registration. A licence to use a trade mark is unnecessary if the trade mark is to be used in connection with the goods of the proprietor of the trade mark, and is illegal, because leading to deception, if it is to be used in connection with the goods of anyone else.[1] The goodwill of a business to which the trade mark is attached may be leased for a period, and then, no doubt, the lessee would acquire the trade mark along with the goodwill, and be possessed of it for the same period.[2]

Registration of assignments is dealt with by sec. 33,[3] which corresponds to the first part of the old sec. 87.

"Subject to the provisions of this Act." These are—sec. 22, trade mark to be assigned and transmitted only in connection with the goodwill; sec. 27, associated trade marks to be assigned and transmitted only as a whole.

"Subject to any rights, &c." The Act makes express provision for registration subject to limitations and conditions (sec. 12 (2)), and for the registration of identical or nearly identical marks for similar goods in special cases (secs. 19 to 21).[4]

"Any equities," &c. This clause is unaltered. Notices of trusts affecting a registered mark are not to be entered on the register.[5]

By reason of this section the registered proprietor can make a good title to any purchaser of the trade mark and goodwill of the business concerned,[6] who has no notice of any conflicting equitable rights in either which may exist in a third person. But if the purchaser has notice of any such conflicting right at the time of the purchase, he takes subject to it.[7]

Rights of proprietor of trade mark.

39. Subject to the provisions of section forty-one of this Act and to any limitations and conditions entered upon the register, the registration of a person as proprietor of a trade mark shall, if valid, give to such person the exclusive right to the use of

[1] As to licences generally, see p. **335**, **393**.

[2] Pp. **335**, **336**, and see *Rickerby* v. *Reay*, 20 R. P. C. 380 (1903), and *Montgomerie* v. *Young*, 21 R. P. C. 285, reversing 20 R. P. C. 781 (1903).

[3] Ante, p. 76.

[4] See also sec. 39.

[5] Sec. 5, ante, p. 19.

[6] Sec. 22, ante, p. 66; cf. sec. 30 of the Companies Act, 1862.

[7] See the patent case, *New Irlam Tyre Co.* v. *Spilsbury*, [1898] 2 Ch. 137, 484; 15 R. P. C. 380, 567.

such trade mark upon or in connection with the goods in respect of which it is registered: Provided always that where two or more persons are registered proprietors of the same (or substantially the same) trade mark in respect of the same goods no rights of exclusive user of such trade mark shall (except so far as their respective rights shall have been defined by the Court) be acquired by any one of such persons as against any other by the registration thereof, but each of such persons shall otherwise have the same rights as if he were the sole registered proprietor thereof.

Notes.

This and the two following sections correspond to the old sec. 76, which was as follows:—

> 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 registration, be conclusive evidence of his right to the exclusive use of the trade mark, subject to the provisions of this Act.*[1]

Registration is evidence of title. The phrase now used is that it gives the right "if valid," but by sec. 40[2] registration is *primâ facie* evidence of the validity of the original registration, and by sec. 41,[3] after seven years the validity of that registration can only be attacked on the ground that it was obtained by fraud, or that the use of the mark is calculated to deceive or disentitled to protection in a Court of justice.[4]

It would appear, therefore, that the onus of showing that the registered proprietor has no title, even within the seven years, rests upon anyone who denies it. Under the old practice, a defendant in an action for infringement of a registered trade mark who sought to dispute the plaintiff's title applied to rectify the register.

[1] Sec. 75, which provided that the application for registration of a trade mark should be deemed to be equivalent to public use (p. 304) is now omitted. Its object was apparently to meet a pedantic idea that a trade mark could only be acquired by use and not by registration in contemplation of use; see the definition of "trade mark," sec. 3, ante, p. 14.

[2] Post, p. 88.

[3] Post, p. 88.

[4] Sec. 11, ante, p. 38.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

The title obtained by registration is, of course, of the essence of the Act. Before registration was inaugurated, it was practically possible for a trader to protect his trade mark by calling evidence to show that the use of the mark by the defendant was calculated to pass off the defendant's goods as his goods, and this is still possible, and is often done, where the mark in question is not registered.[1] But the evidence to be adduced on behalf of the plaintiff in such an action must often be elaborate and expensive, and is sometimes difficult to procure, while if the registration is properly effected, all that is necessary is to produce the registrar's certificate.

The right of exclusive use conferred by registration is subject to the general proviso to sec. 41 in favour of any person who has used a similar mark before the use of the registered mark by the proprietor or his predecessor in business.[2]

"Upon or in connection with the goods in respect of which it is "registered." These words are new. The old sec. 76 did not specify what was the extent of the right to the exclusive use conferred. There was no doubt that the right was limited to the particular description of goods for which the mark was registered, but it was open to question whether there could be "infringement" unless the infringing mark was actually marked on or attached to the goods.[3] The right is now defined to extend to use upon or in connection with the goods. This may refer to a physical connection, but it is submitted that it means any such use as indicates that the goods are the goods of the proprietor, whether the mark is attached to the goods or used in invoices, trade descriptions, or advertisements.[4] It is doubtful whether there could be a verbal infringement.[5]

As to infringement see generally Chap. XV., p. **352**.

"Goods in respect of which it is registered." The right is limited to the description of goods for which the mark is registered and used.[6] If the registration extends beyond the user the register may be rectified under sec. 37.[7]

"Provided always." This provision follows the provision for the concurrent registration of identical or nearly identical marks which is contained in secs. 19 to 21,[8] and it is therefore substantially new. Before the Acts, and apart from them, each of two persons who were

[1] See sec. 45, post, p. 94.
[2] See post, p. 38.
[3] P. **369**.
[4] Ante, p. 16.
[5] Cp. the ruling that a verbal false trade description is not within the Merchandise Marks Act, p. **571**.
[6] P. **307**.
[7] Ante, p. 83.
[8] Ante, pp. 61 to 65.

entitled to the same mark could sue an infringer for an injunction,[1] but if he claimed an account of profits he was only entitled to the share appropriate to his own interest in the mark.[2] Although the present section says expressly that each proprietor shall have the same rights as if he were the sole registered proprietor, the old ruling as to profits ought, it is submitted, to be maintained. The right of a successful plaintiff in an action for infringement of trade mark or for passing off to elect between profits or damages has lately been affirmed by the House of Lords.[3]

Registration to be *primâ facie* evidence of validity.

40. In all legal proceedings relating to a registered trade mark (including applications under section thirty-five of this Act) the fact that a person is registered as proprietor of such trade mark shall be *primâ facie* evidence of the validity of the original registration of such trade mark and of all subsequent assignments and transmissions of the same.

Notes.

This and the following section replaces the old sec. 76. See sec. 39 above and the notes thereto.

Sec. 35[4] is the section dealing with the rectification of the register. It will be observed that the reference to a five years' limit, now seven years, is omitted from this section, and placed by itself in the next, and that the section expressly extends to assignments and transmissions.

As to certificates, see sec. 51, and the notes thereto.[5]

Registration to be conclusive after seven years.

41. In all legal proceedings relating to a registered trade mark (including applications under section thirty-five of this Act) the original registration of such trade mark shall after the expiration of seven years from the date of such original registration (or seven years from the passing of this Act, whichever shall last happen) be taken to be valid in all respects unless such original registration was obtained by fraud, or unless the trade mark offends against the provisions of section eleven of this Act:

Provided that nothing in this Act shall entitle the proprietor

[1] Pp. **360**, **463**; *Dent* v. *Turpin*, 2 J. & H. 139; 30 L. J. Ch. 495 (1861), Wood, V.-C.

[2] P. **428**; *Dent* v. *Turpin*, supra.

[3] *Weingarten Bros.* v. *Bayer & Co.* 22 R. P. C. 341 (1905).

[4] Ante, p. 79.

[5] Post, p. 99.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

of a registered trade mark to interfere with or restrain the user by any person of a similar trade mark upon or in connection with goods upon or in connection with which such person has, by himself or his predecessors in business, continuously used such trade mark from a date anterior to the user of the first-mentioned trade mark by the proprietor thereof or his predecessors in business, or to object (on such user being proved) to such person being put upon the register for such similar trade mark in respect of such goods under the provisions of section twenty-one of this Act.

Notes. This and the last section replace the old sec. 76, which was as follows:—

Sec. 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 registration, be conclusive evidence of his right to the exclusive use of the trade mark, subject to the provisions of this Act.*[1]

See secs. 39 and 40 above and the notes thereto. Sec. 35[2] is the rectification section.

The present section effects one of the most important changes of the Act.[3] Although the old sec. 76 provided that registration should be conclusive after five years, the provision was construed to be subject to the liability to removal from the register under the rectification section.[4] The consequence of this was that an application to rectify the register became part of the regular course of the defence of an action for infringement. This is now altered, and after seven years the original registration is to be treated as valid, unless obtained by fraud, or by reason of being calculated to deceive or otherwise disentitled to protection in a Court of justice.[5] How far the exception of fraud will operate to defeat the intention of the promoters that registration shall, as far as possible, become conclusive as to the validity of the original entry, can only be learnt from the practical working of the Act. The presumption of validity under this section does not extend to subsequent assignments entered on the register,

[1] P. 306.
[2] Ante, p. 79.
[3] See the introductory chapter, p. 8.
[4] Pp. 309 *et seq.* But a mark which had been long registered had every presumption made in favour of its validity: *Chesebrough Manufacturing Co.'s Tm.*, 19 R. P. C. 342 (1902), C. A., *Vaseline.*
[5] See 11, ante, p. 38.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

and it is subject to the proviso at the end of the section for the protection of prior users of the mark. It is also, it is submitted, subject to sec. 37,[1] at any rate, so far as that section deals with the effects of non-user subsequent to the original registration.

A question which may have to be considered under the present section, or under it and sec. 44, is, how far the use of the name of a new article manufactured under patent rights can be permanently monopolised by the person who owned the patent, if he has registered and used the name as a trade mark while the patent rights subsisted. The common law rule is that such a name becomes merely descriptive when the patent expires, and can be used by anyone to describe the article,[2] but if the seven years have expired, the original registration of the name can now no longer be attacked. The solution of the difficulty is, it is submitted, to be found in the consideration that when the name becomes merely descriptive on the expiration of the patent rights, it ought to be removed from the register, not on the ground that it was not originally distinctive, but on the ground that its distinctiveness has ceased. In any case the right of the public to use the name, once it has become merely descriptive, is secured by sec. 44.

The advantage which this section offers to traders in regard to their own marks is to some extent balanced by the necessity under which they will now be of carefully watching the advertisements of applications to register, in order to see that nothing is registered or allowed to remain on the register long enough to profit by the section, which is likely to interfere with their business or with marks which they are actually using in it.

"Seven years." As the last to expire of the two periods is to be taken, the section cannot come into operation till August 11th, 1912.

Unless such original registration was obtained by fraud. It would be a fraud for a person to procure the registration of a trade mark which he knows he is not entitled to claim the exclusive use of—for instance, if he knows it is in use by another trader; and although the proviso[3] would protect the other trader from interference, it is submitted he would be able not merely to claim the benefit of the

[1] Ante, p. 83.

[2] *The Linoleum Co.* v. *Nairn*, 7 C. D. 834, and other authorities cited pp. 43—46. See also *Chesebrough Manufacturing Co.'s Tm.*, cited supra, note (4). In that case Cozens-Hardy, L.J., expressed the opinion that the doctrine was not limited to the names of patented articles, but extended to names given to new articles.

[3] See below.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

mark jointly with the registered proprietor, but to object to his registration notwithstanding the lapse of seven years. Another case of fraud which may be suggested is where the agent of a foreign manufacturer registers the trade mark of the latter in his own name.[1]

Sec. 11 forbids the registration of a mark calculated to deceive, or otherwise disentitled to protection, or contrary to law or morality, and of a scandalous design.[2]

"Provided, &c." This provision extends to the whole Act, not merely to the present section. It is new and is a necessary consequence of conferring a conclusive title on the registered owner.[3] In a few cases under the old Acts the person who had been an earlier user of the mark was registered along with a later user who had got upon the register.[3]

As to the registration of identical, or nearly identical, marks for the same description of goods under the present Act, see secs. 19—21.[4]

The first part of the proviso[5] applies whether the earlier user obtains registration under sec. 21[6] or not, but it is conditional upon his having used the mark continuously. The phrase "continuously "used" must, it is submitted, receive a reasonable business interpretation. There are no such saving words in this section with regard to non-user due to special circumstances and not due to an intention to abandon the mark as appear in sec. 37.[7] Nevertheless, it cannot be intended that a mere temporary cessation of user should cause the forfeiture of the right to a valuable mark. "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."[8]

42. No person shall be entitled to institute any proceeding to prevent or to recover damages for the infringement of an unregistered trade mark unless such trade mark was in use before

Unregistered trade mark.

[1] See pp. **53**, **68**, **269**.

[2] Ante, p. 38.

[3] *Jelley's* case, 51 L. J. Ch. 539, n. (1878), Jessel, M.R.; *Mouson* v. *Boehm*, 6 C. D. 398 (1884), Chitty, J. See also *Verity's Tm.*, 19 R. P. C. 58 (1902), Buckley, J.

[4] Ante, p. 61.

[5] Compare the proviso comprised in sec. 44.

[6] Ante, p. 65.

[7] Ante, p. 83.

[8] Per Chitty, J., in *Mouson* v. *Boehm*, 26 C. D. 398; cf. *Daniel & Arter* v. *Whitehouse*, [1898] 1 Ch. 685; 15 R. P. C. 134. As to abandonment see p. **346**.

the thirteenth of August one thousand eight hundred and seventy-five, and has been refused registration under this Act. The registrar may, on request, grant a certificate that such registration has been refused.

Notes.

This corresponds, with some immaterial verbal changes, to the old sec. 77.[1]

August 13th, 1875, is the date of commencement of the first Registration Act.

As to registration being a condition precedent to an action for infringement, see pp. **312—317.** The old section was construed not to affect an action for passing off goods as those of the plaintiff, and it is now expressly provided by sec. 45[2] that this Act shall not do so. The chief practical effect of non-registration of a trade mark is that the proprietor loses the cheap and convenient mode of proving his title to the mark and that its use by others for the same description of goods is wrongful.[3] He is also subject to the risk of someone else getting on the register before him, and, if the proprietor is an English subject, in most foreign countries he cannot get registration for a mark which is not registered here, or get the mark protected without it.

It is difficult to see why the provision of sec. 42 was retained in the Act.[4]

For the form of request for certificate of refusal to register, see post, p. 213.

Infringement.

43. In an action for the infringement of a trade mark the Court trying the question of infringement shall admit evidence of the usages of the trade in respect to the get-up of the goods for which the trade mark is registered, and of any trade marks or get-up legitimately used in connection with such goods by other persons.

Notes.

This is new.[5] It is apparently directed to cases where the defendant's mark is not identical with the plaintiff's registered mark, but it is alleged that the former resembles the latter so nearly as to

[1] P. **312.**
[2] Post, p. 94.
[3] See sec. 39, ante, p. 85.
[4] No such provision appears in the new U. S. Act No. 84 (1905).
[5] See "Evidence," pp. **247** and **445.**

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

be calculated to deceive. This fact, if established, is sufficient to constitute an infringement.[1] The get-up of the goods of either, and a comparison with the marks which are common in the trade, may in some cases have a bearing upon the question whether the resemblance is deceptive or not.[2] It is believed that the evidence referred to in the section was always admissible in such cases, although the Court refused to admit evidence of the opinion of witnesses that a deceptive resemblance existed or did not exist.[3] The section does not affect the latter class of evidence.

User of name, address, or description of goods.

44. No registration under this Act shall interfere with any *bonâ fide* use by a person of his own name or place of business or that of any of his predecessors in business, or the use by any person of any *bonâ fide* description of the character or quality of his goods.

Notes.

This is new so far as it deals with descriptions of the goods. Compare the old sec. 64 (3) (i.),[4] which was as follows:—

> 64 (3) (*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.*[5]

The right to the honest use of a man's own name, even though it may be mistaken for that of another trader, is well established.[6] And this right probably extended at common law to a name of repute.[7] Whether the same extension will be made under this section, having regard to the express reference to the name of any of his predecessors in business, is doubtful. There seems to be no reason, however, why a trade name honestly acquired by a period of innocent user sufficiently prolonged for it to have become descriptive of a trader, should not be "his own name" within the meaning of the section.

"Description of his goods." Under the old Act, existing words

[1] Chap. XV., p. **352**.

[2] See p. **237**, "all the circumstances of "the trade to be considered."

[3] P. **445**; *Addley Bourne* v. *Swan & Edgar*, 20 R. P. C. 105 (1903), Farwell, J.

[4] But see, as to disclaimers, the notes to sec. 15, ante, p. 54.

[5] See p. **202**.

[6] Pp. **500** *et seq.* See *Cash* v. *Cash*, 19 R. P. C. 181 (1902), C. A., and the cases there cited, and per Romer, L.J., *Morrall* v. *Hessin*, 20 R. P. C. at p. 433.

[7] See p. **512**.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

having reference to the character or quality of the goods could not be registered except as "added matter," and only subject to disclaimer.[1] Possibly in any registration under the present Act, limitations or conditions negativing an exclusive right to any obviously descriptive words which occur in the registered mark will be insisted on under sec. 12 (2),[2] unless it is thought safe to rely on this section for the protection of other traders. The ordinary form of application prescribed (post, p. 195) does not include, as the old form F. did, any statement as to essential particulars or a disclaimer of any right to the exclusive use of added matter. As regards cotton marks, however, the form of application contains a disclaimer of exclusive right to any letter press except the applicant's own name and address or the foreign equivalent thereof (post, p. 209).

No monopoly in names which are merely descriptive has ever been allowed.[3]

The question whether a word mark is descriptive often arises in passing-off cases in the form—Is it the name of the goods generally, or the name of the plaintiff's goods? The question may arise under this section and sec. 39, whether a word which is properly registered as a trade mark can subsequently become, either by the proprietor's own use of it, or by extensive misuse by other persons, descriptive of the goods by whomsoever made. This question could hardly have arisen under the old Act, because sec. 76 of that Act was not limited by anything corresponding to the present section, so far as it deals with descriptions.[4] If the right to the exclusive use of a properly registered word mark which continues to be actually used as a trade mark by the proprietor can in fact be lost by such matter subsequent, the onus of making out the necessary facts will probably be very difficult for a defendant to discharge.

As to the registration of the name of a new article manufactured under patent rights, see the note to sec. 41 above, p. 88.

"Passing-off" action.

45. Nothing in this Act contained shall be deemed to affect rights of action against any person for passing off goods as those of another person or the remedies in respect thereof.

[1] See now sec. 15, ante, p. 54, and sec. 9, ante, p. 23, and "Additions and "Disclaimers," Chap. IX., p. **197**.

[2] Ante, p. 39.

[3] P. **467**. As to descriptive marks generally see pp. **36**, **50**; descriptive devices, p. **145**; descriptive words, p. **186**; name of house or factory p. **473**; secondary meaning of names *primâ facie* descriptive, pp. **36**, **477**.

[4] See *Kodak Ltd.* v. *London Stereoscopic Co.*, 20 R. P. C. 337, and *Burroughs, Wellcome & Co.* v. *Thompson*, 21 R. P. C. 69.

This is new, but it makes no change in the law. Compare sec. 42,[1] and see "The Action for Passing off," Chap. XVI., p. **446**.

Legal Proceedings.

Certificate of validity.

46. In any legal proceeding in which the validity of the registration of a registered trade mark comes into question and is decided in favour of the proprietor of such trade mark, the Court may certify the same, and if it so certifies then in any subsequent legal proceeding in which such validity comes into question the proprietor of the said trade mark on obtaining a final order or judgment in his favour shall have his full costs, charges, and expenses as between solicitor and client, unless in such subsequent proceeding the Court certifies that he ought not to have the same.

Notes.

Certificate, p. **292**. This section corresponds to sec. 77A of the Act of 1883, introduced into that Act by sec. 18 of the Act of 1888. It was as follows:—

> *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.*

The important change is that under the new section a certificate may be given in any legal proceeding in which the validity of a trade mark comes into question, and not merely in an action for infringement. Questions as to validity generally arise upon motions to rectify the register, but under sec. 77A a certificate could not be given in such a proceeding, although in one case where an action for infringement and a motion to rectify were heard together and on the same evidence, a certificate was given.[2]

Moreover, where a certificate has been given, costs as between solicitor and client are recovered, subject to a certificate by the Court to the contrary, by the proprietor of the trade mark on obtaining a

[1] Ante, p. 91.

[2] *Field, Ltd.* v. *Wagel Syndicate, Ltd.*, [1900] 1 Ch. 651, 17 R. P. C. 266.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

final order or judgment in any subsequent legal proceeding in which the validity of the trade mark comes into question. The old section only gave a right to such costs in subsequent actions for infringement, but it gave such right whether the validity again came into question or not, subject to the power of the Court to certify to the contrary.[1]

The giving of the certificate of validity is a matter of discretion,[2] as is also the refusal of solicitor and client costs in the subsequent proceeding.[3] A certificate that validity has come into question has in several patent cases been given where invalidity has been alleged in the defence and particulars of objections, notwithstanding that the defendant has not appeared at the trial.[4]

"Subsequent legal proceeding" means one commenced after the date of the certificate of validity.[5] The form of the certificate to be given under the new section is that the validity of the trade mark came into question and was decided in favour of the proprietor. This however, is only a change of form.

The order granting a certificate is not appealable.[6]

Registrar to have notice of proceeding for rectification.

47. In any legal proceeding in which the relief sought includes alteration or rectification of the register, the registrar shall have the right to appear and be heard, and shall appear if so directed by the Court. Unless otherwise directed by the Court, the registrar in lieu of appearing and being heard may submit to the Court a statement in writing signed by him, giving particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting the same or of the practice of the office in like cases, or of such other matters relevant to the issues, and within his knowledge as such registrar, as he shall think fit, and such statement shall be deemed to form part of the evidence in the proceeding.

[1] Cf. the patent cases, *Welsbach Incandescent Gas Light Co., Ltd.* v. *Daylight Incandescent Mantle Co., Ltd.*, 16 R. P. C. 344, at p. 354, and the cases there cited. In several cases where the only question raised was infringement the full costs have been withheld: *Saccharin Corporation, Ltd.* v. *Dawson*, 19 R. P. C. 173; *Edison Bell Consolidated Phonograph Co., Ltd.* v. *Waterfield, Clifford & Co.*, 19 R. P. C. 329 (1903).

[2] *Addley Bourne's Tm.*, 20 R. P. C. 105 (1903).

[3] See the cases referred to in note (1).

[4] *E.g.*, in *J. B. Brooks & Co., Ltd.* v. *E. Lycett, Ltd.*, 20 R. P. C. 390 (1903).

[5] *Automatic Weighing Machine Co.* v. *International Hygienic Society*, 6 R. P. C. 475 (1889).

[6] *Haslam* v. *Hall*, 5 R. P. C. 144 (1888) C. A.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

This section is new, but under rule 49 of the Rules of 1890,[1] notice of an application to rectify had to be given to the comptroller, who had the right to appear. By rule 129 it is provided that every application to the Court under the Act shall be served on the registrar (post, p. 189). Notes.

Alteration or rectification of the register may be sought and the application come before the Court under sec. 35 or sec. 33, or, where an appeal from a decision of the registrar under secs. 23, 32 or 34 to the Board of Trade is referred to the Court, under sec. 59.

The latter part of the section is new in substance as well as in form. It is intended to enable the registrar to save the parties the cost of an appearance on his behalf. He will probably be content with submitting a statement under the section wherever he does not think that examination of witnesses or argument on his behalf is necessary in the public interest.

"Particulars of the proceedings before him in relation to the matter "or of the grounds of any decision given by him affecting the same." In cases under secs. 23, 32, 33 or 34, the matter would come before the registrar in the first instance, but this would not be so under sec. 35.

The Court may in any application for rectification review a decision of the registrar relating to the entry or correction, sec. 54 (post, p. 100).

Costs.

48. In all proceedings before the Court under this Act the costs of the registrar shall be in the discretion of the Court, but the registrar shall not be ordered to pay the costs of any other of the parties. Costs of proceedings before the Court.

Costs, pp. **93** and **293**.

This express provision is new, and it embodies a concession on the part of the Treasury authorities. Under the Act of 1883 it was held that there was no jurisdiction on an appeal from the comptroller to order him to pay costs.[2] And in oppositions which came before the Court on appeal from the comptroller, and proceedings for rectification, the almost invariable rule was for the unsuccessful party to be ordered to pay costs, including those of the comptroller in the Court of first instance, if he appeared.[3] In some few special cases, Notes.

[1] P. **700**.

[2] *Leaf's Tm.*, 33 C. D. 477 ; 3 R. P. C. 289 (1886) ; *Van Duzer's Tm.*, 3 R. P. C. 243 (1886) ; *Eastman, etc. Co.'s Application*, [1898] A. C. 585 ; 15 R. P. C. 487.

[3] Pp. **94** and **293**.

however, an applicant for registration who successfully appealed from the refusal of the comptroller to register has not been ordered to pay the comptroller's costs.[1]

As to the registrar's right to appear in proceedings for alteration or rectification of the register, see sec. 47.[2] He is to be served on every application to the Court under the Act, rule 129 (post, p. 189).

Evidence.

Mode of giving evidence.

49. In any proceeding under this Act before the Board of Trade or the registrar, the evidence shall be given by statutory declaration in the absence of directions to the contrary, but, in any case in which it shall think it right so to do, the tribunal may (with the consent of the parties) take evidence *vivâ voce* in lieu of or in addition to evidence by declaration. Any such statutory declaration may in the case of appeal be used before the Court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

In case any part of the evidence is taken *vivâ voce* the Board of Trade or the registrar shall in respect of requiring the attendance of witnesses and taking evidence on oath be in the same position in all respects as an official referee of the Supreme Court.

Notes.

This section is new. The old rule was that upon oppositions before the registrar all evidence was taken by statutory declaration.[3] On an appeal being referred by the Board of Trade to the Court directions were usually given on the reference that the parties might adduce such evidence by affidavit, examination or cross-examination of witnesses and otherwise as the Court should direct or permit.[4] The deponents of the statutory declarations had each to make an affidavit verifying his declaration.[5] Under the present section this will now be unnecessary. The power conferred on the Board of Trade and the registrar to take *vivâ voce* evidence with the consent of the parties is new.

As to the powers of an official referee to require the attendance of

[1] See pp. 94 and 95.
[2] Ante, p. 96.
[3] Rule 31 (3), (4), of 1890, pp. 80 and 81. As to declarations, see rules 105 and 106 of 1906, post, p. 185.
[4] P. 740.
[5] Evidence upon appeal, p. 90, see now rule 125, post, p. 189.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

witnesses and to take evidence on oath, see Order XXXVI., r. 49, and the Arbitration Act, 1889.

"On oath" and "affidavit," see Interpretation Act, 1889, sec. 3, post, p. 224.

As to the registrar's power to dispense with evidence, see rule 97 (post, p. 184).

Sealed copies to be evidence.

50. Printed or written copies or extracts of or from the register, purporting to be certified by the registrar and sealed with the seal of the Patent Office, shall be admitted in evidence in all Courts in His Majesty's dominions, and in all proceedings, without further proof or production of the originals.

This is practically the same as those parts of sec. 89 of the Act of 1883 which relate to trade marks. Sec. 84 of the Act of 1883, which provides that impressions of the seal of the Patent Office shall be judicially noticed and admitted in evidence, is unrepealed.[1]

Certificate of registrar to be evidence.

51. A certificate purporting to be under the hand of the registrar as to any entry, matter, or thing which he is authorised by this Act, or 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 not done.

Notes.

Except for the substitution of "registrar" for comptroller and the omission of the words "any general" before the word "rule," this section is exactly the same as sec. 96 of the Act of 1883.

On registration of a trade mark the applicant is entitled to a certificate of registration.[2]

Certificates of copies of or extracts from the register, sealed with the seal of the Patent Office, are evidence in all Courts of the British dominions.[3] See also rule 102,[4] and Forms O No. 2 (post, p. 200), Cotton Nos. 3 and 4 (post, pp. 210, 211), M. B. Nos. 1 and 2 (post, pp. 211, 212), and T. M. Nos. 31 to 34 (post, pp. 213, 214).

Certificate of Board of Trade to be evidence.

52.—(1) All documents purporting to be orders made by the

[1] Post, p. 158.
[2] Sec. 17, ante, p. 60, and rule 67, post, p. 179.
[3] Sec. 50.
[4] Post, p. 185.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

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.

(2) 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.

This section is in exactly the same terms as sub-secs. (2) and (3) of the sec. 102A of the Act of 1883 as amended by the Act of 1888. The provisions of sub-sec. (1) of sec. 102A are contained in sec. 58 of the new Act.

PART II.

Powers and Duties of Registrar of Trade Marks.

Exercise of discretionary power by registrar.

53. Where any discretionary or other power is given to the registrar by this Act or rules made thereunder he shall not exercise that power adversely to the applicant for registration or the registered proprietor of the trade mark in question without (if duly required so to do within the prescribed time) giving such applicant or registered proprietor an opportunity of being heard.

Notes.

See pp. 74 and 78.

Sec. 94 of the Act of 1883 contained a similar provision, but, so far as regarded trade marks, only in favour of an applicant for registration.

The registrar has new powers in many respects under the Act, *e.g.*, under sec. 32 for the correction of the register, and sec. 34 for alteration of a registered mark, and the present section is made to apply to all powers, discretionary or otherwise, and whether given by the Act or the rules thereunder.

As to the recognition of agents, see sec. 55.[1]

One month from the date when the matter has arisen is the prescribed time, see rules 83 to 86.

Appeal from registrar.

54. Except where expressly given by the provisions of this Act or rules made thereunder there shall be no appeal from a

[1] Post, p. 101 : also rule 10, post, p. 170.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

decision of the registrar otherwise than to the Board of Trade, but the Court, in dealing with any question of the rectification of the register (including all applications under the provisions of section thirty-five of this Act), shall have power to review any decision of the registrar relating to the entry in question, or the correction sought to be made.

Notes.

This section is new, but under the Act of 1883 there was no right of direct appeal from a decision of the comptroller, except where expressly provided. But in substance his decision could usually be reviewed by a motion for rectification of the register, under sec. 90, as where he had refused to register an assignment. The power of the Court, in proceedings for rectification, to review decisions of the comptroller is now expressly reserved. Where there has been a decision of the same matter by the Court between the parties, for instance, on an appeal from the registrar to the Court arising out of an opposition,[1] the matter would be *res judicata*, and notwithstanding the saving contained in the last part of the section, it is presumed that the question could not be reopened by the defeated party.[2]

The right of appeal to the Court direct is given by secs. 12,[3] 14,[4] 33,[5] 63 (9)[6] (in reference to Sheffield marks), and sec. 64 (5)[7] (in reference to cotton marks).

Where an appeal is made to the Board of Trade it may refer the matter to the Court.[8]

Section 35. The only power given to the Court to rectify the register is under sec. 35, unless an appeal is referred to the Court by the Board of Trade, *e.g.*, under sec. 32, or an appeal is made from the registrar to the Court under sec. 33. By rule 63 (post, p. 179) a right of appeal is given where registration is refused under sec. 16.

Recognition of agents.

55. Where by this Act any act has to be done by or to any person in connection with a trade mark or proposed trade mark or any procedure relating thereto, such act may under and in accordance with rules made under this Act or in particular cases

[1] Sec. 14, sub-sec. (5).
[2] See *Normal Co.'s Tm.*, 35 C. D. 231; 3 R. P. C. 269; 4 R. P. C. 123 (1886); and see p. 88.
[3] Ante, p. 39.
[4] Ante, p. 48.
[5] Ante, p. 76.
[6] Post, p. 108.
[7] Post, p. 112.
[8] Sec. 59, post, p. 103.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

by special leave of the Board of Trade be done by or to an agent of such party duly authorised in the prescribed manner.

There was no such provision in the Act of 1883. Rule 2 of 1898,[1] however, provided that "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 dis-"graceful professional conduct, has been erased from the Register of "Patent Agents kept under the provisions of the Patents, Designs "and Trade Marks Act, 1888,[2] relating to the registration of patent "agents, and not since restored."

Most of the professional work with regard to applications at the Patent Office is now done by patent agents.

Any application or opposition may be by an agent; see now rule 10 (post, p. 170) as to agents generally. An agent must be duly authorised to the satisfaction of the registrar, rule 2 (post, p. 168).

Registrar may take directions of law officers.

56. The registrar may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to His Majesty's Attorney-General or Solicitor-General for England for directions in the matter.

Page 74.

Except for a mere verbal change, this section is the same as sec. 95 of the Act of 1883.

It was decided on that section in a patent case that the Court would not grant a mandamus against the comptroller where he has properly taken the directions of the law officers,[3] even although a question of construction of the Act was involved. But the fact that the registrar acted under such direction would not affect the right of appeal from his decision given by the Act.[4]

[1] P. 692.

[2] Sec. 1. See also Patent Agents Rules, 1889 and 1891.

[3] *R. v. Comptroller-General of Patents, Ex p. Tomlinson*, [1899] 1 Q. B. 909; 16 R. P. C. 233. C. A. See also the judgment of Lindley, L.J., in *Re Tm. Normal*, 35 C. D. p. 245; 4 R. P. C. 123.

[4] It was stated in the course of the argument in *Christy & Co. v. Tipper & Son*, 21 R. P. C. 97, that in allowing registration of a word with a note of the kind there registered, the Comptroller had acted under the directions of the law officer.

57. The Comptroller-General of Patents, Designs, and Trade Marks shall, in his yearly report on the execution by or under him of the Patents, Designs and Trade Marks Act, 1883, and Acts amending the same, include a report respecting the execution by or under him of this Act, as though it formed a part of or was included in such Acts.

Annual reports of comptroller. 46 & 47 Vict. c. 57.

This section has reference to the reports of the comptroller under sec. 102 of the Act of 1883, which provides for annual reports to be made.

Elsewhere in the Act the comptroller is referred to as the registrar.

Powers and Duties of the Board of Trade.

58. 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 or any person authorised in that behalf by the President of the Board.

Proceedings before Board of Trade.

This section is the same as sub-sec. (1) of sec. 102A of the Act of 1883, with the addition of the words at the end, "or any person "authorised in that behalf by the President of the Board of Trade."

59. Where under this Act an appeal is made to the Board of Trade, the Board of Trade may, if they think fit, refer any such appeal to the Court in lieu of hearing and deciding it themselves, but, unless the Board so refer the appeal, it shall be heard and decided by the Board, and the decision of the Board shall be final.

Appeals to Board of Trade.

This section as a general provision is new. As regards appeals from the comptroller on applications to register and on oppositions, there was a similar power to refer an appeal to the Court.[1]

Except where expressly given by the Act or the rules made under

[1] Sec. 62 (5) and sec. 69 (4) of the Act of 1883, as amended by the Act of 1888. For forms of reference and directions, see p. **740**.

it, there is no appeal from the registrar except to the Board of Trade,[1] but the Board may upon any appeal refer it to the Court under this section. A right of appeal to the Court direct is given on applications to register by sec. 12,[2] on oppositions by sec. 14,[3] and from decisions as to assignments, etc., by sec. 33[4]; also under sec. 63, sub-secs. (5) and (9) as to Sheffield marks,[5] and under sec. 64, sub-sec. (5)[6] as to cotton marks.

"The Court" means the High Court of Justice in England.[7]

See rules 122 to 127 (post, p, 128) as to the procedure on appeal to the Board of Trade. One month from the date of the decision is allowed for appeal.

Power of Board of Trade to make rules.

60.—(1) Subject to the provisions of this Act the Board of Trade may from time to time make such rules, prescribe such forms, and generally do such things as they think expedient—

(*a*) For regulating the practice under this Act:

(*b*) For classifying goods for the purposes of registration of trade marks:

(*c*) For making or requiring duplicates of trade marks and other documents:

(*d*) For securing and regulating the publishing and selling or distributing in such manner as the Board of Trade think fit, of copies of trade marks and other documents:

(*e*) Generally, for regulating the business of the office in relation to trade marks and all things by this Act placed under the direction or control of the registrar, or the Board of Trade.

(2) Rules made under this section shall, whilst in force, be of the same effect as if they were contained in this Act.

(3) Before making any rules under this section the Board of Trade shall publish notice of their intention to make the rules and of the place where copies of the draft rules may be obtained

[1] Sec. 54, ante, p. 100.
[2] Ante, p. 39.
[3] Ante, p. 48.
[4] Ante, p. 76.
[5] Post, p. 108.
[6] Post, p. 112.
[7] Sec. 3.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

in such manner as the Board consider most expedient, so as to enable persons affected to make representations to the Board before the rules are finally settled.

(4) Any rules made in pursuance of this section shall be forthwith advertised twice in the Trade Marks Journal, and 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.

(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.

Notes.

With the exception of sub-sec. (3), which is new, this section is practically a reproduction of sec. 101 of the Act of 1883.[1]

The existing rules,[2] tables of fees,[3] and classification of goods,[4] were to continue in force as if made under this Act until superseded by rules, tables of fees or classification under this Act: sec. 73. New rules have now been made, with table of fees and classification, see Appendix (post, p. 167). They came into force after March 31st, 1906. They contain no express revocation of the rules existing at the passing of the Act. It is presumed that those will continue to apply to applications pending on April 1st, 1906.

"Prescribed," where it occurs in the Act and except in relation to proceedings before the Court, means prescribed by this Act or the rules thereunder.[5]

Fees.

61. There shall be paid in respect of applications and registration and other matters under this Act, such fees as may be, Fees.

[1] Sec. 101, p. **668**.
[2] Trade Mark Rules, 1890, as amended by Trade Mark Rules, 1897 and 1898, pp. **691—720**.
[3] Pp. **702**, **703**.
[4] Pp. **715—720**.
[5] Sec. 3, ante, p. 13.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

with the sanction of the Treasury, prescribed by the Board of Trade.

This corresponds in terms with sec. 80 of the Act of 1883.
For Table of Fees, see post, p. 190.

Special Trade Marks.

Standardization, &c., trade marks.

62. Where any association or person undertakes the examination of any goods in respect of origin, material, mode of manufacture, quality, accuracy, or other characteristic, and certifies the result of such examination by mark used upon or in connection with such goods, the Board of Trade may, if they shall judge it to be to the public advantage, permit such association or person to register such mark as a trade mark in respect of such goods, whether or not such association or person be a trading association or trader or possessed of a goodwill in connection with such examination and certifying. When so registered such trade mark shall be deemed in all respects to be a registered trade mark, and such association or person to be the proprietor thereof, save that such trade mark shall be transmissible or assignable only by permission of the Board of Trade.

Notes.

See Introductory Chapter, ante, p. 11.

In *Batts' Trade Marks*,[1] Lindley, M.R., said: "The Trade Mark "Registration Acts presuppose some business or trade in some kind "of goods made, sold, or otherwise dealt with in the course of "business." The definition contained in sec. 3 of this Act gives effect to this principle. Apart from the Acts, the office of a trade mark is to indicate a connection between the goods to which it is applied and a person dealing therein.[2] The section provides an exception to this rule introduced particularly for the convenience of associations or persons who certify goods in the respects mentioned in the section, without themselves having any trading interest in the actual goods so certified, although the section contemplates that the association or

[1] [1898] 2 Ch. 432; 15 R. P. C. 534; affirmed by H. of L., [1899] A. C. 428; 16 R. P. C. 411.

[2] See definition of a trade mark, p. 23.

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person may be engaged in the trade, or possessed of a goodwill in connection with such examination and certifying.

The well-known mark of Lloyd's Register (L.R.) placed upon shipbuilding materials to show that they have been passed by Lloyd's surveyors is an example of marks which under this section may be registered and protected as if they were trade marks.

The general rule that a trade mark can be assigned only in connection with the goodwill of the business in the goods[1] is, of course, inapplicable to the marks registered under this section. The provision inserted here that an assignment, like the original registration, shall only be made with the permission of the Board of Trade is intended to prevent a standardization mark being passed on to somebody in whose hands it would have a meaning different from that it had come to import.

"Person" includes any body of persons corporate or incorporate.[2]

The rules as to applications under this section are rules 42 to 46 (post, p. 175).

Sheffield Marks.

Sheffield marks.

63. 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:—

(1) The Cutlers' Company shall continue to keep at Sheffield the register of trade marks (in this Act called the Sheffield register) kept by them at the date of the commencement of this Act, and, save as otherwise provided by this Act, such register shall for all purposes form part of the register:

(2) The Cutlers' Company shall, on request made in the prescribed manner, enter in the Sheffield register, in respect of metal goods as defined in this section, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the first

[1] Sec. 22, ante, p. 66. [2] Interpretation Act, 1889, s. 19, post, p. 225.

day of January one thousand eight hundred and eighty-four, but which have not been entered in such register before the passing of this Act:

(3) An application for registration of a trade mark used 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 registrar in the prescribed manner, and, unless the registrar within the prescribed time give notice to the Cutlers' Company of any objection to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner:

(5) If the registrar gives notice of an objection as aforesaid, the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may in the prescribed manner 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 registrar, 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 registrar on that day:

(7) The provisions of this Act, and of any 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 (and notwithstanding anything in any Act relating to the Cutlers' Company), 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 rules shall, so far

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The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

as applicable, be construed accordingly with the substitution of the Cutlers' Company, the office of the Cutlers' Company, and the Sheffield register, for the registrar, 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 registrar by the Cutlers' Company:

(8) When the registrar 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 metal goods, he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company:

(9) 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 Court:

(10) 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;

(11) 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 registrar.

Notes.

Sheffield marks, Chap. VI., p. **101.**

The Sheffield Register of Corporate Marks existed for a very long time before a general system of registration for trade marks was introduced by the Act of 1875, and all the Registration Acts have contained special provisions with respect to Sheffield marks. By the Act of 1883[1] a new register was established at Sheffield under the care of the Cutlers' Company. Applications for registration of trade

[1] Sec. 81.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

marks to be used on *metal goods*[1] since the commencement of that Act, if made by a person carrying on business in Hallamshire, or within six miles thereof, have had to be made to the Cutlers' Company. Other applications relating to metal are made to the Patent Office in London in the ordinary manner, but sec. 81 of the Act of 1883 provided, as does the present section (sub-secs. (4) and (8)), for cross-notices to the comptroller and the Cutlers' Company of applications received at Sheffield and in London. The Sheffield register and the same system of registration are continued under the new Act, the Sheffield register being made part of the general register, and except in certain minor respects noticed more particularly below, sec. 63 of the new Act follows sec. 81 of the Act of 1883, as amended by sec. 20 of the Act of 1888. That section, as so amended, is fully set out in the Appendix.[2]

The alterations are as follows:[3] The new sec. 63 adds by sub-sec. (1) the provision that the Sheffield register, save as otherwise provided by this Act, shall for all purposes form part of the register. Sub-sec. (2) omits a transitory provision for the transfer of marks entered before the old Act came into operation. Sub-sec. (7), which directs that the provisions of the Act and rules are to apply to registrations made by the Cutlers' Company, has added to it the words "notwithstanding anything in any Act relating to the Cutlers' Company," and it omits a (presumably) obsolete provision for the protection of the interest of any widow in a Sheffield mark at the time when the mark was put on the Sheffield register. Sub-sec. (9) of the old section, closing the old Cutlers' register, is omitted, as are also sub-secs. (10) and (11) of the old section, which respectively provided for the registration of two or more trade marks for one proprietor and for the registration of a corporate or unincorporate body as proprietor, both matters being now dealt with by the general parts of the Act. Sub-sec. (9) of the new section substitutes an appeal direct to the Court for the appeal given by sub-sec. (12) of the old section to the comptroller.

Sub-sec. (13), which extended the provisions for the summary punishment of persons counterfeiting mark contained in the Cutlers' Act to marks entered on the Sheffield register, is omitted, no doubt

[1] Substituted by the Act of 1888, s. 20 (2), for cutlery, edge tools, raw steel, and goods made of steel or steel and iron combined, whether with or without a cutting edge.

[2] Post, p. 155.

[3] For the exact words of the old section see post, p. 155.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

because sufficient protection is considered to be now given by the Merchandise Marks Act, 1887.

Appeal. The change effected under sub-sec. (9), allowing a person aggrieved to appeal direct to the Court, is the only substantial alteration. No option is given to appeal to the Board of Trade.[1] As to "person aggrieved," compare sec. 35.[2]

The Court means in England the High Court of Justice: see sec. 3.[3]

The rules as to applications under this section are rules 107 to 112.

Cotton Marks.

Cotton marks.

64.—(1) The Manchester Branch of the Trade Marks Registry of the Patent Office (herein-after called "the Manchester Branch") shall be continued according to its present constitution. A chief officer of the Manchester Branch shall be appointed who shall be styled "the Keeper of Cotton Marks," and shall act under the direction of the registrar. The present keeper of the Manchester Branch shall be the first Keeper of Cotton Marks.

(2) As regards cotton goods which have hitherto constituted classes 23, 24, and 25, under the classification of goods under the Patents, Designs, and Trade Marks Acts, 1883 to 1902, the Register of Trade Marks for all such goods, except such as may be prescribed, shall be called "the Manchester register," and a duplicate thereof shall be kept at the Manchester Branch.

(3) All applications for registration of trade marks for such cotton goods in the said classes (herein-after referred to as "cotton "marks") shall be made to the Manchester Branch.

(4) Every application so made to the Manchester Branch shall be notified to the registrar in the prescribed manner together with the report of the Keeper of Cotton Marks thereon, and unless the registrar, after considering the report and hearing, if so required, the applicant, within the prescribed time gives notice to the Keeper of Cotton Marks of objection to the acceptance of the application, it shall be advertised by the

[1] Cf. sec. 12 (3), ante, p. 39.
[2] Ante, p. 79.
[3] Ante, p. 14.

Manchester Branch and shall be proceeded with in the prescribed manner.

(5) If the registrar gives notice of objection as aforesaid the application shall not be proceeded with, but any person aggrieved may in the prescribed manner appeal to the Court or the Board of Trade, at the option of the applicant.

(6) Upon the registration of a trade mark in the Manchester register the Keeper of Cotton Marks shall upon notice thereof from the registrar thereupon enter the mark in the duplicate of the Manchester register, and such registration shall bear date as of the day of application to the Manchester Branch, and shall have the same effect as if the application had been made to the registrar on that day.

(7) When any mark is removed from or any cancellation or correction made in the Manchester register notice thereof shall be given by the registrar to the Keeper of Cotton Marks, who shall alter the duplicate register accordingly.

(8) For the purpose of all proceedings in relation to trade marks entered in the Manchester register a certificate under the hand of the Keeper of Cotton Marks shall have the same effect as a certificate of the registrar.

(9) In every application for registration of a cotton mark, if such mark has been used by the applicant or his predecessors in business prior to the date of application, the length of time of such user shall be stated on the application.

(10) As from the passing of this Act—

(*a*) In respect of cotton piece goods and cotton yarn no mark consisting of a word or words alone (whether invented or otherwise) shall be registered, and no word or words shall be deemed to be distinctive in respect of such goods:

(*b*) In respect of cotton piece goods no mark consisting of a line heading alone shall be registered, and no line heading shall be deemed to be distinctive in respect of such goods:

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

(*c*) No registration of a cotton mark shall give any exclusive right to the use of any word, letter, numeral, line heading, or any combination thereof.

(11) The right of inspection of the Manchester register shall extend to and include the right to inspect all applications whatsoever that have been since the passing of the Trade Marks Registration Act, 1875, and hereafter shall have been made to the Manchester Branch in respect of cotton goods in classes 23, 24, and 25, whether registered, refused, lapsed, expired, withdrawn, abandoned, cancelled, or pending. 39 & 40 Vict. c. 33.

(12) The Keeper of Cotton Marks shall, on request, and on production of a facsimile of the mark, and on payment of the prescribed fee, issue a certified copy of the application for registration of any cotton mark, setting forth in such certificate the length of time of user (if any) of such mark as stated on the application, and any other particulars he may deem necessary.

(13) As regards any rules or forms affecting cotton marks which are proposed by the Board of Trade to be made, the draft of the same shall be sent to the Keeper of Cotton Marks and also to the Manchester Chamber of Commerce. And the said Keeper, and also the said Chamber, shall, if they or either of them so request, be entitled to be heard by the Board of Trade upon such proposed rules before the same are carried into effect.

(14) The existing practice whereby the keeper of the Manchester Branch consults the Trade and Merchandise Marks Committee appointed by the Manchester Chamber of Commerce upon questions of novelty or difficulty arising on applications to register cotton marks shall be continued by the Keeper of Cotton Marks.

Notes

See Introductory Chapter, *ante*, p. 11.

Cotton marks and the Manchester office, Chap. VII., p. **112.**

This section puts cotton marks on a new footing, inasmuch as the Manchester Branch of the registry, and the registration of cotton marks in that branch, are now directly recognised by the Act, instead of being authorised merely by the rules. Cotton marks have,

however, been treated specially from the time of the introduction of registration by the Trade Marks Registration Act, 1875. The Manchester office was established by the rules made under that Act,[1] and a committee of experts was formed and empowered to divide the existing cotton marks, of which representations had to be sent in before a certain date, into two classes known as the Class A and Class B; the first consisting of marks which were registrable under the Act of 1875, and the second of marks not so registrable. No mark in Class B could be registered except in pursuance to an order of the Court. The committee of experts was subsequently dissolved, but the Manchester office was continued as a branch office, see the Rules of 1890, as amended by those of 1897 and 1898,[2] all applications for registration in classes 23, 24 or 25 being sent to that branch.

The same system is continued under the new Act, but, as already noticed, the practice is directly established by the Act itself.

Sub-sec. (1). The existing office is at 48, Royal Exchange, Manchester.

Sub-sec. (2). The cotton goods constituting classes 23, 24, and 25 under the classification existing at the passing of the Act were as follows:—

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.
Class 25. Cotton goods not included in classes 23, 24, or 38 (articles of clothing).

Provision is made for the exclusion by rules of some of these goods from the Manchester register. None have been excluded by the Rules of 1906. Under the new classification the only alteration made is that Class 23 is divided into (*a*) cotton yarn and (*b*) sewing cotton, post, p. 216.

Sub-secs. (3), (4), and (5). Compare sec. 63, sub-secs. (3), (4), and (5)[3] with respect to Sheffield marks applied for at Sheffield Under the present section, however, an option is given as under sec. 12 (3)[4] to appeal to the Board of Trade or the Court. The Board of Trade

[1] Rules of August, 1876.
[2] See Rules 8 and 13.
[3] Ante, p. 111.
[4] Ante, p. 39.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

may under sec. 59 refer the appeal to the Court.[1] "The Court" is defined by sec. 3[2] as the High Court of Justice in England, but as regards cotton marks, the Court of Chancery of the County Palatine of Lancaster has a co-ordinate jurisdiction under sec. 71.

Sub-sec. (6). Under the general provisions of sec. 16[3] a trade mark is registered as of the date of the application for registration.

Sub-sec. (7). The registrar himself receives notice of orders rectifying the register under the provisions of sec. 35 (4).[4]

Sub-sec. (8). A certificate of the registrar is *primâ facie* evidence.[5] By sec. 17[6] a proprietor is entitled on registration to a certificate of registration.

Sub-sec. (9). Record of date of first user. The requirement that the length of time of user should be stated, hitherto only applied to old marks, that is marks in use before August 13th, 1875.[7]

The object of this sub-sec. (9), in conjunction with sub-secs. (11) and (12), appears to be to encourage a system of deposit of trade marks, by means of applications for marks even if not registrable, so as to obtain as complete a record as possible of the marks in actual use; and thereby, not only in some degree to protect the owners by warning other traders of the use of the marks, but to give an opportunity for a person desiring to design and adopt a new mark, to ascertain what marks are in use at the time.

Sub-sec. 10. Words and line headings. It is the practice in the Manchester trade to use very numerous marks, one firm having frequently many hundreds in use at the same time, of which several, and generally at least five, are used on the same piece of goods. The enormous multiplication of marks, both marks which are trade marks and marks which are mere ornaments, and the fact that much of the trade is done with non-European nations, has caused the trade generally to regard word and line headings as not capable of being distinctive.[8]

This sub-section came into operation at the passing of the Act, namely, August 11th, 1905. The Act generally only came into operation on April 1st, 1906.[9]

[1] Ante, p. 103.
[2] Ante, p. 14.
[3] Ante, p. 59.
[4] Ante, p. 79. See also sec. 47, ante, p. 96.
[5] Sec. 51, ante, p. 99.
[6] Ante, p. 60.
[7] See sec. 9, ante, p. 35, and sec. 64 (3) (ii.) of the Act of 1883.
[8] See Introductory Chapter, ante p. 5.
[9] Sec. 2, ante, p. 13.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

Clause (*a*) excepts words, in the case of cotton piece goods and cotton yarn, from the essential particulars enumerated in sec. 9.[1] It does not forbid their registration as part of a mark which is distinctive as a whole. See clause (*c*) below, and as to disclaimer sec. 15.[2]

Clause (*b*). Line headings are the coloured strips woven or stamped across the end of a piece. Lord Herschell's committee recommended that line headings should not be admitted as trade marks upon the register,[3] as not being in themselves sufficiently distinctive.[4] Subject, however, to sec. 15[5] as to disclaimer, there appears to be nothing in the Act to prevent the registration of a mark which includes a line heading. The Manchester witnesses before the committee on the Bill described the headings as very useful as indications of origin in combination with other marks. Their view was generally that it is frequently rather a combination of several marks than one single trade mark which is effective to distinguish a trader's goods. See note on clause (*a*) above.

Clause (*c*). The effect of this clause is that, although any of these symbols may be included in a registered trade mark, no exclusive right to their use is conferred by the registration. Compare the general provisions of sec. 44.[6]

Sub-sec. 11. Inspection of record of applications. See the note to sub-sec. (9) above. The sub-section gives the authority of the Legislature to the practice already existing at the Manchester branch.[7]

Sub-sec. (12). See last note and the note to sub-sec. (9). This is a new provision. The owner, although the mark may not be registrable, will obtain a certificate of the application having been made, and of the claim of user made on such application,[8] and of any other particulars which the keeper of cotton marks may deem necessary. Under sub-sec. (8) and sec. 51 the certificate will be *primâ facie* evidence of the matters certified.

Sub-sec. (13). Rules. As to the power of the Board of Trade to make rules, see sec. 60.[9] The rules as to cotton marks are rules 113 to 120, post, p. 187. They provide for search by the keeper of cotton marks amongst the marks on the register in the B list, and those

[1] Ante, p. 23.
[2] Ante, p. 54.
[3] Report of 1888, p. ix.; and see pp. 150, 239, and 240.
[4] Cf. *Mitchell* v. *Henry*, 15 C. D. 181.
[5] Ante, p. 54.
[6] Ante, p. 93.
[7] And see rule 120, post, p. 188.
[8] See sub-sec. (9).
[9] Ante, p. 104.

which have been refused and those which are pending, and for a report to the registrar on the result of the search and upon the application.

Sub-sec. (14). This continues the existing practice recommended by Lord Herschell's committee and since followed.

International and Colonial Arrangements.

International and colonial arrangements. 48 & 49 Vict. c. 63.

65. The provisions of sections one hundred and three and one hundred and four of the Patents, Designs, and Trade Marks Act, 1883 (as amended by the Patents, Designs, and Trade Marks (Amendment) Act, 1885), relating to the registration of trade marks both as enacted in such Acts and as applied by any Order in Council made thereunder, shall be construed as applying to trade marks registrable under this Act.

Registration of foreign and colonial trade marks, Chap. XX.. p. 545.

Secs. 103 and 104 are not repealed by this Act.[1] Under those sections applicants for trade marks in foreign countries or British possessions to which the section is by Order in Council applied, have four months from such applications within which they can apply in this country to register, and they have priority secured to them during that interval, with the privilege of dating the registration from the date of the original registration abroad.

Lists of foreign States and British possessions to which the sections have been applied by Order in Council will be found at p. **762**. To these must be added *Germany*, which acceded as from May 1st, 1902, and *Austria* as from January 1st, 1904.

Secs. 103 and 104, as amended by sec. 6 of the Act of 1885, are, so far as relates to trade marks, set out in the Appendix.[2]

No mark can be registered under sec. 103 or sec. 104 unless it possesses the qualifications required in the case of other marks.[3]

Offences.

Falsification of entries in register.

66. If any person makes or causes to be made a false entry in the register kept under this Act, or a writing falsely purporting

[1] See Introductory Chapter, ante, p. 12.

[2] Post, p. 162.

[3] *Californian Fig Syrup Co.'s Tm.*, 40 C. D. 620; 6 R. P. C. 126 (1888): *Carter Medicine Co.'s Tm.*, [1892] 3 Ch. 472; 9 R. P. C. 401.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

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.

This is a re-enactment of sec. 93 of the Act of 1883.

Penalty on falsely representing a trade mark as registered

67.—(1) Any person who represents a trade mark 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 a trade mark is registered, if he uses in connection with the trade mark the word "registered," or any words expressing or implying that registration has been obtained for the trade mark.

Notes.

Pages **639**, **404**.[1]

Sec. 105, which this section replaces, so far as relates to trade marks, was in slightly different terms, as follows :—

(1) *Any person who . . . describes . . . any 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 purpose of this enactment, to represent that a . . . trade mark is registered, if he sells the article with the word . . . "registered," or any word or words expressing or implying that . . . registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article.*

Under the new section the sale of the article does not constitute part of the offence. A label used as a trade mark may be deceptive, if it has the words "trade mark" on it, in such a way as to suggest that part only, not separately registered, is the trade mark.[2] "Registered," "Registered Design," "Copyright," "Entered at Stationers'

[1] Cf. also the application of a false trade description under the Merchandise Marks Act, 1887, p. **569**.

[2] See pp. **258**, **404**; *Apollinaris Co.'s Tms.*, [1891] 2 Ch. 186; 8 R. P. C. 137, C. A.; but see *Bass' Tms.*, [1902] 2 Ch. 579; 19 R. P. C. 129 and 529, C. A., and sec. 25, ante, p. 70.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

Hall," "To counterfeit this is forgery," are not to appear on applications, nor "Patent," "Patented," nor "by Royal Letters Patent," rule 11, post, p. 170.

Royal Arms.

68. If any person, without the authority of His Majesty, uses in connection with any trade, business, calling, or profession, the Royal Arms (or arms so closely resembling the same as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorised so to use the Royal Arms, or if any person without the authority of His Majesty or of a member of the Royal Family, uses in connection with any trade, business, calling, or profession any device, emblem, or title in such manner as to be calculated to lead to the belief that he is employed by or supplies goods to His Majesty or such member of the Royal Family, he may, at the suit of any person who is authorised to use such arms or such device, emblem, or title, or is authorised by the Lord Chamberlain to take proceedings in that behalf, be restrained by injunction or interdict from continuing so to use the same: Provided that nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing any such arms, device, emblem, or title to continue to use such trade mark. Unauthorised assumption of Royal Arms.

Notes. This is an amendment and extension of sec. 106 of the Act of 1883, which is nevertheless left unrepealed. It is as follows:—

> 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 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 to a fine not exceeding twenty pounds.*

Sec. 68 was introduced into the Act, with the other contents whereof it has little or nothing in common, at the suggestion

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The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

of the Association of Royal Warrant-holders. It adds to the remedy by summary prosecution provided by the old section a civil remedy by injunction applicable not only to the misuse of the Royal Arms, but also to the use of any device, emblem, or title in such manner as to be calculated to lead to the belief that the person using the same is employed by, or supplies goods to, His Majesty, or a member of the Royal Family. The class of persons who may institute proceedings under the section without the authority of the Lord Chamberlain will, in some instances, *e.g.*, the use of the Royal Arms, be a rather wide one. It will be in the discretion of the Court to refuse relief if the plaintiff is not likely to be in any way damnified.

Provided, &c. With regard to the proviso, it may be noticed that, except in the case of marks used before August 13th, 1875, the registrar is not to register (1) the Royal Arms or crests, or arms or crests, so nearly resembling them as to lead to mistake, (2) representations of any member of the Royal Family, (3) representations of British Royal Crowns, (4) the British national flags, (5) the word Royal, (6) any other words, letters or devices calculated to lead persons to think that the applicant has Royal patronage or authorisation, rules 11 and 12, post, p. 170.

Courts.

General saving for jurisdiction of Courts.

69. 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 trade marks; and with reference to any such proceedings in Scotland the term "the Court" shall mean the Court of Session; and with reference to any such proceedings in Ireland the term "the Court" shall mean the High Court of Justice in Ireland.

Notes.

"The Court" is by sec. 3 [1] defined to mean (subject to the provisions for Scotland, Ireland, and the Isle of Man) His Majesty's High Court of Justice in England. As to the County Palatine of Lancashire, see sec. 71 below.

Sec. 111 of the Act of 1883, which this section replaces, was, so far as relates to trade marks, as follows:—

(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*

[1] Ante, p. 14.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in any proceedings relating 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.

(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 of the rectification, shall be served on the comptroller, and he shall rectify the register accordingly.*

The old sub-sec. (2) is now omitted, but sec. 35, which relates to rectification, contains in sub-sec. (4) provisions of a similar nature, referring, however, to any order of "the Court."

It was held in England, under the Act of 1883, that an entry registered in the name of an Irish proprietor could be rectified by the English Courts.[1] It was also held in Ireland that the Irish Courts had no jurisdiction to rectify.[2] The Scotch Courts, on the other hand, held that they had jurisdiction to make a declaration of the invalidity of an entry in the register.[3] The question whether the Scotch Courts had jurisdiction to order an entry to be expunged under the old sec. 90 has not, however, been decided.[4]

The special jurisdiction conferred on the Court is under the new Act of a larger nature, the Act in many sections providing for an appeal from the registrar to the Court. It is apprehended that the joint effect of secs. 3 and 69 is that this jurisdiction cannot be exercised by the Scotch or Irish Courts, and the repeal of sub-sec. (2) of sec. 111 raises the question whether the Scotch Courts have now the jurisdiction which, in *Dewar's* case it was held that they had.[5] As to the jurisdiction of the Lancashire Palatine Court, see sec. 71 below.

[1] *Re King & Co.'s Tm.*, [1892] 2 Ch. 462; 9 R. P. C. 350, Kekewich, J., and C.A.

[2] *Bayer* v. *Connell Bros.*, 14 R. P. C. 275 (1897), Porter, M.R.

[3] *Dewar & Sons, Ltd.* v. *J. H. Dewar*, 17 R. P. C. 341 (1901), Lord Ordinary and Inner House: followed in *Dawson* v. *Stewart*, 22 R. P. C. 250 (1905), and *Reid* v. *Thomson & Co.*, 22 R. P. C. 376 (1905).

[4] See pp. **285, 286.**

[5] See also notes to sec. 3, ante, p. 17.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

Isle of Man.

70. 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 trade mark competent to those Courts:

(2) The punishment for a misdemeanor 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.

This section is in exactly the same terms as section 112 of the Act of 1883.

Jurisdiction of Lancashire *Palatine* Court.

71. 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 Branch, have the like jurisdiction under this Act as His 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.

Notes.

Except for the substitution of Manchester Branch for Manchester office, this section is the same as sec. 112A of the Act of 1883, *introduced into that Act by sec. 26 of the Act of 1888.*

The Manchester Branch for cotton marks, that is for marks

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

applied for in respect of cotton goods[1] at the date of the Act, is put under the direct statutory provisions of sec. 64, instead of, as formerly, being dealt with by the Rules only:[2] see sec. 64 and the notes thereto.[3]

This section, as regards such marks, confers on the Lancashire Palatine Court a co-ordinate jurisdiction with the High Court, not only in actions for infringement, but in any "other proceedings" in relation to any such trade mark. This includes the special jurisdiction exercised in rectification under sec. 35, and also jurisdiction upon appeals from the registrar.

Offences in Scotland.

72. In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the Sheriff Court.

This exactly reproduces sec. 108 of the Act of 1883.

Offence punishable on summary conviction: see sec. 67, above.

Sec. 106 of the Act of 1883, which created an offence (the unauthorised assumption of the Royal arms) punishable on summary conviction, is not repealed. Such offence is not, it would seem, an "offence under this Act."[4]

Repeal; Savings.

Repeal and saving for rules, &c.

73. The enactments described in the schedule to this Act are repealed to the extent mentioned in the third column, but this repeal shall not affect any rule, table of fees, or classification of goods made under any enactment so repealed, but every such rule, table of fees, or classification of goods shall continue in force as if made under this Act until superseded by rules, tables of fees, or classification under this Act.

For the schedule see p. 125.

The repeal is of all parts of the Acts of 1883 and 1888, which

[1] See notes to sec. 64, ante, p. 111.

[2] Rules 8 and 13 of 1890, as amended by the Rules of 1897.

[3] Ante, p. 111.

[4] The savings in the next two sections, 73 and 74, do not affect the question.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

relate to trade marks, except secs. 103 and 104,[1] 106,[2] and secs. 82, 83 and 84, which relate to the constitution and seal of the Patent Office, and are expressly continued in regard to trade marks by sec. 74.

The rules in force at the passing of the Act were the Trade Mark Rules, 1890, as amended by the Trade Mark Rules, 1897 and 1898,[3] the table of fees being contained in the first schedule, the prescribed forms in the second schedule, and the classification in the third schedule to the rules. These are, after March 31st, 1906, superseded by the Trade Mark Rules, 1906, with table of fees and classification, see post, p. 167.

The date of the commencement of the Act is (except where otherwise provided) April 1st, 1906.

This Act contains no general saving similar to those of sec. 113 of the Act of 1883, and sec. 27 of the Act of 1888; but the general provisions contained in sec. 38 of the Interpretation Act, 1889,[4] apply.

Application of 46 & 47 Vict. c. 57, ss. 82—84.

74. The provisions of sections eighty-two to eighty-four of the Patents, Designs, and Trade Marks Act, 1883, as amended by any subsequent enactment, shall continue to apply with respect to the administration at the Patent Office of the Law relating to the registration of trade marks, and shall accordingly be construed as if this Act formed part of that Act.

See notes to the last section.

[1] International and colonial arrangements. These are applied to trade marks registrable under this Act: see sec. 65, ante, p. 117.

[2] Penalty on unauthorised use of Royal arms: see also sec. 68, ante, p. 119.

[3] Pp. **691—720.**

[4] Appendix III., p. 167.

The references to chapters and to pages in black type are to "Kerly on Trade Marks," 2nd ed.

SCHEDULE.

ENACTMENTS REPEALED.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	Sections sixty-two to eighty-one, and, so far as they respectively relate to trade marks, sections eighty-five to ninety-nine, one hundred and one, one hundred and two, one hundred and five, one hundred and eight, and one hundred and eleven to one hundred and seventeen.
51 & 52 Vict. c. 50.	The Patents, Designs, and Trade Marks Act, 1888.	Sections eight to twenty, and, so far as they respectively relate to trade marks, sections twenty-one to twenty-six.

APPENDIX I.

THE TRADE MARKS ACT, 1905.

(5 Edw. VII. c. 15.)

An Act to consolidate and amend the Law relating to Trade Marks.

[11th August, 1905.]

Be it enacted by the King'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 Trade Marks Act, 1905. Short title.

2. This Act shall, save as otherwise expressly provided, come into operation on the first day of April one thousand nine hundred and six. Commencement of Act.

Part I.

Definitions.

3. In and for the purpose of this Act (unless the context otherwise requires) :— Definitions.

A "mark" shall include a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof :

A "trade mark" shall mean a mark used or proposed to be used upon or in connection with goods for the purpose of indicating that they are the goods of the proprietor of such trade mark by virtue of manufacture, selection, certification, dealing with, or offering for sale :

A "registrable trade mark" shall mean a trade mark which is capable of registration under the provisions of this Act :

"The register" shall mean the register of trade marks kept under the provisions of this Act :

A "registered trade mark" shall mean a trade mark which is actually upon the register :

"Prescribed" shall mean, in relation to proceedings before the

Court, prescribed by rules of court, and in other cases, prescribed by this Act or the Rules thereunder:

"The Court" shall mean (subject to the provisions for Scotland, Ireland, and the Isle of Man) His Majesty's High Court of Justice in England.

Register of Trade Marks.

Register of trade marks.

4. There shall be kept at the Patent Office for the purposes of this Act a book called the Register of Trade Marks, wherein shall be entered all registered trade marks with the names and addresses of their proprietors, notifications of assignments and transmissions, disclaimers, conditions, limitations, and such other matters relating to such trade marks as may from time to time be prescribed. The register shall be kept under the control and management of the Comptroller-General of Patents, Designs, and Trade Marks, who is in this Act referred to as the Registrar.

Trust not to be entered on register.

5. There shall not be entered in the register any notice of any trust expressed, implied, or constructive, nor shall any such notice be receivable by the Registrar.

Incorporation of existing register.

6. The register of trade marks existing at the date of the commencement of this Act, and all registers of trade marks kept under previous Acts, which are deemed part of the same book as such register, shall be incorporated with and form part of the register. Subject to the provisions of sections thirty-six and forty-one of this Act the validity of the original entry of any trade mark upon the registers so incorporated shall be determined in accordance with the statutes in force at the date of such entry, and such trade mark shall retain its original date, but for all other purposes it shall be deemed to be a trade mark registered under this Act.

Inspection of and extract from register.

7. The register kept under this Act shall at all convenient times be open to the inspection of the public, subject to such regulations as may be prescribed; and certified copies, sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

Registrable Trade Marks.

Trade mark must be for particular goods.

8. A trade mark must be registered in respect of particular goods or classes of goods.

Registrable trade marks.

9. A registrable trade mark must contain or consist of at least one of the following essential particulars:—

(1) The name of a company, individual, or firm represented in a special or particular manner;

(2) The signature of the applicant for registration or some predecessor in his business;
(3) An invented word or invented words;
(4) A word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
(5) Any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the above paragraphs (1), (2), (3), and (4), shall not, except by order of the Board of Trade or the Court, be deemed a distinctive mark:

Provided always that any special or distinctive word or words, letter, numeral, or combination of letters or numerals used as a trade mark by the applicant or his predecessors in business before the thirteenth day of August one thousand eight hundred and seventy-five, which has continued to be used (either in its original form or with additions or alterations not substantially affecting the identity of the same) down to the date of the application for registration shall be registrable as a trade mark under this Act.

For the purposes of this section "distinctive" shall mean adapted to distinguish the goods of the proprietor of the trade mark from those of other persons.

In determining whether a trade mark is so adapted, the tribunal may, in the case of a trade mark in actual use, take into consideration the extent to which such user has rendered such trade mark in fact distinctive for the goods with respect to which it is registered or proposed to be registered.

Coloured trade marks.

10. A trade mark may be limited in whole or in part to one or more specified colours, and in such case the fact that it is so limited shall be taken into consideration by any tribunal having to decide on the distinctive character of such trade mark. If and so far as a trade mark is registered without limitation of colour it shall be deemed to be registered for all colours.

Restriction on registration.

11. It shall not be lawful to register as a trade mark or part of a trade mark any matter, the use of which would by reason of its being calculated to deceive or otherwise be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

Registration of Trade Marks.

Application for registration.

12.—(1) Any person claiming to be the proprietor of a trade mark who is desirous of registering the same must apply in writing to the Registrar in the prescribed manner.

(2) Subject to the provisions of this Act the Registrar may refuse

such application, or may accept it absolutely or subject to conditions, amendments, or modifications.

(3) In case of any such refusal or conditional acceptance the Registrar shall, if required by the applicant, state in writing the grounds of his decision and the materials used by him in arriving at the same, and such decision shall be subject to appeal to the Board of Trade or to the Court at the option of the applicant.

(4) An appeal under this section shall be made in the prescribed manner, and on such appeal the Board of Trade or the Court, as the case may be, shall, if required, hear the applicant and the Registrar, and shall make an order determining whether, and subject to what conditions, amendments, or modifications, if any, the application is to be accepted.

(5) Appeals under this section shall be heard on the materials so stated by the Registrar to have been used by him in arriving at his decision, and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the Registrar, other than those stated by him, except by leave of the tribunal hearing the appeal. Where any further grounds of objection are taken the applicant shall be entitled to withdraw his application without payment of costs on giving notice as prescribed.

(6) The Registrar or the Board of Trade or the Court, as the case may be, may at any time, whether before or after acceptance, correct any error in or in connection with the application, or may permit the applicant to amend his application upon such terms as they may think fit.

Advertisement of application.

13. When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions, the Registrar shall, as soon as may be after such acceptance, cause the application as accepted to be advertised in the prescribed manner. Such advertisement shall set forth all conditions subject to which the application has been accepted.

Opposition to registration.

14.—(1) Any person may, within the prescribed time from the date of the advertisement of an application for the registration of a trade mark, give notice to the Registrar of opposition to such registration.

(2) Such notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

(3) The Registrar shall send a copy of such notice to the applicant, and within the prescribed time after the receipt of such notice, the applicant shall send to the Registrar, in the prescribed manner, a counter-statement of the grounds on which he relies for his application, and, if he does not do so, he shall be deemed to have abandoned his application.

(4) If the applicant sends such counter-statement, the Registrar shall furnish a copy thereof to the persons giving notice of opposition, and shall, after hearing the parties, if so required, and considering the evidence, decide whether, and subject to what conditions, registration is to be permitted.

(5) The decision of the Registrar shall be subject to appeal to the Court or, with the consent of the parties, to the Board of Trade.

(6) An appeal under this section shall be made in the prescribed manner, and on such appeal the Board of Trade or the Court, as the case may be, shall, if required, hear the parties and the Registrar, and shall make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

(7) On the hearing of any such appeal any party may either in the manner prescribed or by special leave of the tribunal bring forward further material for the consideration of the tribunal.

(8) In proceedings under this section no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the Registrar other than those stated by the opponent as herein-above provided except by leave of the tribunal hearing the appeal. Where any further grounds of objection are taken the applicant shall be entitled to withdraw his application without payment of the costs of the opponent on giving notice as prescribed.

(9) In any appeal under this section, the tribunal may, after hearing the Registrar, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity of such trade mark, but in such case the trade mark as so modified shall be advertised in the prescribed manner before being registered.

(10) The Registrar, or in the case of an appeal to the Board of Trade the Board of Trade, shall have power in proceedings under this section to award to any party such costs as they may consider reasonable, and to direct how and by what parties they are to be paid.

(11) If a party giving notice of opposition or of appeal neither resides nor carries on business in the United Kingdom, the tribunal may require such party to give security for costs of the proceedings before it relative to such opposition or appeal, and in default of such security being duly given may treat the opposition or appeal as abandoned.

Disclaimers.

15. If a trade mark contains parts not separately registered by the proprietor as trade marks, or if it contains matter common to the trade or otherwise of a non-distinctive character, the Registrar or the Board of Trade or the Court, in deciding whether such trade mark

shall be entered or shall remain upon the register, may require, as a condition of its being upon the register, that the proprietor shall disclaim any right to the exclusive use of any part or parts of such trade mark, or of all or any portion of such matter, to the exclusive use of which they hold him not to be entitled, or that he shall make such other disclaimer as they may consider needful for the purpose of defining his rights under such registration: Provided always that no disclaimer upon the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

Date of registration.

16. When an application for registration of a trade mark has been accepted and has not been opposed, and the time for notice of opposition has expired, or having been opposed the opposition has been decided in favour of the applicant, the Registrar shall unless the Board of Trade otherwise direct, register the said trade mark, and the trade mark, when registered, shall be registered as of the date of the application for registration, and such date shall be deemed for the purposes of this Act to be the date of registration.

Certificate of registration.

17. On the registration of a trade mark the Registrar shall issue to the applicant a certificate in the prescribed form of the registration of such trade mark under the hand of the Registrar, and sealed with the seal of the Patent Office.

Non-completion of registration.

18. Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice of the non-completion to the applicant in writing in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in such notice.

Identical Trade Marks.

Identical marks.

19. Except by order of the Court or in the case of trade marks in use before the thirteenth day of August, one thousand eight hundred and seventy-five, no trade mark shall be registered in respect of any goods or description of goods which is identical with one belonging to a different proprietor which is already on the register with respect to such goods or description of goods, or so nearly resembling such a trade mark as to be calculated to deceive.

Rival claims to identical marks.

20. Where each of several persons claims to be proprietor of the same trade mark, or of nearly identical trade marks in respect of the same goods or description of goods, and to be registered as such proprietor, the Registrar may refuse to register any of them until their rights have been determined by the Court, or have been settled by

agreement in a manner approved by him or (on appeal) by the Board of Trade.

Concurrent user.

21. In case of honest concurrent user or of other special circumstances which, in the opinion of the Court, make it proper so to do, the Court may permit the registration of the same trade mark, or of nearly identical trade marks, for the same goods or description of goods by more than one proprietor subject to such conditions, and limitations, if any, as to mode or place of user or otherwise, as it may think it right to impose.

Assignment.

Assignment and transmission of trade marks.

22. A trade mark when registered shall be assigned and transmitted only in connection with the goodwill of the business concerned in the goods for which it has been registered and shall be determinable with that goodwill. But nothing in this section contained shall be deemed to affect the right of the proprietor of a registered trade mark to assign the right to use the same in any British possession or protectorate or foreign country in connection with any goods for which it is registered together with the goodwill of the business therein in such goods.

Apportionment of marks on dissolution of partnership

23. In any case where from any cause, whether by reason of dissolution of partnership or otherwise, a person ceases to carry on business, and the goodwill of such person does not pass to one successor but is divided, the Registrar may (subject to the provisions of this Act as to associated trade marks), on the application of the parties interested, permit an apportionment of the registered trade marks of the person among the persons in fact continuing the business, subject to such conditions and modifications, if any, as he may think necessary in the public interest. Any decision of the Registrar under this section shall be subject to appeal to the Board of Trade.

Associated Trade Marks.

Associated trade marks.

24. If application be made for the registration of a trade mark so closely resembling a trade mark of the applicant already on the register for the same goods or description of goods as to be calculated to deceive or cause confusion if used by a person other than the applicant, the tribunal hearing the application may require as a condition of registration that such trade marks shall be entered on the register as associated trade marks.

Combined trade marks.

25. If the proprietor of a trade mark claims to be entitled to the exclusive use of any portion of such trade mark separately he may apply to register the same as separate trade marks. Each such

separate trade mark must satisfy all the conditions and shall have all the incidents of an independent trade mark, except that when registered it and the trade mark of which it forms a part shall be deemed to be associated trade marks and shall be entered on the register as such, but the user of the whole trade mark shall for the purposes of this Act be deemed to be also a user of such registered trade marks belonging to the same proprietor as it contains.

Series of trade marks.

26. When a person claiming to be the proprietor of several trade marks for the same description of goods which, while resembling each other in the material particulars thereof, yet differ in respect of—

(*a*) statements of the goods for which they are respectively used or proposed to be used; or

(*b*) statements of number, price, quality, or names of places; or

(*c*) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or

(*d*) colour;

seeks to register such trade marks, they may be registered as a series in one registration. All the trade marks in a series of trade marks so registered shall be deemed to be, and shall be registered as, associated trade marks.

Assignment and user of associated trade marks.

27. Associated trade marks shall be assignable or transmissible only as a whole and not separately, but they shall for all other purposes be deemed to have been registered as separate trade marks. Provided that where under the provisions of this Act user of a registered trade mark is required to be proved for any purpose, the tribunal may if and so far as it shall think right accept user of an associated registered trade mark, or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for such user.

Renewal of Registration.

Duration of registration.

28. The registration of a trade mark shall be for a period of fourteen years, but may be renewed from time to time in accordance with the provisions of this Act.

Renewal of registration.

29. The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period, renew the registration of such trade mark for a period of fourteen years from the expiration of the original registration or of the last renewal of registration, as the case may be, which date is herein termed "the expiration of the last registration."

Procedure on expiry of period of registration.

30. At the prescribed time before the expiration of the last registration of a trade mark, the Registrar shall send notice in the

prescribed manner to the registered proprietor at his registered address of the date at which the existing registration will expire and the conditions as to payment of fees and otherwise upon which a renewal of such registration may be obtained, and if at the expiration of the time prescribed in that behalf such conditions have not been duly complied with, the Registrar may remove such trade mark from the register, subject to such conditions (if any) as to its restoration to the register as may be prescribed.

Status of unrenewed trade mark.

31. Where a trade mark has been removed from the register for nonpayment of the fee for renewal, such trade mark shall, nevertheless, for the purpose of any application for registration during 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 Registrar that there had been no *bonâ fide* trade user of such trade mark during the two years immediately preceding such removal.

Correction and Rectification of the Register.

Correction of register.

32. The Registrar may, on request made in the prescribed manner by the registered proprietor or by some person entitled by law to act in his name,—

(1) Correct any error in the name or address of the registered proprietor of a trade mark; or

(2) Enter any change in the name or address of the person who is registered as proprietor of a trade mark; or

(3) Cancel the entry of a trade mark on the register; or

(4) Strike out any goods or classes of goods from those for which a trade mark is registered; or

(5) Enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of such trade mark.

Any decision of the Registrar under this section shall be subject to appeal to the Board of Trade.

Registration of assignments, &c.

33. Subject to the provisions of this Act where a person becomes entitled to a registered trade mark by assignment, transmission, or other operation of law, the Registrar shall, on request made in the prescribed manner, and on proof of title to his satisfaction, cause the name and address of such person to be entered on the register as proprietor of the trade mark. Any decision of the Registrar under this section shall be subject to appeal to the Court or, with the consent of the parties, to the Board of Trade.

Alteration of registered trade mark.

34. The registered proprietor of any trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter such trade mark in any manner not substantially affecting the identity of

the same, and the Registrar may refuse such leave or may grant the same on such terms as he may think fit, but any such refusal or conditional permission shall be subject to appeal to the Board of Trade. If leave be granted, the trade mark as altered shall be advertised in the prescribed manner.

Rectification of register.

35. Subject to the provisions of this Act—

(1) The Court may on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, make such order for making, expunging, or varying such entry, as it may think fit:

(2) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of the register:

(3) In case of fraud in the registration or transmission of a registered trade mark, the Registrar may himself apply to the Court under the provisions of this section:

(4) Any order of the Court rectifying the register shall direct that notice of the rectification shall be served upon the Registrar in the prescribed manner, who shall upon receipt of such notice rectify the register accordingly.

Trade marks registered under previous Acts.

36. No trade mark which is upon the register at the commencement of this Act and which under this Act is a registrable trade mark shall be removed from the register on the ground that it was not registrable under the Acts in force at the date of its registration. But nothing in this section contained shall subject any person to any liability in respect of any act or thing done before the commencement of this Act to which he would not have been subject under the Acts then in force.

Non-user of trade mark.

37. A registered trade mark may, on the application to the Court of any person aggrieved, be taken off the register in respect of any of the goods for which it is registered, on the ground that it was registered by the proprietor or a predecessor in title without any *bonâ fide* intention to use the same in connection with such goods, and there has in fact been no *bonâ fide* user of the same in connection therewith, or on the ground that there has been no *bonâ fide* user of such trade mark in connection with such goods during the five years immediately preceding the application, unless in either case such non-user is shown to be due to special circumstances in the trade, and not to any intention not to use or to abandon such trade mark in respect of such goods.

Effect of Registration.

Powers of registered proprietor.

38. Subject to the provisions of this Act—

(1) The person for the time being entered in the register as proprietor of a trade mark shall, subject to any rights appearing from such register to be vested in any other person, have power to assign the same, and to give effectual receipts for any consideration for such assignment:

(2) Any equities in respect of a trade mark may be enforced in like manner as in respect of any other personal property.

Rights of proprietor of trade mark.

39. Subject to the provisions of section forty-one of this Act and to any limitations and conditions entered upon the register, the registration of a person as proprietor of a trade mark shall, if valid, give to such person the exclusive right to the use of such trade mark upon or in connection with the goods in respect of which it is registered: Provided always that where two or more persons are registered proprietors of the same (or substantially the same) trade mark in respect of the same goods no rights of exclusive user of such trade mark shall (except so far as their respective rights shall have been defined by the Court) be acquired by any one of such persons as against any other by the registration thereof, but each of such persons shall otherwise have the same rights as if he were the sole registered proprietor thereof.

Registration to be primâ facie evidence of validity.

40. In all legal proceedings relating to a registered trade mark (including applications under section thirty-five of this Act) the fact that a person is registered as proprietor of such trade mark shall be *primâ facie* evidence of the validity of the original registration of such trade mark and of all subsequent assignments and transmissions of the same.

Registration to be conclusive after seven years.

41. In all legal proceedings relating to a registered trade mark (including applications under section thirty-five of this Act) the original registration of such trade mark shall after the expiration of seven years from the date of such original registration (or seven years from the passing of this Act, whichever shall last happen) be taken to be valid in all respects unless such original registration was obtained by fraud, or unless the trade mark offends against the provisions of section eleven of this Act:

Provided that nothing in this Act shall entitle the proprietor of a registered trade mark to interfere with or restrain the user by any person of a similar trade mark upon or in connection with goods upon or in connection with which such person has, by himself or his predecessors in business, continuously used such trade mark from a date anterior to the user of the first-mentioned trade mark by the proprietor thereof or his predecessors in business, or to object (on

such user being proved) to such person being put upon the register for such similar trade mark in respect of such goods under the provisions of section twenty-one of this Act.

Unregistered trade mark.

42. No person shall be entitled to institute any proceeding to prevent or to recover damages for the infringement of an unregistered trade mark unless such trade mark was in use before the thirteenth of August one thousand eight hundred and seventy-five, and has been refused registration under this Act. The Registrar may, on request, grant a certificate that such registration has been refused.

Infringement.

43. In an action for the infringement of a trade mark the Court trying the question of infringement shall admit evidence of the usages of the trade in respect to the get-up of the goods for which the trade mark is registered, and of any trade marks or get-up legitimately used in connection with such goods by other persons.

User of name, address, or description of goods.

44. No registration under this Act shall interfere with any *bonâ fide* use by a person of his own name or place of business or that of any of his predecessors in business, or the use by any person of any *bonâ fide* description of the character or quality of his goods.

"Passing off" action.

45. Nothing in this Act contained shall be deemed to affect rights of action against any person for passing off goods as those of another person or the remedies in respect thereof.

Legal Proceedings.

Certificate of validity.

46. In any legal proceeding in which the validity of the registration of a registered trade mark comes into question and is decided in favour of the proprietor of such trade mark, the Court may certify the same, and if it so certifies then in any subsequent legal proceeding in which such validity comes into question the proprietor of the said trade mark on obtaining a final order or judgment in his favour shall have his full costs, charges, and expenses as between solicitor and client, unless in such subsequent proceeding the Court certifies that he ought not to have the same.

Registrar to have notice of proceeding for rectification.

47. In any legal proceeding in which the relief sought includes alteration or rectification of the register, the Registrar shall have the right to appear and be heard, and shall appear if so directed by the Court. Unless otherwise directed by the Court, the Registrar in lieu of appearing and being heard may submit to the Court a statement in writing signed by him, giving particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting the same or of the practice of the office in like cases, or of such other matters relevant to the issues, and within his knowledge as such Registrar, as he shall think fit, and such statement shall be deemed to form part of the evidence in the proceeding.

Costs.

Costs of proceedings before the Court.

48. In all proceedings before the Court under this Act the costs of the Registrar shall be in the discretion of the Court, but the Registrar shall not be ordered to pay the costs of any other of the parties.

Evidence.

Mode of giving evidence.

49. In any proceeding under this Act before the Board of Trade or the Registrar, the evidence shall be given by statutory declaration in the absence of directions to the contrary, but, in any case in which it shall think it right so to do, the tribunal may (with the consent of the parties) take evidence *viva voce* in lieu of or in addition to evidence by declaration. Any such statutory declaration may in the case of appeal be used before the Court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

In case any part of the evidence is taken *viva voce* the Board of Trade or the Registrar shall in respect of requiring the attendance of witnesses and taking evidence on oath be in the same position in all respects as an Official Referee of the Supreme Court.

Sealed copies to be evidence.

50. Printed or written copies or extracts of or from the register, purporting to be certified by the Registrar and sealed with the seal of the Patent Office, shall be admitted in evidence in all courts in His Majesty's dominions, and in all proceedings, without further proof or production of the originals.

Certificate of Registrar to be evidence.

51. A certificate purporting to be under the hand of the Registrar as to any entry, matter, or thing which he is authorised by this Act, or rules made thereunder, to make or do, shall be *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or not done.

Certificate of Board of Trade to be evidence.

52.—(1) 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.

(2) 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.

PART II.

Powers and Duties of Registrar of Trade Marks.

Exercise of discretionary

53. Where any discretionary or other power is given to the Registrar by this Act or rules made thereunder he shall not exercise

power by Registrar.

that power adversely to the applicant for registration or the registered proprietor of the trade mark in question without (if duly required so to do within the prescribed time) giving such applicant or registered proprietor an opportunity of being heard.

Appeal from Registrar.

54. Except where expressly given by the provisions of this Act or rules made thereunder there shall be no appeal from a decision of the Registrar otherwise than to the Board of Trade, but the Court, in dealing with any question of the rectification of the register (including all applications under the provisions of section thirty-five of this Act), shall have power to review any decision of the Registrar relating to the entry in question or the correction sought to be made.

Recognition of agents.

55. Where by this Act any act has to be done by or to any person in connection with a trade mark or proposed trade mark or any procedure relating thereto, such act may under and in accordance with the rules made under this Act or in particular cases by special leave of the Board of Trade be done by or to an agent of such party duly authorised in the prescribed manner.

Registrar may take directions of law officers.

56. The Registrar may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to His Majesty's Attorney-General or Solicitor-General for England for directions in the matter.

Annual reports of Comptroller. 46 & 47 Vict. c. 57.

57. The Comptroller-General of Patents, Designs, and Trade Marks shall in his yearly report on the execution by or under him of the Patents, Designs, and Trade Marks Act, 1883, and Acts amending the same, include a report respecting the execution by or under him of this Act as though it formed a part of or was included in such Acts.

Powers and Duties of the Board of Trade.

Proceedings before Board of Trade.

58. 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 or any person authorised in that behalf by the President of the Board.

Appeals to Board of Trade.

59. Where under this Act an appeal is made to the Board of Trade, the Board of Trade may, if they think fit, refer any such appeal to the Court in lieu of hearing and deciding it themselves, but, unless the Board so refer the appeal, it shall be heard and decided by the Board, and the decision of the Board shall be final.

Power of Board of Trade to make rules.

60.—(1) Subject to the provisions of this Act the Board of Trade may from time to time make such rules, prescribe such forms, and generally do such things as they think expedient—

(*a*) For regulating the practice under this Act:

(*b*) For classifying goods for the purposes of registration of trade marks:

(*c*) For making or requiring duplicates of trade marks and other documents:

(*d*) For securing and regulating the publishing and selling or distributing in such manner as the Board of Trade think fit, of copies of trade marks and other documents:

(*e*) Generally, for regulating the business of the office in relation to trade marks and all things by this Act placed under the direction or control of the Registrar, or of the Board of Trade.

(2) Rules made under this section shall, whilst in force, be of the same effect as if they were contained in this Act.

(3) Before making any rules under this section the Board of Trade shall publish notice of their intention to make the rules and of the place where copies of the draft rules may be obtained in such manner as the Board consider most expedient, so as to enable persons affected to make representations to the Board before the rules are finally settled.

(4) Any rules made in pursuance of this section shall be forthwith advertised twice in the Trade Marks Journal, and 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.

(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.

Fees.

Fees.

61. There shall be paid in respect of applications and registration and other matters under this Act, such fees as may be, with the sanction of the Treasury, prescribed by the Board of Trade.

Special Trade Marks.

Standardization, &c., trade marks.

62. Where any association or person undertakes the examination of any goods in respect of origin, material, mode of manufacture, quality, accuracy, or other characteristic, and certifies the result of such examination by mark used upon or in connection with such goods, the Board of Trade may, if they shall judge it to be to the public advantage, permit such association or person to register such mark as a trade mark in respect of such goods, whether or not such association or person be a trading association or trader or possessed

of a goodwill in connection with such examination and certifying. When so registered such trade mark shall be deemed in all respects to be a registered trade mark, and such association or person to be the proprietor thereof, save that such trade mark shall be transmissible or assignable only by permission of the Board of Trade.

Sheffield Marks.

Sheffield marks.

63. 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:—

(1) The Cutlers' Company shall continue to keep at Sheffield the register of trade marks (in this Act called the Sheffield register) kept by them at the date of the commencement of this Act, and, save as otherwise provided by this Act, such register shall for all purposes form part of the register:

(2) The Cutlers' Company shall, on request made in the prescribed manner, enter in the Sheffield register, in respect of metal goods as defined in this section, 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 such register before the passing of this Act:

(3) An application for registration of a trade mark used 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 Registrar in the prescribed manner, and, unless the Registrar within the prescribed time gives notice to the Cutlers' Company of any objection to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner:

(5) If the Registrar gives notice of an objection as aforesaid, the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may in the prescribed manner 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 Registrar, 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 Registrar on that day:

(7) The provisions of this Act, and of any 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 (and notwithstanding anything in any Act relating to the Cutlers' Company), 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 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 Registrar, 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 Registrar by the Cutlers' Company:

(8) When the Registrar 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 metal goods, he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company:

(9) 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 Court:

(10) 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.

(11) 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 Registrar.

Cotton Marks.

Cotton marks.

64.—(1) The Manchester Branch of the Trade Marks Registry of Patent Office (herein-after called "the Manchester Branch") shall be continued according to its present constitution. A chief officer of the Manchester Branch shall be appointed who shall be styled "the Keeper of Cotton Marks," and shall act under the direction of the Registrar. The present keeper of the Manchester Branch shall be the first Keeper of Cotton Marks.

(2) As regards cotton goods which have hitherto constituted

classes 23, 24, and 25, under the classification of goods under the Patents, Designs, and Trade Marks Acts, 1883 to 1902, the Register of Trade Marks for all such goods, except such as may be prescribed, shall be called "the Manchester Register," and a duplicate thereof shall be kept at the Manchester Branch.

(3) All applications for registration of trade marks for such cotton goods in the said classes (herein-after referred to as "cotton marks") shall be made to the Manchester Branch.

(4) Every application so made to the Manchester Branch shall be notified to the Registrar in the prescribed manner together with the report of the Keeper of Cotton Marks thereon, and unless the Registrar, after considering the report and hearing, if so required, the applicant, within the prescribed time gives notice to the Keeper of Cotton Marks of objection to the acceptance of the application, it shall be advertised by the Manchester Branch and shall be proceeded with in the prescribed manner.

(5) If the Registrar gives notice of objection as aforesaid the application shall not be proceeded with, but any person aggrieved may in the prescribed manner appeal to the Court or the Board of Trade, at the option of the applicant.

(6) Upon the registration of a trade mark in the Manchester Register the Keeper of Cotton Marks shall upon notice thereof from the Registrar thereupon enter the mark in the duplicate of the Manchester Register, and such registration shall bear date as of the day of application to the Manchester Branch, and shall have the same effect as if the application had been made to the Registrar on that day.

(7) When any mark is removed from or any cancellation or correction made in the Manchester Register notice thereof shall be given by the Registrar to the Keeper of Cotton Marks, who shall alter the duplicate register accordingly.

(8) For the purpose of all proceedings in relation to trade marks entered in the Manchester Register a certificate under the hand of the Keeper of Cotton Marks shall have the same effect as a certificate of the Registrar.

(9) In every application for registration of a cotton mark, if such mark has been used by the applicant or his predecessors in business prior to the date of application, the length of time of such user shall be stated on the application.

(10) As from the passing of this Act—

(*a*) In respect of cotton piece goods and cotton yarn no mark consisting of a word or words alone (whether invented or otherwise) shall be registered, and no word or words shall be deemed to be distinctive in respect of such goods:

(*b*) In respect of cotton piece goods no mark consisting of a line heading alone shall be registered, and no line heading shall be deemed to be distinctive in respect of such goods:

(*c*) No registration of a cotton mark shall give any exclusive right to the use of any word, letter, numeral, line heading, or any combination thereof.

(11) The right of inspection of the Manchester Register shall extend to and include the right to inspect all applications whatsoever that have been since the passing of the Trade Marks Registration Act, 1875, and hereafter shall have been made to the Manchester Branch in respect of cotton goods in classes 23, 24, and 25, whether registered, refused, lapsed, expired, withdrawn, abandoned, cancelled, or pending. 39 & 40 Vict. c. 33.

(12) The Keeper of Cotton Marks shall, on request, and on production of a facsimile of the mark, and on payment of the prescribed fee, issue a certified copy of the application for registration of any cotton mark, setting forth in such certificate the length of time of user (if any) of such mark as stated on the application, and any other particulars he may deem necessary.

(13) As regards any rules or forms affecting cotton marks which are proposed by the Board of Trade to be made, the draft of the same shall be sent to the Keeper of Cotton Mark., and also to the Manchester Chamber of Commerce. And the said Keeper, and also the said Chamber, shall, if they or either of them so request, be entitled to be heard by the Board of Trade upon such proposed rules before the same are carried into effect.

(14) The existing practice whereby the keeper of the Manchester Branch consults the Trade and Merchandise Marks Committee appointed by the Manchester Chamber of Commerce upon questions of novelty or difficulty arising on applications to register cotton marks shall be continued by the Keeper of Cotton Marks.

International and Colonial Arrangements.

65. The provisions of sections one hundred and three and one hundred and four of the Patents, Designs, and Trade Marks Act, 1883 (as amended by the Patents, Designs, and Trade Marks (Amendment) Act, 1885), relating to the registration of trade marks both as enacted in such Acts and as applied by any Order in Council made thereunder, shall be construed as applying to trade marks registrable under this Act. International and Colonial arrangements. 48 & 49 Vict. c. 63.

Offences.

66. If any person makes or causes to be made a false entry in the register kept under this Act, or a writing falsely purporting to be a Falsification of entries in register.

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.

Penalty on falsely representing a trade mark as registered.

67.—(1) Any person who represents a trade mark 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 a trade mark is registered, if he uses in connection with the trade mark the word "registered," or any words expressing or implying that registration has been obtained for the trade mark.

Royal Arms.

Unauthorised assumption of Royal Arms.

68. If any person, without the authority of His Majesty, uses in connection with any trade, business, calling, or profession, the Royal Arms (or arms so closely resembling the same as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorised so to use the Royal Arms, or if any person without the authority of His Majesty or of a member of the Royal Family, uses in connection with any trade, business, calling, or profession any device, emblem, or title in such manner as to be calculated to lead to the belief that he is employed by or supplies goods to His Majesty or such member of the Royal Family he may, at the suit of any person who is authorised to use such arms or such device, emblem, or title, or is authorised by the Lord Chamberlain to take proceedings in that behalf, be restrained by injunction or interdict from continuing so to use the same: Provided that nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing any such arms, device, emblem, or title to continue to use such trade mark.

Courts.

General saving for jurisdiction of Courts.

69. 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 trade marks; and with reference to any such proceedings in Scotland the term "the Court" shall mean the Court of Session; and with reference to any such proceedings in Ireland the term "the Court" shall mean the High Court of Justice in Ireland.

Isle of Man.

70. 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 trade mark competent to those Courts:

(2) The punishment for a misdemeanor 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.

71. 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 Branch, have the like jurisdiction under this Act, as His 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.

Offences in Scotland.

72. In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the Sheriff Court.

Repeal; Savings.

Repeal and saving for rules, &c.

73. The enactments described in the schedule to this Act are repealed to the extent mentioned in the third column, but this repeal shall not affect any rule, table of fees, or classification of goods made under any enactment so repealed, but every such rule, table of fees, or classification of goods shall continue in force as if made under this Act until superseded by rules, tables of fees, or classification under this Act.

Application of 46 & 47 Vict. c. 57, ss. 82—84.

74. The provisions of sections eighty-two to eighty-four of the Patents, Designs, and Trade Marks Act, 1883, as amended by any subsequent enactment, shall continue to apply with respect to the administration at the Patent Office of the Law relating to the registration of trade marks, and shall accordingly be construed as if this Act formed part of that Act.

Sect. 73.

SCHEDULE.

ENACTMENTS REPEALED.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	Sections sixty-two to eighty-one, and, so far as they respectively relate to trade marks, sections eighty-five to ninety-nine, one hundred and one, one hundred and two, one hundred and five, one hundred and eight, and one hundred and eleven to one hundred and seventeen.
51 & 52 Vict. c. 50.	The Patents, Designs, and Trade Marks Act, 1888.	Sections eight to twenty, and, so far as they respectively relate to trade marks, sections twenty-one to twenty-six.

APPENDIX II.

THE PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883, AS AMENDED BY THE ACT OF 1888 (SO FAR AS RELATING TO TRADE MARKS).

(46 & 47 VICT. c. 57; 51 & 52 VICT. c. 50.)

PART I.—PRELIMINARY.[1]

1. THIS Act may be cited as the Patents, Designs, and Trade Marks Act, 1883. Short title.

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.

PART IV.—TRADE MARKS.

Registration of Trade Marks.

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.* *Application for registration.*

(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* [*such place and in such manner as may be prescribed*]. *Act* 1888, *s.* 8.

[1] The unrepealed sections are printed in Roman type. Amendments made by the Act of 1888 are indicated by square brackets.

(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.*

(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.*

(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.*

Act, 1888, s. 8.

[(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.*]

Limit of time for proceeding with application.

Act, 1888, s. 9.

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 Comptroller shall give notice of 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 not be deemed to be abandoned*].

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:—*

(*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.*]

Connection of trade mark with goods.

65. *A trade mark must be registered for particular goods or classes of goods.*

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.*

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*].

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*].

Opposition to registration.

Act, 1888, s. 13, *sub-ss.* 1, 2.

69.—(1) *Any person may within* [*one month or such further time, not exceeding three months, as the Comptroller may allow*] *of the 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.*

Act, 1888, s. 13, *sub-s.* 3.

(2) *Within* [*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.*

Act, 1888, s. 13,

[(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.*]

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.*

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.*

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.*

Act, 1888, s. 14.

(2) [*Except as aforesaid*] *the Comptroller shall not register with respect to the same goods or description of goods a trade mark* [*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.*

Further restriction on registration.

Act, 1888, s. 15.

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.*

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*—

(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 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;

[(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.* Act, 1888, s. 16.

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.]

(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.*

Effect of Registration.

Registration equivalent to public use.

75. [*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.*] Act, 1888, s. 17.

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.*

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.

Certificate as to exclusive use and rule 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.*]

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.*

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.*

(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.*

(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 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.*

(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.

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.

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.

(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 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:*]

Act, 1888, s. 20, sub-s. 1.

(3) *An application for registration of a trade mark used [on metal goods] shall, if made after the commencement of this Act by a*

Act, 1888, s. 20, sub-s. 2.

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 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. 2.

(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 metal goods*], *he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company:*

(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 Comptroller shall be subject to a further appeal to the Court:*

(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:*

[(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.*] *Act*, 1888, *s.* 20, *sub-s.* 4.

[(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.*]

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.

(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.

(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 authorised 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.

Trusts 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.*

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.*

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 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.*

Act, 1888, s. 21.

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.*

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.

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.*

(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.*

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*

(*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 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.*

[(*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.*]

Act, 1888, s. 24.

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.*

(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, cause the Register to be altered in conformity with the order of leave.

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.*

Power of Comptroller to take directions of law officers.

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.*

Certificate of Comptroller to be evidence.

96. *A certificate purporting to be under the hand of the Comptroller 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* 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.*

Applications and notices by post.

97.—(1) *Any application, notice, or other document authorised 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.*

(2) *In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.*

Provision as to days for leaving documents at office.

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.*

Declaration by infant, lunatic, &c.

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 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.

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.*

(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.*

(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 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 inventions, designs, and trade 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.

(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.

(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.

(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 provision 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.

(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.*

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.

Scotland, Ireland, &c.

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.*

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.*

(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.*

[**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.]

Jurisdiction of Lancashire Palatine Court.

Act, 1888, s. 26.

Repeal, Transitional Provisions, Savings.

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.

Repeal and saving for past operation of repealed enactments, &c.

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.*

Former registers to be deemed continued.

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 existing rules.

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.

Section 62.

FORMS OF APPLICATION, &c.

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.

APPENDIX III.

STATUTORY RULES AND ORDERS, 1906.

No. 233.

TRADE MARK.

TRADE MARKS RULES, 1906. DATED MARCH 24, 1906.

ARRANGEMENT OF RULES.

Rule 1. Preliminary.
„ 2. Interpretation.
„ 3. Fees.
„ 4. Forms.
„ 5. Classification of goods.
Rules 6—9. Documents and address.
Rule 10. Agents.
Rules 11—16. Registrable trade marks.
„ 17—28. Application for registrations.
„ 29—34. Procedure on receipt of application.
„ 35—41. Special applications under paragraph 5 of sec. 9.
„ 42—46. Special trade marks under sec. 62.
„ 47—50. Advertisement of application.
„ 51—61. Opposition to registration.
Rule 62. Non-completion.
„ 63. Refusal after acceptance.
Rules 64—67. Entry on the register.
„ 68—75. Renewal.
„ 76—81. Assignment.
Rule 82. Alteration of address.
Rules 83—86. Discretionary power.
„ 87—89. Applications under sec. 23.
„ 90—92. Applications under sec. 32.
„ 93—94. Applications under sec. 34.
Rule 95. Search.
„ 96. Hours of inspection.
„ 97. Power to dispense with evidence.
„ 98. Amendments.
Rules 99—101. Enlargement of time.

ARRANGEMENT OF RULES—*continued.*

Rules 102—104. Certificates.
„ 105—106. Declarations.
„ 107—112. Cutlers' Company.
„ 113—120. Cotton marks.
Rule 121. Appeals to the Court.
Rules 122—127. Appeal to Board of Trade.
Rule 128. Withdrawal of appeals.
Rules 129—130. Applications to, and orders of, the Court.

By virtue of the provisions of the Trade Marks Act, 1905, the Board of Trade do hereby make the following Rules:—

Preliminary.

1. These Rules may be cited as the Trade Marks Rules, 1906, and shall come into operation from and immediately after the 31st day of March, 1906.

Interpretation.

Interpretation.

2. In the construction of these Rules any words herein used the meaning of which is defined by the said Act or the Interpretation Act, 1889,[1] shall have the meanings thereby assigned to them respectively.

"Agent" means an agent duly authorised to the satisfaction of the Registrar.

"Office" means Patent Office, Trade Marks Branch, 25, Southampton Buildings, London, W.C.

"Journal" means "Trade Marks Journal."

Fees.

Fees.

3. The fees to be paid in pursuance of the said Act shall be the fees specified in the First Schedule to these Rules.

Forms.

Forms.

4. The forms herein referred to are the forms contained in the Second Schedule to these Rules and such forms shall be used in all cases to which they are applicable, and shall be modified as directed by the Registrar to meet other cases.

[1] NOTE.—The more material definitions of the Interpretation Act are:—
"Statutory Declaration" means a declaration made by virtue of the Statutory Declarations Act, 1835.
"Month" means calendar month.
"Person," unless the contrary intention appears, includes any body of persons corporate or incorporate.
Words in the singular shall include the plural and words in the plural shall include the singular. See *post*, p. 224.

Classification of Goods.

Classification of goods.

5. For the purposes of trade marks registration and of these Rules goods are classified in the manner appearing in the Third Schedule hereto.

If any doubt arises as to what class any particular description of goods belongs to, the doubt shall be determined by the Registrar.

Documents.

Size, &c., of documents.

6. Subject to any other directions that may be given by the Registrar, all applications, notices, counter-statements, papers having representations affixed, or other documents required by the said Act or by these Rules to be left with or sent to the Registrar or to the Keeper of Cotton Marks or to the Cutlers' Company, shall be upon foolscap paper of a size of approximately 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.

Service of documents.

7. Any application, statement, notice, or other document authorised or required to be left, made, or given at the Office, or to or with the Registrar, or with or to any other person may be sent through the post by a prepaid or official-paid letter; any document so sent shall be deemed to have been delivered at the time when the letter containing the same would be delivered in the ordinary course of post, and in proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post. A letter addressed to a registered proprietor of a trade mark at his address as it appears on the register, or address for service, or to any applicant for or person opposing the registration of a trade mark at the address appearing in the application or notice of opposition or given for service as hereinafter provided shall be deemed to be sufficiently addressed.

Address.

8. Where any person is by the said Act or these Rules bound to furnish the Registrar with an address the following provisions shall apply:—

The address given shall in all cases be as full as possible, for the purpose of enabling any person easily to find the place of business of the person whose address is given.

When a person does not reside in a town with streets, the Registrar may require the address to include all indications which he thinks necessary for such purpose so far as it can be attained.

When an applicant resides in a town where there are streets, the address given shall include the name of the street, and the number in the street or name of premises, if any.

Address for service.

9. Every applicant for the registration of any trade mark, and

every opponent to such registration, and every agent, who does not reside or carry on business in the United Kingdom, shall, if so required, give an address for service in the United Kingdom, and such address may be treated as the actual address of such applicant, opponent, or agent for all purposes connected with such application for registration or the opposition thereto.

The Registrar may require the proprietor of a registered trade mark who does not reside or carry on business within the United Kingdom to give an address for service within the United Kingdom, and such address may be treated as the actual address of the proprietor for all purposes connected with such trade mark.

Agents.

Agency.

10. An application for registration and an opposition to registration and all other communications between an applicant, an opponent and the Registrar, or the Board of Trade, and between the proprietor of a registered trade mark and the Registrar, or the Board of Trade, or any other person, may be made by or through an agent.

Any such applicant, opponent, or proprietor may appoint an agent to represent him in the matter of the trade mark by signing and sending to the Registrar an authority in writing to that effect in the Form TM No. 1, or in such other form as the Registrar may deem sufficient. In case any proprietor of a registered trade mark shall appoint such an agent, service upon such agent of any document relating to such trade mark shall be deemed to be service upon the person so appointing him, and all communications directed to be made to such person in respect of such trade mark may be addressed to such agent.

The Registrar shall not be bound to recognise as such agent any person who has been convicted criminally or struck off the Roll of Solicitors, or 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.

Registrable Trade Marks.

Registrable trade marks.

11. The Registrar may refuse to accept any application upon which the following appear:—

(*a*) The words "Patent," "Patented," or "By Royal Letters Patent," "Registered," "Registered Design," "Copyright,"

"Entered at Stationers' Hall," "To counterfeit this is forgery," or words to like effect.

(*b*) Representations of Their Majesties or of any member of the Royal Family.

Roya Arms.

12. Representations of the Royal Arms or Royal crests, or arms or crests so nearly resembling them so as to lead to mistake, or of British Royal crowns, or of the British national flags, or the word Royal or any other words, letters, or devices calculated to lead persons to think that the applicant has Royal patronage or authorization, may not appear on trade marks the registration of which is applied for. Provided always that nothing contained in this rule shall preclude the Registrar from allowing the registration as an "old mark," that is as a mark which was used by the applicant or his predecessors in business before the 13th August, 1875, of any mark which was capable of being so registered before the Trade Marks Act, 1905, came into operation.

Arms of foreign State.

13. Where representations of the arms of a foreign State or place appear on a mark the Registrar may call for such justification as he may deem necessary for their use.

Arms of city, &c.

14. Where a representation of the arms or emblems of any city, borough, town, place, society, body corporate, or institution appears on a mark, the applicant shall, if so required, furnish the Registrar with a consent from such official as the Registrar may consider entitled to give consent to the use of such arms or emblems.

Representations of living person or persons recently dead.

15. Where the names or representations of living persons appear on a trade mark, the Registrar shall if he so require be furnished with consents from such persons before proceeding to register the mark. In the case of persons recently dead the Registrar may call for consents from their legal representatives before proceeding with registration of a trade mark on which their names or representations appear.

Name or description of goods.

16. Where the name or a description of any goods appears on a trade mark the Registrar may refuse to register such mark in respect of any goods other than the goods so named or described.

Where the name or description of any goods appears on a trade mark which name or description in use varies the Registrar may permit the registration of the mark with the name or description upon it for goods other than those named or described, the applicant stating in his application that the name or description varies.

Application for Registration.

Application by firm.

17. If application for registration of a trade mark be made by a firm or partnership it may be signed in the name or for and

on behalf of the firm or partnership by any one or more members thereof.

If the application be made by a body corporate it may be signed by a Director or by the Secretary or other principal officer of such body corporate.

Any application may be signed by an agent.

Address of application.

18. Where application is made for registration of a cotton mark the applicant shall address and send his application to the Keeper of Cotton Marks at the Manchester Branch, 48, Royal Exchange, Manchester. Other applications (except applications which under section 63 of the said Act should be made to the Cutlers' Company) shall be addressed and sent to the Registrar at the Office.

Acknowledgment of application.

19. On or after receipt of the application the Registrar shall furnish the applicant with an acknowledgment thereof.

Application for old mark.

20. 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 by whom it has been used in respect of the goods mentioned in the application. The Registrar may require a statutory declaration verifying such user with exhibits showing the mark as used.

Contents of form of application.

21. Every application for registration of a trade mark shall contain a representation of the mark affixed to it in the square which the Form TM No. 2 contains 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 Registrar may consider suitable. Part of the mounting shall be affixed in the space aforesaid and the rest may be folded over.

Additional representations.

22. There shall be sent with every application for registration of a trade mark four additional representations of such mark on the Form TM No. 3, exactly corresponding to that affixed to the application Form TM No. 2, and noted with all such particulars as may from time to time be required by the Registrar or by the Keeper of Cotton Marks. Such particulars shall, if required, be signed by the applicant or his agent.

Representations to be durable.

23. 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 TM No. 3, half sheets of strong foolscap of the size aforesaid with the representations affixed thereon and noted as aforesaid.

Separate applications.

24 Applications for the registration of the same mark in different

classes shall be treated as separate and distinct applications, and in all cases where a trade mark is registered under the same official number for goods in more than one class, the registration shall henceforth for the purpose of fees and otherwise be deemed to have been made on separate and distinct applications in respect of the goods included in each class.

Representations to be satisfactory.

25. The Registrar, 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.

Specimens of trade marks in exceptional cases.

26. 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 Registrar may think most convenient.

The Registrar may also, in exceptional cases, deposit in the 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 a manner as he may think fit.

Series of trade marks.

27. When application is made for the registration of a series of trade marks under section 26 of the said Act, a representation of each trade mark of the series shall be affixed, as aforesaid, to the application upon Form TM No. 2, and to each of the accompanying Forms TM No. 3.

Transliteration and translation.

28. When a trade mark contains a word or words in other than Roman characters, there shall be endorsed on the application in Form TM No. 2, and on each of the accompanying representations in Form TM No. 3, a sufficient transliteration and translation to the satisfaction of the Registrar of each of such words, and every such indorsement 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 Registrar may ask for an exact translation thereof, and if he so requires such translation shall be endorsed and signed as aforesaid.

Procedure on Receipt of Application.

Search.

29. Subject to the provisions for special applications under paragraph 5 of section 9 of the said Act, upon receipt of an application for registration the Registrar shall cause a search to be made amongst the registered marks and pending applications for the purpose of ascertaining whether there are on record any marks for the same goods or description of goods identical with the mark applied for or so nearly resembling it as to be calculated to deceive.

Acceptance.

30. If after such search and a consideration of the application the Registrar thinks there is no objection to the mark being registered, he may accept it absolutely or subject to conditions, amendments, and modifications which he shall communicate to the applicant in writing.

Objections.

31. If after such search and consideration of the application any objections appear, a statement of those objections shall be sent to the applicant in writing, and unless within one month the applicant applies for a hearing, he shall be deemed to have withdrawn his application.

Hearings.

32. If the Registrar accepts an application subject to any conditions, amendments, or modifications, and the applicant objects to such conditions, amendments, or modifications, he shall within one month from the date of the communication notifying such acceptance apply for a hearing, and if he does not do so he shall be deemed to have withdrawn his application. If the applicant does not object to such conditions, amendments, or modifications, he shall forthwith notify the Registrar in writing.

Decision of Registrar.

33. The decision of the Registrar at such hearing as aforesaid shall be communicated to the applicant in writing, and if he objects to such decision, he may within one month apply upon Form TM No. 4, requiring the Registrar to state in writing the grounds of his decision and the materials used by him in arriving at the same.

Upon receipt of such form the Registrar shall send to the applicant such statement as aforesaid in writing, and the date when such statement is sent shall be deemed to be the date of the Registrar's decision for the purpose of appeal.

Disclaimers.

34. The Registrar may call on an applicant to insert in his application such disclaimer as the Registrar may think fit in order that the public generally may understand what the applicant's rights, if his mark is registered, will be.

Special Applications under Paragraph 5 of Section 9.

Special applications under section 9, paragraph 5.

35. An application to register a name, signature, or word or words under paragraph 5 of section 9 of the said Act shall be made on the Form TM No. 5, and not otherwise.

Search.

36. Upon receipt of such an application the Registrar shall cause a search to be made amongst the registered marks and pending applications for the purpose of ascertaining whether there are on record any marks for the same goods or description of goods identical with the mark applied for or so nearly resembling it as to be calculated to deceive.

37. If after such search the Registrar thinks there are no such marks, he shall notify the applicant accordingly, but if after such search any such marks appear, he shall notify to the applicant the numbers of those marks and the journals (if any) in which they have been advertised. Result of search.

38. Within one month from the receipt of such notification the applicant shall send to the Registrar in writing a case in duplicate stating at length the grounds upon which he relies in support of his application, and whether he desires to be heard by the Board of Trade or by the Court. If he fails to do so his application shall be deemed to be withdrawn. If he desires to be heard by the Board of Trade, he shall send with his case Form TM No. 10. If the Board think fit to refer the appeal to the Court, the Registrar may certify the spoilt fee on such form for allowance. Appeal by applicant.

Upon receipt of such case the Registrar shall send the same to the Board of Trade for their information, together with a copy of all communications that have passed between the Registrar and the applicant.

39. Upon receipt of such case the Board of Trade shall if the applicant desires to be heard by them fix a day for such hearing at which the applicant and the Registrar may attend and be heard, and the Board shall make an order determining whether and subject to what conditions, amendments, or modifications, if any, the application is to be accepted, or may require the applicant to apply to the Court and limit a time for that purpose. Hearing.

40. If the applicant desires to obtain an order of the Court he shall within one month from sending to the Registrar his case as aforesaid bring the matter before the Court by motion, and if he does not do so he shall be deemed to have withdrawn his application. Order of the Court.

41. If the application is accepted either by the Board of Trade or the Court it shall be advertised and proceedings thereafter shall be had in respect of it as if it had been accepted by the Registrar in the ordinary course. Advertisement, &c., of application.

Special Trade Marks under Section 62.

42. Where an association or person desires to register a mark under section 62 of the said Act they shall apply to the Registrar in writing upon the Form TM No. 6. Application under section 62.

43. Such application shall be in duplicate and shall be accompanied by six copies of the mark applied for. Mode of application.

44. Upon the receipt of such application the Registrar shall as soon as may be notify the same to the Board of Trade together with his report upon the application, and shall at the same time send a Report by Registrar.

copy of the application together with three copies of the mark applied for to the Board. The Registrar shall also send the applicants a copy of his report, and within one month from the receipt of such report the applicants shall send the Board in duplicate a case setting out the grounds upon which they rely in support of their application, and if they fail so to do their application shall be deemed to be abandoned.

Hearing.

45. Upon receipt of such case the Board may call for such evidence, if any, as they think fit and shall, if necessary, hear the applicants and the Registrar, and make an order determining whether and subject to what conditions, amendments or modifications, if any, the application may be permitted to proceed.

Advertisement, &c.

46. If such application is permitted to proceed the mark shall be advertised and the application shall be treated in all respects as if it were an ordinary application, and it shall be open to opposition in the same way and all such proceedings shall be had thereon as if it were an application under section 12 of the said Act.

Advertisement of Application.

Advertisement of application.

47. Every application when accepted shall be advertised by the Registrar in the Journal during such times and in such manner as the Registrar may direct.

If no representation of the trade mark be inserted in connexion with the advertisement of an application, the Registrar shall refer in such advertisement to the place or places where a specimen or representation of the trade mark is deposited for exhibition.

Wood block or electrotype.

48. 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 Registrar, or such other information or means of advertising the trade mark as may be required by the Registrar; and the Registrar, 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.

49. When an application relates to a series of trade marks differing from one another in respect of the particulars mentioned in section 26 of the said Act, 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; or the Registrar 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.

50. Advertisements under section 14 (9) of the said Act shall *mutatis mutandis* be made in the same manner as advertisements relating to an application for registration. Advertisement under section 14 (9).

Opposition to Registration.

51. Any person may within one month from the date of any advertisement in the Journal of an application for registration of a trade mark give notice in writing at the Office of opposition to the registration. Opposition.

52. Such notice shall be in Form TM No. 7, and shall contain a statement of the grounds upon which the opponent objects to the registration. If registration is opposed on the ground that the mark resembles marks already on the register, the numbers of such marks and the numbers of the Jounals in which they have been advertised shall be set out. Such notice shall be accompanied by a duplicate which the Registrar will forthwith send to the applicant. Notice of opposition.

53. Within one month from the receipt of such duplicate the applicant shall send to the Registrar a counterstatement (Form TM No. 8) in writing setting out the grounds on which he relies as supporting his application. The applicant shall also set out what facts, if any, alleged in the Notice of Opposition he admits. Such counterstatements shall be accompanied by a duplicate in writing. Counter-statement.

54. Upon receipt of such counterstatement and duplicate the Registrar will forthwith send the duplicate to the opponent and within one month from the receipt of the duplicate the opponent shall leave at the Office such evidence by way of statutory declaration as he may desire to adduce in support of his opposition and shall deliver to the applicant copies thereof. Evidence in support of opposition.

55. If an opponent leaves no evidence, he shall be deemed to have abandoned his opposition, but if he does then within one month from the receipt of the copies of declarations, the applicant shall leave at the Office such evidence by way of statutory declaration as he desires to adduce in support of his application and shall deliver to the opponent copies thereof. Evidence in support of application.

56. Within fourteen days from the receipt by the opponent of the copies of the applicant's declarations the opponent may leave at the Office evidence by statutory declaration in reply, and shall deliver to the applicant copies thereof. Such evidence shall be confined to matters strictly in reply. Evidence in reply by opponent.

57. In any proceedings before the Registrar, he may at any time, if he thinks fit, give leave to either the applicant or the opponent to file any evidence upon such terms as to costs or otherwise as the Registrar may think fit. Further evidence.

Exhibits.

58. Where there are exhibits to declarations filed in an opposition, copies or impressions of such exhibits shall be sent to the other party on his request, or, if such copies or impressions cannot conveniently be furnished, the originals shall be sent to the Office, so that they may be open to inspection. The original exhibits shall be produced at the hearing unless the Registrar otherwise directs.

Hearing.

59. Upon completion of the evidence the Registrar shall give notice to the parties of a date when he will hear the arguments in the case. Such appointment shall be for a date at least fourteen days after the date of the notice, unless the parties consent to a shorter notice. Within seven days from the receipt of such notice both parties shall file Form TM No. 9. A party who receives such notice and who does not, within seven days from the receipt thereof, give notice on Form TM No. 9, that he intends to appear, may be treated as not desiring to be heard, and the Registrar may act accordingly.

Extension of time.

60. Where in opposition proceedings any extension of time is granted to any party, the Registrar may thereafter, if he thinks fit, without giving the said party a hearing, grant any reasonable extension of time to the other party in which to take any subsequent step.

Security for costs.

61. Where a party giving notice of opposition neither resides or carries on business in the United Kingdom, the Registrar may call upon him to give a security in such form as the Registrar may deem sufficient for the costs of the proceedings before the Registrar, for such amount as to the Registrar may seem fit, and at any stage in such opposition may require further security to be given at any time before giving his decision in the case.

Non-Completion.

Non-completion within 12 months.

62. Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar shall give notice to the applicant in writing in the Form O No. 1 of such non-completion, and if the applicant has an agent, shall send a duplicate of such notice to such agent. If after fourteen days from the date when such notice was sent the registration is not completed, the application shall be deemed to be abandoned, but the Registrar may with such notice, where the applicant lives at a distance, give a further time after such fourteen days for the completion of such application.

Refusal after acceptance.

Refusal after acceptance.

63. In pursuance of section 16 of the said Act the Board of Trade hereby direct that in cases where a mark has been accepted by error, the Registrar need not register the mark but may withdraw his acceptance and refuse to register, but any such refusal shall be deemed to be a refusal under sub-section 2 of section 12 of the said Act, and an applicant shall have thereafter the same right of being heard, and of appealing, as he would have had if the mark had been refused immediately upon its receipt. In any other case the Board, having regard to any special facts, will give special directions under section 16 of the said Act.

Entry on the Register.

Entry on register.

64. As soon as may be after the expiration of one month from the date of the advertisement in the Journal of any application, the Registrar shall, subject to any opposition and the determination thereof, and subject to the provisions of Rule 63, and upon payment of the prescribed fee, on Form TM No. 11, enter the trade mark on the register. The entry of a trade mark on the register shall give the date of the registration, the goods in respect of which it is registered, and all particulars named in section 4 of the Act, together with particulars of the trade, business, profession, or occupation, if any, of the proprietor, and such other particulars as the Registrar may deem necessary.

Associated marks.

65. Where a mark is registered as associated with any other mark or marks the Registrar shall note upon the register in connection with such mark the numbers of the marks with which it is associated and shall also note upon the register in connection with each of the associated marks the number of the newly registered mark as being an associated mark with each of them.

Death of applicant before registration.

66. 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 Registrar, 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, on such ownership being proved to the satisfaction of the Registrar.

Certificate of registration.

67. Upon the registration of a trade mark the Registrar shall issue to the applicant a certificate in the Form O No. 2.

Renewal.

Renewal of registration.

68. At any time not less than two months and not more than three months before the expiration of the last registration of a trade

mark any person may leave at the Office a fee for the renewal of the registration of the mark upon Form TM No. 12. Such person shall indorse upon such form his name and address, and before taking any further step the Registrar may require such person to furnish within five days an authority to pay such fee signed by the registered proprietor, and if such person does not furnish such authority, may return such fee and treat it as not received.

Notification of receipt of renewal fee.

69. When he does not require such authority, the Registrar shall upon receipt of such fee communicate with the registered proprietor at his registered address, stating that the fee has been received and that the registration will in due course be renewed.

Notice before removal of trade mark from register.

70. At a date not less than one month and not more than two months before the expiration of the last registration of a mark, if no fee upon the Form TM No. 12 has been received, the Registrar shall send to the registered proprietor at his registered address a notice in the Form O No. 3.

Second notice before removal of trade mark from register.

71. At a time not less than fourteen days and not more than twenty-eight days before the expiration of the last registration of a mark, the Registrar shall, if no renewal fee has been received, send a notice to the registered proprietor at his registered address in the Form O No. 4.

Advertisement of non-payment.

72. If at the date of the expiration of the last registration of a mark the renewal fee has not been paid, the Registrar shall advertise the fact forthwith in the Journal, and if within one month of such advertisement the renewal fee upon Form TM No. 13, together with an additional fee upon Form TM No. 14, is received, he may renew the registration without removing the mark from the register.

Removal of trade mark from register.

73. Where after one month from such advertisement such fees have not been paid, the Registrar may remove the mark from the register as of the date of the expiration of the last registration, but may upon payment of the renewal fee upon Form TM No. 13, together with the additional fee upon the Form TM No. 15, restore the mark to the register if satisfied that it is just so to do, and upon such conditions as he may think fit to impose.

Removal of mark from register.

74. Where a trade mark has been removed from the register the Registrar shall cause to be entered in the register a record of such removal and of the cause thereof.

Notice and advertisement of renewal.

75. Upon the renewal of a registration a notice to that effect shall be sent to the registered proprietor at his registered address and the renewal shall be advertised in the Journal.

Assignment.

Joint request for entry of assignment.

76. The Registrar may on request made jointly by a registered proprietor of a mark and the person to whom he has assigned such

mark, together with the goodwill of the business concerned in the goods for which it has been registered, register the assignee as proprietor of the mark. Such application shall be in the Form TM No. 16. If the Registrar so require, the assignee shall furnish a declaration in Form TM No. 17.

Request for entry of assignment by subsequent proprietor.

77. Where no such joint request is made, any person who has become entitled to a registered trade mark by assignment, transmission, or other operation of law, may leave a request at the Office for the entry of his name in the register as proprietor of such trade mark. The request shall be on the Form TM No. 18, and such request shall contain the name, address, and description of the person claiming to be entitled to the Trade Mark, hereinafter called the claimant.

Case accompanying request.

78. Together with such request the claimant shall leave a case stating full particulars of the assignment, transmission, or other operation of law by virtue of which he claims to be entitled to be entered in the register as proprietor of the trade mark, 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 goods for which the trade mark has been registered.

Signature of request.

79. Such request shall in the case of an individual be made and signed by the claimant, and in the case of a firm or partnership by one or more members of such firm or partnership, and in the case of a body corporate shall be signed by a director or by the secretary or other principal officer of such body corporate.

Statutory declaration in support of request.

80. Where the Registrar shall determine that the case sets out particulars such as entitle the claimant to be registered as proprietor of such trade mark, he shall call upon the claimant to furnish a statutory declaration (Form TM No. 19) verifying the several statements in the case and declaring that the particulars given comprise every material fact and document affecting the proprietorship of the trade mark claimed by such request.

Proof of title.

81. In any case, the Registrar may call on any person who desires to be registered as proprietor of a trade mark for such proof or additional proof of title and of the existence and ownership of such goodwill as aforesaid as the Registrar may require for his satisfaction.

Alteration of Address.

Alteration of address in register.

82. Every registered proprietor of a trade mark who alters his address shall forthwith apply to the Registrar on the Form TM

No 20 to insert the new address on the register, and the Registrar shall alter the register accordingly.

Discretionary Power.

Hearing.

83. Before exercising any discretionary power given to the Registrar by the said Act adversely to any person, the Registrar shall, if so required, hear the person who will be affected by the exercise of such power.

Application for hearing.

84. An application for a hearing shall be made within one month from the date when the matter on which the Registrar is called on to exercise discretionary power has arisen.

Notice of hearing.

85. Upon receiving such application the Registrar shall give the person applying ten days' notice of a time when he may be heard by himself or his agent.

Within five days from the date when such notice would be delivered in the ordinary course of post the person applying shall notify the Registrar whether or not he intends to be heard on the matter.

Notification of decision.

86. The decision of the Registrar in the exercise of any such discretionary power as aforesaid shall be notified to the person affected.

Applications under Section 23.

Application under section 23.

87. All applications to the Registrar under section 23 of the said Act shall be upon the Form TM No. 21. Such application shall be accompanied by a case setting out fully the facts relating to the marks which the Registrar is requested to permit an apportionment of.

Registrar to enquire and decide.

88. Upon receipt of such request and of such case the Registrar shall enquire into the facts and call for such evidence as he may deem necessary upon the subject of such application. Before giving his decision the Registrar shall, if necessary, give the parties an opportunity of attending before him at a hearing either by themselves or by their agents.

The decision of the Registrar shall be in writing.

Note in register.

89. Upon any apportionment of marks under this section the Registrar shall insert in the register a note in connection with each of the registered trade marks of the fact of such apportionment, and shall in such note refer to the date of the decision under which such apportionment has taken place.

Applications under Section 32.

Application under section 32.

90. Applications under section 32 to the Registrar may be made by the registered proprietor, or by the trustee in bankruptcy of the

registered proprietor, or where the registered proprietor is a company in liquidation by the liquidator, and in other cases by such person as the Registrar may decide to be entitled to act in the name of the registered proprietor.

Evidence.

91. Where such application is made the Registrar may require such evidence by statutory declaration or otherwise as he may think fit as to the circumstances in which the application is made.

Advertisement of application.

92. Where application is made, on Form TM No. 26, to enter a disclaimer or memorandum relating to a trade mark, the Registrar, before deciding upon such application, shall advertise the application in the Journal for one month in order to enable any person desiring so to do to state any reasons in writing against the applicant being allowed to make such disclaimer or enter such memorandum.

Applications under Section 34.

Alteration of trade mark.

93. Where a person desires to apply under section 34 to alter a trade mark he shall make his application in writing on Form TM No. 27, and shall furnish the Registrar with six copies of the mark as it will appear when altered.

Advertisement of alteration.

94. Before proceeding with such application the Registrar may call on the applicant to furnish a block suitable to advertise in the Journal the fact that such application has been made, or, if he think fit, the Registrar, without calling for a block, may insert an advertisement describing the alteration proposed in words so that it can be understood by persons interested in the matter.

Where leave is granted the Registrar may, if he is not already in possession of a block showing the trade mark as altered, cause the applicant to furnish a block showing the trade mark as altered for advertisement in the Journal, and upon receipt of such block shall forthwith advertise the mark as altered in the Journal.

Search.

Searches.

95. The Registrar, if requested so to do in writing upon a Form TM No. 28, may cause a search to be made in any class to ascertain whether any marks are on record at the date of such search which may resemble any mark sent in duplicate to him by the person requesting such search and may cause that person to be informed of the result of such search.

Hours of Inspection.

Hours of inspection.

96. The Office shall be open to the public every weekday, except Saturday, between the hours of ten and four, and on Saturday between the hours of ten and one, except on the days following :—

Christmas Day ; Good Friday ; the day observed as His Majesty's

birthday; the days observed as days of public fast or thanksgiving, or as holidays at the Bank of England; and days which may from time to time be notified by a placard posted in a conspicuous place at the Office.

Power to Dispense with Evidence.

Dispensing with evidence.

97. 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 Registrar, or at the Office, and it is shown to the satisfaction of the Registrar 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 Registrar, and upon the production of such other evidence, and subject to such terms as he may think fit, to dispense with any such act or thing, document, declaration or evidence.

Amendments.

Amendment of documents.

98. Any document or drawing or other representation of a trade mark may be amended, and any irregularity in procedure which in the opinion of the Registrar may be obviated without detriment to the interests of any person may be corrected, if the Registrar think fit, and on such terms as he may direct.

Enlargement of Time.

Enlargement of time.

99. The time prescribed by these Rules for doing any act, or taking any proceeding thereunder, may be enlarged by the Registrar, if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct, and such enlargement may be granted though the time has expired for doing such act or taking such proceeding.

Excluded days.

100. Whenever the last day fixed by the said Act, or by these Rules, for leaving any document or paying any fee at the 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.

Fees paid late by persons living at distances from Office.

101. Where a time for paying a fee is limited by these Rules and the person who is bound to pay such fee resides at such distance from the Office that he cannot reasonably be expected to pay the fee

on the date limited by the Rule, the Registrar, if satisfied that the omission to pay the fee has not been from any want of diligence on the part of the person whose business it is to pay it, may accept the fee even though the date for paying the fee has passed, and treat it as if received on the correct date, provided always that the fee is actually paid with such promptitude as can be expected in the circumstances.

Certificates.

Certificates by Registrar.

102. The Registrar, when required otherwise than under section 17 of the said Act to give a certificate as to any entry, matter, or thing which he is authorised by the said Act 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 so given shall have specified on the face thereof, whether the same is to be used in legal proceedings, or for the purpose of obtaining registration abroad, or for purposes other than use in legal proceedings or obtaining registration abroad.

Marks registered without limitation of colour.

103. Where a mark is registered without limitation of colour it shall be lawful for the Registrar to grant a certificate of its registration for the purpose of obtaining registration abroad either in the colour in which it appears upon the register or in any other colour or colours.

Certificates for use in obtaining registration abroad.

104. Where a certificate of registration is desired for use in obtaining registration abroad, the Registrar shall affix to the said certificate a copy of the mark, and shall state in such certificate such particulars concerning the registration of the mark as to him may seem fit, and may omit therefrom reference to any disclaimers appearing on the register.

Declarations.

Manner in which, and person before whom, declaration is to be taken.

105. The statutory declarations required by the said Act 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 authorised 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 His Majesty's dominions, before any court, judge, justice of the peace, or any officer authorised by law to administer an oath there for the purpose of a legal proceeding; and

(*c*) If made out of His 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.

106. Any document purporting to have affixed, impressed, or subscribed thereto or thereon the seal or signature of any person hereby authorised to take such declaration in testimony of such declaration having been made and subscribed before him, may be admitted by the Registrar without proof of the genuineness of any such seal or signature, or of the official character of such person or his authority to take such declaration.

Cutlers' Company.

Applications.

107. All applications to the Cutlers' Company for registration of a trade mark, under section 63 of the said Act, shall be in duplicate, accompanied by the prescribed fees and representations. Requests to enter old corporate marks on the Sheffield Register, under section 63 (2), should be made on Form Sheffield No. 1.

Notice to Registrar.

108. The Cutlers' Company shall, within seven days of the receipt by them of an application to register a trade mark, send the Registrar 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.

Objections by Registrar to acceptance.

109. The time within which the Registrar 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 Registrar of the notice from the said Company of the making of the application.

Advertisement of application.

110. If no such objection is made by the Registrar, the Cutlers' Company shall require the applicant to send the Registrar a wood block or electrotype as the Registrar may direct, and the Registrar shall, if satisfied with such wood block or electrotype, advertise the application in the same manner as an application made to him at the Office.

Notification to Cutlers' Company of application.

111. The manner in which the Registrar shall notify to the Cutlers' Company an application and proceedings thereon made as mentioned in sub-section 8 of section 63 of the said Act shall be by sending to the Cutlers' Company a copy of the Journal containing the application of which notice is required to be given, with a note distinguishing such application.

Similarity of proceedings in London and Sheffield.

112. 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.

Cotton Marks.

Application.

113. An application to the Manchester Branch for registration of a trade mark under section 64 of the said Act shall be in duplicate. The special Forms for cotton marks contained in the Second Schedule to these Rules shall be used. One of the Forms of application shall be stamped and the other unstamped.

One representation to be sent to Registrar.

114. The Keeper of Cotton Marks shall forthwith, on receipt of such application, send the Registrar one representation of the mark applied for.

Search.

115. As soon as may be after receiving any application the Keeper of Cotton Marks shall make a search amongst the marks on the Manchester register, in the B List, and those which have been refused and those which are pending, and shall notify to the Registrar the application and the marks, if any, which he has found so nearly resembling the mark applied for as to be calculated to deceive, and together with such notification shall send a report upon the application.

Hearings.

116. Upon considering such report, if the Registrar thinks it will be necessary to object to the acceptance of the, application, he shall give notice to the applicant of a time when he can be heard, and, within one month after hearing the applicant, may give notice to the Keeper of Cotton Marks of objection to the acceptance of the application, or that he has no objection, as the case may be. If no notice of objection, or if notice of no objection is received from the Registrar, the application shall be advertised in the Journal by the Manchester Branch.

If the applicant, being notified as aforesaid of a time for hearing, does not attend, his application shall be deemed to be refused.

Registration.

117. If the mark is advertised by the Manchester Branch and is not opposed, the Keeper of Cotton Marks may call upon the applicant for the prescribed fee for the registration of such trade mark, and upon receipt thereof shall report to the Registrar, who shall forthwith, if he think fit, register the same.

Procedure.

118. Where under the said Act or these Rules an application has to be made to the Keeper of Cotton Marks, such application shall be made and such proceedings shall be had thereon as if in these Rules the expression "Manchester Branch, 48, Royal Exchange, Manchester," were substituted for the word "Office," and the expression "Keeper of Cotton Marks" were substituted for the word "Registrar."

Service of documents.

119. Where any document is by these Rules directed to be served upon the Registrar it shall, in respect of cotton marks, be served in duplicate upon the Keeper of Cotton Marks, who shall forthwith transmit one copy to the Registrar.

Search under Rule 95.

120. Where under Rule 95 a search has to be made by the Keeper of Cotton Marks, such search shall cover all marks of which there is a right of inspection under section 64 (11) of the said Act.

Appeals to the Court.

Appeal to Court.

121. When any person intends to appeal to the Court, such appeal shall be made by motion in the usual way, and no such appeal shall be entertained unless notice of motion be given within one month from the date of the decision appealed against or within such further time as the Registrar shall allow.

Appeals to Board of Trade.

Appeal to Board of Trade.

122. When any person intends to appeal to the Board of Trade he shall, before doing so, apply to the Registrar for a hearing and obtain a decision from him upon the point raised. Within one month from the date of such decision he shall, if he is advised to appeal to the Board of Trade in any case in which an appeal is given by the said Act, leave at the Office a notice of such his intention, on Form TM No. 29.

Such notice shall be accompanied—

(1) In case the appeal concerns an application not yet advertised, by a copy of the form of application and six representations of the mark applied for and a copy of the grounds of the Registrar's decision.

(2) In case of an opposition by a copy of the decision of the Registrar, and if the appeal is by the applicant also by a copy of the form of application and six representations of the mark opposed.

(3) In other cases by a copy of the decision of the Registrar and a statement of the date of the hearing before him.

Grounds of appeal to be stated.

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

Transmission of notice.

124. A copy of the notice and all the accompanying documents shall also be forthwith sent by the appellant to the Secretary of the Board of Trade, No. 7, Whitehall Gardens, London; and where there has been an opposition before the Registrar to the opponent or applicant as the case may be.

125. The Board of Trade may thereupon give such directions (if any) as they may think fit with respect to parties and 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. Directions by Board.

126. 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 Registrar and to the appellant, and where there has been an opposition before the Registrar to the opponent or applicant as the case may be. Hearing of appeal.

127. 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 Registrar may allow, except by special leave of the Board of Trade. No appeal unless notice duly given.

Withdrawal of Appeals.

128. Where under section 12 (5) or section 14 (8) of the said Act an appellant is entitled to withdraw his appeal, such withdrawal shall be effected by notice given to the Registrar and to the other parties, if any, to such appeal within seven days after the leave referred to in such sections has been obtained. Withdrawal of appeal.

Applications to and Orders of the Court.

129. Where an order has been made by the Court in any case under the said Act, the person in whose favour such order has been made, or such one of them, if more than one, as the Registrar may direct, shall forthwith leave at the Office an office copy of such order, together with Form TM No. 30 if required. The register may, if necessary, thereupon be rectified or altered by the Registrar. Order of Court.

Every application to the Court under the said Act shall be served on the Registrar.

130. Whenever an order is made by the Court under the said Act, the Registrar may, if he thinks that such order should be made public, publish it in the Journal. Publication of order of Court.

Dated this 24th day of March, 1906.

(Sd.) D. LLOYD-GEORGE,
President of the Board of Trade.

SCHEDULES.

First Schedule.

Fees.

The following fees shall be paid in connection with applications registrations, and other matters under the Act. Such fees must in all cases be paid before or at the time of the doing of the matter in respect of which they are to be paid:—

	£	s.	d.	Correspond. ing Form.
1. On application not otherwise charged to register a trade mark for one or more articles included in one class.	0	10	0	T.M. No. 2 or 5, Cotton No. 1
1*a*. On application not otherwise charged to register a series of trade marks for one or more articles included in one class.	0	10	0	T.M. No. 2 or 5, Cotton No. 1.
1*b*. On request to the Cutlers' Company to enter a mark on the Sheffield Register under sec. 63, sub-sec. (2)	5	0	0	Sheffield No. 1.
1*c*. On application to the Board of Trade under sec. 62 for leave to register a mark for goods in one class	0	10	0	T.M. No. 6
1*d*. On application to the Board of Trade under sec. 62 for leave to register a mark for goods in more than one class—				
In respect of every class	0	10	0	T.M. No. 6
Total fee in no case to exceed £10 for any number of classes.				
2. On an application to Registrar to state grounds of decision and materials used under sec. 12, sub-sec. (3).	0	10	0	T.M. No. 4
3. On request to be heard by the Board of Trade on application to register a name, signature, word or words under sec. 9, par. (5).	1	0	0	T.M. No. 10
4. On notice of opposition for each application opposed, by opponent.	1	0	0	T.M. No. 7
4*a*. On filing a counter-statement in answer to a notice of opposition, by the applicant for each application opposed.	0	10	0	T.M. No. 8
4*b*. On the hearing of each opposition, by applicant and by opponent respectively.	1	0	0	T.M. No. 9
5. For registration of a trade mark for one or more articles included in one class.	1	0	0	T.M. No. 11
5*a*. For registration of a series of marks for one or more articles included in one class—				
For the first mark	1	0	0	T.M. No. 11
And for every other mark of the series	0	5	0	
5*b*. For registration under sec. 62 of a mark for goods in more than one class in respect of every class.	1	0	0	T.M. No. 11
Total fee not to exceed £20 for any number of classes.				
6. Upon each entry in the register of a mark of a note that the mark is associated with a newly registered mark.	0	1	0	—

	£ s. d.	Corresponding Form.
7. On application to register a subsequent proprietor in cases of assignment or transmission of a single mark.	1 0 0	T.M. No. 16 or 18.
7*a*. On application to register a subsequent proprietor of more than one mark standing in the same name, the devolution of title being identical in each case—		
For the first mark	1 0 0	T.M. No. 16 or 18.
And for every other mark...	0 2 0	
8. On application to change the name of a proprietor of a single mark where there has been no alteration in the proprietorship.	0 5 0	T.M. No. 23
8*a*. On application to change the name of a proprietor of more than one mark standing in the same name, the change being the same in each case—		
For the first mark...	0 5 0	T.M. No. 23
And for every other mark	0 1 0	
9. For renewal of registration of a mark at expiration of last registration.	1 0 0	T.M. No. 12 or 13.
9*a*. For renewal of registration of a series of marks at the expiration of last registration—		
For the first mark of the series	1 0 0	T.M. No. 12 or 13.
And for every other mark of the series ...	0 2 0	
9*b*. For renewal of a mark registered under sec. 62 for goods in more than one class—		
In respect of every class	1 0 0	T.M. No. 12 or 13.
Total fee in no case to exceed £20 for any number of classes.		
10. Additional fee under Rule 72...	0 10 0	T.M. No. 14
11. Additional fee under Rule 73...	1 0 0	T.M. No. 15
12. For altering a single entry of the address of a registered proprietor.	0 5 0	T.M. No. 20
12*a*. For altering more than one entry of the address of a registered proprietor where the address in each case is the same and is altered in the same way—	0 5 0	
For the first entry	0 5 0	T.M. No. 20
And for every other entry	0 1 0	
13. For every entry in the register of a rectification thereof or an alteration therein, not otherwise charged.	0 10 0	T.M. No. 30
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	T.M. No. 24 or 25.
15. On request, not otherwise charged, under sec. 12 (6) or under sec. 32.	0 5 0	T.M. No. 22 or 26.
16. For a search under Rule 95	0 10 0	T.M. No. 28
17. For certificate of Registrar of registration to be used in legal proceedings.	1 0 0	T.M. No. 34
18. For certificate of Registrar of the registration of a trade mark to be used for the purpose of obtaining registration abroad.	0 5 0	T.M. No. 33
18*a*. For certificate of Registrar of the registration of a series of marks for the purpose of obtaining registration abroad.	0 10 0	T.M. No. 33
19. For certificate of Registrar other than certificate under sec. 17 or certificate of registration to be used in legal proceedings, or for the purpose of obtaining registration abroad.	1 0 0	T.M. No. 31 or 32.

	£	s.	d.	Corresponding Form.
20. For certificate of Keeper of Cotton Marks	0	5	0	Cotton No. 3 or 4.
21. On appeal from Registrar to Board of Trade in respect of each decision appealed against by Appellant.	1	0	0	T.M. No. 29
22. On an application to the Registrar under sec. 23 ...	5	0	0	T.M. No. 21
23. On an application to the Registrar for leave to add to or alter a single mark.	1	0	0	T.M. No. 27
23*a*. On an application to the Registrar for leave to add to or alter more than one mark of the same proprietor, the addition or alteration to be made, in each case being the same—				
For the first mark	1	0	0	T.M. No. 27
And for every other mark	0	10	0	
24. For inspecting register in connection with any particular trade mark, for every quarter of an hour.	0	1	0	—
25. For making a search amongst the classified representations of trade marks, for every quarter of an hour.	0	1	0	—
26. For office copy of documents for every 100 words (but never less than 1*s.*).	0	0	4	—
27. For certifying office copies MS. or printed matter	0	10	0	—
28. 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	—

The fees to be paid on any proceeding at the Manchester Branch and at Sheffield (except as specially provided above) shall be the same as for the similar proceeding at the London office.

For the purpose of these fees (except as specially provided above) every mark of a series under sec. 66 of the Patents Designs and Trade Marks Act, 1883, or sec. 26 of this Act, shall be deemed to be a mark separately registered.

Dated this 24th day of March, 1906.

(Sd.) D. LLOYD-GEORGE,
President of the Board of Trade.

Approved.

(Sd.) J. HERBERT LEWIS,
CECIL NORTON,
Lords Commissioners
of His Majesty's Treasury.

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[1] The pages here inserted are those of this book, and not those actually inserted in the published Rules.

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Trade Marks Act, 1905.

Form TM No. 1.

Form of Authorisation.

Sir,

I beg to inform you that I have appointed (*a*) of to act as my agent for (*b*) .

I am, Sir,
Your obedient Servant
(*c*) ——
Address

Dated the day of 19 .

To the Registrar, Patent Office, Trade Marks Branch, 25, Southampton Buildings, Chancery Lane, London, W.C.

(*a*) Here insert name and address of agent.
(*b*) Here state the particular purpose for which the agent is appointed.
(*c*) To be signed by the person appointing the agent.

(TRADE MARKS. 10s.)

TRADE MARKS ACT, 1905.

Form TM No. 2.

Application for Registration of Trade Mark (other than Cotton Mark).

One representation to be fixed within this square, and four others to be sent on separate Forms TM No. 3.

Representations of a larger size may be folded, but must then be mounted upon linen and affixed hereto.

Application is hereby made for Registration of the accompanying Trade Mark in Class , in respect of (*a*) in the name of (*b*) of [*address and description*] trading as who claims to be the proprietor thereof (*c*). do not claim the registration of this Trade Mark under the special provisions of paragraph 5 of sec. 9 of the Trade Marks Act, 1905, in regard to names, signatures, or words.

(Signed) ——.

Dated the day of 19 .

To the Registrar, Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane, London, W.C.

(*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.

TRADE MARKS ACT, 1905.

Form TM No. 3.

Additional Representation of Trade Mark, to accompany Application for Registration (other than Cotton Mark).

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 hereto.

FOUR of these ADDITIONAL REPRESENTATIONS of the Trade Mark must accompany *each* Form of Application.

(TRADE MARKS. 10s.)

TRADE MARKS ACT, 1905.

Form TM No. 4.

Request for Statement of Grounds of Decision under Sec. 12 (3).

You are hereby requested under sub-sec. 3 of sec. 12 of the Trade Marks Act, 1905, and Rule 33 made thereunder to state in writing the grounds of your decision, dated the day of 19 , after the hearing on the day of 19 , and the materials used by you in arriving at such decision.

(Signed) ——.

Dated the day of 19 .

To the Registrar, Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane, London, W.C.

(TRADE MARKS. 10s.)

TRADE MARKS ACT, 1905.

Form TM No. 5.

Special Application for Registration of Trade Mark under Paragraph 5 of Sec. 9.

One representation to be fixed within this square, and four others to be sent on separate Forms TM No. 3.

Application is hereby made for registration of the accompanying Trade Mark in Class , in respect of (*a*) in the name of (*b*) of [*address and description*] trading as who claims to be the proprietor thereof (*c*) and desires an order of the Board of Trade or the Court directing registration of the same.

(Signed) ——.

Dated the day of 19 .

To the Registrar, Patent Office, Trade Marks Branch, 25, Southampton Buildings, Chancery Lane, London, W.C.

(*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.

(TRADE MARKS. Fee 1*s.* or 1*d.*)

TRADE MARKS ACT, 1905.

Form TM. No. 6.

Special Application for Registration of Trade Mark under Sec. 62.

(To be accompanied by an unstamped duplicate.)

One representation to be fixed within this square, and six others to be sent on separate half-sheets of foolscap.

Representations of a larger size may be folded, but must then be mounted upon linen and affixed hereto.

Application is hereby made for registration of the accompanying Trade Mark in Class , in respect of (*a*) in the name of of [*address and description*] who desire the Board of Trade under sec. 62 of the said Act to permit the registration thereof.

(Signed) ——.

Dated day of 19 .

To the Registrar, Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane, London, W.C.

(*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.

(TRADE MARKS. £1.)

TRADE MARKS ACT, 1905.

Form TM. No. 7.

Notice of Opposition to Application for Registration.

(To be accompanied by an unstamped duplicate.)

In the matter of an application, No. by of .

I,* 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 19 , No. , page .

The grounds of opposition are as follows :—

(Signed) ——.

Dated the day of , 19 .

Address for Service :—

To the Registrar, Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane, London, W.C.

* Here state full name and address.

(TRADE MARKS. 10s.)

TRADE MARKS ACT, 1905.

Form TM No. 8.

Form of Counter-statement.

(*To be accompanied by an unstampedduplicate.*)

In the matter of an Opposition, No. , to Application No. .

I the applicant for the above Trade Mark, hereby give notice that the following are the grounds on which I rely as supporting my application :—

I admit the following allegations in the notice of Opposition :—

(Signature) ——

Dated this day of , 19 .

To the Registrar, Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane, London, W.C.

(TRADE MARKS. £1.)

TRADE MARKS ACT, 1905.

Form TM No. 9.

Form of Application for Hearing by the Registrar in Cases of Opposition.

SIR,

IN reply to your Notice dated the giving of (*a*) a date on which you will hear the arguments in the case of Opposition No. to Application No. I beg to say that I intend to appear before you on the date you have fixed, namely the day of 19 .

I am, Sir,
Your obedient Servant,

To the Registrar, Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane, London, W.C.

(*a*) Here insert address.

(TRADE MARKS. £1.)

TRADE MARKS ACT, 1905.

Form TM No. 10.

Application is hereby made to the Board of Trade to hear the matter of the Application No. under Rule 38.

(Signature) ——

Dated this day of 19 .

To the Registrar, Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane, London, W.C.

Form O No. 1.

Notice of Non-completion of Registration.

No.

The Registrar has to call your attention to Sec. 18 of the Trade Marks Act, 1905, and to Rule 62 of the Trade Marks Rules made thereunder. The Section and the Rule are printed on the back hereof.

Your application numbered as above was made on the day of 19 . Registration has not been completed by reason of your default. Unless it is completed within days from this date the application will be treated as abandoned.

Dated this day of 19 .

To

The Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane, London, W.C.

(TRADE MARKS. Fee 5 or 5*a*.)

Trade Marks Act, 1905.

Form TM No. 11.

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,

(*a*) ——.

Dated the day of 19 .

To the Registrar, Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane, London W.C.

a Signature.

Trade Marks Act, 1905

Form O No. 2.

Certificate of Registration under Sec. 17.

To

I hereby certify, pursuant to Rule 67 of the Rules under the above Act, that the Trade Mark in your application No. was duly advertised in the Trade Marks Journal and has been registered in your name in Class , in respect of the goods specified by you.

Witness my hand this day of , 19 .

(Seal of Patent Office.)

Registrar.

The Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane, London, W.C.

(TRADE MARKS. Fee 9 or 9*a*.)

TRADE MARKS ACT, 1905.

Form TM No. 12.

Renewal of Registration before Notice given.

I hereby leave the prescribed fee of for the renewal of the registration of the Trade Mark No , in Class .

Dated the day of 19 .

To the Registrar, Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane, London, W.C.

N.B.—This Form must be indorsed with the name and address of the person leaving the same.

TRADE MARKS ACT, 1905.

Form O No. 3.

Notice before Removal of Trade Mark from the Register, under Sec. 30.

The Registrar hereby gives you notice that in conformity with the provisions of Sec. 30 of the above Act (printed at back hereof), your Trade Mark No. , registered in Class , will be removed from the Trade Marks Register, unless the prescribed fee of (payable by Form TM No. 13) be received at this Office *before* the day of 19 , on which date the existing registration will expire.

A stamped Form TM No. 13, for payment of the fee, may be obtained as directed at the back of this Notice, *but cannot be obtained from this Office.*

Dated this day of 19 .

To

The Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane, London, W.C.

Cheques, Money Orders, or Cash cannot be accepted in payment of fees.

TRADE MARKS ACT, 1905.

Form O No. 4.

SECOND NOTICE.

Notice before Removal of Trade Mark from the Register, under Sec. 30.

The Registrar hereby gives you notice that, in conformity with the provisions of Sec. 30 of the above Act (printed at back hereof), your Trade Mark No. , registered in Class , will be removed from the Trade Marks Register, unless the prescribed fee of (payable by Form TM No. 13) be received at this Office *before* the day of 19 , on which date the existing registration will expire.

If the above fee be not paid *before* the date above named, the Trade Mark will, after the end of one month from the date on which the omission to pay the fee has

been advertised in the Trade Marks Journal, be removed from the Trade Marks Register, unless an *additional* fee of 10*s.* (payable by Form TM No. 14) be remitted.

Stamped Forms for payment of renewal fees, may be obtained as directed at the back of this Notice, *but cannot be obtained from this Office.*

Dated this day of 19 .

To

The Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane, London W.C.

Cheques, Money Orders, or Cash cannot be accepted in payment of fees.

(TRADE MARKS. Fee 9 or 9*a.*)

TRADE MARKS ACT, 1905.

Form TM No. 13.

Renewal of Registration of Mark after Notice.

SIR,

IN pursuance of the notice received from you, I hereby transmit the prescribed fee of for Renewal of Registration of the Trade Mark No. , in Class .

Dated the day of 19 .

To the Registrar, Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane, London, W.C.

N.B.—This Form must be indorsed with the name and address of the person transmitting the same.

(TRADE MARKS. 10*s.*)

TRADE MARKS ACT, 1905.

Form TM No. 14.

Additional Fee of 10s. to accompany Renewal Fee (Form TM No. 13), within One Month after Advertisement of Non-payment of Renewal Fee.

SIR,

IN pursuance of the notices issued by you, I hereby transmit the additional fee of 10*s.* (along with Form TM No. 13) for the renewal of the Registration of the Trade Mark No. in Class .

Dated the day of 19 .

To the Registrar, Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane, London, W.C.

N.B.—This Form must be Indorsed with the name and address of the person transmitting the same.

(TRADE MARKS. £1.)

TRADE MARKS ACT, 1905.

Form TM No. 15.

Restoration of Trade Mark where removed for Non-payment of Fee.

(*To accompany Form TM No.* 13.)

SIR,

IN pursuance of the notices issued by you, I hereby transmit the additional fee of £1 (along with Form TM No. 13) for restoration to the Trade Marks Register of the Trade Mark No. in Class .

Dated the day of 19 .

To the Registrar, Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane, London, W.C.

N.B.—This form must be indorsed with the name and address of the person transmitting the same.

(TRADE MARKS. Fee 7 or 7*a*.)

TRADE MARKS ACT, 1905.

Form TM No. 16.

Joint Request by Registered Proprietor and Assignee to Register the Assignee as Subsequent Proprietor of a Trade Mark.

We, (*a*) of (*b*) , and (*c*) , of (*d*) , hereby request, under Rule 76, that the name of (*e*) , carrying on business as (*f*) , at (*g*) , may be entered in the Register of Trade Marks as proprietor of the Trade Mark No. in Class .

(*h*) ——.
(*i*) ——.

To the Registrar, Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane, London, W.C.

(*a*) Name of Registered Proprietor.
(*b*) Address of Registered Proprietor.
(*c*) Name of Assignee.
(*d*) Address of Assignee.
(*e*) Name of Assignee.
(*f*) Trade or business of Assignee.
(*g*) Address of Assignee.
(*h*) Signature of Registered Proprietor.
(*i*) Signature of Assignee.

TRADE MARKS ACT, 1905.

Form TM No. 17.

Form of Declaration (only to be furnished when requested by Registrar) by Assignee in support of Form TM No. 16.

I (*a*) of (*b*) do hereby solemnly and sincerely declare that the Trade Mark No. in Class has been assigned to me by (*c*) of (*d*)

together with the goodwill of the business concerned in the goods for which it has been registered, and that I have accepted such Assignment.

(*e*) 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.

(*f*) ——.

Declared at this day of 19 .

Before me (*g*) ——.
(*h*) ——.

[If the declaration be made before any authority other than a Justice of the Peace, it will require to be stamped with a 2*s.* 6*d.* impressed Inland Revenue Stamp.]

(*a*) Name of Assignee.
(*b*) Address of Assignee.
(*c*) Name of Assignor.
(*d*) Address of Assignor.
(*e*) This paragraph is not required when the declaration is made out of the United Kingdom.
(*f*) Signature of Assignee.
(*g*) Signature of Authority.
(*h*) Title of Authority.

(TRADE MARKS. Fee 7 or 7*a*.)

TRADE MARKS ACT, 1905.

Form TM No. 18.

Request to enter Name of Subsequent Proprietor of Trade Mark upon the Register.

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.

Accompanying this Request is a statement of (*e*) case.

(*f*) ——

Dated this day of , 19 .

To the Registrar, Patent Office, Trade Marks Branch, 25, Southampton Buildings, Chancery Lane, London, W.C.

(*a*) *Or* We. Here insert name, address, and description.
(*b*) My *or* our.
(*c*) *Or* names.
(*d*) I am *or* We are.
(*e*) My *or* our.
(*f*) Signature.

TRADE MARKS ACT, 1905.

Form TM No. 19.

Form of Declaration (only to be furnished when requested by Registrar) in support of Statement of Case accompanying Form TM No. 18.

I, , of , do hereby solemnly and sincerely declare that the particulars set out in the statement of case, exhibit marked and left by me in connection with my request to be registered as subsequent proprietor of the Trade

Mark, No. , in Class are true and comprise every material fact and document affecting the proprietorship of the said Trade Mark as above claimed.

(*a*) 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.

(*b*) ——.

Declared at this day of 19 .

Before me, (*c*) ——

——.

To the Registrar, Patent Office, Trade Marks Branch,
25, Southampton Buildings Chancery Lane, London W.C.

[If the declaration be made before any authority other than a Justice of the Peace it will require to be stamped with a 2*s.* 6*d.* impressed Inland Revenue Stamp.]

(*a*) This paragraph is not required when the declaration is made out of the United Kingdom.

(*b*) To be signed here by the person making the declaration.

(*c*) Signature and title of the authority before whom the declaration is made.

(TRADE MARKS. Fee 12 or 12*a*.)

TRADE MARKS ACT, 1905.

Form TM No. 20.

Notice of Application for Alteration of Address on Register of Trade Marks.

In the matter of the Trade Mark, No. registered in Class .

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 19 .

(*a*) ——.

To the Registrar, Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane, London, W.C.

(*a*) Signature of Proprietor.

(TRADE MARKS. £5.)

TRADE MARKS ACT, 1905.

Form TM No. 21.

Application to Permit an Apportionment of Trade Marks.

In the matter of the Registered Trade Marks No. .

We, being the parties interested within the meaning of Section 23 of the Trade Marks Act, 1905, in certain Marks of who has ceased to carry on business, request you to permit an apportionment of those Marks amongst the persons in fact continuing the business. With this application we send a case in pursuance of Rule 87.

Signed ——.

Signed ——.

Dated this day of 19 .

To the Registrar, Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane, London, W.C.

(TRADE MARKS. 5s.)

TRADE MARKS ACT, 1905.

Form TM No. 22.

Form of Request for Correction of Clerical Error or for Permission to Amend Application under Sec. 12 (6) or Sec. 32 (1).

SIR,

I HEREBY request that

(*a*) ——.

Dated this day of 19 .

To the Registrar, Patent Office, Trade Marks Branch, 25, Southampton Buildings, Chancery Lane, London, W.C.

(*a*) Signature.

(TRADE MARKS. Fee 8 or 8*a*.)

TRADE MARKS ACT, 1905.

Form TM No. 23.

Request to Enter Change of Name of Registered Proprietor of Trade Mark upon the Register.

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.

There has been no change in the actual proprietorship of the said Trade Mark but (*e*)

(*f*) ——.

Dated this day of 19 .

To the Registrar, Patent Office, Trade Marks Branch, 25, Southampton Buildings, Chancery Lane, London W.C.

(*a*) *Or* We.
Here insert name, address, and description.
(*b*) My *or* Our.
(*c*) *Or* Names.
(*d*) I am *or* We are.
(*e*) Here state the circumstances under which the change of name took place.
(*f*) Signature.

(TRADE MARKS. 5s.)

TRADE MARKS ACT, 1905.

Form TM No. 24.

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

Place of Business .

Description

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 Trade Marks of the Trade Mark No. in Class may be cancelled.

(*a*) ——.

Dated this day of 19 .

To the Registrar, Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane, London, W.C.

(*a*) Signature.

(TRADE MARKS. 5s.)

TRADE MARKS ACT, 1905.

Form TM No. 25.

Request to strike out Goods from those for which a Trade Mark is Registered.

I, of hereby request that you will strike out from the goods for which the Trade Mark No. is registered in Class .

(*a*) ——

Dated this day of 19 .

To the Registrar, Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane, London, W.C.

(*a*) Signature.

(TRADE MARKS. 5s.)

TRADE MARKS ACT, 1905.

Form TM No. 26.

Request to Enter Disclaimer or Memorandum relating to a Trade Mark.

I, of , hereby request that you will enter in the Register in connection with Trade Mark No. in Class the following , namely—

(*a*) ——.

Dated this day of 19 .

To the Registrar, Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane, London, W.C.

(*a*) Signature.

(TRADE MARKS. Fee 23 or 23*a*.)

TRADE MARKS ACT, 1905.

Form TM No. 27.

Application under Sec. 34 to Add to or Alter a Trade Mark.

In the matter of the Trade Mark No. in Class .

Application is hereby made on behalf of the registered proprietor of the Trade Mark numbered as above to alter it in the following particulars that is to say—

(Here fill in full particulars.)

Six copies of the mark as it will appear when so altered are filed herewith.

(Signed) ——

Dated this day of 19 .

To the Registrar, Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane, London, W.C.

(TRADE MARKS. 10*s*.)

TRADE MARKS ACT, 1905.

Form TM No. 28.

Request for Search under Rule 95.

You are hereby requested to search under Rule 95 in Class to ascertain whether any Trade Marks are on record which resemble the Trade Mark sent herewith in duplicate each mounted on a half-sheet of foolscap.

(*a*) ——.
(*b*) ——.

Dated this day of 19 .

To the Registrar, Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane, London, W.C.

(*a*) Signature.
(*b*) Address.

(CORPORATE MARK. £5.)

TRADE MARKS ACT, 1905.

Form Sheffield No. 1.

Request to Enter a Mark under Sec. 63, Sub-sec. (2).

You are hereby requested to register the accompanying Old Corporate Mark in Class in respect of in the name of who claims to be the proprietor thereof.

(Signed) ——.

Dated this day of 19

To the Cutlers' Company,
Cutlers' Hall, Sheffield.

COTTON MARKS. STAMP 10*s.*)

TRADE MARKS ACT, 1905.

Cotton No. 1.

Application for Registration of Trade Mark.

(See the annexed Extracts from the Trade Marks Act.)

(To be accompanied by an unstamped duplicate of this Form, and also by four Additional Representations on Form Cotton No. 2.)

One representation to be fixed within the square.

Representations of a larger size may be folded, but must then be mounted upon cloth and affixed hereto.

Application is hereby made for Registration of the accompanying Trade Mark in Class (*a*) in respect of (*b*) in the Name of Address and description (*c*) Trading as who claim to be the Proprietor thereof.

No claim of exclusive right is made to any of the letterpress appearing on the said Trade Mark except in so far as it consists of the applicant's own name and address, or the foreign equivalent thereof.

The said Trade Mark has not hitherto been used by the applicant upon or in connection with the above-mentioned goods, but is proposed to be so used [*or* (*d*) The said Trade Mark has been used by the applicant [$\frac{\text{and}}{\text{or}}$ by the predecessors in business of the applicant] upon or in connection with the above-mentioned goods since the 19].

(Signed) ——.

Dated the day of 19 .

To the Keeper of Cotton Marks, Manchester Branch of the Trade Marks Registry, 48, Royal Exchange, Manchester.

(*a*) Insert the class.

(*b*) Insert "all goods included in this class" or, if it is not desired that the registration should cover the whole class, the description of the goods.

Only goods contained in one and the same class may be set out here. A separate Application Form is required for each separate class.

(*c*) If the applicant is outside the U.K. an address for service in the U.K. must be given before the application can be proceeded with.

(*d*) Strike out the alternative paragraph which does not apply to the case.

(COTTON MARKS.) TRADE MARKS ACT, 1905.

Cotton No. 2.

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 on "Form Cotton No. 1."

Any representation of a larger size than foolscap may be folded, but must then be mounted upon cloth, and affixed hereto.

Class
Description of Goods
Length of User (if any)
Name of Applicant
Address
Description

No claim of exclusive right is made to any of the letterpress appearing on the Mark except in so far as it consists of the applicant's own name and address or the foreign equivalent thereof.

Four of these Additional Representations of the Trade Mark must accompany *each* Form of Application.

(COTTON MARKS. STAMP 5s.) TRADE MARKS ACT, 1905.

Cotton No. 3.

Request for Certificate under Sub-sec. (12) *of Sec.* 64.

SIR,

You are hereby requested to issue a certified copy of the application numbered and dated the day of , 19 , for registration in Class of the Cotton Mark of which a fac-simile is sent herewith, setting forth in such certificate the length of time of user (if any) of such Mark as stated on the application. and any other particulars you may deem necessary.

Dated this day of , 19 .

(Signed) ——.
Address ——.

To the Keeper of Cotton Marks, Manchester Branch of the Trade Marks Registry, 48, Royal Exchange, Manchester.

(COTTON MARKS. STAMP 5s.) TRADE MARKS ACT, 1905.

Cotton No. 4.

Request for Certificate of Keeper of Cotton Marks as to a Trade Mark entered in the Manchester Register.

In the matter of the Trade Mark No. in Class .

SIR,

I HEREBY request you to furnish me with your Certificate of Registration of the Mark numbered as above for use (*a*)

Dated this day of 19 .

(Signed) ——.
Address ——.

To the Keeper of Cotton Marks, Manchester Branch of the Trade Marks Registry, 48, Royal Exchange, Manchester.

(*a*) Here state the purpose for which the Certificate is required, *i.e.*, whether for use in legal proceedings, or for obtaining registration abroad, or for what other purpose.

(COTTON MARKS.) TRADE MARKS ACT, 1905.

MB No. 1.

Certificate under Sub-sec. (12) *of Sec.* 64.

Manchester Branch of the Trade Marks Registry,
48, Royal Exchange, Manchester.

It is hereby certified by the Keeper of Cotton Marks, that a true copy of the application numbered and dated the day of 19 , for registration in Class of the Cotton Mark therein referred to is contained in the paper hereto annexed and that a fac-simile of the said Mark is attached thereto, and that the length of time of user of such Mark as stated on the application is (*a*) and that the said Mark is on deposit at this office.

WITNESS my hand this day of 19 .

(Seal of Patent Office.)

Keeper of Cotton Marks.

(*a*) Space for any other particulars the Keeper may deem necessary.

(COTTON MARKS.) TRADE MARKS ACT, 1905.

MB No. 2.

General Certificate

Manchester Branch of the Trade Marks Registry,
48, Royal Exchange, Manchester.

It is hereby certified by the Keeper of Cotton Marks, that

REPRESENTATION OF TRADE MARK

WITNESS my hand this day of 19 .

(Seal of Patent Office.)

Keeper of Cotton Marks.

(TRADE MARKS. £1.) TRADE MARKS ACT, 1905.

Form TM No. 29.

Form of Appeal from the Registrar 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 Registrar of the day of 19 whereby he (*c*)

Accompanying this notice is a statement of my case for the decision of the Board of Trade.

(Signed) ——.

Dated this day of 19 .

To the Registrar, Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane, London, W.C.,
and to
[*Name of Opponent, if any*].

(*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.

(TRADE MARKS. 10s.)

TRADE MARKS ACT, 1905.

Form TM No. 30.

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 19 , it was directed that

An Office Copy of the Order of the Court is enclosed herewith.

Dated this day of 19 .

(a) ——

To the Registrar, Patent Office, Trade Marks Branch, 25, Southampton Buildings, Chancery Lane, London, W.C.

(a) To be signed by the person interested or his agent.

(TRADE MARKS. £1.)

TRADE MARKS ACT, 1905.

Form TM No. 31.

Request for General Certificate of Registrar (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 19 .

To the Registrar, Patent Office, Trade Marks Branch, 25, Southampton Buildings, Chancery Lane, London, W.C.

(a) Here set out the particulars which the Registrar is requested to certify.
(b) Signature.

(TRADE MARKS. £1.)

TRADE MARKS ACT, 1905.

Form TM No. 32.

Request for Certificate of Refusal to Register a Trade Mark

In the matter of an Application for registration of a 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 19 .

To the Registrar, Patent Office, Trade Marks Branch, 25, Southampton Buildings, Chancery Lane, London, W.C.

(a) Signature of applicant.

(TRADE MARKS. Fee 18 or 18*a*.)

TRADE MARKS ACT, 1905.

Form TM No 33.

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 19 .

To the Registrar, Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane, London, W.C.

(*a*) Here state name of country in which registration is to be sought.
(*b*) Signature.

(TRADE MARKS. £1.)

TRADE MARKS ACT, 1905.

Form TM No. 34.

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 19 .

To the Registrar, Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane, London, W.C.

(*a*) Signature.

Dated this 24th day of March, 1906.

D. LLOYD-GEORGE,
President of the Board of Trade.

THIRD SCHEDULE.

CLASSIFICATION OF GOODS.

Illustrations.

Note.—Goods are mentioned in this column by way of illustration, and not as an exhaustive list of the contents of a class.

CLASS 1.

Chemical substances used in manufactures, photography, or philosophical research, and anti-corrosives. (Such as acids, including vegetable acids; alkalies; artists' colours; pigments; mineral dyes.)

CLASSIFICATION OF GOODS—*continued.*

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.)

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.)

APPENDIX III.

CLASSIFICATION OF GOODS—*continued.*

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 metal; 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.
(*b*) Sewing cotton.

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.)

CLASSIFICATION OF GOODS—*continued.*

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.

APPENDIX III.

CLASSIFICATION OF GOODS—*continued.*

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 grass, 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, rick-cloths, 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.)

Dated this 24th day of March, 1906.

(Sd.) D. LLOYD-GEORGE,
President of the Board of Trade.

APPENDIX IV.

SUGGESTED DEFINITION CLAUSE (CLAUSE 9).

(Being a paper handed in by Mr. Ralph Griffin, Registrar of Trade Marks, to the Select Committee on the Trade Marks Bill, 1905.)

A REGISTRABLE trade mark must be of a distinctive character, so as to be adapted, in use in the trade for which it is intended, to distinguish the goods of the proprietor of the trade mark from the goods of other firms in the same trade.

The following particulars shall be deemed distinctive:—

(1) The facsimile signature of the person applying for registration.

(2) The signature of a predecessor in business of the person applying for registration if the applicant has, by agreement, the exclusive right to the use of that signature as a trade mark.

(3) The seal of a corporation.

The following particulars are not distinctive, and no exclusive right can be gained to them by registration:—

(1) A word or words which are commonly employed in the trade or which are reasonably required for use in the trade.

(2) Topographical words which may be legitimately used by more than one trader, and which actually refer to the place of manufacture or sale of the goods, or would be reasonably supposed so to do, provided that ancient names of places may be registered when the use of them by the applicant would not be deceptive.

(3) Surnames.

(4) Letters and their names.

(5) Numerals and their names.

(6) A pictorial representation of the goods or diagrams illustrating their action.

(7) Any particulars which, by rule made under this Act, the Board of Trade may declare to be open to any particular trade.

APPENDIX V.

DEFINITIONS OF A REGISTRABLE TRADE MARK UNDER THE LAWS OF CERTAIN FOREIGN COUNTRIES.

(*Being a paper handed in by Mr. Ralph Griffin, Registrar of Trade Marks, to the Select Committee on the Trade Marks Bill*, 1905.)

France.

The Law is dated 23rd June, 1857.

Art. 1.—Sont considérés comme marques de fabrique et de commerce les noms sous une forme distinctive, les dénominations, emblèmes, empreintes, timbres, cachets, vignettes, reliefs, lettres chiffres, enveloppes, et tous autres signes servant à distinguer les produits d'une fabrique ou les objets d'un commerce.

Germany.

The Law is dated 12th May, 1894. It does not define a Trade Mark, but it provides for registration and forbids the registration of certain things, thus :—

Section 4.

Die Eintragung in die Rolle ist zu versagen für Freizeichen, sowie für Waarenzeichen,

(1) Welche ausschliefslich in Zahlen, Buchstaben oder solchen Wörtern bestehen, die Angaben über Art, Zeit und Ort der Herstellung, über die Beschaffenheit, über die Bestimmung, über Preis-, Mengen- oder Gewichtsverhältnisse der Waare enthalten ;

(2) Welche in- oder ausländische Staatswappen oder Wappen eines inländischen Ortes, eines inlandischen Gemeinde- oder weiteren Kommun-alverbandes enthalten ;

(3) Welche Aergerniss erregende Darstellungen oder solche Angaben enthalten die ersichtlich den thatsächlichen Verhält-

nissen nicht entsprechen und die Gefahr einer Täuschung begründen,

which is thus translated in Commercial No. 5 (1894) (C-7393) :—

Sec. 4.—Entry in the register is to be denied to merchandise marks—

(1) Which are composed exclusively of figures, letters, or of such words as go to describe the kind, date, and place of manufacture of the goods, their nature, use, or conditions of price, quantity, or weight;

(2) Which contain home or foreign State armorial bearings, or the armorial bearings of any German town, commune, or other commercial union;

(3) Which contain representations capable of giving offence, or which convey implications which manifestly do not correspond with actual conditions, and create a danger of deception.

SWITZERLAND.

The Law is dated 26th September, 1890.

Art. 1.—"Sont considérés comme marques de fabrique et de commerce—

(1) Les raisons de commerce ;

(2) Les signes appliqués sur les produits ou marchandises industriels et agricoles ou sur leur emballage, a l'effet de les distinguer ou d'en constater la provenance."

Art. 3.—"Les armoiries publiques et tous autres signes devant être considérés comme propriété d'un Etat ou propriété publique, qui figurent sur les marques des particuliers, ne peuvent être l'objet de la protection légale.

Il est interdit de faire figurer, sur une marque de fabrique, aucune indication de nature à porter atteinte aux bonnes mœurs."

DENMARK.

The Law is dated 11th April, 1890.

It contains no definition of a trade mark.

Art. 4 says, "Varemaerket maa ikke registreres—

(1) Naar det udelukkende bestaar i Tal, Bogstaver eller Ord, som ikke have en saa fremtraedende eiendommelig Form, at det kan anses som Figurmaerke ;

(2) Naar det uden Hjemmel indeholder andet Navn eller andet Firma end Anmelderens eller navnet paa en anden Mands faste Eieudom ;

(3) Naar det indeholder offentlige Vaaben eller Maerker ;

(4) Naar det indeholder Fremstillinger, der kunne vokke Forargelse."

Art. 7 says, "Indeholder et registreret Varemaerke Tal, Bogstaver eller Ord, som ikke have en saa fremtraedende eiendommelig Form, at det kan anses Figurmaerke, eller bestaar det helt eller delvis af saadanne Tegn eller Maerker, der almindelig benyttes i visse Klasser af Forretninger, udelukkes Andre ikke Derved fra at benytte de samme Betegnelser som Varemaerke eller Del af et saadant."

Which may be translated thus:—

Art. 4.—A trade mark cannot be registered—

(1) When it consists exclusively of numbers, letters, or words, which do not possess such a distinctive form as to qualify them to be considered as figure-marks;

(2) When it contains without due warrant another name or another firm than that of the applicant, or the name of another person's (landed) estate;

(3) When it contains public armorial bearings or signs;

(4) When it contains statements which might give rise to offence.

Art. 7.—If a registered trade mark contains numbers, letters, or words, which do not possess so distinctive a form as to qualify them to rank as figure marks, or if it is composed entirely or in part of such signs or marks as are of common employment in certain branches of trade, other persons cannot be thereby prevented from making use of the same indications as their trade mark, or as a portion thereof.

United States of America.

The law is one approved 20th February, 1905.

There is no exact definition of a trade mark, but sec. 5 states:—

(1) That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade mark on account of the nature of such mark unless such mark—

(a) consists of or comprises immoral or scandalous matter;

(b) consists of or comprises the flag or coat-of-arms or other insignia of the United States, or any simulation thereof, or of any State or municipality, or of any foreign nation: Provided that trade marks which are identical with a registered or known trade mark owned and in use by another, and appropriated to merchandise of the same descriptive properties, or which so nearly resemble a registered or known trade mark owned and in use by another, and appropriated to merchandise of the same

descriptive properties, as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers, shall not be registered: Provided that no mark which consists merely in the name of an individual firm, corporation, or association, not written, printed, impressed, or woven in some particular or distinctive manner or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods or merely a geographical name or term, shall be registered under the terms of this Act. Provided further, that no portrait of a living individual may be registered as a trade mark, except by the consent of such individual, evidenced by an instrument in writing: and provided further, that nothing herein shall prevent the registration of any mark used by the applicant or his predecessors or by those from whom title to the mark is derived in commerce with foreign nations or among the several States, or with Indian tribes, which was in actual and exclusive use as a trade mark of the applicant or his predecessors from whom he derived title for ten years next preceding the passage of this Act.

APPENDIX VI.

INTERPRETATION ACT, 1889, EXTRACTS FROM.

SEC. 1.—(1) In this Act and in every Act passed after the year 1850, whether before or after the commencement of this Act, unless the contrary intention appears,

(a) Words importing the masculine gender shall include females; and

(b) Words in the singular shall include the plural, and words in the plural shall include the singular.

Sec. 2.—(1) In the construction of every enactment relating to an offence punishable on indictment or on summary conviction, whether contained in an Act passed before or after the commencement of this Act, the expression 'person" shall, unless the contrary intention appears, include a body corporate.

Sec. 3.—In every Act passed after the year 1850, whether before or after the commencement of this Act, the following expressions shall, unless the contrary intention appears, have the meanings hereby respectively assigned to them, namely,

The expression "month" shall mean calendar month;

The expressions "oath" and "affidavit" shall, in the case of persons for the time being allowed by law to affirm or declare instead of swearing, include affirmation and declaration, and the expression "swear" shall, in the like case, include affirm and declare.

Sec. 12.—(3) The expression "High Court," when used with reference to England or Ireland, shall mean Her Majesty's High Court of Justice in England or Ireland, as the case may be.

Sec. 14.—In every Act passed after the commencement of this Act, unless the contrary intention appears, the expression "rules of "Court" when used in relation to any court shall mean rules made by the authority having for the time being power to make rules or orders regulating the practice and procedure of such court, and as regards Scotland shall include Acts of adjournal and Acts of sederunt.

The power of the said authority to make rules of court as above defined shall include a power to make rules of court for the purpose

of any Act passed after the commencement of this Act, and directing or authorising anything to be done by rules of court.

Sec. 19.—In this Act and in every Act passed after the commencement of this Act, the expression "person" shall, unless the contrary intention appears, include any body of persons corporate or unincorporate.

Sec. 20.—In this Act and in every other Act, whether passed before or after the commencement of this Act, expressions referring to writing shall, unless the contrary intention appears, be construed as including references to printing, lithography, photography, and other modes of representing or reproducing words in a visible form.

Sec. 21.—In this Act and in every other Act, whether passed before or after the commencement of this Act, the expression "statutory declaration" shall, unless the contrary intention appears, mean a declaration made by virtue of the Statutory Declarations Act, 1835.

Sec. 31.—Where any Act, whether passed before or after the commencement of this Act, confers power to make, grant, or issue any instrument, that is to say, any order in Council, order, warrant, scheme, letters patent, rules, regulations, or bye-laws, expressions used in the instrument, if it is made after the commencement of this Act, shall, unless the contrary intention appears, have the same respective meanings as in the Act conferring the power.

Sec. 32.—(1) Where an Act passed after the commencement of this Act confers a power or imposes a duty, then, unless the contrary intention appears, the power may be exercised and the duty shall be performed from time to time as occasion requires.

(2) Where an Act passed after the commencement of this Act confers a power or imposes a duty on the holder of an office as such, then, unless the contrary intention appears, the power may be exercised and the duty shall be performed by the holder for the time being of the office.

(3) Where an Act passed after the commencement of this Act confers a power to make any rules, regulations, or bye-laws, the power shall, unless the contrary intention appears, be construed as including a power exercisable in the like manner and subject to the like consent and conditions, if any, to rescind, revoke, amend, or vary the rules, regulations, or bye-laws.

Sec. 36.—(1) In this Act and in every Act passed either before or after the commencement of this Act, the expression "commencement," when used with reference to an Act, shall mean the time at which the Act comes into operation.

(2) Where an Act passed after the commencement of this Act or

any order in Council, order, warrant, scheme, letters patent, rules, regulations, or bye-laws made, granted, or issued under a power conferred by any such Act, is expressed to come into operation on a particular day, the same shall be construed as coming into operation immediately on the expiration of the previous day.

Sec. 37.—Where an Act passed after the commencement of this Act is not to come into operation immediately on the passing thereof, and confers power to make any appointment, to make, grant, or issue any instrument, that is to say, any order in Council, order warrant, scheme, letters patent, rules, regulations, or bye-laws, to give notices, to prescribe forms, or to do any other thing for the purposes of the Act, that power may, unless the contrary intention appears, be exercised at any time after the passing of the Act, so far as may be necessary or expedient for the purpose of bringing the Act into operation at the date of the commencement thereof, subject to this restriction, that any instrument made under the power shall not, unless the contrary intention appears in the Act, or the contrary is necessary for bringing the Act into operation, come into operation until the Act comes into operation.

Sec. 38.—(1) Where this Act or any Act passed after the commencement of this Act repeals and re-enacts, with or without modification, any provisions of a former Act, references in any other Act to the provisions so repealed shall, unless the contrary intention appears, be construed as references to the provisions so re-enacted.

(2) Where this Act or any Act passed after the commencement of this Act repeals any other enactment, then, unless the contrary intention appears, the repeal shall not—

(a) revive anything not in force or existing at the time at which the repeal takes effect; or

(b) affect the previous operation of any enactment so repealed or anything duly done or suffered under any enactment so repealed; or

(c) affect any right, privilege, obligation, or liability acquired, accrued, or incurred under any enactment so repealed; or

(d) affect any penalty, forfeiture, or punishment incurred in respect of any offence committed against any enactment so repealed; or

(e) affect any investigation, legal proceeding, or remedy in respect of any such right, privilege, obligation, liability, penalty, forfeiture, or punishment as aforesaid;

and any such investigation, legal proceeding, or remedy, may be instituted, continued, or enforced, and any such penalty, forfeiture, or punishment may be imposed, as if the repealing Act had not been passed.

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